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**Case Number : W 10 /86**

**International Application No. PCT/GB 86/00182**

**D E C I S I O N**  
**of the Technical Board of Appeal 3.3.1**  
**of 15 September 1986**

**Applicant :** The British Petroleum Company p.l.c.  
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**Representative :** Richard D. Crack  
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**Subject of the Decision :** Protest according to Rule 40.2(c) of the Patent Cooperation Treaty made by the applicants against the invitation (payment of additional fee) of the European Patent Office (branch at The Hague) dated 09.06.86.

**Composition of the Board :**

**Chairman :** K. Jahn  
**Member :** F. Antony  
**Member :** G. D. Paterson

Summary of Facts and Submissions

- I. The Applicants filed International patent application PCT/EP 86/00182 with the British Patent Office on 27 March 1986. The EPO was the designated office in the sense of Article 2(xiii) PCT.
- II. On 9 June 1986, the EPO acting as International Search Authority (ISA) sent to the Applicants an Invitation to pay an additional search fee in accordance with Article 17(3)(a) and R.40.1 PCT. The Invitation indicated that the ISA considered that the above-referred application does not comply with the requirements of unity of invention, specifying two different subjects, as follows:
- "Claims 1-15, 16-19 (in part): Oligomerisation and hydratation process, composition for addition to gasoline and gasoline in so far as it contains ethers which can be prepared according to Claim 1.
- 16-19 (in part):
- Gasolines containing an ether which can not be prepared according to Claim 1."
- However, the Invitation did not specify the reasons for its aforesaid findings.
- III. A cheque in settlement of the additional International Search Fee was received from the Applicants within the 30 days term set in the Invitation; a letter containing a protest in accordance with R.40.2(c) PCT arrived on 8 July 1986. According to the reasons of this protest, there is no need to make a separate search for Claim 16, and although Claim 17 is not limited to all the features of Claim 16, its

subject-matter is so closely related to the latter that it is directed to the same invention.

Reasons for the Decision

1. Pursuant to Article 154(3) EPC and Article 9 of the agreement between WIPO and the EPO, the Boards of Appeal of the EPO are responsible for deciding on protests made by Applicants against additional search fees charged by the EPO under Article 17(3)(a) PCT (OJ EPO 4/1978, 249). The protest is admissible under Rule 40.2(c) PCT because the Applicants have paid the additional fees under protest and have added to the protest reasons according to which the international application complies with the unity requirements.
  
2. The ISA has made clear in its Invitation that it considers the two groups specified in the Annex thereto as a group of inventions not so linked as to form a single general inventive concept. Contrary to R.40.1 PCT, however, it failed to specify, in the Invitation or the Annex thereto, the reasons for its above findings. It is true that in connection with the second group, the Invitation refers to "an ether which cannot be prepared according to Claim 1" (emphasis added). However, even if this was indeed correct, it would not exclude the existence of a broader concept encompassing the subject-matter of each of Claims 1 to 19; thus the quoted statement in itself is not sufficient to constitute "reasons" as required by R.40.1 PCT.
  
3. This Board and another Appeal Board of the EPO have already decided (W 04/85 of 22 April 1986 and W 07/86 of 6 June 1986) that the provision of reasons in an Invitation

pursuant to Article 17(3)(a), and Rule 40.1 PCT is an essential prerequisite for such an Invitation to be legally effective. This Board has further decided that it is not sufficient if reasons could be found in the files, because the reasons must be communicated to the Applicant in the Invitation (W 09/86 of 11 August 1986).

4. There being no reasons given in the Invitation or its Annex, it remains to be seen whether the present case is an exceptionally simple one, in which the mere enumeration of subjects (groups 1 and 2) is sufficient to demonstrate lack of unity:

4.1. According to the Annex to the Invitation, group 1 relates to an oligomerisation and hydration process, to a composition for addition to gasoline, and to gasoline insofar as it contains ethers which can be prepared according to Claim 1; whereas group 2 relates to gasolines containing an ether "which cannot be prepared according to Claim 1".

4.2. However, even leaving aside the fact that, as pointed out by the Applicants in their protest, the afore-quoted statement cannot apply to Claim 16 (which refers back to the composition of Claim 11), the said statement cannot without detailed supporting reasons be accepted as necessarily correct; for, a priori, it cannot be excluded that C-C bonds are split and rearranged in the course of the catalytic process of Claim 1, to form the low-boiling ethers defined in sections (iii) of both Claims 17 and 18, or the methyl ethers mentioned in Claim 19.

4.3. Furthermore, without detailed reasons, it is not clear why the presence of methyl ethers as stated in Claim 19 provides a different inventive concept. For example,

Claim 17 could constitute a broad concept to which Claim 1 and the appendant claims might contribute by providing a process to produce at least part of the required compositions.

4.4. In summary, the Board fails to see a simple case in which the mere enumeration of subjects could sufficiently demonstrate lack of unity even in the absence of detailed reasons.

5. Accordingly, the Invitation lacks legal basis because it contravenes Rule 40.1 read in conjunction with Rule 13.1 PCT, and thus cannot have any legal effect. Therefore the additional search fee cannot be retained.

ORDER

For these reasons it is decided:

Refund of the additional search fee is ordered.

MP

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John