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G 1/89

Aktenzeichen / Case Number / N° du recours :

Anmeldenummer / Filing No / N° de la demande :

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Bezeichnung der Erfindung: Polysuccinate esters and lubricating compositions
Title of invention: comprising same
Titre de l'invention :

Klassifikation / Classification / Classement : C10M 145/22

ENTSCHEIDUNG / DECISION
vom / of / du 2 May 1990

Anmelder / Applicant / Demandeur :

Patentinhaber / Proprietor of the patent /
Titulaire du brevet :

Einsprechender / Opponent / Opposant :

Stichwort / Headword / Référence : Polysuccinate esters

EPU / EPC / CBE Articles 112(1)(a)(b), 154(3); PCT Article 17(3)(a);
PCT Rules 13, 33, 40

Schlüsselwort / Keyword / Mot clé : "Competence of the Enlarged Board of Appeal in
protest cases under the PCT." - "Non-unity
a posteriori"

Leitsatz / Headnote / Sommaire

The agreement between the European Patent Organisation and the WIPO dated 7 October 1987, including the obligation under its Article 2 for the EPO to be guided by the PCT guidelines for international search, is binding upon the EPO when acting as an ISA and upon the Boards of Appeal of the EPO when deciding on protests against the charging of additional search fees under the provisions of Article 17(3)(a) PCT. Consequently, as foreseen in these guidelines, an international application may, under Article 17(3)(a) PCT, be considered not to comply with the requirement of unity of invention, not only "a priori" but also "a posteriori", i.e. after taking prior art into consideration. However, such consideration has only the procedural effect of initiating the special procedure laid down in Article 17 and Rule 40 PCT and is, therefore, not a "substantive examination" in the normal sense of that term.

Europäisches
Patentamt

Beschwerdekammern

European Patent
Office

Boards of Appeal

Office européen
des brevets

Chambres de recours



Case Number : G 1/89

D E C I S I O N
of the Enlarged Board of Appeal
of 2 May 1990

Applicant :

Representative :

Decision referring :
questions of law

Decision of the Technical Board of
Appeal 3.3.1 dated 29 June 1989 in
the case W 12/89 (protest under
Rule 40.2(c) PCT).

Composition of the Board :

Chairman : Paolo Gori

Members : Eskil Persson

Peter Ford

Arthur Jahn

Kurt Lederer

Gerald Paterson

Clément Payraudeau

Summary of relevant provisions and of the proceedings

- I. The European Patent Office (EPO) acts as an International Searching Authority (ISA) within the meaning of Chapter I of the Patent Cooperation Treaty of 19 June 1970 (PCT) in accordance with an agreement between the European Patent Organisation and the World Intellectual Property Organization (WIPO) based on Article 154 EPC and Article 16 PCT. The present agreement (the Agreement) was concluded on 7 October 1987 and entered into force on 1 January 1988 (OJ EPO 1987, 515). It is largely in line with a previous one of 11 April 1978.

- II. The international search and the establishment of the international search report under Articles 15-18 PCT are carried out by the Search Divisions of the EPO in the branch at The Hague. In accordance with Article 154(3) EPC, the Boards of Appeal of the EPO are responsible for deciding on protests made by applicants against additional search fees charged by the EPO, i.e. the Search Divisions, under the provisions of Article 17(3)(a) PCT in case of (alleged) lack of unity of invention. The Boards of Appeal exercise thereby the functions of the special instance of the ISA as referred to in Rule 40.2(c) PCT.

- III. According to Article 3(4)(iii) PCT, an international application shall comply with "the prescribed requirement of unity of invention". This means, as explained in Rule 13.1 PCT, that the application shall relate to one invention only or to a group of inventions so linked as to form a single general inventive concept. The normal fees for search (and preliminary examination) of international applications (Rules 16.1(a) and 58.1(a) PCT) are based on the assumption that the applications are restricted in

this way. If they are not, additional fees may be charged for each invention more than one (Articles 17(3)(a) and 34(3)(a) PCT).

