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D E C I S I O N
of 5 December 2001

Case Number: W 0004/00 - 3.3.4

Application Number: PCT/GB 99/01108

Publication Number: WO 99/53055

IPC: C07K 14/48, C07K 14/71

Language of the proceedings: EN

Title of invention:
Therapeutic agent

Applicant:
University of Bristol et al.

Headword:
-

Relevant legal provisions:
PCT Art. 17(3)(a)
PCT R. 13.2 and 40.2

Keyword:
"Reasoned statement (no) - protest inadmissible"

Decisions cited:
W 0002/01

Catchword:
-



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Boards of Appeal

Chambres de recours

Case Number: W 0004/00 - 3.3.4
International Application No. PCT/GB/01108

D E C I S I O N
of the Technical Board of Appeal 3.3.4
of 5 December 2001

Applicant: University of Bristol et al
Senate House
Tyndall Avenue
Bristol BS8 1TH (GB)

Representative: Withers & Rogers
Goldings House
2 Hays Lane
London SE 1 2HW (GB)

Subject of the Decision: Protest according to Rule 40.2(c) of the Patent Cooperation Treaty made by the applicant against the invitation (payment of additional fee) of the European Patent Office (International Searching Authority) dated 12 October 1999.

Composition of the Board:

Chairwoman: U. Kinkeldey
Members: C. Holtz
L. Galligani

Summary of Facts and Submissions

- I. On 12 October 1999, the European Patent Office, acting as the International Searching Authority (ISA), issued an invitation pursuant to Article 17(3) (a) and Rule 40.1 PCT to the appellant to pay eight additional search fees for international application PCT/GB 99/01108 within 30 days, having concluded for reasons given in the invitation that the application did not comply with the requirements of unity of invention (Rules 13.1, 13.2 and 13.3 PCT).
- II. With letter of 8 November 1999, the appellant paid additional eight search fees under protest.
- III. On 31 January 2000, the ISA issued a notification informing the appellant that, with regard to the protest, the ISA had reviewed the justification for the invitation to pay additional fees. The appellant was invited to pay a protest fee pursuant to Rule 40.2(e) PCT. According to an annex to the notification, the search division had issued a formally acceptable reasoned statement why the application lacked unity, but it was also noted that no reasoned statement had accompanied the appellant's protest as required under Rule 40.2(c) PCT. The consideration of refund of the additional fees was therefore not justified and consequently no refund of additional fees was ordered.
- IV. With letter of 29 February 2000 the appellant paid the protest fee. This letter also contained the opinion of the appellant that there would be very little, if any, additional searching required to search the subject-matter of the claims objected to.

Reasons for the Decision

1. The letter of 8 November 1999, by which the appellant paid eight additional fees, did not contain any reasons as regards the finding of non-unity, but only the statement that the payment was made under protest.

2. As observed by the ISA, a protest must be accompanied by a reasoned statement to the effect that the international application does comply with the requirement of unity of invention or that the amount of the required fee(s) is excessive, Rule 40.2(c) PCT. This means that the reasons must be submitted within the time period given by the ISA, i.e., in the present case, on or before 12 November 1999. Since the appellant did not comply with this provision, the protest is not admissible (see eg. decision W 2/01 of 27 April 2001, *mutatis mutandis*).

Order

For these reasons it is decided that:

The protest under Rule 40.2(c) PCT is rejected as inadmissible.

The Registrar:

The Chairwoman:

P. Cremona

U. Kinkeldey