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**Datasheet for the decision  
of 11 September 2008**

**Case Number:** W 0016/08 - 3.3.03  
**Application Number:** PCT/EP2007/050512  
**Publication Number:** WO 2007/082919  
**IPC:** C09C 1/36, C08K 3/22,  
C08K 9/06, C09D 7/12,  
B22F 1/00, H01L 33/00

**Language of the proceedings:** EN

**Title of invention:**  
Novel monomeric and polymeric materials

**Applicant:**  
Lemnis Lighting IP GmbH

**Headword:**

-

**Relevant legal provisions:**  
PCT Art. 17(3)(a)  
PCT R. 13, 13.2, 40.1(iii), 40.2(c), 40.2(e)

**Relevant legal provisions (EPC 1973):**  
EPC Art. 154(4), 155(3)

**Keyword:**

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**Decisions cited:**  
W 0025/89, W 0003/93, W 0018/06, W 0020/06, W 0022/06,  
W 0024/06, W 0001/07, W 0002/07, W 0006/07

**Catchword:**

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Case Number: W 0016/08 - 3.3.03

International Application No. PCT/EP2007/050512

**D E C I S I O N**  
of the Technical Board of Appeal 3.3.03  
of 11 September 2008

**Applicant:** Lemnis Lighting IP GmbH  
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**Representative:** Rasser, Jacobus Cornelis  
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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 20 December 2007 .

**Composition of the Board:**

**Chairman:** R. Young  
**Members:** C. Idez  
T. Bokor

## Summary of Facts and Submissions

I. International application PCT/EP2007/050512 entitled "Novel monomeric and polymeric materials" comprising 49 claims was filed on 18 January 2007. Independent Claims 1, 17, 27, 44 and 46 of the application as filed read as follows:

"1. A hybrid organic-inorganic monomeric material comprising inorganic nanoparticles having covalently bonded to their surface at least one polymerizable moiety.

17. A polymeric resin comprising the monomeric material of any one of the preceding claims.

27. A method for preparing a hybrid organic-inorganic monomeric material comprising the steps of:

a) peptizing an inorganic particulate material in an inorganic acid to provide a solution of the inorganic particulate material;

b) fractionating the solution obtained in step a) to provide a solution of inorganic particles having a particle size range of 5 nm to 100 nm;

c) mixing the fractionated solution obtained in step b) with an organic solvent S1;

d) reacting the mixture of step c) with a solution in an organic solvent S2 of a reactive silane-functional organic monomer.

44. A light source comprising at least one light emitting diode encapsulated in a polymeric resin according to any one of claims 17 through 26.

46. An encapsulation assembly for a light emitting diode comprising: a) a hemispherical dome of a polymeric resin having a refractive index of at least 2.0; b) a first layer covering the hemispherical dome, said first layer having a refractive index of at least 1.7; c) a second layer covering said first layer, said second layer having a refractive index of not more than 1.5."

Claims 2 to 16, 18 to 26, 28 to 43, 45, and 47 to 49 were dependent claims.

- II. On 20 December 2007, the European Patent Office (EPO), acting as International Searching Authority (ISA), in compliance with Article 17(3)(a) PCT and Rule 40.1 PCT issued an "Invitation to pay Additional Fees" (hereinafter "Invitation") stating that the application did not comply with the requirements of unity of invention according to Rule 13 PCT and inviting the Applicant to pay, within a time limit of 1 month, 3 additional search fees.
- III. In the Invitation, the International Searching Authority defined the following four groups of inventions to which the application related:

Group 1. Claims: 1 to 26  
Hybrid organic-inorganic monomeric material and polymeric resin using this monomer.

Group 2: Claims: 27 to 43  
Method to improve inorganic nanoparticles being subsequently grafted.

Group 3: Claims 44 to 45

Light source.

Group 4: Claims: 46 to 49

Encapsulation assembly.

According to the Invitation, the special technical features (STF) of the subject-matter of these groups were not the same and were not corresponding because they didn't have the same effect over the prior art. There was hence no same nor corresponding STF (in the sense of Rule 13.2 PCT) shared by the different inventions. Therefore the requirements of Rule 13 PCT were not met.

- IV. On 16 January 2008, the Applicant paid the three additional search fees.
- V. In its letter dated 16 January 2008 announcing the afore-mentioned payment the Applicant indicated that the search fee for the subject-matter of Claims 44 to 45 was paid under protest and simultaneously requested reimbursement of that fee. In that respect, it argued essentially that Claim 44 was fully dependent upon claim 17 which formed part of the first defined invention, and that, hence, any amendment to render Claim 1 patentable would also apply to Claim 44. Furthermore, it submitted that it was excessive to require further fees to fully search the claims subject-matter.
- VI. On 28 February 2008, the ISA invited the Applicant to pay a protest fee within one month (Form PCT/ISA/228 (April 2005)). In the annex to this communication, the

Applicant was told that after review of the protest the additional search fee should not be reimbursed.

VII. The Applicant paid the protest fee on 17 March 2008.

VIII. The Applicant requested the reimbursement of one additional search fee.

### **Reasons for the Decision**

#### 1. *Competence and admissibility*

1.1 The application in suit was filed on 18 January 2007. Therefore, the protest is subject to the provisions of the PCT as in force from 1 April 2006.

1.2 Pursuant to Article 1(6) of the Decision of the Administrative Council of 28 June 2001 on the transitional provisions under Article 7 of the Act revising the European Patent Convention of 29 November 2000, Articles 154(3) and 155(3) EPC 1973 shall continue to apply to PCT application pending at the time of entry into force of the EPC 2000. Accordingly, the Boards of Appeal shall continue to be responsible for deciding on protests made against the charging of an additional fee under Article 17, paragraph 3(a) or Article 34, paragraph 3(a) PCT. The protest procedure is governed by Rules 40 and 68 PCT. This implies that the review body specified in Rule 40.2 (C) PCT, second sentence is a board of appeal of the EPO.

