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Aktenzeichen / Case Number / N° du recours : W 12/89 - 3.3.1

Anmeldenummer / Filing No / N° de la demande : PCT/ US 88/03 743

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

Bezeichnung der Erfindung: Polysuccinate esters and lubricating  
Title of invention: compositions comprising same  
Titre de l'invention :

Klassifikation / Classification / Classement : C10M 145/22  
C10M 129/95

**ENTSCHEIDUNG / DECISION**  
vom / of / du 23 August 1990

Anmelder / Applicant / Demandeur : The Lubrizol Corporation

Patentinhaber / Proprietor of the patent /  
Titulaire du brevet :

Einsprechender / Opponent / Opposant :

Stichwort / Headword / Référence :

EPO / EPC / CBE PCT Art. 17(3) (a) and Rule 40.1

Schlagwort / Keyword / Mot clé : "No reason in invitation for a posteriori  
consideration" - "Unreasoned allegation of  
lack of novelty" - "Not a clear case of  
lack of unity"

Leitsatz / Headnote / Sommaire



Case Number : W 12/89  
International Application No PCT/US 88/03743

**D E C I S I O N**  
of the Technical Board of Appeal 3.3.1  
of 23 August 1990

**Applicant :** The Lubrizol Corporation

**Representative :** Joseph P. Fischer  
Lubrizol Corporation  
29400 Lakeland Boulevard  
Wickliffe, Ohio 44092  
U.S.A.

**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 10 April 1989

**Composition of the Board :**

**Chairman :** K.J.A. Jahn  
**Members :** G.D. Paterson  
R. Spangenberg

## Summary of Facts and Submissions

- I. Following the filing of this international application, the EPO acting as ISA issued an invitation to pay six additional search fees because it considered that the application does not comply with the requirement of unity of invention - at least a posteriori, because Claims 1 and 2 were said to lack novelty. The applicant paid one additional fee under protest, and contested the suggestion of lack of novelty, giving a reason for this. He therefore contested the suggested lack of unity of invention on an a posteriori basis, and also contested lack of unity of invention because the claims appeared to meet the requirements of Rule 13.1(i) PCT and because a search of the subject-matter of the independent claims will uncover any art relating to the dependent claims. He relied upon Decision W 3/88 (OJ EPO 1990, 126) in support.
  
- II. By a decision dated 29 June 1989 (headnote OJ EPO 10/1989), the Board of Appeal referred certain questions of law which arose in the protest to the Enlarged Board of Appeal, who duly issued Decision G 1/89 (to be published) in response to the referred questions.

## Reasons for the Decision

1. According to Decision G 1/89, an ISA may as a matter of discretion request an additional search fee where an international application is considered to lack unity of invention a posteriori. Furthermore, such consideration should be made with a view to giving an applicant fair treatment, and the charging of additional fees should only be made in clear cases.

2. Although the ISA has based its finding of lack of unity upon a posteriori considerations, it has given no reason why such considerations are appropriate in the present case for the purpose of the international search. Furthermore, although the ISA has based its provisional opinion that there is lack of novelty in Claims 1 and 2 of the international application upon the disclosure of a specific United States patent, the invitation contains no reasoning to support what is in fact a mere allegation of lack of novelty by the ISA.

Having regard also to the fact that the applicant has not only contested the allegation of lack of novelty but has also pointed to a specific feature of Claims 1 and 2 in support of such contention, in the above circumstances in the Board's view the present case is certainly not a clear case in which additional search fees have been justified.

Even if the Board was able to support the ISA's allegation of lack of novelty, it would not be able to follow the reasons given by the ISA as to why there is non-unity. However, in the circumstances there is no need to explain this in detail.

#### Order

For these reasons, it is decided that:

1. The invitation to pay additional fees is set aside.
2. Refund of the additional fee which was paid is ordered.

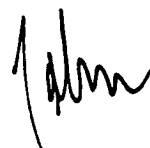
The Registrar:

The Chairman:

M. Beer



K.J.A. Jahn



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