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File Number: W 50/92 - 3.2.2

Application No.: PCT/CA 92/00222

Publication No.:

Title of invention: Medical diagnostic nuclear camera system

Classification: A61B 6/00, G01T 1/166

**D E C I S I O N**  
of 6 April 1993

Applicant: Independent Scintillation Imaging Systems  
(ISIS) Inc.

Headword:

PCT Article 17(3)(a); Rules 40.1, 40.2(c), 13.2

Keyword: "Reasons missing in the invitation to pay"



Case Number : W 50/92 - 3.2.2  
International Application No. PCT/CA 92/00222

**D E C I S I O N**  
of the Technical Board of Appeal 3.2.2  
of 6 April 1993

**Applicant :** Independent Scintillation Imaging  
Systems (ISIS) Inc.  
3195 Louis-A-Amos  
Lachine, Quebec H8T 1C4 (CA)

**Representative :** Robic,  
55 St Jacques Street  
Montreal, Quebec H2Y 3X2 (CA)

**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 3 September 1992.

**Composition of the Board :**

**Chairman :** G. Szabo  
**Members :** M. Noël  
J. Van Moer

## Summary of Facts and Submissions

- I. On 28 May 1992 the Applicants filed international application PCT/CA 92/00222.
- II. On 3 September 1992, the EPO as competent International Searching Authority (ISA), pursuant to Article 17(3)(a) and Rule 40.1 PCT, issued an invitation to pay two additional search fees since the application lacked unity of invention a priori.
- III. The ISA based the invitation on the following statement:
- "The combination of categories of independent claims does not belong to any of those mentioned in Rule 13.2 PCT. The subjects defined and their means of solution as listed below do not present a sufficient technical relationship or interaction so as to form a single general inventive concept.
1. Claims 1-7: Mechanical positioner
  2. Claims 8-10: Collimator changer
  3. Claims 11-14: Camera system"
- IV. By letter received on 15 October 1992 together with an appropriate payment voucher, the Applicants paid one additional fee under protest according to Rule 40.2(c) PCT and requested that the fee be applied to Claims 8 to 10 of the second group of inventions. They also filed a reasoned statement to the effect that all of the originally filed Claims 1 to 14 were directed to one overall inventive concept.

**Reasons for the decision**

1. The protest is admissible.
2. The Board's understanding of Rule 40.2(c) PCT is that its responsibility in examining protests is limited to deciding whether the protest is justified in respect of the additional fees actually paid under protest. This means that only independent Claims 1 and 8 will be considered in the following.
3. According to Rule 40.1 PCT the invitation "shall specify the reasons for which the international application is not considered as complying with the requirement of unity of invention".

The statement given by the ISA, as mentioned under paragraph III above, is an unspecific allegation which does not refer to the factual subject-matter of the case.

4. In the decision W 4/85 dated 22 April 1986 and published in OJ EPO 1987, 63, the Board of Appeal expressed the opinion that the requirement to give reasons in an invitation pursuant to Article 17(3)(a) PCT is so fundamental that an unsubstantiated invitation cannot be regarded as legally effective. The present Board supports that view.

In the cited decision it was further stated that in straightforward cases all that may be necessary to substantiate lack of unity is a list of the application's various subject-matters. The Board is not, however, convinced that the present case is such a straightforward one.

The list presented in the invitation mentions as first invention a "Mechanical positioner" and as second invention a "Collimator changer". Both inventions pre-suppose, either in final or in causal respect, the totality of a medical diagnostic nuclear camera system and thus relate to two integral complements of a unit. In any case, it has been established in case W 6/90, OJ EPO 1991, 438 that a feature analysis, involving structural and functional features could establish whether or not there is a sole common concept around, and that the character of the common features will then determine whether these can be dismissed as clearly having no role in the later substantive examination for the inventive step for each independent subject-matter.

Therefore, the list presented by the ISA is not sufficient in itself to understand prima facie why the claims, and hence the application, cannot be considered to relate to a single general inventive concept.

Further, the invitation states that the listed subjects "do not present a sufficient technical relationship or interaction". As suggested above, this can only be established from the common features and their possible relevance to a future discussion about the inventive step.

5. It follows from the above that the invitation issued by the ISA did neither specify the reasons for which the international application was not considered as complying with the requirement of unity of invention nor did it present of the various subject-matters in sufficient detail to render specifying such reasons immediately superfluous. The invitation of the ISA is, therefore, without legal effect and accordingly the additional fee paid by the Applicants cannot be retained.

Order

For these reasons, it is decided that:

Refund of the additional search fee is ordered.

The Registrar:



S. Fabiani

The Chairman:

  
G Szabo

*R. Wolf* 28.5.93

*JM* 28.5.93