

Abstract

Protest of the payment of an additional search fee. Appeal of the decision by the ISA on lack of unity of invention. Protest was justified because invitation was issued improperly.

EPO boards of appeal decisions

Date of decision 7 November 1990

Summary of Facts and Submissions

- I. On ... the applicants filed international patent application No. ... under the Patent Cooperation Treaty.
- II. On ... the Hague branch of the European Patent Office acting as International Searching Authority sent the applicants an invitation to pay four additional search fees within 30 days of the said despatch date, stating its view that the international application failed to fulfil the unity-of-invention requirement.
- III. In support of its invitation the International Searching Authority pointed out that the subject-matter of Claims 1 and 2 formed part of the prior art known from EP-A-0 190 416 and that the application had been found "a posteriori" to lack unity. In particular, it covered five different inventions reflected in the following five groups of claims:
 1. Claims 1 to 3, 8, 13 and 14 (insofar as dependent on 1 to 3);
 2. Claims 4, 8, 13 and 14 (insofar as dependent on 4);
 3. Claims 5 to 7, 8, 13 and 14 (insofar as dependent on 5 to 7);
 4. Claims 9 to 12, 13 and 14 (insofar as dependent on 9 to 12);
 5. Claims 15 to 18 In particular, it was argued that the subject-matters of the first group of claims lacked unity in themselves - although that objection could be disregarded since the subject-matters were obviously not patentable - and that the substances claimed in the second group of claims differed so fundamentally from those specified in Claims 2 and 3 that they constituted another type of solution.

IV. On 12 September 1988 the International Searching Authority notified the applicants by telephone that the time limit for payment of the additional fees was due to expire on 13 September. In a letter dated 12 September 1988 and received by the International Searching Authority on 13 September 1988 the applicants paid an additional search fee under protest, but without specifying the group of claims for which it was intended. On 13 December 1988 the applicants requested that the search for which an additional fee had been paid be extended to the second group of claims.

V. In support of their protest the applicants asserted essentially that the invention consisted of a synergic combination of the following additives: - surface-active substances/compounds, - substances/compounds which act as catalysts or bind heavy metals, and - alkaline substances. The essence of the invention was therefore contained in Claims 5, 6, 7, 9, 10, 11 and 12.

Reasons for the Decision

1. Admissibility of the additional fee payment and of the protest. 1.1 Compliance with the time limit provided for in Article 17(3)(a) in conjunction with Rule 40.3 PCT. 1.1.1 Under Rule 80.3 and 80.5 PCT, the 30-day period set by the International Searching Authority in its invitation dated 12 August 1988 expired on Monday, 12 September 1988. However, the additional search fee and the protest were not received by the International Searching Authority until 13 September 1988. 1.1.2 The (incorrect) information which the International Searching Authority gave the applicants on 12 September 1988 to the effect that the time limit only expired on 13 September 1988 may be interpreted as granting an extension of the time limit. Rule 40.3 PCT is worded as follows: "The time limit provided for in Article 17(3)(a) shall be fixed, in each case, according to the circumstances of the case, by the International Searching Authority; it shall not be shorter than 15 or 30 days, respectively, depending on whether the applicant's address is in the same country as or in a different country from that in which the International Searching Authority is located, and it shall not be longer than 45 days, from the date of the invitation." The provision whereby the time limit is fixed in each case according to the circumstances of the case means that the International Searching Authority is empowered to extend a time limit as originally set if the circumstances justify it (naturally taking account of the 45-day limit). Under the particular circumstances, therefore, the additional fee was paid, and the protest received, in due time. 1.2 Designation of the group of claims for which the additional search fee was paid. 1.2.1 The applicants designated the group of claims specified by the International Searching Authority, for which an additional search was to be carried out, not straight away when paying the relevant fee, but only three months later on 13 December 1988. 1.2.2 The Board believes that, in the absence of any relevant provision in

the PCT, failure to designate the group of inventions for which a search report is to be drawn up cannot render the payment of additional fees inadmissible. 1.2.3 One of the objectives of the Patent Cooperation Treaty is to have the international search report published with the international application (Rule 48.2(a)(v) PCT). It is therefore important that additional searches already deferred on account of the time limit granted to the applicant for his reply should not be further delayed simply because the applicant has failed to pay all the additional fees and to specify which parts of his application require an additional search. Under Article 17(3)(a) PCT a "normal" search report is established on those parts of the international application relating to the invention first mentioned in the claims ("main invention"). The Board therefore takes the view that, unless the applicant himself has expressly requested otherwise, the first additional search is to be established on the next invention defined in the claims and specified in the International Searching Authority's invitation. For the protest to be admissible, therefore, the invention requiring the additional search did not need to be designated within the time limit for payment.

