

Abstract

The invitation by the ISA to pay additional search fees was unjustified for lack of reasoning and proper legal basis.

EPO boards of appeal decisions

Date of decision 14 April 1989

Summary of Facts and Submissions

I. The Applicant filed International patent application PCT/US.... on 6 January 1988.

II. On 9 May 1988, the European Patent Office (EPO), acting as International Search Authority (ISA), sent to the Applicant an invitation to pay three additional search fees in accordance with Article 17(3)(a) and Rule 40.1 PCT.

The invitation indicated that the ISA considered that the application did not comply with the requirements of unity of invention for the following reasons:

"The general problem underlying the invention is not novel and a solution to it has already been found or does not involve an inventive step having regard to the state of the art as illustrated by US-A-3 835 822 and JP-A-55 109 758.

Therefore, the original single general inventive concept is not acceptable anymore, making it necessary to reconsider the technical relationship or interaction between the different solutions mentioned.

This leads to their regrouping under distinct subjects as listed below, each subject now falling under its own inventive concept, being a solution to the problem in a way that differs from the state of the art.

1. Claims 1-5, 27-29:

cooler with water hose concentric to fuel line

2. Claims 6:

cooler with helically wound water hose around fuel line

3. Claims 7-11, 15-26:

cooler with means for clamping water hose into heat transfer relation with fuel line

4. Claims 12-14:

cooler with water hose and rubber hose with fuel passage therethrough."

III. In his telex of 23 June 1988, afterwards confirmed by a letter received on 27 June 1988, the Applicant informed the ISA of his intention to pay one additional search fee for establishing a search report on that part of the application which relates to the invention mentioned in Claims Nos. 7 to 11 and 15 to 26 under protest (Rule 40.2(c) PCT). Furthermore, the Applicant protested against the fact that the basis for the non-unity determination included the contention that the single, general inventive concept underlying the overall application was allegedly not novel and did not involve an inventive step in the light of the art cited in the invitation.

IV. Subsequently, the protest has been referred to this Board of Appeal.

Reasons for the Decision

1. Pursuant to Article 154(3), the Boards of Appeal are responsible for deciding on the protest raised by the Applicant against the additional search fee charged by the EPO under Article 17(3)(a) PCT.

2. The protest complies with Rule 40.2(c) PCT and is, therefore, admissible.

3. Having regard to the reasons given in the invitation for payment of additional fees the following has to be observed:

3.1 In the present case, the reasons cited in the invitation by the ISA should be interpreted as meaning that the subject-matter of Claim 1 is not novel or does not involve an inventive step in the light of the state of the art known from US-A-3 835 822 and JP-A-55 109 758, and that, therefore, the various remaining subjects do not relate anymore to a group of inventions so linked as to form a single general inventive concept.

3.2 When assessing novelty, the documents of the relevant prior art should be considered separately according to the Guidelines for International Search (WIPO) to be carried out under the Patent Cooperation Treaty (PCT) dated 18 November 1977. Consequently, it is not permissible to combine or mosaic separate documents together (Chapter VI- 2.1). On the other hand, a document takes away the novelty of any subject-matter explicitly contained therein (Chapter VI-2.2).

The present invitation, however, does not indicate which of the above-mentioned two documents represents the relevant prior art and which is capable of being of assistance in determining that the claimed invention is not new (cf. PCT Rule 33.1(a)) as each of these documents concerns a different subject, namely:

- a cooled fuel pump for internal combustion engines (US-A-3 835 822) and
- a fuel cooler of automobile engine (JP-A-55 109 758).

3.3 The Guidelines for International Search (WIPO) also point out (Chapter VII-2.) that the invitation must specify the reasons why the international application is not deemed to relate to a single inventive concept and must indicate the individual inventions.

The invention as claimed relates to a fuel line cooler for a marine propulsion system having a water-cooled internal combustion engine in a heat-retentive compartment. According to the application, the problem to be solved seems to be to prevent the vaporization of the fuel: cf. page 1, lines 19 and 20.

The ISA, however, enumerated in its invitation two subjects without specifying what are the characteristics of the diverse subject-matter to be examined after the expected elimination of Claim 1, depriving them from being considered as falling under a common inventive concept.

3.4 Therefore, having regard to decisions of Boards of Appeal of the EPO, according to which decisions the indication of reasons in any invitation pursuant to Article 17(3)(a) and Rule 40.1 PCT is an essential prerequisite for such an invitation to be legally effective (cf. W 04/85, W 07/86 and W 09/86 - OJ EPO, 1987, 63, 67 and 459), the mere enumeration of the different subjects even together with the statement that the original single general inventive concept is not acceptable and that each subject now falls under its own inventive concept, does not make the absence of a single general inventive concept "perfectly clear".

The reasons given by the ISA in the invitation do not enable the Applicant and the Board to establish whether the invitation to pay the additional fees was correctly issued.

4. Accordingly, the invitation lacks legal basis because it contravenes Rule 40.1 PCT read in conjunction with Rule 13.1 PCT, and thus cannot have any legal effect. Therefore, the additional search fee cannot be retained.

ORDER

For these reasons, it is decided that:

Refund of the additional search fee is ordered.