

Publication in the Official Journal  Yes /  No

File Number: W 4/91 - 3.3.1  
Application No.: PCT/US 90/02463  
Publication No.: WO 9013531  
Title of invention: Octadienyl ethers and a process for making  
octadienyl ethers

Classification: C07C 43/178

**D E C I S I O N**  
of 31 January 1991

Applicant: Henkel Research Corporation

Proprietor of the patent:

Opponent:

Headword: Octadienyl Ethers/HENKEL

EPC PCT Rule 40.2(c)

Keyword: "Additional fee paid in time" - "Payment not accompanied by a  
reasoned statement"

**Headnote**

Case Number : W 4/91 - 3.3.1  
International Application No. PCT/US 90/02463

**D E C I S I O N**  
of the Technical Board of Appeal 3.2.3  
of 31 January 1991

**Applicant :** Henkel Research Corporation  
2330 Circadian Way  
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United States of America

**Representative :** A. von Kreisler  
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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 16 October 1990.

**Composition of the Board :**

**Chairman :** K. Jahn  
**Members :** R. Spangenberg  
J. Stephens-Ofner

## Summary of Facts and Submissions

- I. The Applicant filed international patent application PCT/US 90/02463 on 3 May 1990.

On 16 October 1990, the EPO acting as International Search Authority (ISA) sent to the Applicant an invitation to pay seven additional search fees in accordance with Article 17(3)(a) and Rule 40.1 PCT.

The invitation indicated that the application did not meet the requirement of unity of invention and set out eight groups of claims. The Applicant was informed at the same time that the additional fee had to be paid within 45 days from the date of mailing (i.e. by 30 November 1990) and that the payment may be made under protest, in accordance with Rule 40.2(c) PCT.

- II. By letter dated 26 November 1990 and received at the ISA on 28 November 1990, i.e. before the above-mentioned time limit had expired, the Applicant paid the required additional search fees.

This letter contained the following sentence:

"The payment of the additional fee is made under protest and it is requested to refund any overpaid fees to Account No. .... with the EPO".

However, it was not accompanied by a reasoned statement indicating the grounds on which the Applicant's protest is based.

- III. The ISA has referred the protest to this Board of Appeal for examination in accordance with Rule 40.2(c) PCT.

### Reasons for the Decision

1. Under Article 154(3) EPC the Boards of Appeal are responsible for deciding on a protest made by an Applicant against an additional fee charged by the EPO under the provisions of Article 17(3)(a) of the Cooperation Treaty.
  
2. Pursuant to Article 17(3)(a) PCT, the ISA shall establish the international search report on the parts of the international application which relate to the additional inventions, provided the corresponding fees have been paid within the prescribed time limit. In the present case, a time limit of 45 days from the date of mailing has been granted by the EPO, which is consistent with the provisions of Rule 40.3 PCT.

Since the search fees for the inventions deemed to be additional were paid in due time, the European Patent Office must establish the international search report on those parts of the present international application which relate to the said inventions.

3. Rule 40.2(c) PCT enables the Applicant to pay the additional fees under protest, "that is, accompanied by a reasoned statement to the effect that the international application complies with the requirement of unity of invention ...".

This makes it clear that if an Applicant wishes to pay additional fees under protest, then not only the additional fees must be paid, but also the reasoned statement that sets out the protest must be made within the specified time limit (cf. Decision W 4/87, OJ EPO 11/1988, 425).

From the statement referred to under paragraph II above it is clear that the Applicant wanted to pay the additional fees under protest but since he gave absolutely no reason indicating why in his opinion his application complies with the requirement of unity of invention, such a statement alone cannot be considered as a "reasoned statement" within the meaning of Rule 40.2(c) PCT; see also W 8/89 - 3.2.3 of 11 December 1990 (to be published in OJ EPO).

Therefore, the Applicant's protest under Rule 40(2)(c) PCT has to be dismissed as inadmissible.


4. Under these circumstances, the Board does not have to examine whether the invitation to pay is legally effective e.g. has been properly reasoned to substantiate lack of unity since that is a question of substantive law which has to be dealt with on the occasion of substantive examination of the protest which may only be initiated if the protest is admissible (cf. Decision W 6/88 of 14 April 1989, not published).
5. Consequently, the additional fees 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:

