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Aktenzeichen / Case Number / N° du recours : W 8/89 - 3.2.3

Anmeldenummer / Filing No / N° de la demande : PCT/US 88/01832

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Bezeichnung der Erfindung: Cold weather system

Title of invention:

Titre de l'invention :

Klassifikation / Classification / Classement : A41D 13/00

### ENTSCHEIDUNG / DECISION

vom / of / du 11 December 1990

Anmelder / Applicant / Demandeur : Burlington Industries, Inc.

Patentinhaber / Proprietor of the patent /  
Titulaire du brevet :

Einsprechender / Opponent / Opposant :

Stichwort / Headword / Référence :

EPO / EPC / CBE PCT Rule 40.2(c)

Schlagwort / Keyword / Mot clé : "Additional fee paid in time"  
"Payment not accompanied by a reasoned  
statement"

#### Leitsatz / Headnote / Sommaire

"When a payment is made under protest in due time but is not accompanied by a reasoned statement within the meaning of Rule 40.2(c) PCT, the additional search shall be made by the ISA and the protest has to be dismissed whether or not the invitation to pay has been properly reasoned."

Europäisches  
Patentamt  
Beschwerdekammern

European Patent  
Office  
Boards of Appeal

Office européen  
des brevets  
Chambres de recours



Case Number : W 8/89 - 3.2.3  
International Application No. PCT/US 88/01832

**D E C I S I O N**  
of the Technical Board of Appeal 3.2.3  
of 11 December 1990

**Appellant :** Burlington Industries Inc.  
3330 West Friendly Avenue  
Greensboro, North Carolina 27420  
USA

**Representative :** Robert A. Vanderhye  
Nixon & Vanderhye P.C.  
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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 5 October 1988.

**Composition of the Board :**

**Chairman :** C.T. Wilson  
**Members :** R. Gryc  
J.C. Saisset

## Summary of Facts and Submissions

- I. The Applicant filed international patent application PCT/US 88/01832 on 2 June 1988.

On 5 October 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 application did not meet the requirement of unity of invention and set out two groups of claims. The Applicant was informed at the same time that the additional fee had to be paid within 45 days from the date of mailing (i.e. by 19 November 1988) and that the payment may be made under protest, in accordance with Rule 40.2(c) PCT.

- II. By letter dated 31 October 1988 and received at the ISA on 9 November 1988, i.e. before the above-mentioned time limit had expired, the Applicant paid the required additional search fee.

Although this letter contained the following sentence:

"This payment is made under protest"

it was not accompanied by a reasoned statement indicating the grounds on which the Applicant's protest is based.

- III. The ISA has referred the protest to this Board of Appeal for examination in accordance with Rule 40.2(c) PCT.

## Reasons for the Decision

1. Under Article 154(3) EPC the Boards of Appeal are responsible for deciding on a protest made by an Applicant against an additional fee charged by the EPO under the provisions of Article 17(3)(a) of the Cooperation Treaty.
2. Pursuant to Article 17(3)(a) PCT, the ISA shall establish the international search report on the parts of the international application which relate to the additional inventions, provided the corresponding fees have been paid within the prescribed time limit. In the present case, a time limit of 45 days from the date of mailing has been granted by the EPO, which is consistent with the provisions of Rule 40.3 PCT.

Since the search fee for the invention deemed to be additional was paid in due time, the European Patent Office must establish the international search report on those parts of the present international application which relate to the said invention.

3. Rule 40.2(c) PCT enables the Applicant to pay the additional fee under protest, "that is, accompanied by a reasoned statement to the effect that the international application complies with the requirement of unity of invention ...".

This makes it clear that if an Applicant wishes to pay the additional fee under protest, the additional fee must be accompanied by the reasoned statement that sets out the protest. Since, in accordance with Article 17(3)(a) and Rule 40.3 PCT as set out above, the additional fee must be paid within the specified time limit, it is also clear that

the protest must be made within the same time limit (cf. Decisions W 1/87, OJ EPO 5/1988, 182 and W 4/87, OJ EPO 11/1988, 425).

From the following statement:

"This payment is made under protest"

made in Applicant's letter of 31 October 1988, it is clear that the Applicant wanted to pay the additional fee under protest but since he gave absolutely no reason indicating why in his opinion his application complies with the requirement of unity of invention, such a statement alone cannot be considered as a "reasoned statement" within the meaning of Rule 40.2(c) PCT.

Therefore, the Applicant's protest under Rule 40(2)(c) PCT has to be dismissed as inadmissible.

4. Under these circumstances, the Board does not have to examine whether the invitation to pay is legally effective e.g. has been properly reasoned to substantiate lack of unity since that is a question of substantive law which has to be dealt with on the occasion of substantive examination of the protest which may only be initiated if the protest is admissible (cf. Decision W 6/88 of 14 April 1989, not published).
5. Consequently, the additional fee paid by the Applicant shall not be refunded.

Order

For these reasons, it is decided that:

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

The Registrar:

The Chairman:



S. Fabiani

C.T. Wilson

R.G.

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