- IV. Neither in the PCT itself, nor in the Rules under the PCT, are there any provisions specifying how to decide whether or not an international application complies with the prescribed requirement of unity of invention. However, in the Guidelines for International Search to be carried out under the PCT as agreed upon by the Interim Committee for Technical Cooperation at its seventh session in Geneva in October 1977 (PCT/INT/5), it is stated, inter alia, that lack of unity of invention may be directly evident "a priori", i.e. before considering the claims in relation to any prior art, or may only become apparent "a posteriori", i.e. after taking prior art into consideration. The latter situation is illustrated in the guidelines by the example that a document discovered in the international search shows that there is lack of novelty in a main claim, leaving two or more dependent claims without a single general inventive concept (Chapter VII, point 9). According to Article 2 of the Agreement referred to in paragraph I above, the EPO shall, in carrying out international search, be guided by these guidelines.
- V. As to the orientation of the international search, it follows from Rule 33.3 PCT that the search shall be made on the basis of the claims, with due regard to the description and the drawings (if any) and with particular emphasis on the inventive concept towards which the claims are directed. Insofar as possible and reasonable, the search shall cover the entire subject-matter to which the claims are directed or to which they might reasonably be expected to be directed after they have been amended.

VI. In its decision W 03/88 of 8 November 1988, the Technical Board of Appeal 3.3.1 noted that the ISA was examining many applications for novelty and inventive step, "at least on a preliminary basis", and thereafter judging such applications for unity of invention in the light of such examination ("a posteriori"). This practice was, in the Board's view, contrary to the obligations and power of the ISA under the PCT. In the reasons for its decision, the Board, making a sharp distinction between the duties of the ISA under Chapter I of the PCT and those of the International Preliminary Examining Authority (IPEA) under Chapter II of the PCT, stated that, in fact, the presence of Chapter II in the PCT emphasises the lack of competence of the ISA in respect of examining for novelty and inventive step. It was held that the duties of the ISA in relation to an international application as set out in Article 17 PCT are purpose-related solely to the carrying out of the international search and the production of a search report. The Board also took the view that the requirement of unity of invention set out in Rule 13 PCT is a procedural requirement relating to the carrying out of the international search in accordance with the procedure under Article 17 PCT, so as to ensure that the relevant prior art for the search as set out in Rule 33 PCT is limited to what can fairly be regarded as a single general inventive concept. This concept was interpreted by the Board in the following way (point 6 of the reasons for the decision):

"The term "single general inventive concept" (emphasis added) in Rule 13.1 PCT could at a first glance be misinterpreted as requiring an examination for novelty and inventive step. In the Board's view, however, the word "inventive" in this context is to be understood in the sense of "allegedly inventive", i.e. it refers to what the Applicant at the time of filing considers to be his

invention, irrespective of what the prior art, and therefore the patentable invention (if any) actually is. In other words, the "general inventive concept" within the meaning of Rule 13.1 PCT is simply the general concept of what the Applicant subjectively claims to be his invention."

No reference was made in decision W 03/88 to the PCT guidelines dealt with in paragraph IV above.

- VII. In its decision W 44/88 of 31 May 1989, the Technical Board of Appeal 3.4.1 took a different view on how to decide whether an international application complies with the requirement of unity of invention. The Board arrived at the conclusion that the ISA has, under the PCT and the Rules, both the power and the obligation to consider this requirement on an "a posteriori" basis (as well as "a priori"). Furthermore, the Board held that the EPO as an ISA must obey the PCT guidelines, insofar as they are not contradictory to the PCT or the Rules, which, in the Board's view, was not the case in this respect.

In the reasons for the decision, it was emphasised that the consideration whether or not an international application complies with the requirement of unity of invention has a direct impact on the extent of the search to be carried out.

- VIII. In its decision W 35/88 of 7 June 1989, the Technical Board of Appeal 3.5.1, referring in particular to the PCT guidelines in conjunction with Article 17(3)(a) and Rule 13.1 PCT, came to the same conclusion as Board 3.4.1 in respect of considering the requirement of unity of invention by the ISA on an "a posteriori" basis.

