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D E C I S I O N
of 28 April 2003

Case Number: W 0008/01 - 3.2.4

Application Number: PCT/CA 99/00015

Publication Number: WO 99/35944

IPC: A47G 27/04

Language of the proceedings: EN

Title of invention:
Anchor sheet and anchor sheet module

Applicants:
TAC-FAST SYSTEMS S.A.
TAC-FAST SYSTEMS CANADA LIMITED

Opponent:
-

Headword:
-

Relevant legal provisions:
PCT R. 40.1, 40.2

Keyword:
"Protest limited to one of several additional search fees"
"Invitation to pay protest fee - not ruling out any misunderstanding"
"Refund of the protest fee"

Decisions cited:
W 0003/93

Catchword:
In view of the fact that the limited protest was entirely allowed by the review panel, the protest fee paid without any reason and apparently due to a misunderstanding is refunded.

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Beschwerdekammern | Boards of Appeal | Chambres de recours

Case Number: W 0008/01 - 3.2.4

D E C I S I O N
of the Technical Board of Appeal 3.2.4
of 28 April 2003

Applicants: TAC-FAST SYSTEMS S.A.
TAC-FAST SYSTEMS CANADA LIMITED

Representative: Hunt, John, C. et al.
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Subject of this decision: **Protest according to Rule 40.2(c) of the Patent Cooperation Treaty made by the applicants against the invitation (payment of additional fees) of the European Patent Office (International Searching Authority) dated 18 May 1999**

Composition of the Board:

Chairman: C. Andries
Members: B. Schachenmann
T. Kriner

Summary of Facts and Submissions

I. On 18 May 1999 the EPO acting as International Searching Authority (ISA) issued an invitation under Rule 40.1 PCT to pay four additional fees within 45 days because the international application No. PCT/CA 99/00015 contained five groups of inventions (1) to (5).

II. The applicant paid the additional fees under protest on 3 June 1999 and requested "that the Examiner reconsider the separation of claim groups (2) and (3)". The reasoned statement accompanying the protest was limited to the issue that in the applicant's view the subject matter of these two claim groups related to a single general inventive concept and that the limited number of elements required to be searched in order to cover the non-overlapping subject matter did "not warrant an additional search fee". The applicant did not contest the non-unity objection of the ISA concerning claim groups (1),(2),(4) and(5).

III. On 11 October 1999 the ISA issued a "Notification regarding review of justification for invitation to pay additional search fees" on form PCT/ISA 228 (January 1994). The printed text of the relevant section of the form reads as follows:

"The applicant is hereby notified that (...) this International Searching Authority has reviewed the justification for the invitation to pay additional search fees (...) and the applicant is **invited to pay a protest fee**, within the time limit indicated above, for further examination of the protest, in the amount of (...) EUR 1.022,00, because the invitation is justified

in part. To the extent the invitation is not justified, 1 additional search fee paid under protest will be refunded in due course.

The reasons for this invitation to pay a protest fee are indicated in the Annex.

Failure to pay the protest fee within the time limit indicated above will result in the protest being considered withdrawn."

IV. The applicant paid the protest fee on 25 October 1999 without supplementing the reasoned statement which accompanied the protest or changing its requests.

Reasons for the Decision

1. As all formal requirements of Rule 40.2 PCT (protest fee, reasoned statement) were met in due time, the protest is admissible.

2. In its notification of 11 October 1999 the ISA, after prior review of the justification for the invitation to pay additional fees, accepted the applicant's sole request referring to the refund of only one search fee for the claim groups (2) and (3) and announced the refund of one additional search fee "in due course". Thus, in effect, the review panel of the ISA considered the protest which was limited to claim groups (2) and (3) as entirely justified.

3. Nevertheless, the printed text of the relevant section of the form used for notification of the result of the review invited the applicant to pay a protest fee "for

further examination of the protest". In addition, the form also contained at the end of the relevant section (see paragraph III, *supra*) a warning that failure to pay the protest fee would result in the protest being considered withdrawn. It is obviously against this background that the applicant paid the protest fee even if the review panel had entirely accepted his limited protest.

4. It appears that form PCT/ISA 228 (January 1994) used by the ISA in the present case is well suited for the standard cases in which the review panel either finds that the invitation was not justified or that the invitation was entirely justified as well as for cases where a protest can only be accepted in part. However, the same form seems to be less suited for cases like the present one in which a limited protest is entirely allowed by the review panel. In these circumstances the unconditional invitation to pay a protest fee does not appear to rule out any misunderstanding.

5. As explained in the Notice from the European Patent Office dated 26 August 1992 concerning the protest procedure under the PCT [lack of unity], OJ EPO 1992, 547, if the review panel finds that the invitation was justified only in part, the applicant is invited to pay the protest fee if he wishes the protest to be referred for decision to the Board of Appeal **to the extent it was not allowed** (emphasis added). Thus, it is clear that an applicant whose limited protest was entirely allowed does not need to pay a protest fee as a precondition for the announced partial refund of the additional search fees.

6. Neither could, in these circumstances, payment of a

protest fee have any effect for the further examination of the protest. As set out in decision W 3/93 (OJ EPO 1994, 931), the Boards of Appeal acting as "three-member board" within the meaning of Rule 40.2(c) PCT only examine whether, considering the reasons stated by the ISA and the submissions made in support of the protest, retaining additional search fees was justified. If a protest is only directed against a part of the invitation, as in the present case, the Board would have no reason to examine of its own motion whether the uncontested part of the invitation was justified even if a protest fee was paid. Furthermore, since such a limited protest will not of course be substantiated as far as the uncontested part of the invitation is concerned, a protest fee paid in these circumstances could never be refunded.

7. However, in view of the fact that the limited protest was entirely allowed by the review panel, the Board considers it equitable to treat the present case as if the protest was entirely justified, which leads to a refund of the protest fee under Rule 40.2(e) PCT, last sentence. Otherwise the applicant would have paid the protest fee without any reason and apparently due to a misunderstanding not ruled out by the form used by the ISA.

Order

For these reasons it is decided that:

1. The protest is considered justified as far as the requested refund of one additional search fee is concerned.

2. The uncontested part of the invitation to pay additional search fees is not examined.

3. The protest fee is reimbursed.

The Registrar: The Chairman:

G. Magouliotis C. Andries