

Abstract

Protest of the payment of an additional search fee. Appeal of the decision by the ISA on lack of unity of invention. The protest was justified because the multiple inventions were conceptually very close and the international search could be carried out with negligible additional effort.

Summary of Facts and Submissions

I. Following the filing of International Patent Application No. PCT/GB.... the EPO, acting as ISA, issued an invitation to pay 2 additional search fees because it considered that the application did not comply with the requirement of unity of invention, having regard to 6 prior art documents cited in the application. The ISA stated that methods for dehalogenating halogenated organic compounds with the aid of metal chelate complexes of macrocyclic tetrapyrrolic compounds were already known as demonstrated by the cited documents. The remaining technical problem of proposing further methods for dehalogenating a halogenated organic compound being characterised by the step of causing the compound to react with a reducing agent in the presence of a metal complex of a macrocyclic tetrapyrrolic compound, was solved by specifying three structurally different classes of such macrocyclic tetrapyrrolic compounds, which had no new structural feature in common. Thus the application was directed to three different solutions to the above technical problem which were not based on a single general inventive concept, i.e. the application lacked unity of invention.

The invitation further contained a "preliminary remark" according to which Claims 17 to 19 and 23 of the application did not satisfy the requirement of Art. 6 PCT.

II. The Applicant paid the two additional fees in due time under protest. He accepted that the only common technical feature of the four alternative processes comprised by Claim 1 of the application was that the dehalogenation agents all contained a macrocyclic pyrrole ring system and that this feature already belonged to the state of the art. He submitted, however, that this feature did in fact represent the single general inventive concept unifying all four alternative processes.

The Applicant further contested the correctness of the ISA's statement in the above "preliminary remark". He requested the reimbursement of the two additional search fees and the withdrawal of the above "preliminary remark".

Reasons for the Decision

1. As far as the request for reimbursement of the additional search fees is concerned, the protest is admissible.
2. In the Board's judgment the objection raised by the ISA in this respect relates to non-unity a posteriori.

According to the Guidelines for International Search to be carried out under The Patent Cooperation Treaty (hereinafter cited as "the Guidelines"), which are binding for the EPO acting as an ISA (see the decision G 1/89 of the Enlarged Board of Appeal of 2 May 1990, OJ EPO 1991, 155), Chapter VII, 9, lack of unity of invention may be directly evident "a priori", i.e., before considering the claims in relation to any prior art, or may only become apparent "a posteriori", i.e. after taking the prior art into consideration. Thus the Guidelines do not make any difference between prior art already acknowledged in the patent application and prior art found during the international search with respect to the question whether or not an objection of lack of unity of invention was raised "a priori" or "a posteriori". The only distinguishing feature is whether or not prior art had been taken into consideration, which is the case here (see paragraph I above).

3. In its decision G 1/89 referred to above the Enlarged Board of appeal has established two conditions which must be met if an invitation to pay additional search fees is based upon an objection of lack of unity of invention "a posteriori", namely that such "a posteriori" considerations should only be applied with a view to give the applicant fair treatment and that additional fees should only be charged in clear cases.

3.1 In the Board's judgment, the present application clearly lacks unity of invention, since the four alternatives comprised by Claim 1 relate to a further development of the state of the art in different directions, namely by employing different classes of dehalogenation agents having no new technical feature in common. The Board cannot share the Applicant's view that the "single general inventive concept" addressed in Rule 13.1 PCT need not be represented by a new technical feature present in all claimed alternatives, since if one would accept this standpoint the possibility of raising an objection of lack of unity of invention "a posteriori", which is expressly mentioned in the Guidelines, would become substantially meaningless. Therefore, in the present case, where already at least one solution of the underlying technical problem, which was correctly identified by the ISA as acknowledged by the Applicant, formed part of the state of the art, the requirement of a "single general inventive concept" implies that the further solutions to that problem proposed in the application must have at least one new element in common, this new element being normally represented by at least one new technical feature. Since the absence of such a unifying new

technical feature was admitted by the Applicant, the application relates to more than one invention.

3.2 However, the Guidelines also state in paragraph 11 that, for reasons of economy, the search for the main invention should be extended to cover the additional inventions as well, as far as the same classification units are concerned. In addition, paragraph 12 of the Guidelines states that the search should be completed for all inventions and that no objection of lack of unity of invention should be raised if e.g. the inventions are conceptually very close and none of them requires search in additional classification units, so that the international search for all inventions can be carried out with negligible additional effort. In such a situation, therefore, the charging of additional search fees would, in the Board's judgment, be contrary to the principle of giving the applicant fair treatment.

3.3 In this respect, the Applicant submitted that there is a close structural similarity between the four types of dehalogenating agents and that all alternatives of the claimed method relate to the same narrow technical field of dehalogenation. Moreover, at least one of the cited documents related to examples for three of the four alternative subclasses of pyrrole macrocycles, thus demonstrating that these alternatives belonged together. Therefore the Board is satisfied that in the present case the three inventions identified by the ISA are indeed conceptually very close and that, consequently, the condition of paragraph 12 of the Guidelines is met. There is nothing in the invitation or in the International Search Report which would support a different conclusion.

4. According to Art. 154(3) EPC the Boards of Appeal are responsible for deciding on a protest made by an applicant against an additional search fee charged by the EPO under the provisions of Art. 17(3)(a) of the PCT. However, the "preliminary remark" in the Invitation in fact relates to Art. 6 PCT or to Art. 17(2)(a) and (b) PCT, respectively, as can be seen from the International Search Report (see Supplemental Sheet B, last paragraph) and the Invitation, page 1, fourth paragraph. Therefore, the Board is not competent to deciding on the Applicant's request to withdraw said "preliminary remark". Moreover, there is no provision in the PCT for a protest against the ISA's actions pursuant to Art. 17(2) PCT. In this respect, therefore, the protest is inadmissible.

ORDER

For these reasons it is decided as follows:

1. Reimbursement of the additional search fees is ordered.

2. The request to withdraw the "preliminary remark" is rejected as inadmissible.