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Aktenzeichen / Case Number / N^o du recours : W 25/89 - 3.4.2

Anmeldenummer / Filing No / N^o de la demande : PCT/US89/01564

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

Bezeichnung der Erfindung: Radiation/Microbe Bioassay

Title of invention:

Titre de l'invention :

Klassifikation / Classification / Classement : G01N 21/47, G01N 15/00, C12Q 1/18,
C12M 1/34

ENTSCHEIDUNG / DECISION

vom / of / du 16 March 1990

Anmelder / Applicant / Demandeur : Technical Assessment Systems, Inc.

Patentinhaber / Proprietor of the patent /
Titulaire du brevet :

Einsprechender / Opponent / Opposant :

Stichwort / Headword / Référence :

EPÜ / EPC / CBE PCT Article 17(3)(a), Rule 40.2(c)

Schlagwort / Keyword / Mot clé : "Protest not accompanied by a reasoned statement"

Leitsatz / Headnote / Sommaire



Case Number : W 25/89 - 3.4.2
International Application No. PCT/US89/01564

D E C I S I O N
of the Technical Board of Appeal 3.4.2
of 16 March 1990

Applicant : Technical Assessment Systems, Inc.
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Representative : Lavine, Irvin A.
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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 31 August 1989.

Composition of the Board :

Chairman : E. Turrini
Members : C. Black
 : C. Payraudeau

Summary of Facts and Submissions

- I. The applicant filed international patent application PCT/US89/01564 at the United States Patent and Trade Mark Office.

- II. The European Patent Office, as competent International Searching Authority (ISA) issued, pursuant to Article 17(3)(a) and Rule 40.1 PCT an invitation to pay one additional fee because it considered that the application did not comply with the requirement of unity of invention as set out in Rule 13.1 PCT.

- III. The final paragraph of the ISA's observations accompanying the invitation summarised the invention as being that claimed in Claims 1 to 30 and that claimed in Claims 31 and 32. These were considered to be two independent sets of claims solving two different problems and therefore constituted two separate inventions. The ISA also stated that in view of the prior art revealed by its search, independent Claims 1 and 14 were not new and in effect that as a result the dependent claims lack unity. Nevertheless, possibly in application of the Guidelines for International Search to be carried out under the PCT, Chapter VII.12, most of these dependent claims would seem to have been covered by the search. The exceptions are Claims 11, 12, 25 and 26 which however the ISA grouped with Claims 31 and 32.

- IV. Within the prescribed time limit the applicant paid the additional fee and submitted a response to the invitation, the tenor of which was that the additional fee was being paid under protest. The applicant explained why he considered that Claim 30 related to the same invention as Claims 1 to 13. He also argued that since Claims 31 and 32

relate respectively to a composition and to a method of making it, these claims are not distinct.

Reasons for the Decision

1. Pursuant to Rule 40.2(c) PCT and Article 154(3) EPC the Boards of Appeal of the EPO are responsible for deciding on protests made by an applicant against an additional fee charged by the EPO acting as ISA under the provisions of Article 17(3)(a) PCT.
2. In accordance with Article 17(3)(a) PCT, the ISA shall establish the international search report on those parts of the international application which relate to the additional inventions, provided that the corresponding fees have been paid with the prescribed time limit. In the present case a time limit of 45 days from the date of mailing of the invitation was set by the EPO, which is consistent with the provisions of Rule 40.3 PCT.
3. Rule 40.2(c) PCT offers the applicant the possibility to pay the additional fees under protest, "that is, accompanied by a reasoned statement to the effect...that the amount of the required additional fee is excessive". Consequently, if the applicant wishes to pay the additional fees under protest, these fees must be accompanied by such reasoned statement. Since, according to Article 17(3)(a) and Rule 40.3 PCT, these fees have to be paid within a specified time limit, it is also clear that the protest must be made within the same time limit, (see decision W 4/87; OJ EPO 1988, 425).
4. The fee in respect of the additional invention was paid in time. According to Article 17(3)(a) PCT, the ISA is therefore obliged to establish the international search

report on those parts of the international application which relate to the additional invention. However although the corresponding communication from the applicant, to the effect that the additional fee was being paid under protest, was also received in due time, it cannot be said to contain anything which could be interpreted as being a reasoned statement as to why the applicant considers that the ISA was wrong in finding that Claims 31 and 32 related to a different invention from that claimed in Claims 1 to 30. The communication refers to Claim 30, but no additional fee was required in respect of this claim. As regards Claims 31 and 32 the communication only explains why, in the opinion of the applicant, these relate to the same invention as each other. Accordingly the applicant's protest under Rule 40.2(c) has to be dismissed as inadmissible.

5. In these circumstances, 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:

M. Beer

E. Turrini