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**D E C I S I O N**  
of 27 April 2001

**Case Number:** W 0002/01 - 3.5.1

**Application Number:** PCT/US...

**Publication Number:** -

**IPC:** ...

**Language of the proceedings:** EN

**Title of invention:**  
...

**Applicant:**  
N.N.

**Opponent:**  
-

**Headword:**  
-

**Relevant legal provisions:**  
PCT Art. 34(3)(a)  
PCT R. 68.3(c)

**Keyword:**  
"Reasoned statement (no)"  
"Protest inadmissible"

**Decisions cited:**  
-

**Catchword:**  
-



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Patentamt

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Beschwerdekammern

Boards of Appeal

Chambres de recours

**Case Number:** W 0002/01 - 3.5.1  
**International Application No.** PCT/US...

**D E C I S I O N**  
**of the Technical Board of Appeal 3.5.1**  
**of 27 April 2001**

**Applicant:** N.N.

**Representative:** N.N.

**Subject of the Decision:** Protest according to Rule 68.3(c) of the Patent Cooperation Treaty made by the applicant against the invitation of the European Patent Office (International Preliminary Examining Authority) to restrict the claims or pay additional fees dated.

**Composition of the Board:**

**Chairman:** S. V. Steinbrener  
**Members:** A. S. Clelland  
C. Holtz

## Summary of Facts and Submissions

- I. International patent application PCT/US... was filed at the USPTO on 5 May 1999, claiming the priority of an earlier national application.
- II. On 3 March 2000 the European Patent Office, in its capacity as International Preliminary Examination Authority (IPEA), invited the applicants to restrict the claims or pay additional fees in accordance with Article 34(3)(a) PCT and Rule 68.2 PCT.
- III. In its invitation the IPEA argued that various prior art documents, of which only US-A-... was discussed in detail, completely disclosed the subject-matter of independent claim 1. It was then argued that independent claim 26 comprised all the steps recited in claim 1; since these steps were all known there was no common inventive feature and claims 1 and 26 were not linked by a common inventive concept. The IPEA also held that claims 31 and 33 were not linked to any other independent claim by a common inventive concept.
- IV. The appellant paid the additional fees under protest in accordance with Rule 68.3(c) PCT. The protest was in the form of a fax, received on 31 March 2000, including a cover sheet stating that three pages were being sent, a single-page letter bearing the same date, informing the IPEA of the payment of three additional search fees and stating that these fees were being paid under protest, and a sub-authorisation. other than formal matters the letter only included the following sentence:

"This fee is being paid under protest for it is Applicant's contention that unity isn't lacking"

No further reasoning was received either within the 1-month time limit set by the IPEA or subsequently.

### **Reasons for the Decision**

1. Rule 68.3(c) PCT states that an applicant may pay an additional search fee under protest, that is, accompanied by a reasoned statement to the effect that the international application complies with the requirement of unity of invention or that the amount of the required additional fee is excessive.
2. As noted at point IV above, in the present case the protest consists of the single sentence that the applicant contends that there is no lack of unity. This is a mere assertion and cannot be described as a reasoned statement within the sense of Rule 68.3(c) PCT; the established case-law requires that such a statement must give reasons as to why the IPEA is wrong as to unity of invention or why the search fees are excessive.
3. The Board therefore concludes that there is no reasoned statement. Accordingly, the protest must be rejected as inadmissible.

**Order**

**For these reasons it is decided that:**

The protest under Rule 68.3(c) PCT is rejected as inadmissible.

The Registrar:

The Chairman:

M. Kiehl

S. V. Steinbrener