2. Merits of the protest

2.1 The Board notes that in the grounds for their protest the applicants do not dispute the lack of unity of the subject-matters of the claims as filed but maintain only that the essence of the invention consists in a combination of features which have nevertheless been claimed separately from each other, particularly by virtue of the numerous alternative formulations in the claims.

2.2 The applicants are quite at liberty to choose the version of the claims to be taken as the basis for the international search under Article 15(3) PCT. If, as here, they decide to claim not only a combination of features but also the individual elements thereof, they cannot argue the unity of the entire combination in order to demonstrate the existence of a single general inventive concept between the individual elements. The applicants' further argument that the essence of the invention was contained in Claims 5, 6, 7, 9, 10, 11 and 12 is irrelevant since the subject-matter in question belongs to none of the groups of inventions for which a search fee has been paid. Under these circumstances, the applicants' arguments as set out in the grounds for their protest are unacceptable. The Board has therefore of its own motion examined whether the invitation to pay the additional search fees was justified, bearing in mind the PCT's provisions relating to unity of invention.

2.3 "A posteriori" lack of unity 2.3.1 The International Searching Authority did not question "a priori" the unity of the invention defined by the claims in the international application. On the other hand it considered that the subject-matter of Claims 1 and 2 had been anticipated by EP-A-0 190 416, so that the other

claims related to five different groups of inventions ("a posteriori" lack of unity). Before examining whether these groups of inventions form a single general inventive concept within the meaning of Rule 13.1 PCT it will first be necessary to determine whether, for the purpose of establishing the international search report, the International Searching Authority is in fact empowered to adduce "a posteriori" lack of unity as a reason for inviting the applicant to pay additional search fees. 2.3.2 Numerous decisions of Boards of Appeal acting under Article 154(3) EPC as departments of special instance (Rule 40.2(c) PCT) have recognised the International Searching Authority's power to question the unity of international applications in the light of documents discovered during the search which deprive the subject-matter of a main claim of its novelty or inventive step, so that the other claims individually dependent thereon no longer define a unitary invention.

2.3.3 Nevertheless, a more recent Board of Appeal decision (W 03/88, OJ EPO 1990, 126) deviates from this earlier case law by contending that the International Searching Authority is neither obliged nor empowered to question the unity of an application on the basis of prior art discovered during the search.

2.3.4 As required by Article 15(1) of its Rules of Procedure, the Board explains below why it believes it must adhere to the earlier Board of Appeal case law and thus deviate from Decision W 03/88.

2.3.5 Concerning the PCT, Decision W 03/88 argues essentially as follows: The International Searching Authority's duties regarding the application of Article 17 PCT were restricted solely to carrying out the international search and producing an international search report (point 5, fourth paragraph). In the context of the international search, the term "single general inventive concept" in Rule 13.1 PCT meant a single concept alleged to be inventive, i.e. it referred to what the applicant regarded as his invention at the time of filing irrespective of any prior art subsequently discovered. In other words, the general inventive concept under Rule 13.1 PCT was simply the concept of what the applicant subjectively claimed to be his invention (point 6). The International Searching Authority was not obliged or empowered under the PCT to carry out substantive examination (i.e. as to novelty and/or inventive step), a prerequisite for "a posteriori" examination concerning the unity-of-invention requirement. Accordingly, an analysis of the technical problem and solution underlying the invention lay outside the competence of the International Searching Authority and any such examination or analysis would be contrary to the scheme of the PCT and its particular provisions regarding the international search (point 8).

2.3.6 This suggests an interpretation of the PCT whereby the term "inventive concept" used in Rule 13.1 PCT is to be understood differently according to

whether the matter in hand is an international search (alleged inventive concept) or the subsequent substantive examination, the argument being that the latter is not the International Searching Authority's responsibility.

2.3.7 Having thoroughly examined the PCT, its Regulations, the Guidelines for International Search to be Carried Out under the PCT (PCT/INT/5) dated 18 November 1977, and the Agreement between the EPO and WIPO of 7 October 1987 (OJ EPO 1987, 515) in relation to the functioning of the European Patent Office as an International Searching and International Preliminary Examining Authority under the PCT, however, the Board cannot agree.

2.3.8 Provisions of the PCT Under Article 3(4)(iii) PCT the international application must comply with the prescribed requirement of unity of invention. Under Article 15(2), (3) and (4) the objective of the international search is to discover relevant prior art. Article 17 lays down the procedure for the International Searching Authority, which under (3)(a) may invite the applicant to pay additional fees if it considers that the application does not comply with the requirement of unity of invention.

