Abstract
The Board held that searching in separate classification units for dependant claims, because the novelty or inventive step of the main claim is questionable, is normal practice and does not as such justify the charging of additional search fees for the International Searching Authority.

EPO boards of appeal decisions

Date of decision 7 November 1990

Summary of Facts and Submissions

I. International patent application PCT/GB.... was filed at the United Kingdom Patent Office on 12 April 1990.

II. On 9 August 1990, the European Patent Office, as competent International Search Authority (ISA), issued an invitation pursuant to Article 17(3)(a) and Rule 40.1 PCT to pay two additional search fees.

The ISA considered that the application did not comply with the requirement of unity of invention as set forth in Rule 13 PCT. This was said to be because the general problem underlying the invention was not novel and a solution to it had already been found or did not involve an inventive step having regard to the state of the art as illustrated by US-A-4 730 190. The claims were accordingly considered to require regrouping under the following distinct inventive concepts:

(1) Claims 1, 6-9

A portable laser rangefinding device adapted in shape to be provided with handgrips, including a sighting eyepiece and a keypad for inputting data

(2) Claims 1-4

An inclinometer adapted for use on a laser rangefinder

(3) Claims 1, 5

A velocity measuring device using variations in successive rangefinder measurements to determine velocity of a target.

III. The applicant paid both additional fees in due time and in a letter dated 31 August 1990 stated that the payment was made under protest. It was argued that the disclosure of US-A-4 730 190 did not cause Claim 1 of the application to lack novelty or inventive step and that even if Claim 1 were to lack novelty or be demonstrably obvious the application provided a basis for an amended Claim 1 forming a unifying inventive concept for the appendant claims. Refund of the additional fees was requested.

Reasons for the Decision

1. Pursuant to Rule 40.2(c) PCT and Article 154(3) EPC, the Boards of Appeal of the EPO are responsible for deciding on a protest made by an applicant against additional search fees charged under Article 17(3)(a) PCT by the EPO when acting as the ISA.

2. The protest complies with the formal requirements of Rules 40.2 and 40.3 PCT and is accordingly admissible.

3. The objection of lack of unity made by the ISA only arose after a preliminary search had been carried out and was accordingly made "a posteriori", i.e. after taking prior art into consideration. The question of whether the EPO when acting as an ISA is entitled to raise an "a posteriori" lack of unity objection or whether such an objection pre-empts the separate preliminary examination under Chapter II PCT was referred to the Enlarged Board of Appeal of the EPO. In its recent decision G 1/89 of 2 May 1990, to be published, the Enlarged Board concluded that "a posteriori" objection of lack of unity was allowable since the ISA only formed a provisional opinion on novelty and inventive step for the purpose of carrying out an effective search which did not constitute a substantive examination in the normal sense of that term.

4. The Enlarged Board stated that consideration of the requirement of unity of invention should always be made with a view to giving the applicant fair treatment and that the charging of additional fees under Article 17(3)(a) PCT should be made only in clear cases; restraint should be exercised in the assessment of novelty and inventive step and borderline cases preferably resolved in favour of the applicant.

5. Turning now to the application, this has in essence only a single embodiment and has a single independent claim, Claim 1, directed to a laser rangefinder. Against this claim the search examiner has cited document US-A- 4 730 190. However, the Board do not consider it necessary to address the question of whether or not Claim 1 is sustainable because the nature of the dependent claims is such that even if Claim 1 were not sustainable the charging of additional

search fees could not be justified. These dependent claims either automatically fall if Claim 1 falls or they are related in a manner which required them to be searched as part of the search on Claim 1, so that in neither case can the charging of additional search fees be justified.

6. The claims which automatically fall if Claim 1 falls are Claims 2 to 4, which introduce the additional feature of an inclinometer. The description contains no details of an inclinometer but merely indicates in the sentence bridging pages 4 and 5 that this is of a known generic or proprietary type; it is accordingly clear that if the subject-matter of Claim 1 were lacking in novelty or inventive step then, since what is added by Claims 2 to 4 is well-known per se, this would also be true of these claims. In the absence of a description it would not be open to the applicant to resile from his statement that the device is of known type. Whatever the fate of Claim 1, an additional search fee for these claims could not, therefore, be justified.

7. The remaining groups of claims are on the one hand Claim 5, which relates to calculating target speed, and on the other hand Claims 6 to 9, which relate to features of device construction. The Board do not consider any lack of unity between these claims to be a sufficiently clear case to justify the charging of additional search fees since their subject-matter is so closely related to that of Claim 1 that they could be DG3: DBA case W 0044/90 - 3.5.1 expected to be searched in connection with claim 1. Attention is directed to the "Guidelines for International Search to be carried out under the Patent Cooperation Treaty", which at Chapter III, paragraph 3.9 indicates that 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. Paragraph 3.10 indicates that in the case of claims characterised by a combination of elements the international search should be directed towards the combination, but sub-combinations, including the elements individually, should be searched at the same time. It is, therefore, clear from the international search guidelines that the necessity of searching in separate classification units for the appendant claims because the novelty or inventive step of the main claim is questionable is normal practice and does not as such justify the charging of additonal seach fees. The Board considers that in the case of the present application no search additional to that prescribed by the above- mentioned Guidelines has been necessitated by any of Claims 5 to 9, so that no additional search fee can be justified.

ORDER

For these reasons, it is decided that:

Reimbursement of all the additional search fees paid is ordered.