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D E C I S I O N
of 23 November 1995

Case Number: W 0003/95 - 3.2.1
Application Number: PCT/US 94/02212
Publication Number: WO 94/21503
IPC: B61D 3/18, B61F 3/12

Language of the proceedings: EN

Title of invention:

Intermodal vehicle for forming train of highway trailers

Applicant:

RailRunner Systems, INC. et al.

Opponent:

-

Headword:

Intermodal Vehicle/RAILRUNNER SYSTEMS

Relevant legal provisions:

PCT Article 34(3)(a); Rules 68.2, 68.3
EPC Article 155(3); Rule 104a(3)

Keyword:

"Additional examination fees paid under protest"
"Time limit for payment of the protest fee"
"Referral of the protest to the Board of Appeal"

Decisions cited:

W 0053/91, W 0004/93

Headnote:

It is the responsibility of the European Patent Office, acting as International Preliminary Examining Authority, to ascertain whether the protest fee was paid in due time before referring a protest to the Board of Appeal for a decision.



Case Number: W 0003/95 - 3.2.1

D E C I S I O N
of the Technical Board of Appeal 3.2.1
of 23 November 1995

Applicant: RailRunner Systems, Inc.
1428 Hwy, 19/41 Bypass
Griffin, GA 30223 (US)

Wicks, Harry O.
350 Thunderbird, 38
El Paso, TX 79912 (US)

Representative: Thompson, John C.
69 Grayton Road
Tonawanda, NY 14150 (US)

Subject of the Decision: Protest pursuant to Rule 68.3(c) of the Patent Cooperation Treaty made by the applicant against the invitation of the European Patent Office dated 4 January 1995 pursuant to PCT Article 34(3)(a) and Rule 68.2 to restrict the claims or pay additional fees (for the international preliminary examination).

Composition of the Board:

Chairman: F. A. Gumbel
Members: S. Crane
B. Schachenmann

Summary of Facts and Submissions

- I. On 4 January 1995 the applicants of international patent application No. PCT/US 94/02212 were invited by the European Patent Office, acting in its capacity as International Preliminary Examining Authority (IPEA), to restrict the claims or to pay two additional fees pursuant to Article 34(3)(a) and Rule 68.2 PCT on the grounds that the requirement of unity of invention was not complied with.

- II. The applicants paid the additional fees under protest on 6 March 1995. According to their submissions of 2 March 1995 the examiner was in error in his finding of lack of unity of the invention.

- III. On 22 March 1995 the IPEA mailed a communication informing the applicants that after review the invitation referred to above was considered to be justified. The applicants were therefore invited to pay the protest fee pursuant to Rule 68.3(e) PCT and Rule 104a(3) EPC within one month from the date of mailing of the communication.

- IV. On 22 April 1995 the applicants informed the IPEA by facsimile letter that they continued to protest the examiner's finding of lack of unity of the invention and that a cheque for the protest fee of DEM 2000.- was enclosed with the confirming copy of the facsimile. The confirming copy with the cheque was received at the IPEA on 26 April 1995.

- V. On 1 June 1995 the protest was referred to the Board of Appeal for a decision. The applicants requested that the findings of the IPEA be reversed and that the additional examination fees of DEM 6000.- as well as the protest fee be refunded.

Reasons for the Decision

1. According to Article 155(3) EPC the Boards of Appeal, in their capacity as a "special instance" of the IPEA pursuant to Rule 68.3 PCT, are responsible for deciding on protests made by applicants against an additional fee charged by the IPEA under the provisions of Article 34(3)(a) PCT. Thus, the Board is competent to deal with the present protest.
2. The protest procedure before the IPEA is governed by the provisions of Rule 68.3, paragraphs (c) to (e) PCT, and, as far as the European Patent Office acting as IPEA is concerned, also by Rule 104a(3) EPC. According to these provisions the IPEA is responsible, in a first phase of the proceedings, for the following procedural steps: review of the justification for the invitation to pay additional fees, notification to the applicant of the results of the review and, where applicable, invitation to pay the protest fee. If the protest fee is paid in due time, the protest will be referred to the "special instance" of the IPEA which, in a second phase of the proceedings, decides on the protest.
3. In the circumstances of the present case, the IPEA, after prior review, invited the applicant to pay the protest fee. The notification to the applicant of the result of the review was mailed on 22 March 1995 indicating that the protest fee was due within one month of the date of mailing. However, the cheque for the

protest fee of DEM 2000.- was not received until Wednesday, 26 April 1995. Thus, considering the provisions for the computation of time limits under the PCT (see in particular Rule 80 PCT), there are serious doubts whether the protest fee was paid in due time.

Nevertheless, the IPEA referred the present protest case to the Board of Appeal for a decision without any previous examination of this issue.

4. Thus, the procedural question arises whether, in view of Article 155(3) and Rule 104a(3) EPC, it was right for the IPEA in these circumstances to refer the protest to the Board of Appeal for a decision.

4.1 Whereas Article 155(3) EPC generally states the responsibility of the Boards of Appeal for deciding on protests, implementing Rule 104a(3) EPC, last sentence, more precisely prescribes that any protest shall be referred to the Board of Appeal for a decision, "if the protest fee is paid in due time".

From this provision it is to be concluded a *contrario* that if the protest fee is paid late or is not paid at all, the protest is not to be referred to the Board of Appeal for a decision with the effect that the protest case does not become pending before the Board of Appeal.

Accordingly, it is the duty of the IPEA to ascertain whether the protest fee was paid in due time before referring a protest to the Board of Appeal for a decision.

