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Aktenzeichen / Case Number / N^o du recours : W 03/88

Anmeldenummer / Filing No / N^o de la demande : PCT/US 87/01580

Veröffentlichungs-Nr. / Publication No / N^o de la publication :

Bezeichnung der Erfindung: Lubricant and fuel additives derived from O,O-
Title of invention: Dialkyldithiophosphoric acid and a norbornyl
Titre de l'invention : reactant

Klassifikation / Classification / Classement : C/OM 137/10

ENTSCHEIDUNG / DECISION

vom / of / du 8 November 1988

Anmelder / Applicant / Demandeur : The Lubrizol Corporation et al

Patentinhaber / Proprietor of the patent /
Titulaire du brevet :

Einsprechender / Opponent / Opposant :

Stichwort / Headword / Référence : Lubricants/Lubrizol

PCT Article 17, Rules 13, 33, 40

Schlagwort / Keyword / Mot clé :

"Invitation to pay twelve additional fees following a posteriori examination of unity of invention"

Leitsatz / Headnote / Sommaire

I. The duties of the ISA in relation to an international application are set out in Article 17 PCT and are purpose-related solely to the carrying out of the international search and the production of a search report.

II. The requirement of unity of invention set out in Rule 13 PCT is a procedural requirement relating to the carrying out of an international search.

III. In considering the requirement of unity of invention the ISA does not have any obligation or power to carry out an "a posteriori" examination of an international application.

Europäisches
Patentamt

Beschwerdekammern

European Patent
Office

Boards of Appeal

Office européen
des brevets

Chambres de recours



Case Number : W 03 /88

International Application No PCT/US 87/01580

D E C I S I O N
of the Technical Board of Appeal 3.3.1
of 8 November 1988

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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 fee) of the
European Patent Office (branch at The Hague)
dated 26 October 1987.

Composition of the Board :

Chairman : K. Jahn

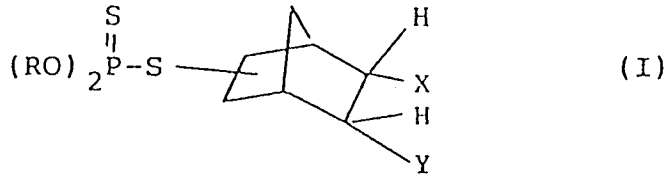
Members : F. Antony

G.D. Paterson

Summary of Facts and Submissions

- I. On 2 July 1987, the Applicant filed international patent application PCT/US 87/01 580 with the United States Patent and Trademark Office. The European Patent Office was the designated Office within the meaning of Article 2(xiii) PCT.
- II. On 26 October 1987, the European Patent Office as competent International Searching Authority (ISA) issued, pursuant to Article 17(3)(a) EPC and Rule 40.1 PCT, an Invitation to pay twelve additional search fees (DM 25 140) in view of the fact that it was considered that the above identified application did not comply with the requirements of unity of invention as set forth in Rule 13(1) PCT.
- III. The application is concerned with lubricant and fuel additives derived from O,O-dialkyldithiophosphoric acid and a norbornyl reactant. As background to the invention, the application states that it has been discovered that these novel additives improve the extreme pressure, anti-wear and antioxidant properties of lubricants and fuels.

After a review of the state of the art, in which six prior patent specifications are referred to and briefly discussed (including US-A-3 023 209), it is stated that "None of the foregoing disclosures teach the norbornyl dialkyldithiophosphoric acid adducts of the present invention....". Such "adducts of the present invention" are stated to be represented by the following formula:



wherein R is, independently, alkyl or aryl and X and Y are the same or different and are hydrogen, carboxy, hydrocarbyl carboxy, cyano, aldehyde, hydrocarbyl keto, N-substituted carboxamide, thio- or dithiocarbamate, thioamide, thio acid or ester, a hydrocarbyl phosphorus containing radical, or X and Y together are dicarboxylic anhydride or imide or N-hydrocarbyl substituted imide (Claims 1 to 7).

