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**Datasheet for the decision
of 28 February 2007**

Case Number: W 0026/06 - 3.3.08

Application Number: PCT/IB2005/003369

Publication Number: WO 2006051397

IPC: C07H 21/00

Language of the proceedings: EN

Title of invention:
Oligonucleotide probes

Applicant:
Consiglio Nazionale delle Ricerche

Opponent:
-

Headword:
Oligonucleotide probes/CONSIGLIO

Relevant legal provisions:
EPC Art. 150(2), 154(3)
EPC R. 105(3), 158(3)
PCT R. 40.2

Keyword:
-

Decisions cited:
W 0001/06

Catchword:

The present international application was filed on 10 November 2005. Thus, the protest procedure was subject to the amended Rule 40.2 PCT entered into force on 1 April 2005 the aim of which was to provide only one instance of review. This procedure does not leave room for a further review carried out by the board of appeal (see points 2 to 9 of the reasons). In the present case, the review body constituted within the EPO acting as the ISA concluded that the invitation to pay additional fees had been justified. Nevertheless, disregarding the new procedure, it invited the applicant to pay the protest fee only after its review, which amounts to a substantial procedural violation. Thus, the fee must be reimbursed.



Case Number: W 0026/06 - 3.3.08

International Application No. PCT/IB2005/003369

D E C I S I O N
of the Technical Board of Appeal 3.3.08
of 28 February 2007

Applicant: Consiglio Nazionale delle Ricerche
Piazzale Aldo Moro, 7
I-00185 Roma (IT)

Representative: Studio Torta
Jorio, Prater, Boggio & Partners
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Decision under appeal: Protest according to Rule 40.2(c) of the Patent
Cooperation Treaty made by the applicant
against the invitation (payment of additional
fees) of the European Patent Office
(International Searching Authority) dated
14 June 2006 .

Composition of the Board:

Chairman: L. Galligani
Members: T. J. H. Mennessier
C. Holtz

Summary of Facts and Submissions

- I. International patent application PCT/IB2005/003369, published as WO 2006/051397, was filed on 10 November 2005 with 52 claims.

- II. The European Patent Office as International Searching Authority (ISA) on 14 June 2006 issued a reasoned invitation under PCT Article 17(3) (a) and Rule 40.1 to pay three additional fees, considering that the application contained four groups of different inventions.

- III. On 13 July 2006, the applicant paid three additional fees under protest according to Rule 40.2(c) PCT.

- IV. On 18 September 2006, the ISA issued an invitation to pay within one month a protest fee under Rule 40.2(e) PCT. A reasoning by a review panel was attached to the invitation. The review panel had come to the conclusion that the invitation to pay additional fees had been justified. No refund of additional fees was ordered.

- V. The protest fee was paid on 17 October 2006.

- VI. The ISA referred the file to the Boards of Appeal on 12 December 2006.

Reasons for the Decision

Admissibility

1. The protest of the applicant is admissible. However, there is no legal basis for the ISA to refer the case to the Boards of Appeal, for the reasons given below.

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

2. The present international application under the Patent Cooperation Treaty (PCT) was filed on **10 November 2005**. Thus, the protest procedure was 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) which had entered into force on **1 April 2005**.

The text of amended Rule 40.2(c),(d), and (e) reads as follows (the text within slashes and struck through are deleted from the previous version of the Rule; in bold type characters the new added text):

"(c) Any applicant 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 or that the amount of the required additional fees is excessive. Such protest shall be examined by ~~/a three-member board or other special instance of the International Searching Authority or any competent higher authority/~~ **a review body constituted in the framework of the International Searching Authority,**

which, to the effect that it finds the protest justified, shall order the total or partial reimbursement to the applicant of the additional fees. On the request of the applicant, the text of both the protest and the decision thereon shall be notified to the designated Offices together with the international search report. The applicant shall submit any translation thereof with the furnishing of the translation of the international application required under Article 22."

"(d) **The membership of the review body referred to in paragraph (c) may include but shall not be limited to the** ~~/The three member board, special instance or competent higher authority referred to in paragraph (c) shall not comprise any/~~ person who made the decision which is the subject of the protest."

"(e) **The examination of a protest referred to in paragraph (c) may be subjected by the International Searching Authority to the payment to it, for its own benefit, of a protest fee. Where the applicant has not, within the time limit under Rule 40.1(iii), paid any required protest fee, the protest fee shall be considered not to have been made and the International Authority shall so declare. The protest fee shall be refunded to the applicant where the review body referred to in paragraph (c) finds that the protest was entirely justified.**" ~~/Where the applicant has, under paragraph (c) paid an additional fee under protest, the International Searching Authority may, after a prior review of the justification for the invitation to pay an additional fee, require that the applicant pay a fee for the examination of the protest ("protest") fee. The~~

~~protest fee shall be paid within one month from the date of the notification to the applicant of the result of the review. If the protest fee is not so paid, the protest shall be considered withdrawn. The protest fee shall be refunded to the applicant where the three member board, special instance or higher authority referred to in paragraph (c) finds that the protest was entirely justified.~~

3. The aim behind the amendments to Rule 40.2(c)(d)(e) PCT was to simplify the protest procedure by providing **only one instance of review**, namely a review body (cf. decision W 1/06 of 4 January 2007, point 2 of the reasons), which, in view of the global application of the PCT in widely differing legal systems, can be a court, a three-member board, or another authority as constituted in the framework of the International Search Authority.