IX. In its decision W 12/89 of 29 June 1989, the Board of Appeal 3.3.1, in dealing with another protest under Rule 40.2(c) PCT, considered the situation in view of the fact that the Boards 3.4.1 and 3.5.1 had declined to follow decision W 03/88. The Board 3.3.1 was not convinced by the reasoning of the decisions W 44/88 and W 35/88 and did not accept that the existence of either the Agreement or the PCT guidelines could alter the primary obligation of both the ISA and the Boards of Appeal to apply the law as set out in the PCT and as properly interpreted. Thus, the Board 3.3.1 wished to follow its previous decision W 03/88 also in deciding upon the case now before it. Since, however, it had become clear that there was no uniform application of the law within the Boards of Appeal concerning the power and obligations of an ISA under Article 17(3)(a) PCT, which state of affairs was undesirable, the Board of Appeal 3.3.1 decided, pursuant to Article 112(1)(a) EPC, to refer the following three questions to the Enlarged Board of Appeal (case G 1/89):

1. Does an ISA have the power to carry out a substantive examination of an international application in respect of novelty and inventive step when considering under Article 17(3)(a) PCT whether the application complies with the requirement of unity of invention set forth in Rule 13.1 PCT?
2. If an ISA does have such power, in what circumstances does it have an obligation to carry out such a substantive examination?
3. Is the agreement between EPO and WIPO "dated 1 January 1988" binding either upon the EPO when acting as an ISA or upon the Boards of Appeal of the EPO?

- X. By letter dated 3 August 1989, the President of the EPO, having noted the diverging opinions of the Boards of Appeal 3.3.1 (decision W 03/88) and 3.4.1 (decision W 44/88) referred to in paragraphs VI and VII above, requested, pursuant to Article 112(1)(b) EPC, the Enlarged Board of Appeal to give its opinion on whether the EPO in its function as an ISA may, pursuant to Article 17(3)(a) PCT, request a further search fee where the international application is considered to lack unity of invention "a posteriori" (case G 2/89).
- XI. In a note of explanation attached to the President's letter, the Enlarged Board was informed that in 1988 the EPO produced 7.655 international searches and that in 230 cases objections of non-unity of invention were raised. Although no statistics exist, it was assumed that in some 30 to 40 of these 230 cases, the objections were made on an "a posteriori" basis. In commenting upon the decision W 03/88, inter alia, the following points were made:

"The essential point made by Board of Appeal 3.3.1 in Decision W 03/88 is that the word "inventive" as used in "single general inventive concept" in Rule 13.1 PCT is to be interpreted as "allegedly inventive", i.e. it refers to what the applicant at the time of filing considers to be his invention.

It should be remarked here that the often used distinction between a priori and a posteriori lack of unity of invention is essentially artificial since the border is fluid. Lack of unity a priori is based on general knowledge of the skilled person whereas a posteriori is based on knowledge from a particular prior art document. The distinction between general knowledge and particular knowledge is, however, only one of degree.

The basis of the decision is worrying in that it effectively advocates the abandonment of an objective criterion for assessing unity of invention in preference for a subjective criterion. Furthermore, it leads to the ISA being required to carry out a search on what is in reality two or more inventions merely because the applicant alleges that there is only one. For this service the ISA will receive a single search fee. Even if in later grant procedure it is found that there is indeed more than one invention, the ISA may still not be able to recoup a search fee if for instance the extra invention(s) is then abandoned.

On the other side, there is no loss of rights for the applicant if he decides not to pay any further search fee on invitation by the ISA. It is true that designated Offices are empowered to regard subject-matter as withdrawn which has not been searched in consequence of non-payment of additional search fees; they are, however, obliged to give the applicant an opportunity to avoid this legal consequence (if foreseen in national law) by the payment of a special fee (Article 17(3) PCT, cf. Rule 104(b)(3) EPC)."

- XII. On 14 September 1989, the Enlarged Board, considering that the points of law, which had been referred to the Board in case G 1/89 and case G 2/89, concerned similar subject-matters, decided to consider these points in consolidated proceedings in accordance with Article 8 of the Rules of Procedure of the Enlarged Board of Appeal.
- XIII. In a communication dated 9 October 1989, the applicant in case G 1/89 (W 12/89) was informed about the action taken by the President of the EPO in case G 2/89 and given the opportunity to file any observations he might wish to make on the matters before the Enlarged Board within a time

limit of three months. No such observations have, however, been received by the Board.

