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D E C I S I O N
of 18 April 2001

Case Number: W 0001/01 - 3.3.2

Application Number: 99936957.2

Publication Number: PCT/IT99/00224

IPC: A61

Language of the proceedings: EN

Title of invention:
Odontostomatologic use of apatite-base nanostructured material

Applicant:
Dolci G., Mongiorgi R., Prati C., Valdré G.

Opponent:
-

Headword:
Apatite/DOLCI

Relevant legal provisions:
PCT Art. 17(3)
PCT R. 13(1), 40

Keyword:
-

Decisions cited:
G 0001/89, G 0002/89, W 0004/87, W 0016/92

Catchword:
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Beschwerdekammern | Boards of Appeal | Chambres de recours

Case Number: W 0001/01 - 3.3.2
International Application No. PCT/IT99/00224

D E C I S I O N
of the Technical Board of Appeal 3.3.2
of 18 April 2001

Applicants: Dolci, Giovanni
Via Antonio Guarnieri 51
00124 Roma (IT)

Mongiorgi, Romano
Via Canovella 3/2
40043 Marzabotto (BO) (IT)

Pratti, Carlo
Via Mameli 18
47100 Forli' (IT)

Valdre', Giovanni
Via Mascarella 77/2
40126 Bologna (IT)

Representative: Banchetti, Marina - Capasso, Olga -
de Simone, Domenico - Iannone, Carlo -
Taliercio, Antonio - Zanardo, Giovanni -
Ing. Barzano' & Zanardo Rome S.p.A.
Via Piemonte 26
00187Roma (IT)

Subject of the Decision: **Protest according to Rule 40.2(c) of the Patent Cooperation Treaty by the applicants against the invitation (payment of additional fee) of the European Patent Office (International Search Authority) dated.**

Composition of the Board:

Chairman: U. Oswald
Members: C. Germinario
B. Günzel

Summary of Facts and Submissions

I. By letter despatched on 22 November 1999, the European Patent Office, acting as International Searching Authority (ISA) for international application No. PCT/IT 99/00224, raised the objection that the application did not comply with the requirements of unity of invention under Rule 13.1 PCT since the features common to the different defined inventions were known and thus no single general inventive concept existed. The applicants were invited to pay four additional search fees under Article 17(3)(a) and Rule 40(1) PCT within 30 days of the date of despatch of the communication.

III. The applicants paid the requested additional fees under protest on 16 December 1999. The protest was accompanied by the statement that the reasons on which the ISA had based its findings were not properly grounded. Moreover, since the objection was based on the alleged lack of novelty of the claimed subject-matter, in the applicant's view, the ISA was not the competent authority to deal with it, as an evaluation of that kind should have been made during the substantive examination, and not during the search. In a letter dated 16 February 2000 directed to the EPO acting as International Preliminary Examining Authority (IPEA) the applicants explained with substantive arguments the reasons why, in their opinion, the claimed subject-matter met the requirements of unity of invention.

IV. By letter despatched on 22 March 2000 the Review Panel pursuant to Rule 40(2)(e) PCT declared the invitation of the ISA to pay additional fees justified, because

the ISA was entitled to raise an "*a posteriori*" lack of unity objection, and the applicants' protest was not accompanied by a reasoned statement within the meaning of Rule 40.2(c) PCT, but simply by an unsubstantiated assertion. The applicants were invited to pay the protest fee, which was paid on 19 April 2000.

With respect to the finding of the Review Panel that the protest had not been sufficiently reasoned, the applicants relied on their letter dated 16 February 2000, addressed to the EPO acting as IPEA, in which substantive reasons as to the unity of the invention had been produced.

Reasons for the Decision

1. According to Article 17(3)(a) PCT the additional fees due if the ISA considers that the international application does not comply with the requirements of unity of invention have to be paid within a prescribed time limit. Moreover, Rule 40.2(c) PCT provides that the applicants "may pay the additional fees under protest, that is, **accompanied by a reasoned statement** to the effect that the international application complies with the requirement of unity of invention..". It follows from this that the time limit for paying these fees also applies to the filing of the protest and that when paying under protest, the applicant has, **at the same time** or at least within the time limit stated for the payment, to file **with the same authority substantive arguments** supporting his opinion that the claimed subject-matter complies with the requirement of unity of invention provided for in Rule 13.1 and 13.2 PCT. Therefore, for the protest to be admissible, a

reasoned statement has to be filed within the time limit for paying the additional fees under protest and no arguments submitted after expiry of that time limit can be taken into account for the purpose of determining the admissibility of the protest. For this reason alone, the applicants' letter dated 16 February 2000, which was filed after expiry of the time limit for filing the protest, namely 22 December 1999, cannot be taken into consideration for the purpose of determining the admissibility of the protest (W 04/87 - OJ EPO 1988, 425, points 3 and 5).

2. In the present case, the payment of the additional fees was accompanied by the simple assertion that the reasons given by the search examiner were not properly grounded, and the only argument given in support of this opinion was that the ISA was not the competent authority to raise objections of lack of unity *a posteriori* based on considerations directly related to the patentability of the claimed subject-matter, which considerations, so the applicants argued, should remain in the competence of the International Preliminary Examining Authority.

3. The legal question of whether the ISA is competent or not to deal with *a posteriori* lack of unity objections has been settled by the Enlarged Board of Appeal in decisions G 1/89 (OJ EPO 1991, 155) and, specifically, G 2/89 (OJ EPO 1991, 166). Both decisions laid down that the EPO in its functions as an ISA may, pursuant to Article 17(3)(a) PCT and in accordance with the PCT Guidelines (here for International Search), raise an objection and request a further search fee where the international application is considered to lack unity of invention *a posteriori.* In this situation, if an

applicant wishes to question the legal correctness of such findings, for the protest to be substantiated on the basis of these arguments, it is not sufficient to put forward a simple assertion without giving any reason as to why the findings of the Enlarged Board of Appeal were to be considered incorrect. No such reason has been given by the applicants in the present case.

4. As to the substantive issue of non-unity, the "reasoned statement" required by Rule 40.2(c) PCT necessitates a substantive argumentation aimed at showing the existence of the single general inventive concept, which, in the applicants' view, links all the different inventions within the meaning of Rule 13.1 and 13.2 PCT. No such arguments have been produced within the stated time limit of 30 days (see W 16/92 - OJ EPO 1994, 237).

5. Under these circumstances, the protest is not considered to be reasoned within the meaning of Rule 40.2(c) PCT and, for this reason, it is inadmissible.

Order

For these reasons it is decided that:

1. The protest under Rule 40.2(c) PCT is rejected as inadmissible.

2. The protest fee is reimbursed.

The Registrar: The Chairman:

A. Townend U. Oswald