The claims define:

A lubricating composition comprising a minor amount of a compound of such formula (Claims 1 to 7);

a method of improving the load bearing properties of lubricating compositions by admixing therewith a minor amount of an agent of such formula (Claims 8 and 9);

a compound of the above formula with particular specified substituents for R, X and Y (Claims 10 and 11);

subject-matter of different categories, all requiring the presence of a compound of such formula (Claims 12 to 17).

IV. The ISA has raised essentially two objections:

- (i) The general problem underlying the invention was not novel and a solution to it had already been found, as illustrated by US-A-3 023 209. Therefore, the original single general inventive concept was no longer acceptable and it was necessary to separately

consider each solution to the problem differing from the state of the art.

- (ii) According to Rule 13.2(i) PCT the scope of the products of Claims 10 and 11 on the one hand, and of the products used according to Claims 1 to 9 on the other hand had to be substantially identical. This not being the case, a single general inventive concept covering the different claim categories could not be considered to be present.

On the basis of these objections, the ISA grouped the subject-matter of the application into fourteen subjects; one such subject being considered unsearchable, the Applicant was invited to pay one additional search fee for each of the remaining twelve subjects in excess of the first, a total of DM 25 140.

It was noted that the term "thio- or dithiocarbamate" as used in Claims 1 and 10 is obscure and that Claims 1 to 7 were not completely searchable.

The first two subjects were given as follows:

- "1. Claims 1 to 9, 16 and 17 partially:

Lubricating composition containing a minor amount of a compound of given formula in which X and Y can be hydrogen.

- 2. Claims 1 to 9, 16 and 17 partially:

Lubricating compositions containing a minor amount of a compound of given formula in which X and Y can be carboxy (-COOH) or "hydrocarbyl carboxy" understood as -COO-hydrocarbyl."

V. On 24 November 1987 the Applicant paid one additional search fee to cover an additional search directed to the second mentioned subject. He paid this additional search fee under protest (Rule 40.2(c) PCT) and asserted that the required additional fee was excessive. By way of reasoning it is stated: "A search of the lubricating art for the basic structure, as shown in the abstract, would identify art relating to derivatives of that basic structure."

Reasons for the Decision

1. Pursuant to Article 154(3) EPC and Article 9 of the agreement between WIPO and the EPO, the Boards of Appeal of the EPO are responsible for deciding on protests made by an Applicant against an additional search fee charged by the EPO under the provisions of Article 17(3)(a) PCT (OJ EPO 1985, 320, 324).
2. Both the Invitation to pay and the Protest comply with Rule 40 PCT and are admissible.
3. When what is prima facie a normal application in normal form, in respect of an allegedly novel group of compounds defined by a general formula having a desirable effect, is the subject of a request for DM 25 140 as additional search fees on the basis that the application is in respect of fourteen different inventions, a radical examination of the legal basis for this request seems clearly to be called for. This is particularly so since the Board is aware that this particular case is not an isolated one.

The file of the case as transmitted to the Board includes a "pro forma" headed "A POSTERIORI". The first sentence of this form states

"The general problem underlying the invention is not novel and a solution to it has already been found or does not involve an inventive step having regard to the state of the art as illustrated by" ("US A 3 023 209 (J. Reese)" filled in in handwriting). The pro forma continues:

"Therefore, the original single general inventive concept is not acceptable anymore, making it necessary to reconsider the technical relationship or interaction between the different solutions mentioned."

The contents of this pro forma are repeated in the Invitation to pay.

The existence of this pro forma indicates that as a matter of practice, the ISA is at present examining many applications for novelty and inventive step, at least on a preliminary basis, and thereafter judging such applications for unity of invention in the light of such examination - a posteriori. This practice is, in the Board's view, contrary to the obligations and power of the ISA under the PCT, for the reasons set out below.

4. The present international application was filed at the United States Patent and Trademark Office pursuant to Article 3 PCT, and contains a request that it be processed according to the PCT, in accordance with Article 4(1)(i) PCT.

5. The PCT is essentially procedural in nature. According to its preamble, one of its aims is "to simplify and render

more economical the obtaining of protection for inventions where protection is sought in several countries".

In particular, Chapter I of the PCT, comprising Articles 3 to 30, is concerned with the procedure governing both the making of an "international application" and an international search in respect of such an application.

In accordance with this procedure, after filing of an international application at a Receiving Office and formal checking of its contents, a copy of the application is transmitted to the competent International Searching Authority (ISA) referred to in Article 16 PCT (in this case the EPO), for carrying out of an international search in accordance with Article 15 PCT. The procedure before the ISA is governed by Article 17 PCT. The object of this procedure is the production of the international search report as required by Article 18 PCT.

In the Board's view, it is quite clear from a reading of Article 17 PCT and the relevant Rules, as well as the Agreement between the International Bureau and the ISA which is referred to in Article 17(1) PCT, that the duties of the ISA in relation to an international application as set out in Article 17 PCT are purpose-related solely to the carrying out of the International Search and the production of a search report.

Article 3(4) PCT, in addition to requiring that an international application shall be in a prescribed language and form and shall be subject to payment of prescribed fees, requires that the application shall comply with the requirement of unity of invention set out in Rule 13 PCT. From its context within the PCT, in the Board's view this requirement of unity of invention is a procedural requirement relating to the carrying out of the

international search in accordance with the procedure under Article 17 PCT, so as to ensure that the relevant prior art for the search as set out in Rule 33 PCT is limited to what can fairly be regarded as a single general inventive concept (as to which, see paragraph 6 below). Provided that the subject-matter of an application is so limited, the international search should be carried out having regard to the guidance set out in Rule 33 PCT.

In particular, Rule 33.3(b) should be noted: "Insofar as possible and reasonable, the international search shall cover the entire subject-matter to which the claims are directed or to which they might reasonably be expected to be directed after they have been amended". The object of the search is of course to identify the documents which will be relevant during a later substantive examination in order that it can be decided whether the subject-matter of the application as identified in Rule 33.3(b) PCT, satisfies the requirements of novelty and inventive step.

6. The term "single general inventive concept" (emphasis added) in Rule 13.1 PCT could at a first glance be misinterpreted as requiring an examination for novelty and inventive step. In the Board's view, however, the word "inventive" in this context is to be understood in the sense of "allegedly inventive", i.e. it refers to what the Applicant at the time of filing considers to be his invention, irrespective of what the prior art, and therefore the patentable invention (if any) actually is. In other words, the "general inventive concept" within the meaning of Rule 13.1 CPT is simply the general concept of what the Applicant subjectively claims to be his invention.

7. As to Chapter II of the PCT, this is concerned with a further, optional phase of processing under the PCT,

namely an "international preliminary examination" in respect of patentability (the result of which is non-binding). Processing under Chapter II PCT is quite separate and distinct from the procedure under Chapter I PCT. In particular, the preliminary examination of an international application in respect of novelty and inventive step is the responsibility of the International Preliminary Examining Authority - which is of course quite distinct from the ISA. The ISA has no competence under Chapter II PCT. In fact, the presence of Chapter II in the PCT emphasises the lack of competence of the ISA in respect of examining for novelty and inventive step.

8. From the above considerations, in the Board's view it is quite clear that in carrying out its obligations under the PCT, the ISA is neither required nor empowered to carry out a substantive examination of an application with regard to the requirement of unity of invention set out in Rule 13 PCT. What is required is that if, during the "a priori" examination of an application with a view to identifying the technical fields which the search should cover in accordance with Rule 33.2 PCT, it is considered that the subject-matter of the application relates to more than one invention, or more than one general inventive concept, an Invitation to pay additional fees should then be issued in accordance with Article 17(3)(a) PCT.

