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Aktenzeichen / Case Number / N^o du recours : W 28/88

Anmeldenummer / Filing No / N^o de la demande : PCT/NL 88/00007

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

Bezeichnung der Erfindung: Molecular cloning and expression of genes encoding
Title of invention: proteolytic enzymes
Titre de l'invention :

Klassifikation / Classification / Classement : C12N 15/27

ENTSCHEIDUNG / DECISION

vom / of / du 5 December 1988

Anmelder / Applicant / Demandeur : Gist-Brocades N.V. et al

Patentinhaber / Proprietor of the patent /
Titulaire du brevet :

Einsprechender / Opponent / Opposant :

Stichwort / Headword / Référence : Genes encoding proteolytic enzymes/Gist-Brocades

EPÜ / EPC / CBE PCT Article 17(3)(a), Rules 13.1, 40.1 and 40.2(c)

Schlagwort / Keyword / Mot clé : "Lack of unity - absence of sufficiently detailed reasons in the Invitation to pay an additional fee."

Leitsatz / Headnote / Sommaire



Case Number : W 28/88
International Application No PCT/NL 88/00007

DECISION
of the Technical Board of Appeal 3.3.2
of 5 December 1988

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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 14 July 1988.

Composition of the Board :

Chairman : P. Lançon
Members : A.J. Nuss
R. Schulte

Summary of Facts and Submissions

- I. The Applicant filed International patent application PCT/NL 88/00007 on 26 February 1988.

- II. On 14 July 1988, the EPO acting as International Search Authority (ISA) sent to the Applicant an Invitation to pay an additional search fee in accordance with Article 17(3)(a) and Rule 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 in the following terms:

"The subjects, defined by the problems and their means of solution, as listed below are so different from each other that no technical relationship or interaction can be appreciated to be present so as to form a single general inventive concept."

The ISA made out two inventions in the international application:

1. Claims 1-10, 22, 23, 27-31: Production of high alkaline protease vectors, DNA sequences, transformants and diagnostic probes therefrom.

 2. Claims 11-21, 24-26: Transformation of alkalophilic bacillus.
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- III. On 29 July 1988 the additional International Search Fee identified in the invitation referred to above was received from the Applicant, together with a protest accompanied by a reasoned statement to the effect that payment of an additional fee is not justified. In addition

refund of the additional fee is requested by the Applicant.

Reasons for the Decision

1. In accordance with Article 154(3) EPC and Article 9 of the Agreement between WIPO and EPO under the PCT (cf. EPO 1985, 320), the Boards of Appeal are responsible for deciding on the protest raised by the Applicant.
2. The protest was made within the time limit according to Article 17(3)(a) and Rule 40.3 PCT, and complies with Rule 40.2(c) PCT; it is, therefore, admissible.
3. Rule 40.1 PCT stipulates that the invitation provided for in Article 17(3)(a) PCT must specify the reasons for which the international application is not considered as complying with the requirement of unity of invention. The purpose of setting out reasons is to enable the Applicant and, in the case of a protest, also the appeal body to examine whether the request to pay additional fees owing to lack of unity of the invention is justified. The basic considerations behind the finding that the invention lacks unity must therefore be set out in a logical sequence. At the least, the considerations that motivated the decision must be readily comprehended from the reasons indicated in the invitation of the ISA.
4. In the present case, however, the invitation of the ISA cannot be considered as containing an acceptably reasoned statement setting out the considerations for the decision in a way which could be readily understood. The indication in the invitation that "the subjects ... as listed ... are so different from each other that no technical relationship or interaction can be appreciated to be

present so as to form a single general inventive concept", is a mere allegation but no statement of grounds for the decision, because the reader of this text is not able to find out the technical differences, so that no technical relationship or interaction could be recognized by the ISA. The complement that these subjects are "defined by the problems and their means of solution" does not help the reader either, since the invitation does not state which problems are supposed to be solved in this case. Without further explanations the technical sense behind the remarks in the invitation cannot be really understood and one can only speculate about the meaning of these remarks.

The Board's view is that the degree of abstraction of the language used by the ISA in its invitation is such that it causes considerable difficulties to establish a correlation between the indicated reasons and the technical background of the present case. The language used resembles much that of an all-round standard clause.

5. In several decisions the Boards of the EPO have already consistently expressed the view that an indication of reasons is an essential prerequisite for an invitation to be legally effective. Only in certain straightforward cases where the list of claimed subject-matter itself made the reasons obvious why it was considered that various claims lacked unity, could express reasoning be dispensed with (W 04/85 - OJ EPO 1987, 63; W 07/86 - OJ EPO 1987, 67; W 09/86 - OJ EPO 1987, 459). In a case like the present one where apparently several problems had been made out by the ISA, the invitation should contain all the technical details relevant to the case in order that the objection could be fully understood.

Furthermore, the ISA must take as its point of reference the description, not only the claims as it did in this case, since the mere technical differences between the claims do not, at any rate prima facie, rule out the possibility that there is unity of invention, i.e. that independent claims which are technically different from each other are part of a single general inventive concept.

6. In the absence of sufficiently detailed reasons, the Board is not in a position to establish whether the invitation to pay an additional fee was correctly issued. The objection in the invitation lacks thus the necessary substantiation and therefore violated the obligation to specify reasons laid down in Rule 40.1 in conjunction with Rule 13.1 PCT.

Consequently the invitation of the ISA to pay an additional fee is not legally effective and therefore the additional fee paid by the Applicant cannot be retained.

Order

For these reasons, it is decided that:

Reimbursement of the additional fee to the Applicant is ordered.

The Registrar:

The Chairman:

F.Klein

P.Lançon

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