

Abstract

The additional search fees and the protest fee must be paid in the allotted timeframe. Failure to do so will lead to a denial of the protest.

EPO boards of appeal decisions

Date of decision 11 April 1988

Summary of Facts and Submissions

- I. The Applicant filed international patent application PCT/GB.... on 16 July 1987.
- II. On 30 September 1987, the EPO, acting as International Search Authority (ISA), sent to the Applicant an invitation to pay additional search fees in accordance with Article 17(3)(a) and Rule 40.1 PCT because it considered that the application did not comply with the requirements of unity of invention, since it contained, besides the invention first mentioned, two additional inventions. Furthermore, the invitation also stated that the Applicant was invited within 30 days from the date of mailing (i.e. by 30 October 1987) to pay the additional fees and that, in accordance with Rule 40.2(c) PCT, such payment could be made under protest.
- III. The Applicant paid the search fees for the two additional inventions on 22 October 1987. Moreover, in a letter received at the EPO on 3 November 1987, the Appellant communicated his intention to pay these fees under protest. This letter also contained a reasoned statement within the meaning of Rule 40.2(c) PCT.
- IV. Subsequently, the protest has been referred to this Board of Appeal.

Reasons for the Decision

1. In accordance with Article 154(3) EPC and Article 9 of the Agreement between WIPO and EPO under the PCT (cf. OJ EPO 1985, 320), the Boards of Appeal are responsible for deciding on the protest raised by the Applicant.
2. Pursuant to Article 17(3)(a) PCT, the ISA shall establish the international search report on the parts of the international application which relate to the additional inventions, provided the corresponding fees have been paid within the prescribed time limit. In the present case, a time limit of 30 days from the date

of mailing has been granted by the EPO, which is consistent with the provisions of Rule 40.3 PCT.

3. Rule 40.2(c) PCT offers the Applicant the possibility to pay the additional fees under protest, "that is, accompanied by a reasoned statement to the effect... that the amount of the required additional fee is excessive". Consequently, if the Applicant wishes to pay the additional fees under protest, these fees must be accompanied by the reasoned statement that sets out the protest. Since, according to Article 17(3)(a) and Rule 40.3 PCT, these fees have to be paid within a specified time limit, it is also clear that the protest must be made within the same time limit.

4. The fees regarding the two additional inventions were paid in time. According to Article 17(3)(a) PCT, the EPO is therefore also obliged to establish the international search report on those parts of the present international application which relate to these additional inventions.

5. In opposition to that, the reasoned statement, indicating the grounds on which the Applicant's protest is based, must be considered as late because it was not received by the EPO until after the accorded time limit of 30 days had expired. Consequently, the Applicant's protest under Rule 40.2(c) PCT has to be dismissed as inadmissible.

6. Under these circumstances, the additional fees paid by the Applicant shall not be refunded.

7. It should be noted, however, that the above findings are subject to the possible application of Article 48 PCT to the facts of the present case. Furthermore, in relation to Article 48(2) and Rule 82bis PCT, Article 122 EPC, which provides for the possibility of re-establishment of rights, is applicable as well. In case an application for restitutio in integrum is made, the department competent to decide on the omitted act shall decide upon this application (Article 122(4) EPC).

ORDER

For these reasons, it is decided that:

The protest under Rule 40.2(c) PCT is dismissed as inadmissible.