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**Datasheet for the decision  
of 4 January 2007**

**Case Number:** W 0001/06 - 3.3.08

**Application Number:** PCT/US2005/017941

**Publication Number:** WO 2005/113760

**IPC:** C12N 9/00

**Language of the proceedings:** EN

**Title of invention:**

Thermostable Y-family polymerases and chimeras

**Applicant:**

The Government of the United States of America, represented by  
the Secretary of the Department of Health and Human Services

**Opponent:**

-

**Headword:**

Thermostable Y-family chimeras/Government of the USA

**Relevant legal provisions:**

PCT Art. 17(3)(a)  
PCT R. 40.1, 40.2

**Keyword:**

"Applicant not adversely affected - no need for further  
reviewing the protest"  
"Protest fee - refund (yes)"

**Decisions cited:**

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**Catchword:**

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**Case Number:** W 0001/06 - 3.3.08

**International Application No.** PCT/US2005/017941

**D E C I S I O N**  
**of the Technical Board of Appeal 3.3.08**  
**of 4 January 2007**

**Applicant:** The Government of the United States of America, represented by the Secretary of the Department of Health and Human Services

**Representative:** David Cash  
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**Decision under appeal:** 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 13 September 2005.

**Composition of the Board:**

**Chairman:** L. Galligani  
**Members:** M. R. Vega Laso  
C. Holtz

## Summary of Facts and Submissions

- I. International patent application PCT/US2005/017941 (published as WO 2005/113760) was filed on 20 May 2005 with 27 claims.
- II. On 13 September 2005, the European Patent Office, acting as an International Searching Authority (ISA), informed the applicant that it considered that the international application did not comply with the requirements of unity of invention as set forth in Rules 13.1, 13.2 and 13.3 PCT, and invited it to pay within a time limit of one month nine additional search fees, pursuant to Article 17(3)(a), Rule 40.1(i)(ii) PCT. As annex to the invitation, the ISA issued a communication including a list of ten different groups of inventions, the reasons for its finding of a lack of unity of invention regarding these groups, and the results of a partial international search carried out for the invention first mentioned in the claims (Group 1).
- III. On 11 October 2005, the applicant paid two additional search fees under protest and requested that the claims in Groups 1, 8 and 9 be examined. Furthermore, it was stated in the protest that:

*"Applicants respectfully request that groups 8 and 9 be joined, and that Applicants' overpayment of fees for the additional group be refunded."*

The protest was accompanied by a reasoned statement with the intent of establishing that groups 8 and 9

shared a single inventive concept and, therefore, constituted a single invention.

- IV. On 22 November 2005, the applicant was notified that, with regard to its protest, the ISA had reviewed the justification for the invitation to pay additional search fees. The applicant was invited to pay within a time limit of one month a protest fee for further examination of the protest, because the invitation to pay additional search fees had been found to be justified in part (according to a pre-printed text on the form). To the extent the invitation had been found not to be justified, one additional search fee paid under protest would be refunded in due course. Furthermore, it was stated in the notification that the reasons for the invitation to pay a protest fee were indicated in the Annex, and that failure to pay the protest fee within the time limit set would result in the protest being considered withdrawn. However, no Annex indicating the reasons for the invitation to pay a protest fee was attached to the notification.
- V. On 1 December 2005, the ISA transmitted the International Search Report, which, according to the statement in Box III.3, was established for the claims for which the fees had been paid.
- VI. On 22 December 2005, the applicants filed a response to the notification of 22 November 2005, requesting that the protest fee be charged to their account. No arguments were put forward by the appellant with respect to the result of the review.

## Reasons for the Decision

*The protest procedure under the amended PCT Regulations as in force from 1 April 2005*

1. The present international application under the Patent Cooperation Treaty (PCT) was filed on 20 May 2005. Thus, the protest procedure is subject to the amended Regulations under the PCT concerning non-unity findings in the International Search (cf amended Rule 40.2(c)(d)(e) PCT) as in force from 1 April 2005).
2. The aim behind the amendments to Rule 40.2(c)(d)(e) PCT was to simplify the protest procedure by substituting the second-tiered review (ie a prior review of the justification for the invitation to pay additional fees, as specified in the first sentence of Rule 40.2(e) PCT, and a subsequent examination of the protest as specified in the second sentence of Rule 40.2(c) PCT, both Rules as in force before 1 April 2005) by **a single review** carried out by a review body constituted in the framework of the ISA (cf amended Rule 40.2(c) PCT as in force from 1 April 2005). As indicated in Rule 40.2(d) PCT such a review body may include, but shall not be limited to the person who made the decision which is the subject of the protest.
3. In spite of the PCT regulations concerning the protest procedure having been amended, the relevant regulations in the EPC (cf Article 154(3) and Rule 105(4) EPC) have remained unchanged, due to a delay in the entry in force of the revised version of the EPC (cf EPC as revised in 2000, Special Edition No. 4 OJ EPO). The difference in the point of time for the entry into