Reasons for the Decision

1. This is the first time the Enlarged Board has been involved in the special activities of the Boards of Appeal as referred to in Article 154(3) EPC, i.e. in deciding on protests against additional search fees charged under Article 17(3)(a) PCT. In view of the fact that these activities are in principle governed by the provisions of the PCT and do not concern the application of the EPC, the Enlarged Board has, of its own motion, considered whether it is competent under Article 112 EPC to decide and to give opinions on such matters. In this respect, it is to be noted that according to Article 150(2) EPC the provisions of the PCT shall be supplemented by the provisions of the EPC when an international application is the subject of proceedings before the EPO. There are no provisions under the PCT corresponding to those under the EPC concerning the Enlarged Board. The main purpose of referring questions to the Enlarged Board is to ensure uniform application of the law. This is, of course, of equal importance under the PCT as under the EPC. Insofar as the Boards of Appeal of the EPO are responsible for the application of the PCT, it is therefore justified and fully in line with the interest of applicants making use of the PCT that questions relating to such application can be referred to the Enlarged Board in accordance with the provisions of Article 112 EPC. Thus, the Enlarged Board is competent to deal with all the questions which have been now referred to it.
2. This is also the first time that the President of the EPO has made use of his power under Article 112(1)(b) EPC to

refer a point of law to the Enlarged Board of Appeal, when two Boards of Appeal have given different decisions on that question. However, in view of the increasing number of Board of Appeal decisions being issued every year, the use by the President of this power in order to ensure uniform application of the law by the rising number of Boards of Appeal is likely to become more important. Against this background, it is clearly desirable that whenever a Board of Appeal is aware that its decision in the course of an appeal involves a different interpretation of the law, on a point of substance and importance, from that applied in a decision of a previous Board, attention is drawn to this fact in its decision, in a manner which is appropriate to the circumstances of the case, and reasons are given for the different interpretation, in order that the President can take appropriate action.

3. In turning to the substance of the matter before the Enlarged Board, as a general remark, it should be noted that the problems involved are mainly due to the fact that under the PCT, as well as under the EPC, search and (substantive) examination are carried out in sequentially different steps and by different examiners. This procedural separation of search and examination leads inevitably to a certain overlapping, because of the functional relationship between search and examination. Thus, although the objective of the search is in principle limited to discover and report on relevant prior art for the purpose of assessing novelty and inventive step, which is finally the task of the examining authority (i.e. the IPEA and/or the designated Office under the PCT and the Examining Division under the EPC respectively), it is obvious that in many instances the search examiner needs to form a provisional opinion on these issues in order to carry out an effective search. Otherwise, he would simply

be at a loss how to judge the relevance of the documents in the prior art and how to arrange the search report accordingly. This overlapping is inherent in the PCT and the EPC and is in contrast to the system of most national patent laws, where search and examination are carried out in one combined operation, normally by the same examiner, and where consequently there is no separation of fees for search and examination as under the PCT and the EPC.

4. The requirement of unity of invention under the PCT (cf. paragraph III above) applies equally to the procedure before the ISA and to the procedure before the IPEA according to Articles 17(3)(a) and 34(3)(a) PCT, which is in conformity with the procedural separation of search and examination as referred to above and reflects the principle that the normal fees for search and examination are related to one invention (or a single general inventive concept) only, as explained in paragraph III above. This leads, in the view of the Enlarged Board, to the conclusion that the requirement of unity of invention under the PCT must in principle be judged by the same objective criteria by both the ISA and the IPEA. Thus, the Enlarged Board cannot agree with the view expressed by the Board 3.3.1 in its decision W 03/88, that the ISA should, in contrast to the IPEA, for the purpose of considering unity of invention be restricted to the general concept of what the applicant subjectively claims to be his invention (cf. paragraph VI above). This view is, in the Enlarged Board's opinion, based on too narrow a concept of the task and the competence of the ISA under the PCT, overlooking the functional relationship between search and examination as explained in paragraph 3 above.
5. As appears from paragraph IV above, the PCT guidelines for international search contain a direct reference to the consideration of unity of invention by the ISA on an

"a posteriori" basis, i.e. after an assessment of the claims with regard to novelty and inventive step in relation to the prior art. A comparison with the corresponding EPO guidelines, which is of a particular interest in this context because of the similarity of the PCT and the EPC in respect of the separation of search and examination, shows that also under the EPC it is clearly foreseen that consideration of unity of invention by the Search Divisions may be carried out on an "a posteriori" basis (Part B, Chapter VII, point 5; cf. Rule 46 EPC). In the view of the Enlarged Board, this is a consequence of the special structure of the PCT and the EPC, as outlined in paragraphs 3 and 4 above. Therefore, the guidelines must on this point be considered as consistent with the PCT and the EPC. As to the PCT guidelines, it is also to be noted that such guidelines are based on Article 56 PCT dealing with the task of the Committee for Technical Cooperation (cf. in particular Article 56(3)(ii) PCT and the reference to the need for uniformity of i.a. working methods).

