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File Number: W 10/89 - 3.3.1

Application No.: PCT/US88/03723

Publication No.: WO 8904358

Title of invention: Compositions and lubricants and functional fluids
containing same

Classification: C10M 141/08

D E C I S I O N
of 27 September 1991

Applicant: The Lubrizol Corporation

Headword: Lubricants/LUBRIZOL

PCT Rules 13.1 and 40.1

Keyword: non-unity a posteriori (no) -
invitation not accompanied by a reasoned statement

Headnote



Case Number : W 10/89 - 3.3.1
International Application No. PCT/US 88/03723

D E C I S I O N
of the Technical Board of Appeal 3.3.1
of 27 September 1991

Applicant : The Lubrizol Corporation, a corporation of the
State of Ohio
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Wickliffe, Ohio 44092 (US)

Representative : Mr William C. Tritt
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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 4 April 1989.

Composition of the Board :

Chairman : K.J.A. Jahn
Members : R. Spangenberg
J. Stephens-Ofner

Summary of Facts and Submissions

- I. Following the filing of International Patent Application No. PCT/US88/03723 the EPO, acting as ISA, issued an invitation to pay 13 additional search fees because it considered that the application did not comply with the requirement of unity of invention. The ISA stated that not only have all the mandatory components listed in Claim 1 of the application been known per se as conventional lubricant additives, but also that lubricating compositions comprising at least one member of each of the mandatory components specified in any of Claims 1, 2 and 67 to 70 have been known as well, e.g. from US-A-4 466 894, resulting in lack of unity a posteriori.

- II. The Applicant paid one additional fee under protest, selecting group 8 from the 14 groups of claims identified by the ISA for the additional search. Referring to Decision W 03/88 of this Board, the Applicant contended that the expression "inventive concept" should be understood in the sense of "allegedly inventive" at the time of filing, irrespective of what the patentable invention eventually may turn out to be and that, consequently, the ISA was wrong to take the prior art into account when assessing the unity of the invention. In addition, he submitted that the additional fee was excessive since in his opinion all prior art relevant to the "other inventions" identified by the ISA should have been found in the search for the first invention.

- III. Since the legal principles on which the decision W 03/88 was based became the subject of a referral to the Enlarged Board of Appeal before a decision in this case could be issued, the proceedings in this case were suspended pending the issuance of the Enlarged Board's decision.

Reasons for the Decision

1. The protest is admissible.
2. In support of his protest the Applicant inter alia relied on the reasoning behind the decision W 03/88, namely that the ISA did not have any obligation or power under the PCT to carry out an "a posteriori" examination as to novelty or inventive step in relation to the requirement of unity of invention. However, in its decision G 1/89 of 2 May 1990, the Enlarged Board of Appeal held that "a posteriori" objections of lack of unity were in principle allowable, but that such "a posteriori" considerations should only be applied with a view to give the applicant fair treatment and that additional fees should only be charged in clear cases (see OJ EPO 1991, 155).
3. The present invitation to pay additional fees which is based on "a posteriori" considerations does not set out why the case should be regarded as clear and why the charging of additional fees was fair. However, since the invitation was issued before the decision of the Enlarged Board of Appeal was taken, the invitation is not invalid for this reason alone.
4. The Applicant has only paid one additional search fee and identified Claims 29 to 31 for the additional search. Therefore the only issue that has to be considered is whether or not this group of claims clearly relates to an inventive concept different from that of Claims 1 to 11 and 67 to 70, taking into account the content of US-A-4 466 894.
5. The reasoning contained in the invitation for the stated non-compliance with the requirement of Rule 13.1 PCT does

not contain any detailed information concerning the specific parts of the cited document supporting the stated anticipation. In the enclosed Search Report, reference is made to the abstract and to col. 1, line 9 to col. 7, line 62, col. 12, line 12 to col. 15, line 15; col. 17, lines 9, 10, 12, 18 - 28, 30 - 65 and Claims 1 to 10, 14, 15, 22 to 26, 28, 30, 32, 33 of the cited document.

6. It is therefore evident that the ISA has based its invitation on the sole ground that its search has revealed a document which could be regarded as prejudicial to the novelty of the subject-matter of Claim 1 of the application.

However, in the Board's judgment, it cannot be inferred from Rule 13 PCT, or from the corresponding Chapter VII of the Guidelines for International Search (which have to be taken into account according to the cited decision G 1/89), that the mere existence of such a document also prejudices the unity of invention of the remaining subject-matter of the application. The Guidelines for international Search, which only serve as comment on the relevant provisions of the PCT but do not replace them, state in Chapter VII, item 9 that lack of unity may become evident after taking prior art into consideration, e.g. a document showing that there is lack of novelty in a main claim, leaving two or more dependent claims without a single general inventive concept. This Guideline does not, however, state or imply that the lack of novelty of an independent claim has the automatic consequence of leaving the dependent claims without a single general inventive concept. On the contrary, the two conditions mentioned in this Guideline, i.e. that e.g., firstly, a document discovered in the international search shows that there is lack of novelty in a main claim which then, secondly, leaves two or more dependent claims without a single general inventive

concept, are to be taken separately and an objection can only be raised if both requirements are fulfilled.

