

Publication in the Official Journal ~~Yes~~ / No

File Number: W 18/91 - 3.3.2

Application No.: PCT/EP 90/02161

Publication No.:

Title of invention: Medicaments and Methods for Treating Acquired Immune
Deficiency Syndrome (AIDS) and Aids Related Complex (ARC)
Employing Anti-Carbohydrate Antibodies and Carbohydrate
Antigens

Classification: C12P, A 61K

D E C I S I O N
of 26 July 1991

Applicant: Bay Michael et al.

Headword: Aids antibodies/BAY

EPC PCT Rule 40.2(c)

Keyword: "Payment not accompanied by a reasoned statement"

Headnote



Case Number : W 18/91 - 3.3.2
International Application No. PCT/EP 90/02161

D E C I S I O N
of the Technical Board of Appeal 3.3.2
of 26 July 1991

Applicant : BAY Michael et al.
Valais
CH - 3974 Mollens

Representative : Gill Jennings & Every
Mr. R.E. Perry
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Subject of the Decision : Protest according to Rule 40.2(c) made by the Applicants against the invitation (payment of additional fee) of the European Patent Office (branch at The Hague) dated 8 April 1991.

Composition of the Board :

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

Summary of Facts and Submissions

- I. The Applicant filed international patent application PCT/EP 90/02161 on 13 December 1990.

On 8 April 1991, 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 invitation indicated that the application did not meet the requirement of unity of invention and set out two groups of claims. The Applicant was informed at the same time that the additional fee had to be paid within 30 days from the date of mailing and that the payment may be made under protest, in accordance with Rule 40.2(c) PCT.

- II. By letter dated 22 April 1991 and received at the ISA on 27 April 1991, i.e. before the above-mentioned time limit had expired, the Applicant announced payment of the required additional search fee, which were then effectively paid on 3 May 1991, i.e. due in time.

The mentioned letter contained only the following sentence indicating the grounds on which the Applicant's protest was based:

"This additional fee is paid under protest, since those claims which can be searched relate to a single inventive concept."

- III. The ISA has referred the protest to this Board of Appeal for examination in accordance with Rule 40.2(c) PCT.

Reasons for the Decision

1. Under 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 under the provisions of Article 17(3)(a) of the Cooperation Treaty.
2. 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.

Since the search fees for the inventions deemed to be additional were paid in due time, the European Patent Office must establish the international search report on those parts of the present international application which relate to the said inventions.

3. 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 ..." (emphasis added).

This makes it clear that if an Applicant wishes to pay additional fees under protest, then not only the additional fees must be paid, but also the reasoned statement that sets out the protest must be made within the specified time limit (cf. Decision W 4/87, OJ EPO 11/1988, 425).

From the statement referred to under paragraph II above it is clear that the Applicant wanted to pay the additional fees under protest but he did not give any reasons. The statement in the protest is only an allegation that those

claims which can be searched relate to a single inventive concept. However, an allegation alone cannot be considered as a "reasoned statement" within the meaning of Rule 40.2(c) PCT (see also W 8/89 of 11 December 1990, to be published in OJ EPO).

Therefore, the Applicant's protest under Rule 40(2)(c) PCT has to be dismissed as inadmissible.

4. Under these circumstances, the Board does not have to examine whether the invitation to pay is legally effective e.g. has been properly reasoned to substantiate lack of unity since that is a question of substantive law which has to be dealt with on the occasion of substantive examination of the protest which may only be initiated if the protest is admissible (cf. Decision W 6/88 of 14 April 1989, not published).
5. Consequently, 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:

The Chairman:

P. Martorana

P. Lançon