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File Number: W 43/91 - 3.3.3

Application No.: 91 909 479.7

Publication No.: WO 91 18025

Title of invention: Termination of anionic polymerization

Classification: C08F 2/42

D E C I S I O N  
of 9 April 1992

Applicant: Shell Internationale Research M.B.V.

Headword:

EPC PCT Rule 40.1

Keyword: "Invitation to pay additional search fees - without legal effect in the absence of reasons given for alleged lack of unity"

Headnote



Europäisches  
Patentamt

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Patent Office

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des brevets

Beschwerdekammern

Boards of Appeal

Chambres de recours

Case Number : W 43/91 - 3.3.3  
International Application No. PCT/EP91/00899

**D E C I S I O N**  
of the Technical Board of Appeal 3.3.3  
of 9 April 1992

**Applicant :**

Shell Internationale Research  
Maatschappij B.V.  
Carel van Bylandtlaan 30  
NL - 2596 HR Den Haag

**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 24 September 1991.

**Composition of the Board :**

**Chairman :** F. Antony  
**Members :** H. Fessel  
G. Davies

## Summary of Facts and Submissions

- I. On 13 May 1991 the Applicant filed international patent application PCT/EP 91/00899 with 20 claims.

The only independent Claim 1 reads as follows:

"In a process for anionically polymerizing monomers with an anionic polymerization initiator in a suitable solvent thereby creating a living polymer and termination of the living polymer, the improvement which comprises terminating the polymerization by the addition of a terminating agent selected from the group consisting of hydrogen or its isotopes, boranes, ammonia, halogens, hydrocarbons containing a C-H group where the carbon is connected directly to a triply-bound carbon or to two doubly-bound carbons and silanes."

- II. On 24 September 1991 the European Patent Office acting as International Search Authority (ISA) sent the Applicant an Invitation to pay 5 additional fees in accordance with Article 17(3)(a) and Rule 40.1 PCT.

In support of the finding of lack of unity of invention the ISA listed 6 inventions together with the relevant claims and the subject-matter relating thereto.

Moreover, a notification was enclosed concerning the result of the partial search carried out on the subject-matter of Claims 1 to 20 relating to the use as terminating agent of hydrogen or its isotopes.

The Invitation pointed out that the international search report would only be drawn up on the subject-matters relating to the use of boranes, ammonia, halogens, hydrocarbons and silanes respectively if, and to the

extent to which 5 additional fees (each in an amount of DM 2,200.-) in a total amount of DM 11,000.- were paid. The Applicant was invited to pay the amount indicated within 30 days from the date of mailing indicated on the Invitation.

- III. On 7 October 1991 the Applicant paid all 5 additional search fees under protest. On 10 October 1991 a reasoned statement was received to the effect that the international application complied with the requirements of unity of invention (Rule 40.2 PCT).

In support of the protest, the Applicant argued that the application met the requirements of unity of invention (Rule 13.1 PCT) since the subject-matter of Claims 1 to 20 was based on the same inventive concept, i.e. terminating a living polymer, which is formed in an anionic polymerisation, by means of a Lewis base, defined as an electron donating agent.

In a detailed reasoning, the termination by electrophilic substitution was explained, and examples of Lewis bases within the meaning of the Applicant, as e.g. borane, were given.

#### Reasons for the Decision

1. The protest is admissible under Rule 40.2(c) PCT, since the Applicant paid the additional fees under protest within the time limit as set in the invitation and filed a reasoned statement within said time limit. The Board is satisfied that the provisions of Rule 40.2(c) PCT reading "... pay the additional fee under protest, that is, accompanied by a reasoned statement ..." are met since "accompanied" in this context is not to be interpreted

according to its literal meaning, as "together with" but, having the purpose of these provisions in mind, in the sense "within the same set time limit".

2. In requesting 5 additional search fees, the ISA indicated that it considered the application to consist of 6 different inventions not so linked as to form a single general inventive concept (Rule 13.1 PCT) and therefore lacking unity of invention.

The Invitation was based on Article 17(3)(a) and Rule 40.1 PCT, the latter stipulating that the Invitation shall specify the reasons for non-unity. Where the Invitation form provides for giving those reasons, the Invitation referred to an annex. This annex then contained an enumeration of the individual inventions as seen by the ISA, together with an indication of the respective subject-matter. Nothing further was said.

It is established practice of the Boards of Appeal that Rule 40.1 PCT requires the reasons for alleged lack of unity to be specified in sufficient detail to enable the Applicant, and in case of a protest the Board, readily to recognise which considerations - in the sense of a logical chain of thoughts - lead the ISA to the conclusion that unity of invention was lacking. In the absence of sufficiently detailed reasons, an Invitation has no legal effect.

In the present case, detailed reasons are lacking, only an enumeration of subject-matters which the ISA considered to constitute separate inventions being given. Such a mere enumeration is not normally sufficient, except in simple, straightforward cases (W 04/85, OJ EPO 1987, 63). Such straightforward cases are rare exceptions, particularly in the chemical field (W 07/86, OJ EPO 1987, 67).

The present case certainly is not such a straightforward case. According to the problem specified in the description, which the ISA must take as its point of reference, the invention relates to an improvement of a hitherto known process for making polymers of any anionically polymerisable monomer, using alcohols as polymerisation terminating agents. According to Claim 1 of the application in suit, this improvement is to be achieved by substituting one of the agents selected from the group of terminating agents specified therein, for the known use of an alcohol. It is not prima facie evident that there is no basis for an inventive concept common to two or more of the agents listed in the annex to the Invitation; hence the present case is not a straightforward one in the sense of the afore-mentioned jurisprudence.

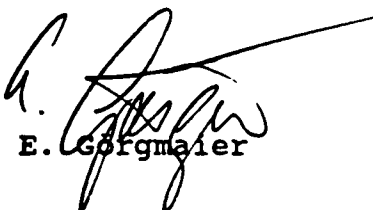
In the absence of detailed reasons enabling the Applicant to recognise the considerations that motivated the Invitation, and of a straightforward case in the above sense, the Invitation has no legal effect. The protest is thus justified. The additional fees paid by the Applicant therefore have to be refunded.

Order

For these reasons, it is decided that:

Refund of the additional search fees paid is ordered.

The Registrar:

  
E. Gorgmaier

The Chairman:

  
F. Antony