

Abstract

In ordering the refund of additional search fees to applicant, the Boards of Appeal held that because the invitation issued by the ISA did not allow applicant to determine whether it was proper or not, on its face, it was in violation of Rule 40.1 of the PCT and thus lacked legal effect.

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 19 April 1988.

II. On 30 September 1988, the European Patent Office (EPO), acting as International Search Authority (ISA), sent to the Applicant an invitation to pay two 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: "

1. Claim 1:

Method of forming a score line in a web by ultrasonic energy

2. Claims 2-5:

Laminating a reinforcing tape and a tear tape to a web

3. Claims 6-9:

Envelope with a pair of score lines, a reinforcing tape and a tear tape.

The problem underlying the invention stated in the independent Claim 1 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-3 737 361; FR-2 570 644; US-4 415 515.

Therefore, the original single general inventive concept also covering the subject-matter of the dependent Claims 2-5 is not acceptable anymore, making it necessary to re-establish the technical relationship or interaction of the very characteristic features stipulated in the dependent claim(s) relating to Claim 1.

Furthermore, the subjects defined by Claims 6-9 are so different from subject of Claim 1 that no technical relationship or interaction can be appreciated to be present so as to form a single general inventive concept.

This leads to a regrouping under different subjects as listed, each subject now falling under its own distinct inventive concept, being a technically distinct and independent feature."

III. With his letter received 10 November 1988, the Applicant paid the two additional search fees under protest (Rule 40.2(c) PCT) for establishing separate search reports on those parts of the application which relate to the inventions mentioned in Claims Nos. 2 to 5 and 6 to 9. According to the reasons of this protest the claims on file are all directed to a single invention. Furthermore, the Applicant contested the opinion of ISA that the invention was not novel and did not involve an inventive step in the light of the art known from the three documents 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-3 737 361, FR-2 570 644 and US-A-4 415 515, and that, therefore, the two remaining subjects do not relate anymore to a group of inventions so linked as to form a single general inventive concept.

3.2 According to the Guidelines for International Search (WIPO) to be carried out under the Patent Cooperation Treaty (PCT) dated 18 November 1977, in considering novelty, the documents of the relevant prior art should be considered separately. 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 three 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 concern a different subject, namely:

- an apparatus for exposing sheet material to ultrasonic energy (US-A-3 373 361),
- a method for making a line of weakness in a sheet of PVC, which line allows to bend this sheet along this line (FR- A-2 570 644), and
- a method and an apparatus for forming a container blank having cut edges and flexible score lines from a flat thermoplastic sheet (US-A-4 415 515

3.3 The Guidelines for Internal 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 ISA, however, enumerated in its invitation three 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 simple general inventive concept is not acceptable. The fact that independent claims remain in the application representing different inventions with different problems to be solved does not necessarily imply that there is no common concept which links these inventions, and does not therefore make the absence of such 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 fees cannot be retained.

ORDER

For these reasons, it is decided that:

Refund of the additional search fees is ordered.