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DBA case W 0053/90 - 3.4.1

Date of decision 22 July 1991
Case number W 0053/90 - 3.4.1
Application number
IPC Class H05K3/10
Proceedings Language EN

Title of the application

Circuit boards with recessed traces

Applicant name

Opponent name

Headnote

Articles and Rules

pct 17(3)(a)

Keywords

No reasoning in invitation for a posteriori objection of non-unity

Objection not justified

Cited Decisions

Catchwords



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▲ Summary of Facts and Submissions

I. Following the filing of this international application, the EPO acting as ISA issued an invitation to pay two additional search fees because of an alleged failure to comply with the requirement of unity of invention, on the ground that "the problem underlying the invention" in Claim 1 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 is illustrated by US-A-3 710 196", and that the original single general inventive concept is not acceptable anymore. The claims were therefore separated into three groups, the subject-matter of each group being said to have its own inventive concept.

II. The Applicant paid one additional fee under protest, and stated that he did not wish to pursue a search of one of the three groups of claims, Claims 34 to 41, at this time. As reasons for the protest, the Applicant stated that he believed that the method claims are for a method which is specially adopted to make the boards claimed in the apparatus claims.

▲ 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 applications 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. In other words, it should be quite clear from the reasoning given in the "Invitation to pay" that the a posteriori objection of lack of unity is definitely justified.

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 opinion that there is lack of novelty or lack of inventive step in Claim 1 of the international application upon the disclosure of a prior patent 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 in respect of only one claim, and contains no reasons as to why all of Claims 1 to 33 and 55 to 61 (including independent Claims 2, 14, 15, 17, 32 and 33, and independent claims 55 and 56, in respect of which no suggestion of invalidity has been made) should be grouped into a subject having a different inventive concept from that of Claims 42 to 54.

3. 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.