7. The reasoned statement required by Rule 40.1 PCT must, therefore, set out the reasons why the case under consideration meets both of the above requirements. The reasoning must not be based upon mere allegations and must be sufficiently detailed to be readily understood by the person to whom it is addressed without further investigations and assumptions. Thus, the mere repetition of the relevant content of the above guideline - to which the reasoning in the invitation here under consideration is equivalent - can only be regarded as a reasoned statement within the meaning of Rule 40.1 PCT in very exceptional and clear cases (see W 4/85, OJ EPO 1987, 63 and W 7/86 OJ EPO 1987, 67), of which the present case is not one. In order to explain the Board's position with respect to the necessary content of a reasoned statement in normal cases (like the present one), this will now be set out in more detail.

8. Claim 1 of the application under consideration refers to three mandatory components of the claimed composition,
 - (A) a specified group of salts of at least one acidic organic compound,
 - (B) at least one metal deactivator and
 - (C) at least one compound selected from the group consisting of
 - (C-1) phosphorus-containing amide
 - (C-2) phosphorus-containing ester
 - (C-3) sulfur-coupled dithiocarbamate
 - (C-4) sulfur-containing compound represented by a structural formula relating to a specific group of (ar)aliphatic thioethers and polysulfides.

Claims 2 to 11 relate to specific subgroups of the acidic compound (A). Claims 67 and 68 relate to a concentrate and a lubricant or functional fluid comprising a composition of Claim 1. Claims 69 and 70 relate to such a concentrate, lubricant or functional fluid made by combining components (A), (B) and (C) of Claim 1 with a diluent or a major amount of an oil.

Claims 29 to 31, which have been identified by the ISA as relating to an inventive concept different from that underlying the subject-matter of Claims 1 to 11 and 67 to 70, further specify the compounds (B) of Claim 1 as being benzotriazole and various substituted benzotriazoles.

US-A-4 466 894, cited by the ISA in support of the stated non-unity, relates according to its Claim 1 and the abstract to compositions whose mandatory components were:

- (A) a metal salt of a mixture of acids comprising phosphordithioic acids identified by a structural formula and at least one aliphatic or alicyclic carboxylic acid from about 2 to about 40 carbon atoms,
- (B) at least one sulfurised Group II metal phenate, and
- (C) a stabilising amount of benzotriazole or an alkyl substituted benzotriazole.

According to the description, col. 17, lines 9 to 29, the composition may also contain further components falling within the definition of Group (C) of Claim 1 of the application.

9. However, the cited document consistently requires the presence of a metal salt of a phosphorodithioic acid and of a sulfurised Group II metal phenate, neither of which are

mandatory constituents of the composition of Claim 1 of the application. The alleged anticipation is therefore not self-explanatory, and could only be recognised by the reader of the invitation as a result of his own evaluation of the facts, including the assumption that Claim 1 of the application under consideration has to be construed, for instance in view of the meaning of "comprising", to cover compositions containing the salts of phosphorodithioic acids and metal phenates mentioned in the cited document. It is self-evident that the requirements of a reasoned statement, as laid down by Rule 40.1 PCT, are not met, if the reason for the objection raised can only be understood on the basis of certain evaluations and assumptions which may or may not turn out to be correct. Therefore, with respect to the first of the above two conditions, i.e. the anticipation, the invitation is based upon no more than a mere allegation.

10. Moreover, even if the Board could have accepted this allegation as sufficient in the present case on the basis that it has been accepted by the Applicant, the reasoning in the invitation would still remain insufficient with respect to the second of the above two requirements, i.e. that the remaining part of the application no longer relates to a single general inventive concept. Such remaining general inventive concept might be seen e.g. in providing further compositions useful as additives to lubricants and being free of sulfurised Group II metal phenates and salts of phosphorodithioic acids. The invitation does not indicate any reason why this or any other concept could not be regarded as common to the groups of inventions identified in the invitation, having regard to the cited prior art. In particular, in view of the fact that the distinguishing feature of the two groups of claims under consideration, i.e. the mandatory presence of a benzotriazole in the compositions according to Claims 28 to

31, forms part of the disclosure of the citation, it cannot be understood why the disclosure in that document should make any difference with regard to the question whether or not these two groups of claims relate to different inventive concepts (see also W 44/90 - 3.5.1 of 7 November 1990, item 3 of the reasons).

11. In addition, this Board shares the opinion already expressed by several other Boards of Appeal in earlier cases that an invitation to pay additional search fees, in order to be legally effective, must always be based on the identification of the technical problem underlying the application (see e.g. W 11/89 - 3.3.2 of 9 October 1989), if this is not immediately apparent from the stated facts. As set out above, such identification of the relevant technical problem is not derivable from the present invitation.
12. For these reasons, the invitation cannot be regarded as being accompanied by a reasoned statement as required by Rule 40.1 PCT. It is not, therefore, legally effective.
13. Moreover, in view of the foregoing, it is immediately apparent that the present case is also not a clear case where, according to the decision G 1/89 cited above, a valid a posteriori objection could be raised.
14. Since for these reasons alone the reimbursement of the additional search fee has to be ordered, there is no need to consider whether the payment of this fee was excessive and should be refunded or reduced for this reason.

Nevertheless the Board feels bound to say that the case appears to be of the kind addressed in Chapter VII, 12 of the Guidelines for International Search, since no circumstances are apparent from the facts of the case which

would support the conclusion that the stated non-unity would have caused major additional search efforts. Therefore, it is at least not clear to the Board that the invitation is in conformity with the said Guidelines in this respect (see also W 36/90 - 3.3.1 of 4 December 1990).

Order

For these reasons, it is decided that:

Reimbursement of the additional search fee is ordered.

The Registrar

The Chairman

E. Görgmaier

K. Jahn