6. As also appears from paragraph IV above, according to Article 2 of the Agreement, the EPO shall, in carrying out international search, be guided by the PCT guidelines. The Board 3.3.1 has in its decision W 12/89 questioned whether the Agreement is binding upon the EPO when acting as an ISA and upon the Boards of Appeal of the EPO (cf. paragraph IX above). The Agreement is properly based on Article 154 EPC and Article 16 PCT and is, therefore, binding on the EPO, including the Boards of Appeal in exercising their special functions under the PCT in accordance with Article 154(3) EPC. Insofar as the question referred to the Enlarged Board by Board 3.3.1 may be related to the obligation under the Agreement to be guided by the PCT guidelines in respect of considering unity of invention by the ISA, based on the idea that in

case of a conflict between the guidelines and the PCT itself, the latter would prevail as higher ranking law, it follows from paragraph 5 above that in the view of the Enlarged Board the guidelines are on this point consistent with the PCT. Consequently, this obligation is binding as well, in the sense that the PCT guidelines are in this respect to be applied as a matter of principle. Such application involves a great deal of discretion in individual cases.

7. It follows from the above considerations that the EPO in its function as an ISA may, pursuant to Article 17(3)(a) PCT, request a further search fee where the international application is considered to lack unity of invention "a posteriori".
8. In its decision W 12/89, the Board 3.3.1 referred two further questions to the Enlarged Board, namely whether an ISA has the power to carry out "a substantive examination" of an international application in respect of novelty and inventive step when considering under Article 17(3)(a) PCT whether the application complies with the requirement of unity of invention set forth in Rule 13.1 PCT and, if so, in what circumstances an ISA does have an obligation to carry out such "a substantive examination " (cf. paragraph IX above).
 - 8.1 In accordance with normal terminology, the term "examination" or "substantive examination" refers to the activities of the authorities responsible for deciding on patentability, such as the Examining Division of the EPO, or, in the case of the PCT, to the activities of the IPEA and/or the designated Office. Obviously, an ISA does not have any power to carry out such activities. As explained in paragraph 3 above, an ISA may only form a provisional opinion on novelty and inventive step for the purpose of

carrying out an effective search. This opinion is in no way binding on the authorities referred to above. The same principle applies also when an ISA considers that an international application does not comply with the requirement of unity of invention set forth in Rule 13.1 PCT on an "a posteriori" basis. Such consideration has only the procedural effect of initiating the special procedure laid down in Article 17 and Rule 40 PCT and is, therefore, not a "substantive examination" in the normal sense of that term.

- 8.2 It may be added that the consideration by an ISA of the requirement of unity of invention should, of course, always be made with a view to giving the applicant fair treatment and that the charging of additional fees under Article 17(3)(a) PCT should be made only in clear cases. In particular, in view of the fact that such consideration under the PCT is being made without the applicant having had an opportunity to comment, the ISA should exercise restraint in the assessment of novelty and inventive step and in border-line cases preferably refrain from considering an application as not complying with the requirement of unity of invention on the ground of lack of novelty or inventive step.

Order

For these reasons, it is decided that the questions of law referred to the Enlarged Board of Appeal by the Technical Board of Appeal 3.3.1 in its decision W 12/89 are answered as follows:

The agreement between the European Patent Organisation and WIPO dated 7 October 1987, including the obligation under its Article 2 for the EPO to be guided by the PCT guidelines for international search, is binding upon the EPO when acting as an

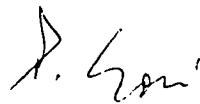
ISA and upon the Boards of Appeal of the EPO when deciding on protests against the charging of additional fees under the provisions of Article 17(3)(a) PCT. Consequently, as foreseen in these guidelines, an international application may, under Article 17(3)(a) PCT, be considered not to comply with the requirement of unity of invention, not only "a priori" but also "a posteriori", i.e. after taking prior art into consideration. However, such consideration has only the procedural effect of initiating the special procedure laid down in Article 17 and Rule 40 PCT and is, therefore, not a "substantive examination" in the normal sense of that term.

The Registrar:



J. Rückerl

The Chairman:



P. Gori