1.3 Details of the procedure are guided by the Decision of the President of the EPO dated 24 June 2007, Article 3

(Special edition No. 3 OJ EPO, 140), and the Notice of the EPO dated June 2007, points 6 to 9 (Special edition No. 3 OJ EPO, 142). This effectively maintains for PCT applications already pending at the time of entry into force of EPC 2000 the two-stage protest procedure as laid out in the Decision of the President of the EPO dated 25 August 1992 providing for review panels for the implementation of the protest procedure under the PCT (OJ EPO 1992, 547) and the Notice from the EPO dated 1 March 2005 concerning the protest procedure under the PCT (OJ EPO 2005, 226), this latter replacing the Notice from the EPO dated 26 August 1992 concerning the protest procedure under the PCT (OJ EPO 1992, 547).

1.4 The application of a two-stage protest procedure even after 1 April 2006, when Rule 40 PCT did no longer require it, has also been approved by several decisions of the boards of appeal (see in particular W 20/06 of 3 April 2007, points 2 to 9 of the reasons, W 22/06 of 15 March 2007, point 2 of the reasons, W 24/06 of 21 June 2007, points 2 and 3 of the reasons, W 1/07 of 26 June 2007, point 1.6-1.6.4 of the reasons, W 6/07 of 17 July 2007, points 1.2 and 1.3). Given that the previous procedure, and by implication, the previous general legal framework continues to apply (see points 1.2 and 1.3 above), the entry into force of the EPC 2000 does not affect the *ratio decidendi* of these decisions. Thus the present board sees no reason to question its own competence.

1.5 As far as the payment of the fees is concerned, the Applicant was invited by the communication of 28 February 2008 ("Form PCT/ISA/228 (April 2005)") to pay the protest fee within one month. The payment was

made on 17 March 2008, i.e. within the time limit of one month of this communication, but not within the time limit of one month of the original invitation to pay the additional fees of 20 December 2007. Though noting that this is still problematic in view of the clear wording of Rule 40.1 (iii) PCT, the board follows the arguments and conclusions of the established jurisprudence (see in particular W 18/06 of 5 March 2007, points 2 to 18 of the reasons, W 20/06 (*supra*), points 10 to 20 of the reasons, W 24/06(*supra*), point 4 of the reasons, W 1/07 (*supra*), points 1.6.4-1.6.15 of the reasons, W 6/07 (*supra*), points 1.3.2 and 1.4 of the reasons). These decisions, though with partly differing reasoning, all found that the protest fee, though perhaps formally paid late, nevertheless was paid effectively in time. The board notes that the *ratio decidendi* underlying the finding of the above decisions is also not affected by the entry into force of the EPC 2000. Thus also in the present case the payment was made in time, and the protest is considered to have been made (Rule 40.2(e) PCT, second sentence).

1.6 Rule 40.2(c) PCT enables the Applicant to 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.

1.7 Consequently, if the Applicant wishes to pay the additional fees under protest, the fees must be accompanied by the reasoned statement that sets out the protest.



1.8 In this connection, the Board firstly observes that the Applicant in its letter dated 16 January 2008, has acknowledged the presence of more than one invention in the application in suit since it has paid without protest the additional search fees for the subject-matter of Claims 27 to 43 (Group 2) and for the subject-matter of Claims 46 to 49 (Group 4) of the application in suit.

1.9 Concerning the payment under protest of the search fee for the subject-matter of Claims 44 to 45 (Group 3), the statement of the Applicant (cf. paragraph V above) accompanying the protest was based:

(i) on the consideration that this group of invention could have been rendered unitary with the subject-matter of the claims of the first group of invention (Group 1), provided Claim 1 would have been amended to render it patentable, and

(ii) on the submission that it was excessive to require further claims fee to fully search the claims subject-matter.

1.9.1 Concerning point (i), even if it would be true, that Claim 1 could be amended in order to restore its patentability, this is, however, totally irrelevant to the question as to whether the subject-matter of Claims 44 to 45 was unitary with the subject-matter of the claims, then on file, of the first invention. Furthermore, the argument that unity of invention could be restored between the invention of Group I and that of Group III by amending Claim 1 implicitly means that the Applicant itself has acknowledged that the findings

of the ISA concerning the lack of unity of invention between the subject of the claims of Group 1 and that of the claims of Group 3 were correct.

1.9.2 Concerning point (ii), as stated in the decision W 2/07 of 23 February 2007 (not published in OJ EPO; Reasons point 14), the term "excessive" in the context of Rule 40.2 (c) means that whilst the protest acknowledges the presence of more than one invention it considers the number of extra inventions, and hence additional search fees to be paid, to be less than that stated by the ISA.

1.9.3 In this connection, while as indicated above in paragraph 1.8, the Applicant has acknowledged in the letter dated 16 January 2008 the presence of more than one invention in the application in suit, the Board can only state that no reasons have been presented in that letter according to which, in the Applicant's view, the number of additional search fees should be regarded as excessive.

1.10 Thus, the Board comes to the conclusion that the letter dated 16 January 2008 contains nothing which could be interpreted as being a reasoned statement as to why the Applicant considered that the ISA was wrong in their argumentation submitted with the invitation to pay an additional search fee in view of the subject-matter of Claims 43 to 44. Consequently the present protest under Rule 40.2(c) PCT has to be dismissed as inadmissible (cf. also W 25/89 of 16 March 1990; not published in OJ EPO, Reasons point 4).

**Order**

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

The protest is rejected as inadmissible.

The Registrar:

The Chairman:

C. Eickhoff

R. Young