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File Number: W 4/90 - 3.3.2

Application No.: PCT/EP89/01036

Publication No.:

Title of invention: Plants transformed with a DNA sequence from bacillus
thuringiensis lethal to lepidoptera

Classification: C12N 15/32

DECISION
of 22 November 1991

Applicant: Plant Genetic Systems, N.V.

Headword: Transformed plants/PLANT GENETIC SYSTEMS

PCT Article 17(3)(a), Rules 13 and 40

Keyword: "Lack of unity 'a priori' (No) - Insufficient reasons in the
invitation"

Headnote



Case Number : W 4/90 - 3.3.2
International Application No. PCT/EP89/01036

D E C I S I O N
of the Technical Board of Appeal 3.3.2
of 22 November 1991

Applicant : Plants Genetic Systems, N.V.
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Representative : S.C. Ernest Gutmann
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Subject of the 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 20 November 1989.

Composition of the Board :

Chairman : P.A.M. Lançon
Members : U. Kinkeldey
C. Holtz

Summary of Facts and Submissions

- I. The Applicant filed international patent application PCT/EP 89/01036.

- II. The EPO, acting as International Search Authority (ISA) sent to the Applicant an invitation to pay one additional search fee in accordance with Article 17(3)(a) and Rule 40.1 PCT.

The ISA indicated that the subject-matter claimed related to two inventions set out as follows:

- 1. Claims 1 to 13: DNA, Bt toxin and protoxin ... concerning to bt18.

- 2. Claims 1 to 14: DNA, Bt toxin and protoxin ... concerning to bt4.

The invitation to the Applicant sets out as "reasons for requiring the additional fee" the two groups of subject-matter listed above, together with the following passage:

"The combination of categories of independent claims does not belong to any of those mentioned in Rule 13.2 PCT and the subjects defined by the problems and their means of solution as listed below do not present a sufficient technical relationship or interaction so as to form a single general inventive concept."

- III. The Applicant paid the additional search fee under protest in accordance with Rule 40.2(c) PCT.

The arguments submitted by the Applicant can be summarised as follows:

- No evidence has been presented in the invitation to pay the additional fee that the claimed bt18 gene and its toxin and protoxin constituted an independent invention from the claimed bt4 gene and its toxin and protoxin.

- Virtually the same search was required for the Bt4 aspects of the claims as for the Bt18 aspects of the claims.

- Claim 5 described a technical relationship between the bt4 and bt18 aspects of the claims, thereby defining a single general inventive concept.

Reasons for the decision

1. The protest is admissible.

2. Rule 40.1 PCT stipulates that the invitation provided for in Article 17(3)(a) PCT must specify the reasons why the international application is deemed not to comply with the requirements of unity of invention. The purpose of setting out reasons is to enable the Applicant and, in the case of a protest, also the Board of Appeal, to examine whether the request to pay additional fees owing to lack of unity of the invention is justified.
 - 2.1 In an earlier published decision (W 04/85, OJ EPO 1987, 63) the Boards of Appeal expressed the view that the requirement to give reasons in an invitation pursuant to Article 17(3)(a) PCT is so fundamental that an unsubstantiated invitation cannot be regarded as legally effective. However, this decision further states that in straightforward cases, all that may be necessary to

substantiate a lack of unity is a list of the different groups of subject-matter in the application.

3. The technical field of the invention is the field of genetic engineering, which is still a complex field.

However, even in this situation, the circumstances of a certain case might be such that the non-unity is apparent at first glance. On the face of it, the two alternatives of Claim 1 could possibly relate to different solution of different problems, because they relate to two different products, i.e. Bt18 and Bt4, which are defined as alternative in the first claim. On the other hand, a careful reading of the description could lead to the conclusion that the two products are technically interconnected.

Thus, the case being not straightforward, the question of the sufficiency of the substantiation of the invitation to pay an additional fee must be examined.

4. The reference to Rule 13.2 PCT in the reasons for the invitation is inappropriate. Rule 13.2 applies in the case where there are independent claims of different categories. Although, in the present case, there are independent claims belonging to different categories the two inventions actually identified by the ISA belong to the same category, since the ISA has based its grouping of the claims on the existence of two different DNA sequences or proteins, Bt18 and Bt4, corresponding to product claims (cf. Rule 13.3 PCT allowing claims of the same category).
5. As no prior art is cited, an a priori objection of lack of unity is meant in the invitation to the Applicant.

5.1 The statement in the invitation that "the subjects listed ... do not present a sufficient technical relationship or interaction so as to form a general inventive concept" provides only the conclusions drawn by the ISA, but not the preceding grounds therefor, e.g the technical differences, on the basis of which the ISA concluded that there is no technical relationship or interaction between the two products Bt18 and Bt4. The addition that these subjects were "defined by the problems and their means of solution" does not help the reader either, since the invitation does not describe these problems. In a case like the present one where the conclusion of non-unity by the ISA was possibly based on the identification of several problems, the invitation should describe all the technical details relevant to the case.

5.2 In the case of a protest under Rule 40(2) PCT, where an objection a priori is raised, no examination of the merits of the claims in comparison with the state of the art has been carried out. The only way to determine the technical problem is, therefore, to rely on the description of the application and the provisional acknowledgement of the prior art therein, if given.

According to the description the problem to be solved is to provide a toxin being the active ingredient in the crystallised protoxin produced by special strains of *Bacillus thuringiensis* with a high activity against *Lepidoptera* species. According to Claim 1 this problem is solved by providing two DNA-sequences. These sequences code for toxins Bt4 and Bt18.

Whether or not possibly different features of the two alternatives of Claim 1 may allow a conclusion of non-unity on the basis of two technically not interconnected solutions is certainly not clear but requires a

substantiation by express references to the underlying problem and an analysis of relevant features.

- 5.3 In view of the above, the objection in the invitation lacks the necessary substantiation and therefore violates the obligation to specify reasons laid down in Rule 40.1 in conjunction with Rule 13.1 PCT.

Under these circumstances, there was no legal basis to invite the Applicant to pay an additional search fee.

Order

For these reasons, it is decided that:

Refund of the additional fee to the Applicant is ordered.

The Registrar:

The Chairman:

P. Martorana

P. Lançon