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D E C I S I O N
of 15 November 2004

Case Number: W 0028/03 - 3.3.1

Application Number: PCT/US 02/35429

Publication Number: WO 03/040256

IPC: C09K 11/06

Language of the proceedings: EN

Title of invention:

Electroluminescent iridium compounds having red-orange or red emission and devices made with such compounds

Applicant:

E.I. Du Pont de Nemours and Company

Opponent:

-

Headword:

Iridium compounds/DU PONT DE NEMOURS

Relevant legal provisions:

PCT Art. 34(3)

PCT R. 13.1, 13.2, 68(2)(3)

Keyword:

"Protest - inadmissible"

Decisions cited:

W 0018/99, W 0002/00

Catchword:

-



Case Number: W 0028/03 - 3.3.1

International Application No. PCT/US 02/35429

D E C I S I O N
of the Technical Board of Appeal 3.3.1
of 15 November 2004

Applicant: E.I. DU PONT DE NEMOURS AND COMPANY
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Delaware 19898 (US)

Representative: Chen Wang
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Decision under appeal: Protest according to Rule 68.3(c) of the Patent
Cooperation Treaty made by the applicants
against the invitation of the European Patent
Office (International Preliminary Examining
Authority) to restrict the claims or pay
additional fees dated 5 August 2003

Composition of the Board:

Chairman: A. J. Nuss
Members: P. P. Bracke
M. B. Günzel

Summary of Facts and Submissions

- I. On 5 August 2003 the European Patent Office, acting as International Preliminary Examining Authority (IPEA) for international patent application No. PCT/US 02/35429, invited the Applicants under Article 34(3) and Rule 68.2 PCT to pay 14 further examination fees on the grounds that there were fifteen separate inventions claimed, which were not so linked as to form a single general inventive concept within the meaning of Rule 13.1 PCT. In particular, the IPEA identified the fifteen separate inventions and gave reasons why those inventions were not so linked as to form a single general inventive concept.
- II. In response, with letter of 4 September 2003 the Applicants paid these fees under protest. As the only reason why the finding of lack of unity of invention by the IPEA was not correct it was stated:
- "Please refer to the 19 February 2003 letter which states that the EPO determined that there were 7 not 14 inventions claimed in the international application, and additional fees of EUR 5.670,00 were paid on 11 March 2003".
- III. On 29 October 2003, the review panel of the EPO under Rule 68.3(e) PCT informed the Applicants that the prior review of the justification for the invitation to pay additional fees had resulted in upholding the requirement to pay additional fees and invited the Applicants to pay a protest fee for the examination of the protest. In particular, the review panel remarked that, besides the sentence cited in point II above, the

Applicants did not provide any further arguments supporting his protest.

IV. The Applicants paid the protest fee on 7 November 2003.

Reasons for the Decision

1. According to Article 34(3)(a) and (b), in conjunction with Rule 68.2 PCT, the additional fees due if the IPEA considers that the international application does not comply with the requirements of unity of invention, have to be paid within a prescribed time limit. Rule 68.3(c) PCT provides that the Applicant may pay the additional fee(s) 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. According to the established jurisprudence of the Boards of Appeal the reasoning must contain verifiable grounds indicating why the Applicant considers unity of invention to be present. A protest which has not been - or not been sufficiently - reasoned within the time limit for filing the protest is to be rejected as inadmissible, see Case Law of the Boards of Appeal of the European Patent Office, 4th edition 2001, IX, D,

- 1.3, for the EPO acting as IPEA, and IX, C, 2.2 for the EPO acting as International Searching Authority (ISA).
2. In the present case, the letter of 19 February 2003, referred to by the Applicants (see point II above) is the invitation to pay additional fees by the ISA. As such invitation only contains a reasoning why the international application does **not** comply with the requirement of unity of invention, the reference thereto cannot be considered as a reasoned statement to the effect that the international application complies with the requirement of unity of invention.

In their protest the Applicants also referred to the fact that the ISA had only identified seven inventions. However, besides that this is not true - the ISA only stated that the inventions grouped by it in the first group could be searched without justifying an additional fee - it would also be irrelevant because the IPEA is not bound by the ISA's findings.

Therefore, in the absence of any substantive argument supporting Applicant's conclusion that the claimed subject-matter complies with the requirement of unity of invention, the protest is not admissible.

3. In view of the inadmissibility of the protest, there was no legal basis for the invitation to pay the protest fee. Therefore, the protest fee is to be refunded, see also e.g. more recent unpublished decisions W 18/99 dated 17 April 2000 and W 2/00 dated 18 October 2000.

Order

For these reasons it is decided that:

1. The protest is rejected as inadmissible.
2. The reimbursement of the protest fee is ordered.

The Registrar:

The Chairman:

C. Eickhoff

A. Nuss