2.3.9 The PCT thus enshrines the principle that the international application must comply with the requirement of unity of invention - the International Searching Authority being empowered to object to lack of unity - and that the purpose of the international search is to discover relevant prior art.

2.3.10 Provisions of the Regulations under the PCT Rule 13.1 defines the requirement of unity of invention applying throughout the PCT, i.e. in respect of both the international search (Article 17(3)(a)) and the international preliminary examination (Article 34(3)(a)). Rule 33 defines the term "relevant prior art", paragraphs 33.2 and 33.3 specifying the scope of the search. This has to cover the entire subject-matter to which the claims are directed or to which they can reasonably be expected to be directed after amendment. Rule 40 sets out the conditions governing the invitation to pay additional fees and any protests, and provides for the setting up of a special appeal body. Rule 43 lays down the form in which the international search report is to be drawn up, Rule 43.5(c) specifying that citations of particular relevance must be specially indicated. If the applicant has paid additional fees, Rule 43.7 requires the search report to say so and also to indicate which parts of the application were searched and which were not. Under Rule 43.9, moreover, the search report (unlike the invitation to pay additional fees) may not contain any expressions of opinion, reasoning, arguments or explanations apart from the details referred to in Rules 33.1(b) and (c), 43.1, 2, 3, 4, 5, 6, 7, 8, 44.2(a) and (b), and the indication referred to in Article 17(2)(b).

Regarding Chapter II PCT (International Preliminary Examination), the procedure for the International Preliminary Examining Authority is laid down in Rule 66, while Rule 70 specifies both the content and form of the international preliminary examination report. The preliminary examination procedure and the examination report differ from the international search procedure and the international search report in their purpose.

2.3.11 The Board believes it is perfectly clear from these Regulations that: - There is only one definition of unity of invention for the purposes of the international search and the international preliminary examination.

- To fulfil the purpose of the search, which according to Rule 33.1 is to discover relevant prior art, the International Searching Authority must establish the general inventive concept of the subject-matter of the claims. This it can only do by comparing the application with the prior art (Rule 33.2), which inevitably means assessing novelty and inventive step to determine the extent of the search.

- The search must be carried out on the basis of the claims (Article 15(3) and Rule 33.3) and objections concerning lack of unity must be raised if the claims prove to relate to different inventions. To fulfil the purpose of the PCT, it is after all essential in the course of the international search to furnish proof of the prior art relating to all the inventions claimed by the applicant and all inventions which he could reasonably be expected to claim, or at least to specify unequivocally, for the information of third parties and designated national Offices, those inventions for which the prior art has not been searched.

- The international search report itself must contain brief details of the estimated relevance of cited documents (e.g. "A", "document defining the general state of the art which is not considered to be of particular relevance"; "X", "document of particular relevance; the claimed invention cannot be considered novel or cannot be considered to involve an inventive step"; "Y", "document of particular relevance; the claimed invention cannot be considered to involve an inventive step when the document is combined with one or more other such documents, such combination being obvious to a person skilled in the art"). These details already presuppose an assessment of the novelty and inventive step of the subject-matter of the claims. So as not to anticipate later examination as to patentability, however, the international search report may not indicate why the International Searching Authority has come to this conclusion (Rule 43.5 and 43.9).

2.3.12 The PCT and its Regulations thus empower and oblige the International Searching Authority to examine the subject-matter of the claims as to novelty and inventive step to determine whether the international application meets the

unity-of- invention requirement under Rule 13 PCT - either "a priori" or, with regard to prior art discovered during the search, "a posteriori" - since its findings will directly affect the scope of the search. Otherwise, either international applications lacking in unity and with no indication to that effect in the search report would be the subject of an incomplete international search, contrary to the basic aim of the PCT, or else the International Searching Authority would be unjustifiably obliged to carry out several searches for a single fee. It should not be overlooked, however, that this is not an examination as to patentability during which the applicant has a right to be heard but one carried out merely for the purposes of the search report, a point also reflected in the fact that the International Searching Authority is not allowed to give its reasons for its views in the search report itself.

2.3.13 This suggests to the Board a conclusion in line with the Guidelines for International Search to be Carried Out under the Patent Cooperation Treaty (PCT), hereinafter referred to as "the Guidelines". Because of the need referred to in Article 56(3)(i) and (ii) PCT to secure the maximum degree of uniformity, particularly in the working methods of the various International Searching Authorities and International Preliminary Examining Authorities, these Guidelines are particularly important. As stated in Chapter I.3 thereof:

In order to ensure uniform practice the International Searching Authorities are expected to adhere to these Guidelines to the extent that they are not amended or revoked by the Committee for Technical Cooperation established under Article 56 of the Treaty. This particularly important aspect of the Guidelines is also emphasised in the Agreement between the EPO and WIPO under the PCT of 7 October 1987, whose Article 2 "Basic Obligations" states that in carrying out the international search the International Searching Authority shall be guided by the Guidelines ("The Authority shall carry out ..."; "L'Administration procède ..."; "Die Behörde führt nach Maßgabe ... der Verwaltungsrichtlinien ... durch ..."). The Board therefore considers that the International Searching Authority is obliged to adhere to the Guidelines and particularly to their interpretation of the PCT, and that it could disregard them only if and where they were at odds with the PCT or its Regulations.

