

w990006ep1.wpd-003676516

Decision of Technical Board of Appeal 3.3.2 dated 7 April 2000

W 6/99 - 3.3.2*

(Translation)

Composition of the board:

Chairman: P. A. M. Lançon

Members: U. Oswald

R. E. Teschemacher

Applicant: N.N.

Headword: NIR radiation II

Article: 154(3) EPC

Article: 19(1), 33(2), 34(2)(b) and (c), 34(3)(a) PCT

Rule: 13, 40.2(e), 66.2(a),(b) and (c), 68.1, 68.2, 68.3(c) and (e) PCT

Keyword: "If a lack-of-unity objection is raised 'a posteriori' during international preliminary examination, a first written opinion pursuant to Rule 66 PCT must be sent and the applicant's reply taken into consideration before an invitation pursuant to Article 34(3) PCT is issued"

Headnote:

Under the PCT Preliminary Examination Guidelines binding on the EPO, an invitation pursuant to Rule 68.2 PCT may not be issued until the applicant's reply to the examiner's first written opinion has failed to overcome the IPEA's 'a posteriori' lack-of-unity objection. The intention of speeding up the procedure by issuing simultaneously the first opinion and the invitation under Rule 68.2 PCT does not

justify departing from the procedure prescribed in the interests of the applicant, nor can it make up for the lack of at least a first written opinion pursuant to Rule 66.2 PCT prior to issue of the invitation pursuant to Article 34(3)(a) PCT in conjunction with Rule 68.2 PCT.

Summary of facts and submissions

I. International application PCT/DE 97... (international publication number WO 98...) has an international filing date of 29 October 1997.

Its claim 1 is worded as follows:

"Compounds of general formula I

...

wherein

F is a dye-signal molecule ..."

II. In the search procedure that preceded preliminary examination, the European Patent Office (EPO), acting as International Searching Authority (ISA), on 22 May 1998 had notified the applicant that the international application comprised five inventions and invited it to pay four additional search fees in accordance with Article 17(3)(a) PCT and Rule 40.1 PCT. The applicant had protested and on 29 May 1998 had paid all the additional fees requested, followed by the protest fee on 7 September 1998.

III. In an invitation dated 2 September 1998 to restrict the claims or to pay additional fees pursuant to Article 34(3)(a) PCT and Rule 68.2 PCT, the applicant was notified that the European Patent Office as the International Preliminary Examining Authority (IPEA) considered that the international application claimed five inventions; the applicant should therefore, as explained, either restrict the claims or pay four additional examination fees totalling DEM 12 000.

The IPEA reasoned that, in the broadest terms, the problem underlying the application could be seen as that of providing compounds for near infra-red diagnosis of Alzheimer's disease.

The only identifiable common feature of the different solutions to this problem using compounds of a general formula I as claimed in the application was the use of dyes F to tag ... protein in diagnosis of Alzheimer's disease.

Since however the prior-art document (1): ... included an earlier description ..., the idea of using dyes to tag ... protein in near infra-red diagnosis of Alzheimer's disease was already known.

Hence the above-mentioned sole common feature of the solutions could no longer be viewed as a special technical feature within the meaning of Rule 13 PCT; and since there was no other special technical feature forming a technical relationship between the inventions, the requirement of unity under Rule 13 PCT was not fulfilled.

To keep the number of solutions underlying all conceivable differing inventions within reasonable bounds, the compounds being considered should be arranged in groups in which F stood for

IV. Together with its protest received on 3 September 1998, the applicant paid all the additional fees requested and substantiated the protest by saying among other things that *an invention had unity if the problem underlying it had unity*, as was the case here. The choice of dyes F resulted in a group of inventions so linked as to form a single general inventive concept within the meaning of Rule 13.1 PCT. According to the description of the invention, especially page 5, paragraph 4, to page 6, paragraph 1, and page 17, paragraphs 2 and 3, the chosen form of "F" meant that the requirement in Rule 13.2 PCT for a relationship involving corresponding special technical features was also met. Under Rule 13.4 PCT dependent claims were also permitted, even where the features of any dependent claim could be considered as constituting in themselves an invention.

V. On 23 October 1998, as a result of the prior review of the invitation to pay the additional examination fees under Rule 68.3(e) PCT, the IPEA notified the applicant that the lack-of-unity objection had to be upheld and invited the applicant to pay a DEM 2 000 protest fee within one month for further examination of the protest.

In its justification it said in effect that, as indicated by the applicant, the problem could be considered to have unity for all claimed variant solutions, but that dye component "F" ..., which was common to all the claimed variants, was already known in Alzheimer's diagnosis from citation (1); the IPEA had therefore been right to find that component "F" as a generalised dye-signal molecule did not constitute a special feature under Rule 13.2 PCT. In that light the specific form of F claimed by the applicant could not be considered a special feature under Rule 13.2 PCT.

VI. The protest fee was paid by means of a letter received on 27 October 1998.

VII. Furthermore, on 23 October 1998, in a first written opinion pursuant to Rule 66 PCT, the IPEA notified the applicant that the disclosure in citation (1) was prejudicial to the novelty of the subject-matter claimed in the international application, so the application did not fulfil the requirements of Article 33(2) PCT. In the same opinion the IPEA also discussed the issue of inventive step.