However, in the Board's judgement the ISA does not have any obligation or power under the PCT to carry out an "a posteriori" examination (i.e. an examination after considering novelty and /or inventive step) in relation to the requirement of unity of invention. An analysis of the problem and solution underlying the claimed invention (such as would be required during substantive examination before the EPO) is therefore not within the competence of the ISA. Such an examination and analysis is contrary to

the scheme of the PCT and its particular provisions mentioned above as regards the carrying out of the international search.

9. In contrast with the procedural examination for unity of invention before the ISA, during the subsequent substantive examination of the application by designated Offices a substantive examination as regards unity of invention is of course normally required. Thus if the EPO is designated, substantive examination of the application includes consideration of unity of invention as required by Article 82 EPC. In the context of such substantive examination a finding of non-unity of invention may of course properly be based upon a closer examination of the subject-matter of the individual claims having regard to the relevant prior art set out in the Search Report.

10. In the present case, as summarised in paragraph IV(i) above, the objection of non-unity of invention as set out in the Invitation to pay is based on the reasons that the general problem underlying the invention is not new, and that a particular prior document has already proposed a solution to it. Consequently, it is said that "the original single general inventive concept is not acceptable anymore", and that the various particular solutions with particular substituents for R, X and Y in the general formula I have to be separated into different categories representing different "inventions".

The Board finds it very difficult to understand this reasoning.

It appears from the description (page 2, lines 23-27) that the underlying problem was to find compounds with excellent activity as extreme pressure and antiwear agents. The Applicant has found that the compounds of the

formula as claimed in Claim 1, where X and Y are hydrogen, carboxy etc., are useful as extreme pressure agents and antiwear agents as well as antioxidants for lubricating compositions (description page 15, lines 21 to 27). Consequently, all such compounds must be considered a solution to the underlying problem; this alone is sufficient to establish unity of invention a priori. Moreover, all these compounds include a significant common structural element (i.e. the 5-nor-bornyl dithiophosphate system) so that also from the point of view of chemical structure there is clearly unity of invention .

11. A further reason for the finding of non-unity is summarised in paragraph IV(ii) above. This reason, however, seems to be based upon a misunderstanding of Rule 13.2 PCT; the wording of this Rule makes it quite clear that the list of possible circumstances in which there is unity of invention between claims of different categories (there set out in sub-paragraphs (i) to (iii)) is in no way excluding the possibility of other circumstances where there is unity of invention between claims of different categories.

A further misunderstanding of Rule 13.2(i) PCT is apparent in that the ISA has wrongly concluded that the respective structural scopes of independent product and use claims must be substantially identical. In the Board's view there is no basis in Rule 13.2 PCT for such a narrow and restrictive interpretation.

12. The Applicant has filed a protest in respect of only one additional fee but this is not surprising in view of the amount of additional fees requested by the ISA (see paragraph II above). In the circumstances of the present case, in the Board's judgement the invitation to pay twelve additional fees was issued in contravention of the

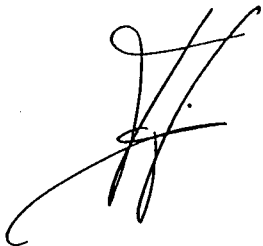
obligations and power of the ISA under the PCT and without due reason, and should therefore be set aside in toto as void and of no legal effect. Thus the ISA should now proceed to carry out the required International Search under the PCT in respect of the subject-matter of all the claims of the present application (subject to any declaration and notification under Article 17(2)(a)(ii) PCT having regard to the lack of clarity of the term "thio- or dithiocarbamate").

Order

For these reasons, it is decided that:

- (1) The Invitation to pay additional fees dated 26 October 1987 is set aside.
- (2) The refund of the additional fee paid is ordered.

The Registrar:



The Chairman:



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