

Veröffentlichung im Amtsblatt	Ja/Nein
Publication in the Official Journal	Yes/No
Publication au Journal Officiel	Oui/Non

Aktenzeichen / Case Number / N^o du recours : W 42/90 - 3.4.1

Anmeldenummer / Filing No / N^o de la demande : PCT/US 90/00525

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

Bezeichnung der Erfindung: Radiation detector array using radiation sensitive
Title of invention: bridges
Titre de l'invention :

Klassifikation / Classification / Classement : H01L 27/146

ENTSCHEIDUNG / DECISION

vom / of / du 23 October 1990

Anmelder / Applicant / Demandeur : Hughes Aircraft Company

Patentinhaber / Proprietor of the patent /
Titulaire du brevet :

Einsprechender / Opponent / Opposant :

Stichwort / Headword / Référence : a posteriori/Hughes Aircraft

EPO / EPC / CBE PCT Rule 40.2(c)

Schlagwort / Keyword / Mot clé : non-unity a posteriori; "invitation not
reasoned"

Leitsatz / Headnote / Sommaire

Europäisches
Patentamt
Beschwerdekammern

European Patent
Office
Boards of Appeal

Office européen
des brevets
Chambres de recours



Case Number : W. 42/90
International Application No. PCT/US 90/00525

D E C I S I O N
of the Technical Board of Appeal
of 23 October 1990

Applicant : HUGHES AIRCRAFT COMPANY
A Corporation of the State of Delaware
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Los Angeles, California 90045-0066
United States of America

Representative : Vijayalakshmi D. Duraiswamy
Hughes Aircraft Company
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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 30 January 1990.

Composition of the Board :

Chairman : K. Lederer
Members : G. Paterson
R. Shukla

Summary of Facts and Submissions

Following the filing of this international application, the EPO acting as ISA issued an invitation to pay an additional search fee because it considered that the application does not comply with the requirement of unity of invention - at least a posteriori, because "The general problem underlying the problem is not novel and a solution to it has already been found or does not involve an inventive step having regard to the state of the art as illustrated by (a published German patent application)." The Applicant paid the additional fee under protest, and contested the allegation of lack of unity, which was said to be based upon "a conclusory allegation".

Reasons for the Decision

1. According to Decision G 1/89 (to be published), 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 or lack of inventive step in the international application upon the disclosure of a specific German patent application which is said to be illustrative of the state of the art, the invitation contains no reasoning to support what is in fact a mere

allegation of invalidity. Such unreasoned and arbitrary allegations can hardly be met with a reasoned statement in reply from the Applicant.

This case seems clearly distinguishable on its facts from recently issued Decisions W 18/90 and W 27/89, in which findings of non-unity of invention a posteriori were upheld by the Board of Appeal as clear cases.

In these circumstances, in the Board's view the present case is certainly not a clear case in which an additional search fee has been justified.

Order

For these reasons, it is decided that:

Refund of the additional fee is ordered.

The Registrar:

The Chairman:

P. Martorana

K. Lederer