Reasons for the decision

1. Under Article 154(3) EPC, the EPO boards of appeal as a competent higher authority within the meaning of Rule 68.3(c) PCT are responsible for deciding on a protest made by an applicant against an additional fee for international examination charged by the EPO under the provisions of Article 34(3)(a) PCT. The board is therefore competent to examine the protest in the light of the circumstances described in paragraphs II and III above.

2. The protest is admissible.

3. Unlike an international search, which concerns itself with the documents as filed (Article 19(1) PCT), an international preliminary examination gives the applicant a chance to correct deficiencies in the application by making amendments (Article 34(2)(b) PCT). Accordingly, the international search report is normally established without correspondence with the applicant, whereas before the international preliminary examination report is established, the applicant has an opportunity to protest against objections raised by the IPEA or to correct any deficiencies.

In case of lack of unity the IPEA may either, under Article 34(3)(a) in conjunction with Rule 68.1 PCT, proceed with the examination in respect of the entire application or, under Article 34(3)(a) in conjunction with Rule 68.2 PCT, invite the applicant to restrict the application to subject-matter which has unity or to pay additional examination fees.

Lack of unity in an application is a deficiency which must be indicated in the IPEA's first written opinion (Article 34(2)(c) in conjunction with Rule 66.2(a) PCT; PCT Preliminary Examination Guidelines VI-5.13, second sentence, PCT Gazette, Special Issue No. 07/1993, in the version which entered into force on 1 July 1992; unamended in the 9 October 1998 version, PCT Gazette, Special Issue No. 07/1998). If the reasons for the objection are not apparent, they must be given in the opinion (PCT Preliminary Examination Guidelines VI-5.13, first sentence, second half-sentence, *loc. cit.*).

4. In the present case the IPEA issued the invitation pursuant to Rule 68.2 PCT and the opinion pursuant to Rule 66.2(a) PCT simultaneously, which does not comply with the applicable provisions. The PCT Preliminary Examination Guidelines binding on the EPO in its capacity as IPEA stipulate in Chapter VI-5.13, third sentence, (*loc. cit.*) that an invitation pursuant to Rule 68.2 PCT is to be issued after the applicant's reply to the lack-of-unity objection in the examiner's first opinion has failed to overcome the objection. Thus there is clearly a prescribed order for the two actions of the IPEA, first the examiner's opinion and then the invitation pursuant to Rule 68.2 PCT. This is evidently meant to give the applicant an opportunity to put forward

arguments or amendments in response to the objection substantiated in the examiner's first opinion before being forced to decide on potentially far-reaching consequences of the alleged lack of unity.

5. It is not clear from the file before the board that the invitation dated 2 September 1998 to restrict the claims or to pay additional fees pursuant to Article 34(3)(a) PCT and Rule 68.2 PCT was preceded by due review of the available prior art with allowance for a reply from the applicant in accordance with Rule 66.2(c) PCT. In fact, in the present case the first written opinion under Rule 66 PCT (Form PCT/IPEA/408), containing a newly raised novelty objection under Article 33(2) PCT, was sent to the applicant by the IPEA on 23 October 1998, at the same time as the result of the prior review of the justification for the invitation to pay the additional search fees under Rule 68.3(e) PCT.

6. The file does show that in its protest under Rule 40.2(c) PCT, dated 2 June 1998, against the invitation to pay additional fees under Article 17(3)(a) PCT and Rule 40.1 PCT, the applicant did not contest the significance of the disclosure in citation (1) as demonstrated by the ISA; but this makes no difference to the prescribed order of subsequent proceedings before the IPEA, even if, as the file shows, the procedures before the ISA and the IPEA were conducted by the same examiner and evidently also by the same review board under Rule 68.3(e) PCT.

Obviously, by acting in this way the IPEA speeded up the procedure. Yet that does not justify departing from the procedure prescribed in the interests of the applicant under the binding guidelines, and in the context of preliminary examination it cannot make up for the lack of at least a first written opinion pursuant to Rule 66 PCT prior to issue of the invitation pursuant to Article 34(3)(a) PCT in conjunction with Rules 40.2(e) and 68.2 PCT.

7. In these circumstances there is no need to consider the IPEA's justification for its invitation dated 2 September 1998 to pay additional fees in accordance with the annex to Form PCT/IPEA/405.

8. The above conclusions regarding the chronological order for issuing a first written opinion under Rule 66 PCT and an invitation to pay additional fees under Article 34(3)(a) PCT in conjunction with Rule 68.2 PCT do not affect the substance of the invitation to pay. Hence an invitation to pay which the ISA has issued and adequately justified during the search procedure may in unchanged circumstances be repeated with the same justification during the preliminary examination procedure before the IPEA.

Order

For these reasons it is decided that:

The additional examination fees which were paid and the protest fee shall be reimbursed.

* As the decision concerns proceedings before the International Preliminary Examining Authority (IPEA), passages relating to technical details of the invention are not published. It is not possible to obtain copies of the unabridged decision.