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File Number: W 33/90 - 3.2.3

Application No.: PCT US 89/04257

Publication No.:

Title of invention: Method and apparatus for erecting and removing offshore structures

Classification: E02B 17/02, B63B 35/02

D E C I S I O N  
of 14 March 1991

Applicant: Sheffield and Adams Engineering, Inc.

Headword:

EPC PCT Article 17(3)(a); Rules 40.1, 40.2(c), 13.1, 13.2

Keyword: "Reasons missing in the 'Invitation to Pay' pursuant to Rule 40.1 PCT"

Headnote



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Boards of Appeal

Chambres de recours

**Case Number : W 33/90 - 3.2.3**

**D E C I S I O N**  
**of the Technical Board of Appeal 3.2.2**  
**of 14 March 1991**

**Appellant :** Sheffield and Adams Engineering, Inc.  
15010 FM 2100, Suite 210  
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USA

**Representative :** Madan, Paul S.  
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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 26 January 1990.

**Composition of the Board :**

**Chairman :** C.T. Wilson  
**Members :** K. Stamm  
W. Moser

## Summary of Facts and Submissions

- I. On 27 September 1989 the Applicants filed international application PCT US 89/04257.
- II. On 26 January 1990, the EPO as competent International Searching Authority (ISA), pursuant to Article 17(3)(a) and Rule 40.1 PCT, issued an invitation to pay an additional search fee amounting to DM 2095.--, since the application lacked unity of invention a priori.
- III. The ISA based the invitation on the following statement:

"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.

  1. Claim 1: Deck placing and removal apparatus.
  2. Claims 2-5: Jacket placing and removal method and apparatus."
- IV. By telefax, received on 12 March 1990 together with an appropriate payment voucher, the Applicants paid the additional fee under protest according to Rule 40.2(c) PCT, filed amended claims and a reasoned statement to the effect that all of the originally filed Claims 1 to 5 were directed to one overall inventive concept.

## Reasons for the Decision

1. The protest complies with the requirements of Rule 40.2(c) PCT.

2. During the procedure of International Search, as the Applicants were correctly informed by the ISA, amendment of claims is not provided for. The question of alleged lack of unity of invention is, thus, to be dealt with having regard to the originally filed Claims 1-5.
3. According to Rule 40.1 PCT the invitation "shall specify the reasons for which the international application is not considered as complying with the requirement of unity of invention".

The statement given by the ISA, as mentioned under paragraph III above, is an unspecific allegation which does not refer to the factual subject-matter of the case.

4. In the decision W 4/85 dated 22 April 1986 and published in OJ EPO 1987, 63, the Board of Appeal expressed the opinion that the requirement to give reasons in an invitation pursuant to Article 17(3)(a) PCT is so fundamental that an unsubstantiated invitation cannot be regarded as legally effective. The present Board supports that view.

In the cited decision it was further stated that in straightforward cases all that may be necessary to substantiate lack of unity is a list of the application's various subject-matters. The Board is not, however, convinced that the present case is such a straightforward one.

The list presented in the invitation mentions as first invention a "Deck placing and removal apparatus" and as second invention a "Jacket placing and removal method and apparatus". Both inventions pre-suppose, either in final

or in causal respect, the totality of an offshore structure and thus relate to two integral complements of a unit.

Therefore, the presented list is not sufficient in itself to understand prima facie why the claims, and hence the application, cannot be considered to relate to a single general inventive concept.

6. It follows from the above that the invitation issued by the ISA did neither specify the reasons for which the international application was not considered as complying with the requirement of unity of invention nor did the list of the various subject-matters presented in it render specifying such reasons superfluous. The invitation of the ISA is, therefore, without legal effect and accordingly the additional fee paid by the Applicants cannot be retained.

Order

For these reasons, it is decided that:

Refund of the additional search fee is ordered.

The Registrar

The Chairman:



N. Maslin



C.T. Wilson

See  
W/2/90