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Anmeldenummer / Filing No / N^o de la demande : PCT/GB 89/00888

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Bezeichnung der Erfindung: Alcohol Reduction of Beverages
Title of invention:
Titre de l'invention :

Klassifikation / Classification / Classement : C12G 3/08

ENTSCHEIDUNG / DECISION

vom / of / du 19 October 1990

Anmelder / Applicant / Demandeur : HARRIS, William J.

Patentinhaber / Proprietor of the patent /
Titulaire du brevet :

Einsprechender / Opponent / Opposant :

Stichwort / Headword / Référence : Alcohol Reduction/HARRIS

EPÜ / EPC / CBE PCT Article 17(3)(a) and Rule 40.1

Schlagwort / Keyword / Mot clé : "Invitation to pay additional fee - no legal
basis - obligation to search the invention
first mentioned in the claims"

Leitsatz / Headnote / Sommaire

Europäisches
Patentamt
Beschwerdekammern

European Patent
Office
Boards of Appeal

Office européen
des brevets
Chambres de recours



Case Number : W 7/90

International Application No. PCT/GB 89/00888

D E C I S I O N
of the Technical Board of Appeal 3.3.2
of 19 October 1990

Appellant : HARRIS, William J.

Representative : Mr. I.M. Armitage
Mewburn Ellis
2 Cursitor Street
London EC4A 1BQ
England

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 14 November 1989.

Composition of the Board :

Chairman : P. Lançon
Members : A.J. Nuss
C. Holtz

Summary of Facts and Submissions

- I. The Applicant filed International patent application PCT/GB 89/00888 on 3 August 1989.
- II. The EPO acting as International Search Authority (ISA) sent to the Applicant an invitation to pay an additional search fee in accordance with Article 17(3)(a) and Rule 40.1 PCT. The ISA indicated that the above-referred application did not comply with the requirements of unity of invention in the following terms:

- "1. Claims 1, 2, 9 (partly), 11, 12, 14 (partly), 16:
removing ethanol using an immobilized binding reagent, e.g.: antibody
2. Claims 3-8, 9 (partly), 10, 13, 14 (partly), 15:
removing ethanol using an immobilised reagent capable of chemically converting ethanol.

Claims 1, 12 and 16 refer to a device, a method and a container for removing ethanol from a beverage, using an immobilized reagent capable of binding or chemically converting the ethanol.

We found that methods and corresponding devices are known, in which ethanol is removed from a fermented product, using a solid material (e.g. a resin) carrying at its surface active ethanol-binding sites. In view of these documents cited in our search report, the application appears to lack novelty, inventivity and does not claim any substantial improvement with regard to these known methods.

Since Claim 1 was destroyed, we could not find any common concept of invention in several depending claims. Therefore we regarded the claims referring to ethanol-binding technology on one hand, and the claims referring to ethanol converting technology on the other one, as constituting two separate sets of claims."

III. The Applicant paid the additional search fee under protest, contending that specific recognition of ethanol is an important feature of the invention, forming a common unifying concept for the two particular ways that the Applicant had exemplified. The prior art resins did not appear to involve specific recognition such as now found with the active sites of enzymes and antibody proteins.

IV. Claims 1, 12 and 16 read as follows:

1. A device for the reduction or removal of alcohol from a beverage which comprises an immobilised reagent for chemically converting or binding to the ethanol.
12. A method for removing ethanol from a beverage which comprises transiently contacting the beverage with an immobilised reagent capable of chemically converting or binding to the ethanol, and then separating the reagent from the beverage.
16. A container for a beverage which has a device according to Claim 1 located in association with the container so that the reagent can contact the beverage.

Reasons for the Decision

1. The protest is admissible.

2. The ISA apparently considered that the additional fee was due in view of the second invention quoted in the invitation, i.e. those claims comprising the feature of removing ethanol by using an immobilised reagent capable of chemically converting the ethanol.
3. In Article 17 PCT, relating to the procedure before the ISA, there is clear wording in paragraph 3(a) stating that "if the International Searching Authority considers that the international application does not comply with the requirement of unity of invention as set forth in the regulations, it shall invite the Applicant to pay additional fees. The International Searching Authority shall establish the International Search Report on those parts of the international application which relate to the invention first mentioned in the claims ("main invention") and, provided the required additional fees have been paid within the prescribed time limit, on those parts of the international application which relate to "inventions in respect of which the said fees were paid" (emphasis added).
4. Under Article 17(3)(a) PCT, the ISA is obliged to establish the International Search Report on the basis of that part of the application which has been mentioned first in the claims. If the first claim comprises more than one subject-matter to be considered as an invention, the Board interprets Article 17(3)(a) PCT as meaning that the first subject-matter in the first claim has to be considered as the "main invention" in the sense of the first part of said Article.
5. There seem to be no doubts that a "first invention" is defined in the first claim. In the present application, the reduction or removal of ethanol involving "chemically converting" is not only mentioned first in Claim 1 but also in Claim 12 (see point IV above) and has, therefore, to be

considered as the "main invention" which has to be searched by the ISA in any case, irrespective of whether or not the Applicant paid any additional fee.

6. The reasons in the invitation given by the ISA established two inventions and defined these inventions in relation to certain claims. Inter alia one subject-matter of the claims is defined as the removal of ethanol by using an immobilised binding reagent, e.g. antibody. Another subject-matter is said to be the removal of ethanol by using an immobilised reagent capable of chemically converting the ethanol (see point II above).

In the reasons of the invitation to pay an additional fee the ISA considers that "the invention first mentioned" in Claims 1, 2, 11, 12, 16 and part of Claims 9 and 14 relates to the one involving a "binding reagent", for example an antibody. However, this alternative corresponds undoubtedly to the second subject-matter mentioned in Claims 1 and 12 and can, therefore, in the Board's opinion, not be considered as being the "main invention" mentioned first in the claims.

Since there is an inconsistency between what the ISA should have done according to the clear wording of Article 17(3)(a) PCT and what the ISA in the invitation states having done, there is confusion as to the object of the international search. Be that as it may, it remains in any case that the ISA did not produce any search result in respect of the main invention as prescribed in said article. The Board concludes that the ISA did not act according to its obligation as clearly defined in Article 17(3)(a) PCT.

7. Thus, before issuing an invitation, the ISA must have completed the international search at least as far as the first subject-matter (main invention) is concerned. This

leads the Board to recall that the EPO is also bound to the PCT guidelines for international search when acting as an ISA (see G 1/89, of 2 May 1990 to be published in the OJ EPO). In Chapter VII, paragraph 12 of these guidelines, it is in particular stated that "Occasionally ..., the search examiner will be able to make a complete international search for both or all inventions with negligible additional work, in particular when the inventions are conceptually very close and none of them requires search in separate classification units. In those cases, the search examiner may decide to complete the international search for the additional invention(s) together with that for the invention first mentioned. All results should then be included in the international search report and no objection of lack of unity of invention should be raised." Therefore, excessive formalism must be avoided when dealing again a posteriori with the question of unity of invention. Furthermore, it is in no way clear to the Board whether the completed search as to the main invention, including the one already carried out by the ISA, would necessarily cover a possible second invention. If this were the case, lack of unity of invention should of course not be raised at all.

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

Order

For these reasons, it is decided that:

1. The invitation to pay one additional fee is set aside.
2. The refund of the additional fee paid is ordered.

The Registrar:

The Chairman:

M. Beer

P. Lançon