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Bezeichnung der Erfindung: Centrifugal superchargers
Title of invention:
Titre de l'invention :

Klassifikation / Classification / Classement :

ENTSCHEIDUNG / DECISION

vom / of / du 14 April 1989

Anmelder / Applicant / Demandeur : Sauter, Richard John

Patentinhaber / Proprietor of the patent /
Titulaire du brevet :

Einsprechender / Opponent / Opposant :

Stichwort / Headword / Référence : Delayed protest/SAUTER

EPÜ / EPC / CBE Articles 17(3)(a) PCT, 154(3) EPC; Rules 40.1, 40.2(c)
and 40.3 PCT

Schlagwort / Keyword / Mot cle: "Additional fees paid in time" -
"Protest not present within time limit"

Leitsatz / Headnote / Sommaire

Europäisches
Patentamt

European Patent
Office

Office européen
des brevets

Beschwerdekammern

Boards of Appeal

Chambres de recours

Case Number : W 6/88 - 3.2.2

International Application No. PCT/GB 87/00322



D E C I S I O N
of the Technical Board of Appeal 3.2.2
of 14 April 1989

Applicant : Sauter, Richard John
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Subject of the Decision : Protest according to Rule 40.2(c) of the Patent Cooperation Treaty made by the applicant against the invitation (payment of 4 additional fees) of the European Patent Office (branch at The Hague) dated 7 August 1987.

Composition of the Board :

Chairman : G. Szabo

Members : W. Moser

H. Seidenschwarz

Summary of Facts and Submissions

- I. The Applicant filed international patent application PCT/GB 87/00322 on 12 May 1987.
- II. On 7 August 1987, the EPO, acting as International Search Authority (ISA), sent to the Applicant an invitation to pay additional search fees in accordance with Article 17(3)(a) and Rule 40.1 PCT because it considered that the application did not comply with the requirements of unity of invention, since it contained, besides the invention first mentioned, three additional inventions. Furthermore, the invitation also stated that the Applicant was invited within 30 days from the date of mailing (i.e. by 7 September 1987) to pay the additional fees and that, in accordance with Rule 40.2(c) PCT, such payment could be made under protest.
- III. The Applicant paid the search fees for two additional inventions on 3 September 1987; but he failed to communicate his intention to pay these fees under protest within the aforementioned time limit.
- IV. In a letter received at the EPO on 10 December 1987, the Applicant submitted that the invitation dated 7 August 1987 was of no legal effect and, therefore, did not give rise to a fixed period within to enter a protest. The Applicant argues in substance as follows:

The invitation merely contains a summary of the subject-matter of the claims, although it is not self-evident that the inventions defined in the individual groups of claims are not so linked as to form a single general inventive concept. Consequently, the invitation fails to specify the reasons for which the present international patent

application is not considered complying with the requirement of unity of invention within the meaning of Rule 40.1 PCT. Thus, in accordance with the decision W 04/85 (OJ EPO 1987, 63), the invitation is of no legal effect.

The letter also contains a statement explaining why, in the Applicant's view, the international patent application has to be regarded as complying with the requirement of unity of invention.

The Applicant requests the repayment of the search fees which, in his view, were paid without any valid reason.

Reasons for the Decision

1. According to Article 154(3) EPC, the Boards of Appeal are responsible for deciding on a protest made by an applicant against an additional fee charged by the EPO.
2. The Applicant has made a protest because his letter dated 10 December 1987 contains a reasoned statement within the meaning of Rule 40.2(c) PCT.
3. Pursuant to Article 17(3)(a) PCT, the ISA shall establish the international search report on the parts of the international application which relate to the additional inventions, provided the corresponding fees have been paid within the prescribed time limit. In the present case, a time limit of 30 days from the date of mailing has been granted by the EPO, which is consistent with the provisions of Rule 40.3 PCT.

4. Rule 40.2(c) PCT offers the Applicant the possibility to pay the additional fees under protest, "that is, accompanied by a reasoned statement". Consequently, if the Applicant wishes to pay the additional fees under protest, these fees must be accompanied by the reasoned statement that sets out the protest. Since, according to Article 17(3)(a) and Rule 40.3 PCT, these fees have to be paid within a specified time limit, it is also clear that the protest must be made within the same time limit.
5. The fees regarding two of the three additional inventions were paid in time. According to Article 17(3)(a) PCT, the EPO is therefore also obliged to establish the international search report on those parts of the present international application which relate to these additional inventions.
6. Whether or not an invitation is to be regarded as legally effective constitutes a question of substantive law which has to be dealt with on the occasion of substantive examination of the respective protest. Such examination may however only be effectuated if the protest is admissible.
7. The protest made by the Applicant is not admissible because no reasoned statement within the meaning of Rule 40.2(c) PCT has been filed during the accorded time limit of 30 days (cf. point 4 above). Consequently, the protest has to be dismissed without substantive examination (cf. point 6 above).
8. Under these circumstances, the additional fees paid by the Applicant shall not be refunded.

Order

For these reasons, it is decided that:

The protest under Rule 40.2(c) PCT is dismissed as inadmissible.

The Registrar:

S. Fabiani

S. Fabiani

The Chairman:

G. Szabo

G. Szabo

W.M. Moser 14.4.89
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