

### Abstract

The issuance of two invitations to pay additional fees, resulting from a lack of unity of invention determination, was procedurally incorrect because the second invitation, cancelling the first invitation, was outside the allowable time limit for an ISA to deliver such an invitation. The additional fees were thus reimbursable to the applicant.

## **EPO boards of appeal decisions**

**Date of decision 19 February 1992**

### **Summary of Facts and Submissions**

I. An invitation to pay additional fees pursuant to Article 17(3)(a) PCT was issued on 1 October 1991 by the European Patent Office in its capacity as International Searching Authority (ISA). Together with the invitation a "notification" was issued, according to which an earlier "communication" of 30 May 1991 had contained a number of errors. The ISA informed the applicant that it therefore had decided to issue a modified invitation, cancelling and replacing the invitation of 30 May 1991.

II. The Applicants paid the additional fees in accordance with the May invitation under protest by letter dated 20 June 1991. This protest is handled by this Board of Appeal under file No. W 28/91.

III. In the present case, in accordance with the October invitation, the Applicants paid the additional fees under protest on 5 November 1991. They argue in support of their protest only with regard to the objections as to unity of invention.

### **Reasons for the Decision**

1. The protest is admissible.
2. Although the Applicants have not argued in their protest on any formal aspects of the second invitation, the Board has of its own motion examined the issue of whether an invitation can be validly cancelled and replaced by a second invitation, although a protest is already pending before a Board of Appeal with regard to the first invitation.
3. Under the Patent Cooperation Treaty (PCT) protests shall be examined by a three-member board or other special instance of the International Searching Authority (ISA) or any other competent higher authority, which may order reimbursement of fees to the extent it finds the protest justified (Rule 40.2 (c))

PCT). The three-member board, special instance or other authority referred to in paragraph (c) shall not comprise any person who made the decision which is the subject of the protest (paragraph (d)).

4. The European Patent Convention (EPC) contains provisions with regard to International applications filed under the PCT, as well as with regard to the European Patent Office (EPO) acting as an ISA (Articles 150 - 158 EPC). In proceedings before the EPO relating to such International applications, the provisions of the PCT apply, supplemented by the provisions of the EPC (Article 150(2) EPC). In case of conflict between the two, the PCT shall prevail. The EPO acts as an ISA under Article 154 EPC. Under Article 154(3) EPC, the Boards of Appeal are responsible for deciding on a protest made by an applicant against an invitation to pay additional fees under Article 17, paragraph 3(a) of the PCT.

5. The EPO acting as an ISA may issue invitations to pay additional fees at any time during the search period of three months provided for under Article 18 and Rule 42 PCT. Apart from Rule 40.2, the PCT does not contain any provisions on the procedural significance of a protest. Consequently, the provisions given in the EPC may supplement the PCT in this regard. The provisions of the EPC on appeals and appeal procedure are based on generally recognised principles of procedural law. Appeals under the Appeal (Article 21 EPC). Protests under the PCT are also to be examined by a separate instance, (Rule 40.2(c) PCT). By analogy, protest cases are therefore to be considered and treated as appeals within the framework of the provisions of the EPC on appeals and appeals procedure, provided that no conflict arises between the two treaties.

6. Under Article 106(1) EPC, an appeal has suspensive effect, i.e. the decision under appeal is temporarily disregarded. A further effect is that a higher authority becomes exclusively competent to examine the appeal (Article 21 EPC). It is a generally recognised principle of procedural law that through the appeal the lower instance is severed from the case (the principle of devolutive legal remedy). To the extent that its decision has been appealed, the lower instance no longer has any power to amend, replace or cancel its decision, at least as long as the appeal is still pending before the appellate instance.

7. Given the above analogy, the first invitation of May 1991 to pay additional fees having been the object of a protest (corresponding to an appeal) could not validly be replaced by the second invitation of October 1991. This holds true even when recognising that the ISA is entitled under the PCT to issue as many invitations as it sees fit within the stipulated period, because the May invitation itself was no longer within the jurisdiction of the ISA as from the date of the

protest. In replacing the May invitation the ISA consequently violated a basic principle of procedural law.

8. The Boards of Appeal have long recognised that decisions may be invalid for violation of formal requirements or generally recognised principles of law. Decisions J 4/85, (OJ EPO 1986, 205, point 3) and T 13/87 of 17 May 1988 (not published in the OJ EPO) both deal with acts done by an incompetent body. As concluded in T 13/87, point 2, such acts are considered *ultra vires* and of no legal effect. A violation of this kind is of such grave importance that the decision as a whole must be considered null and void *ab initio*, i.e. to be a nullity which is to be treated as if it never took place. The decision, being considered as non-existent, cannot be set aside, but must be formally declared null and void.

As from the lodging of the protest of 20 June 1991 the ISA was no longer competent with regard to the first invitation, the decision to set it aside and replace it with a second invitation was invalid *ab initio*. Consequently, the additional fees paid under protest must be reimbursed.

## **ORDER**

For these reasons, it is ordered that:

1. The invitation of 1 October 1991 is declared null and void *ab initio*.
2. The reimbursement of the fees paid under protest with regard to the invitation of 1 October 1991 is ordered.