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Aktenzeichen / Case Number / N^o du recours : W 23/88

Anmeldenummer / Filing No / N^o de la demande : PCT/US88/00750

Veröffentlichungs-Nr. / Publication No / N^o de la publication :

Bezeichnung der Erfindung: Detergent grade olefins, alkylbenzenes and
Title of invention: alkylbenzene sulfonates and process for preparing
Titre de l'invention :

Klassifikation / Classification / Classement : C07C 2/32

ENTSCHEIDUNG / DECISION

vom / of / du 25 November 1988

Anmelder / Applicant / Demandeur : Chevron Research Company

Patentinhaber / Proprietor of the patent /
Titulaire du brevet :

Einsprechender / Opponent / Opposant :

Stichwort / Headword / Référence :

EPÜ / EPC / CBE PCT Art. 17, Rule 40

Schlagwort / Keyword / Mot clé : "Invitation to pay four additional search fees following an 'a posteriori' finding of lacking unity"

Leitsatz / Headnote / Sommaire

Europäisches
Patentamt

Beschwerdekammern

European Patent
Office

Boards of Appeal

Office européen
des brevets

Chambres de recours



Case Number : W 23/88
International Application No. PCT/US88/00750

D E C I S I O N
of the Technical Board of Appeal 3.3.1
of 25 November 1988

Appellant : Chevron Research Company
A Company of the State of Delaware
P.O. Box 7141
San Francisco, California 94120-7141
USA

Representative : Caroli, Claude J.
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Subject of this 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 31 May 1988.

Composition of the Board :

Chairman : K. Jahn
Members : F. Antony
W. Moser

Summary of Facts and Submissions

- I. On 11 March 1988, the Applicant filed the international patent application PCT/US 88/00750 with the United States Patent and Trademark Office. The European Patent Office was designated Office within the meaning of Article 2 (xiii) PCT.
- II. On 31 May 1988, the European Patent Office as competent International Searching Authority (ISA) issued, pursuant to Article 17(3)(a) EPC and Rule 40.1 PCT, an Invitation to pay four additional search fees in view of the fact that it was considered that the above identified application did not comply with the requirements of unity of invention as set forth in Rule 13(1) PCT.
- III. The ISA asserted that 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 as illustrated by GB-A-1 063 825. Therefore, the original single general inventive concept was no longer acceptable and it was necessary to separately consider the technical relationship or interaction between the different solutions mentioned.

On the basis of these objections, the ISA grouped the subject-matter of the application into the following five subjects:

- (a) A process for preparing C₁₂-olefins using a catalyst of group (1);
- (b) a process for preparing C₁₂-olefins using a catalyst of group (2);
- (c) a process for preparing C₁₂-olefins using a catalyst of group (3);

- (d) a process for preparing C₁₂-olefins using a triethylaluminium sesquichloride catalyst;
- (e) an integrated multi-step process for preparing dodecylbenzenesulfonates.

IV. On 29 June 1988 the Applicant paid the four additional search fees under protest (Rule 40.2(c) PCT). By way of reasoning his representative stated that "he believe(s) that the embodiments criticised as not being uniform can be summarised under a generic claim".

V. Subsequently, the protest has been referred to this Board of Appeal.

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 an Applicant against an additional search fee charged by the EPO under the provisions of Article 17(3)(a) PCT (OJ EPO 1985, 320, 324).
2. The protest complies with Rule 40.2(c) PCT. Although the reasoning quoted in section V is extremely short and rudimentary, it is in the present case, where the facts are quite clear to the Board, considered just sufficient for the purpose of admissibility of the protest. The protest is admissible.
3. According to Rule 40.1 PCT, the Invitation to pay additional fees provided for in Article 17(3)(a) PCT shall, inter alia, specify the reasons for which the application

is not considered to comply with the requirement of unity of invention.

In the present case the ISA has based all its reasoning on a mere standardised statement, without any further explanation, to the effect that the problem underlying the invention was not novel and a solution to it had already been found "or" involved no inventive step. In so doing, the ISA has literally followed a "pro forma" and has just inserted, by way of "illustration", the number of a reference, without even bothering to make up its mind whether the said reference does provide a solution to the problem underlying the invention (lack of novelty) or merely renders a solution obvious.

Under such circumstances it appears at least doubtful whether the Invitation can be said to "specify" the reasons, in terms of Rule 40.1 PCT, for which the international application is considered to lack unity. Again, however, as the facts of the case are quite clear to the Board, it is accepted that the minimal requirements of Rule 40.1 PCT are met.

4. Getting to the substance of the Invitation, the ISA has raised the objection of lack of unity between subjects (a) to (e) *a posteriori*, i.e. after taking certain prior art into consideration. The Board has already held in its Decision W 03/88 of 8 November 1988 "Lubricants/Lubrizol" (to be published) that the ISA does not have any obligation or power under the PCT to carry out an "*a posteriori*" examination in relation to the requirement of unity of invention (page 8, last paragraph) and that any Invitation to pay additional fees based on an "*a posteriori*" finding of lacking unity is issued in contravention of the obligations and power of the ISA under the PCT and should therefore be set aside in toto as void and of no legal

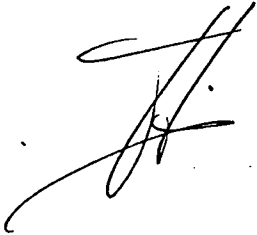
effect (final paragraph of the reasons of the decision referred to). This applying to the present case as well, the four additional search fees paid cannot be retained.

Order

For these reasons, it is decided that:

1. The Invitation to pay additional search fees is set aside.
2. Reimbursement to the Applicant of the four additional search fees paid is ordered.

The Registrar:



30.11.88/W. M. J. W.

30.11.88

The Chairman:

