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File Number: W 6/91 - 3.3.1

Application No.: PCT/EP90/01044

Publication No.: WO 9101970

Title of invention: Cyclic amidocarboxy surfactants, synthesis and use thereof

Classification: C07C 233/65

D E C I S I O N

of 3 April 1992

Applicant: Stepan Company

Headword: Amidocarboxy surfactants/STEPAN

EPC PCT Rules 13, 40 and 92.4(a)

Keyword: "Determination of the technical problem as precondition for
assessment of unity of invention" -
"Failure to determine the technical problem" -
"Disregard of a decision of the Enlarged Board of Appeal" -
"Reimbursement of additional search fees".

Headnote



Case Number : W 6/91 - 3.3.1
International Application No. PCT/EP90/01044

D E C I S I O N
of the Technical Board of Appeal 3.3.1
of 3 April 1992

Applicant : Stepan Company
22 Frontage Road
Northfield, Il. 60093
US

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 28 November 1990.

Composition of the Board :

Chairman : K. Jahn
Members : P. Krasa
J. Stephens-Ofner

Summary of Facts and Submissions

I. Following the filing of the international application PCT/EP 90/01044 the EPO acting as ISA on 28 November 1990 issued an invitation to pay within 30 days twelve additional search fees because it considered that the application did not comply, a posteriori, with the requirement of unity of invention as set forth in Rule 13 PCT because "the problem underlying an invention stated in Claims 1 to 18: phthalamic acid or derivatives thereof or surfactants containing these compounds is not novel. A solution to it has already been found or does not involve an inventive step having regard to the state of art as illustrated by:...". A list of fourteen documents follows without further comments. According to the ISA no single inventive concept could be acknowledged for the international application's subject matter which had to be regrouped into fourteen different subjects.

II. The Applicant paid two additional fees under protest and asserted, by telecopy of 20 December 1990, that the invitation to pay additional fees did not satisfy the requirements of Rule 40.1 PCT as the ISA, apart from saying that Claims 1 to 26 lack novelty and inventive step, had given no explanation as to why the particular groupings were adopted.

Furthermore, the Applicant submitted that the amount requested for the additional search fees, totalling some DM 25140.-, was clearly excessive, especially when taking into account that the search which had been conducted by the ISA must of necessity have covered all the subjects enumerated by the ISA in the various groupings.

III. The Rapporteur informed the Applicant, in a communication, that the written confirmation of the said telecopy, mandatory under Rule 92.4(a) PCT, was not on file and that, accordingly, the Board was inclined to hold that the protest was not in existence.

The Applicant in reply submitted a copy of EPO Form 1037 08.09 as evidence that a letter from the Applicant, dated 20 December 1990 and relating to the application No. PCT/EP 90/01044, was received at the EPO on 21 December 1990.

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 a protest made by an applicant against an additional search fee charged under Article 17(3)(a) PCT by the EPO when acting as the ISA.
2. According to Rule 92.4(a) PCT any communication of a document by telegraph or teleprinter or other like means shall be considered not to have been made if it is not confirmed in writing, signed by the Applicant, within 14 days after such telecopy communication.

The protest was filed via facsimile on 20 December 1990. The facsimile shows the letter head of the Applicant's Representative and in the left upper corner the date 20 December 1990 together with the number 25.26.55 660, designated "Our ref.".

The protest file which is before the Board did not contain the confirmation letter required under Rule 92.4(a) for this telecopy. Answering a respective communication from

the Rapporteur, the Applicant submitted a copy of EPO Form 1037 08.89.

It can be seen from this copy, that this form bears the heading "Acknowledgement of receipt of subsequently filed items for patent applications/patents at the European Patent Office" and goes on "Date and place of receipt are shown by the perforation appearing on this receipt...". It further contains a table, headed "items filed", with three columns. In the first column the Application No. PCT/EP 90/01044 is specified, in the second column, headed "Your reference", the number 25.26.55 660 is written, and the third column, headed "if desired, nature and date of these items", contains the entry "Letter dated 20 December 1990 enclosing Form 1010". A footnote in this form states "The receipt of the items indicated is confirmed". On the top of the copy of Form EPO 1037 08.89 the shadows resulting from the original's perforation show in clearly legible manner the date 21 December 1990.

This evidence strongly indicates that the letter, identified by the reference sign 25.26.55 660 and containing the protest, which had been submitted with the ISA via facsimile on 20 December 1990, was received by the ISA on 21 December 1990. Therefore, the Board concludes that it is plausible that the Applicant did confirm in writing the telecopy of the protest within the 14-day period provided for in Rule 92.4(a) PCT. Thus, the protest is in existence. It also complies with the formal requirements of Rules 40.2 and 40.3 PCT, and, hence, is admissible.

3. Rule 40.1 PCT requires that the invitation to pay additional search fees has to be reasoned. This requirement is designated to ensure the possibility of reviewing the justification of the requested additional

payment by an appellate competent body, namely a Board of Appeal in cases where the European Patent Office acts as ISA.

Although the ISA based its finding of lack of unity upon a posteriori considerations, it has given no reasons for its finding which are capable of being reviewed by the Board. The mere listing up of fourteen documents, allegedly being novelty destroying, is not normally sufficient to comply with the said requirement of Rule 40.1 PCT, even if the relevant passages of these documents are specified, e.g. in the partial international search report accompanying the invitation. A different conclusion could only be drawn in very simple and exceptional cases. The present case is not simple, since, inter alia, two of the citations (US-A-2 582 670 and US-A-3 095 286) were already mentioned in the international application, where their disclosure was said to be "relatively remote".

As all the considerations in the invitation to pay additional search fees are based on an alleged but not substantiated lack of novelty, they cannot remedy this deficiency in the reasoning. Hence, the invitation is void and of no effect, because of its noncompliance with the requirements of Rule 40.1 PCT.

4. Furthermore, although the ISA has based its finding that the international application lacked unity of invention upon the statement that the underlying technical problem was not novel, the invitation contained no analysis as to what the ISA considered to be the particular technical problem in view of both, the disclosure of the international application and the closest document of the state of the art. In view of the ISA's "reasoning" as quoted above (see No. I), it could be assumed that perhaps

the ISA considered the technical problem to be the compounds of Claims 1 to 18. However, compounds cannot normally be technical problems but are rather solutions to a technical problem or problems.

The determination of the technical problem underlying the invention is, however, a mandatory precondition for the assessment of unity of invention, i.e. whether or not the subject-matter claimed as solution of such a problem represents a single general inventive concept (cf. W 11/89 of 9 October 1989 and W 14/89 of 26 September 1990). The disregard of this principle would be in itself sufficient justification for the reimbursement of the additional search fees.

5. The Board also observes that the invitation is seriously defective as it fails to give any indication that the ISA took into account the principles laid down by the Enlarged Board of Appeal in the decisions G 1/89 and G 2/89 namely that, when considering the requirement of unity of invention, the Applicant should be given a fair treatment and additional fees should be charged under Article 17(3)(a) PCT only in clear cases (G 1/89 and G 2/89, in each case paragraph 8.2 of the Reasons, OJ EPO 1991, pages 155 ff. and 166 ff., respectively).
6. It follows from the above that the invitation was issued in violation of the requirements laid down in Rule 40.1 PCT.

Order


For these reasons, it is decided that:

Reimbursement of the two additional fees paid by the Applicant is ordered.

The Registrar:


E. Görgmaier

The Chairman:


K. Jahn