2.3.14 If the PCT and its Regulations are interpreted correctly, however, the Guidelines will be in accord with them. Thus, the Guidelines contain the following instructions regarding the need for international search examiners to assess novelty and inventive step:

"Decisions on novelty and inventive step are the province of the designated Offices. However, these issues must be borne in mind by the search examiner in order to enable an effective international search to be carried out" (Chapter III,

1.1). "Dependent claims should be interpreted as being restricted by all features of the claim(s) from which they depend. Therefore, where the subject matter of the main claim is novel, that of the dependent claims will also be considered novel for the purpose of international search. When the novelty and inventive step of the main claim are apparent as a result of the international search, there is no need to make a further search in respect of the subject matter of the dependent claims as such" (Chapter III, 3.8). "However, where the novelty or inventive step of the main claim is questioned, it may be necessary for assessing inventive step of a dependent claim to establish whether the features of the dependent claim as such are novel by searching one or more additional classification units" (Chapter III, 3.9). "The search examiner should then carry out the international search, directing his attention primarily to novelty, but also at the same time paying attention to any prior art likely to have a bearing on inventive step" (Chapter IV, 2.4). "In considering novelty ..." (Chapter VI, 2). "The inventive step will have to be evaluated" (Chapter VI, 7).

2.3.15 Chapter VII of the Guidelines is devoted entirely to the issue of unity of invention. After pointing out that decisions concerning unity of invention rest with the International Searching Authority (Chapter VII, 4) and explaining the interpretation of Rule 13.2 and 13.3 PCT, the Guidelines give the following instructions: "Lack of unity 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, e.g. a document discovered in the international search shows that there is lack of novelty in a main claim, leaving two or more dependent claims without a single general inventive concept".

2.4 The Board therefore considers that in the present case the International Searching Authority was both empowered and obliged to examine whether main Claim 1 in the international application was to be considered novel compared with EP-A-0 190 416 and, if not, to determine whether the inventions set out in the other claims, and particularly in dependent ones, still constituted a single general inventive concept.

2.5 If the international application is compared with EP-A-0 190 416 it will be seen that, in the former, the subject-matter neither of Claim 1, nor of Claims 2, 3, 4 or 6, nor of Claims 8 and 13 insofar as dependent on Claims 1 to 4 and 6, is new. The other document in fact already describes a process for making reactive calcium hydroxides for cleaning gases and waste gases, which involves adding, particularly during hydration, substances which increase the reactivity of calcium hydroxide. To bind acidic pollutants, alkali hydrogen carbonates such as sodium hydrogen carbonate, hydrogen-forming compounds such as calcium chloride, or compounds such as water-soluble salts of iron, preferably chlorides,

are added. These act as catalysts, particularly when acidic pollutants (SO₂ or HCl) are being separated from gases or waste gases. Cleaning is carried out in the temperature range from 20 to 1 200°C (e.g. between 30 and 400°C), solid matter being separated off by dust removal devices (cloth filters) (cf. EP-A-0 190 416, especially page 8, line 2, to page 9, line 19).

In the claims referred to in the International Searching Authority's invitation as the first and second group, therefore, Claim 14 is the only one whose novelty is not prejudiced by the above publication, being concerned with a particular embodiment of the process in which the calcium hydroxides form a (solid or moving) layer through which the gas to be cleaned is fed. In the known process, by contrast, the sorbents are added to the gas.

2.6 At least insofar as it is dependent on Claims 1 to 4, 6, 8 and 13 of the only groups of claims to be examined here, designated 1 and 2 in the invitation to pay, Claim 14 defines a unitary invention since it offers a solution to the problem indisputably posed in the light of the specified prior art, namely to bring the substances known from EP-A-0 190 416 into contact with the gases to be cleaned in a different manner from that described therein.

2.7 The invitation to pay an additional fee before an international search had been carried out in respect of the inventions defined in Claims 4, 8, 13 and 14 of the second group was therefore issued improperly.

ORDER

For these reasons, it is decided that:

Refund of the additional search fee paid by the applicant is ordered.