4. 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(3) EPC) have remained unchanged due to the fact that the necessary corresponding amendments to the EPC can only take effect when the EPC 2000 enters into force, i.e. on 13 December 2007 at the latest (cf. EPC as revised in 2000, see OJ EPO Special Edition 1/2007). In the EPC 2000, Articles 154 to 158 EPC are deleted entirely and, consequently, new Rule 158(3) EPC (corresponding to the previous Rule 105(3) EPC) no longer indicates that "the protest shall be referred to the Board of Appeal for decision". Thus, according to the EPC 2000, the boards of appeal are no longer the review body constituted within the European Patent Office as an International

Searching Authority. In fact, under the amended PCT regulations it could not be otherwise in view of the provision in Rule 40.2 (d) that the membership of the review body may include the person who made the decision, an impossible option for the boards of appeal.

The protest procedure under the PCT pending entry into force of EPC 2000.

5. Under Article 7 of the Act revising the EPC of 29 November 2000, the Administrative Council of the EPO adopted by decision dated 28 June 2001 (i.e. prior to the entry in force of the PCT amendments mentioned above) transitional provisions. Article 1, point 6 therein prescribes "that Articles 150 to 153 shall apply to international applications pending at the time of their entry into force. However, Articles 154(3) and 155(3) of the version of the Convention in force before that time shall continue to apply to these applications."

6. A number of instructions and informative notices have been issued by the European Patent Office (EPO) to clarify the new procedure as well as to explain how to handle the procedure pending the entry into force of the EPC 2000. Among them, a notice dated 1 March 2005 (cf. OJ EPO 2005, 226) states 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). Thus, the review made by the first instance is **not** considered by the EPO to be a review for the purpose of Rule 40.2 PCT, **but** a voluntary service, the actual review being carried out by the boards of appeal.

7. This shows that 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) and the corresponding regulations and/or notices from the EPO.

The procedure in case of conflict

8. 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 EPO. This principle is confirmed also in the EPC 2000.
9. In the board's judgment, the application of this fundamental principle of hierarchy (which is necessary because otherwise the PCT would not be applied in the same manner across its member states, which are presumed to apply the PCT equally to all applications), leads directly to the conclusion that the PCT must prevail. Consequently, the transitional provision adopted by the Administrative Council in relation to

Article 154(3) of the EPC in force (cf. point 5 supra) as well as the indications given in the above mentioned notice from the EPO (cf. point 6 supra) were made obsolete by the 2005 amendments in the PCT in the sense that the protest procedure to be applied is necessarily that established by the amended PCT regulations to which a PCT application is subject. In the present case, the procedure to be followed is that entered into force on 1 April 2005 which provided for **a single review** (cf. point 3 supra). In the board's view, the amended provisions of the PCT and Article 150(2) EPC (prevalence of PCT over EPC in case of conflict) do not leave room for a review carried out on a voluntary basis as a service from the EPO (cf. also W 1/06 supra).

The procedure before the ISA in the present case

10. Even if this board does not see itself as being under the PCT the review body competent to carry out a review of the present case, in view of the extraordinary procedural situation before the ISA, there is reason to examine the factual situation of the case.
11. In the present case, the EPO acting as the ISA applied essentially the **old** system of the PCT, applicable to applications with an international filing date **before** 1 April 2005. For example, it invited the applicant to pay the protest fee only after having carried out a review which had brought to the conclusion that the invitation to pay additional fees was justified.
12. Since the PCT amendments had already entered into force, the ISA - in view of the stated prevalence of the PCT in case of conflict (cf. point 9 supra) - was obliged

to apply its new provisions. Under the new, applicable system this invitation should have been issued **before** the review took place, viz. Rule 40.2 (e) PCT "The examination of a protest referred to in paragraph (c) may be subjected by the International Searching Authority to the payment to it, for its own benefit, of a protest fee." This can only be read as meaning that the payment of the fee is not mandatory but lies within the discretion of the deciding body and that a decision to levy this fee must be taken and issued before the review is carried out.

13. In the present case, the ISA did the reverse as it invited the applicant to pay the protest fee when the review under the PCT had already been carried out. By this action, the first instance must have been of the opinion that it had indeed provided a prior review as laid down in the previous, now no longer applicable Rule 40.2 (e) PCT. The way in which it invited the applicant to pay the protest fee only after the review confirms that it applied the old system, and that it expected the board of appeal to be competent to do the final review. However, because of the PCT in force, the board cannot carry out a second review.

14. In short, the applicant was treated as if there was no new system in place. In the board's judgement, this amounts to a substantial procedural violation. Thus, the fee must be reimbursed.

Order

For these reasons it is decided that:

The protest fee is reimbursed.

The Registrar:

The Chairman:

G. Rauh

L. Galligani