- force of the amended regulations of the PCT and the EPC has resulted in a situation of conflict between the amended regulations under the PCT and some provisions of the EPC (see, for instance, Rule 105(3) EPC).
4. Article 150(2) EPC prescribes that, in case of conflict between the provisions of the PCT and those of the EPC, the provisions of the Cooperation Treaty shall prevail. The same, of course, applies to a conflict between the provisions of the PCT and any ancillary regulations, or notices or other recommendations from the European Patent Office.
  5. Nevertheless, the EPO issued a notice dated 1 March 2005 (cf OJ EPO 2005, 226) in which it was stated that "Pending entry into force of the revised version of the EPC, where additional fees for international search or international preliminary examination are paid under protest according to Rule 40.2(c) or Rule 68.3(c) PCT, the EPO will continue to subject any invitation to pay such additional fees to an *internal* review, prior to submission of the protest to the board of appeal. This review is in the nature of a service from the EPO and the previous procedure described in Rule 105(3) EPC is no longer applicable." (cf point 3).
  6. In the board's view, the provisions of the PCT and of the EPC (cf points 3 and 4 supra) do not leave room for a review carried out on a voluntary basis as a service from the EPO. The prevailing amended provisions of the Rule 40.2(c) PCT in force at the filing of the present PCT application provided for **a single review** (cf point 2 supra).

*The review of the present protest*

7. In response to the Invitation to Pay Additional Fees issued by the EPO acting as ISA (see section II above), the applicant paid two additional fees under protest and asked the ISA to carry out a search for the subject-matter in Groups 1, 8 and 9 as specified in the Invitation. Since the subject-matter in Group 1, which corresponded to the invention first mentioned in the claims, had already been searched, the applicant's request was in reality limited to Groups 8 and 9.
  
8. Furthermore, the applicant requested that Groups 8 and 9 be joined and the overpayment of fees for the additional group be refunded (see Section III above). In its reasoned statement, the applicant argued in essence that, contrary to the view of the ISA, the subject-matter of Groups 8 and 9 shared a single unifying concept and, consequently, represented a single invention.
  
9. In view of the requests and arguments submitted by the applicant, its protest is restricted to the finding of the International Search Authority that the subject-matter in Groups 8 and 9 represent different inventions, for each of which a search fee is due. Neither a request to establish that the international application **as a whole** complies with the requirement of unity of invention, nor any arguments to this effect have been put forward by the applicant. Rather, as it is apparent from its request to reimburse the overpayment **for the additional group** (cf Section III above), the applicant contests the Invitation to Pay Additional Fees only insofar as two search fees - instead of one - are

- required by the ISA for the international search of the subject-matter in Groups 8 and 9, on the grounds that these two groups represent, in the applicant's view, a single invention.
10. The internal review panel constituted in the framework of the European Patent Office acting as ISA allowed the applicant's request by deciding to reimburse one additional fee, as communicated in the Notification dated 22 November 2005, and by carrying out a search for the subject-matter of Groups 1, 8 and 9 (cf Section V above). Hence, to the extent the Invitation to Pay Additional Fees issued by the ISA was contested, the applicant is no longer adversely affected. Therefore, there is **no need for further reviewing the protest.**
  11. It appears paradoxical that, in spite of having granted all requests put forward by the applicant in its protest, the ISA nevertheless invited the applicant to pay a protest fee. In the absence of an Annex to the Notification dated 22 November 2005 (see Section IV above), the reasons which led the ISA to do so remain unclear.
  12. From the fact that after the internal review one search fee paid by the applicant was refunded, and also from the fact that a search was carried out for the subject-matter of Groups 8 and 9 (in addition to Group 1) as defined in the Invitation to Pay Additional Search Fees of 13 September 2005, it can only be inferred that the three-member panel of the ISA found the applicant's protest to be entirely justified. *Prima facie*, the board sees no reason to differ from this finding. As



indicated in Rule 40.2(e) PCT as in force from 1 April 2005, "[T]he protest fee shall be refunded to the applicant where the review body referred to in paragraph (c) finds that the protest was entirely justified."

13. In view of the above, reimbursement of the protest fee paid by the applicant is ordered.

**Order**

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

The protest fee is to be reimbursed.

The Registrar:

The Chairman:

G. Rauh

L. Galligani