This interpretation appears to be in line with the provision of Rule 68.3(e) PCT according to which any protest shall be considered withdrawn if the protest fee is not paid in due time. By the deemed withdrawal of the protest, the procedure is terminated already before the protest is referred to the Board of Appeal.

- 4.2 At first sight it may appear that the interpretation given above is not in agreement with the decision W 53/91 of 19 February 1992 (not published). In that decision (see points 6 and 7 of the reasons) it was concluded from the parallelism between appeal and protest cases that once an invitation to pay additional fees has been the object of a protest (corresponding to an appeal) the first instance is no longer competent to examine the case and the higher authority becomes exclusively competent to examine it (principle of devolutive legal remedy).

However, it should be noted that the decision referred to above was issued prior to the adoption of the new Rules 68.3(e) PCT and 104a(3) EPC. Indeed, pursuant to the former provisions the payment of the additional fee under protest had as immediate effect that protests were to be examined by the "special instance" of the IPEA.

- 4.3 In contrast, according to the new rules, the timely payment of the additional fee under protest first leads to a review of the justification for the invitation to pay the additional fee by the IPEA, as set out in point 2 above. If the result of the review is negative, the review body will have to give a technical reasoning for its finding (decision W 4/93, OJ EPO 1994, 939, point 2.3 of the reasons; PCT Preliminary Examination Guidelines, Chapter VI, 5.7, published by WIPO on

1 March 1993). The review body may allow the protest in total or in part (see Explanatory Memorandum of the President of the EPO dated 2 April 1992, CA/007/92, point 17).

It clearly emerges from the above that, according to the new provisions, the payment of additional fees under protest does not end the competence of the first instance for the case. On the contrary, it remains fully responsible for the protest proceedings until it either allows the protest or, unless the protest is considered withdrawn, refers it to the Board of Appeal for a decision. Thus, its responsibility includes the examination of the preconditions under which, according to Rule 104a(3) EPC, last sentence, the referral can take place.

- 4.4 According to the preparatory documents for amending Rule 104a EPC (Explanatory Memorandum of the President of the EPO dated 2 April 1992, CA/007/92, part 1, points 11 to 21) the protest procedure before the Boards of Appeal is "broadly comparable" to that of an appeal and differs "neither in nature nor in scope" from ex parte appeal proceedings. These statements were, however, made in support of the proposal to fix the protest fee at an amount equal to that of the appeal fee due to comparable costs for the European Patent Office. Thus, it cannot be derived therefrom that absolute identity between the protest and the appeal procedure was intended.

In this context it is to be noted that there are significant differences between the amended rules governing the filing and handling of a protest in comparison with the provisions of the EPC governing appeals. In particular, among the articles and rules of the Convention governing the appeal procedure there is no provision comparable to the provision of Rule 104a(3)

EPC, last sentence, according to which the protest shall be referred to the Board of Appeal, "if the protest fee is paid in due time". Instead, any appeal, which cannot be allowed by way of interlocutory revision pursuant to Article 109 EPC, **must** be referred to the Boards of Appeal. This is true for all cases in which the appeal fee was **not paid** in due time.

It also follows from the preparatory documents referred to above (see point 19), that an important reason for adopting new Rule 104a(3) EPC was to "substantially reduce the number of protest cases going to the Boards of Appeal". The interpretation of Rule 104a(3) EPC given above (see point 4.1) is in perfect agreement with this intention. If, on the other hand, all protests were referred to the Boards of Appeal, even if the protest fee was not paid in due time or not paid at all, this aim could be undermined.

4.5 Based on the interpretation of Rule 104a(3) EPC referred to in point 4.1, above, the Board comes therefore to the conclusion that it is the responsibility of the IPEA to examine whether or not the protest fee was paid in due time before referring the protest to the Board of Appeal.

5. However, it is also clear that, once the protest has been referred to the Board of Appeal for a decision, the case is pending before the Board independently of whether or not the referral was justified. In such a case it is the duty of the Board to deal with the protest in accordance with the procedural principles applicable to protest cases.

In the decision W 53/91 referred to above (point 5 of the reasons) it was stated that protests should, by analogy, be considered and treated as appeals within the

framework of the provisions of the EPC on appeals and appeals procedure provided that no conflict arises with the PCT. As explained above this may, under the new provisions, no longer be true for the review phase of protests for which the EPC contains specific procedural rules. However, it still appears to be valid as far as the protest proceedings before the Boards of Appeal are concerned.

6. Thus, by analogy to Article 111(1) EPC, the Board decides to remit the protest to the IPEA for further prosecution. The European Patent Office, acting as IPEA, will have to examine in accordance with Rule 104a(3) EPC whether or not the protest fee was paid in due time.

Order

For these reasons it is decided that:

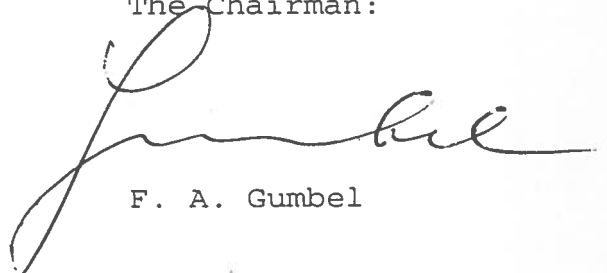
The protest is remitted to the International Preliminary Examining Authority for further prosecution.

The Registrar:



S. Fabiani

The Chairman:



F. A. Gumbel

