



Case Number : W 14 /86  
International Application No. PCT/US 86/01 509

**DECISION**  
of the Technical Board of Appeal 3.3.1  
of 2 March 1987

**Applicant :** The Lubrizol Corporation  
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USA

**Representative :** J. P. Fischer  
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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 23.09.1986

**Composition of the Board :**

**Chairman :** K. Jahn  
**Member :** F. Antony  
**Member :** R. Schulte



## Summary of Facts and Submissions

I. The Applicants filed International patent application PCT/US 86/01509 with the United States Patent and Trademark Office on 21 July 1986. The EPO was the designated office in the sense of Article 2(xiii) PCT.

II. On 23 September 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:

"Subject 1:

Claims 1-69 and 90-126 as far as they concern the preparation of sulfurized compositions in the presence of a specific catalyst E and/or F as mentioned in Claim 1, and their application in lubricant and asphalt composition.

Subject 2:

Claims 70-89 as far as they concern asphalt compositions containing sulfurized compositions prepared otherwise than in the presence of that specific catalyst."

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 45 days term set in the Invitation; a letter containing a protest in accordance with R.40.2(c) PCT arrived on 3 November 1986. According to that letter, the International

application complies with the requirement of unity of invention because a search of sulphur chemistry art would identify art relating to methods for preparing sulphur compounds as well as utility for such sulphur compounds. Additionally the required additional fee is called "excessive".

#### 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 fee 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 subjects specified above 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 characterizing the first Subject, the Invitation is using the term "in the presence of a specific catalyst E and/or F as mentioned in Claim 1", and in connection with the second Subject the term "otherwise than in the presence of that specific catalyst". However, this difference would not necessarily exclude the existence of a broader concept encompassing the subject-matter of each of Claims 1 to 126; 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; both these decisions to be reported in the Official Journal) 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. The earlier one of the cited decisions states (second sentence of second paragraph in numbered section 3) that "in straightforward cases all that may be necessary to substantiate lack of unity is a list of the application's subject-matters... when the list makes perfectly clear that the application does not relate to a single general inventive concept within the meaning of Rule 13.1 PCT". The later cited decision clarifies (Headnote, item 2) that such "straightforward cases in which a mere list of the different aspects of an invention's subject-matter might be regarded as substantiation constitute rare exceptions, particularly in the chemical field".
4. In the present instance, no such exceptional "straightforward case" is recognised by the Board: The ISA's enumeration of two subjects, even together with the statement that Subject 1 relates to compositions prepared in the presence of certain catalysts, whereas the compositions of Subject 2 were prepared otherwise than in the presence of such catalysts, does not make absence of a single general inventive concept "perfectly clear". Quite to the contrary, compositions prepared in the presence and in the absence of a certain catalyst will, as a rule, i.e. without good reasons to the contrary, form a single inventive concept; for, according to common general knowledge, a catalyst remains substantially unchanged in the course of the reaction. It does not form part of the reaction product; rather, it may initiate and accelerate the reaction without as a rule, changing the resulting structure. Only in the

comparatively rare case that the nature of the starting compounds permits a plurality of different reactions may the catalyst accelerate but one of the competing reactions, thereby determining the structure of the reaction product. The ISA has not shown that and why this is the case in the present instance.

5. It is only after having read the whole specification that the Board is at least able to speculate what the ISA may have had in mind: From page 7, lines 6 to 18, and page 61, paragraph 1, it can be deduced that the sulphurized compositions prepared in the presence of a specific catalyst E and/or F are different, in terms of structure and properties, from those prepared in the absence of such catalysts, the said difference in properties being such that the latter compositions are still useful as additives for asphalt compositions, but not as anti-oxidants and friction modifiers for lubricating compositions or as additives in metal working lubricants.

If this should indeed have been the reason why the ISA was of the opinion that the presence or absence of a catalyst E and/or F mattered insofar as unity of invention was concerned, it should have so stated in its Invitation (pointing also to the precise passages of the specification giving rise to such opinion), and it should also have explained why the sentence of page 7, lines 16 to 18, does not, in its view, establish a single general inventive concept. Without such statement and explanation the remarks in the Invitation do not enable the Applicants and the Board to more than speculation about the ISA's possible reasons, but are not in themselves such "reasons" as are required by Rule 40.1 PCT.

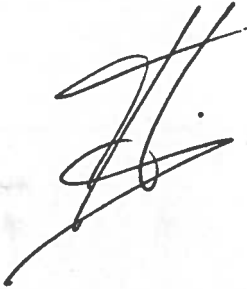
6. Accordingly, the Invitation lacks legal basis because it contravenes Rule 40.1 read in conjunction with Rule 13.1 PCT, and thus cannot have any legal effect.

**Order**

**For these reasons, it is decided:**

**Refund of the additional search fee is ordered.**

*The registrar*



*The chairman*

