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MATTERS

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PROPOSALS TO AMEND PCT RULE 40.2 AND 68.3

*Submitted by the European Patent Office*

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\* *Editor's Note:* This electronic document has been created from the paper original and may contain errors. Please bring any such errors to the attention of the PCT Legal Division by e-mail at [pct.legal@wipo.int](mailto:pct.legal@wipo.int)

EPO second proposal to amend

Rules 40.2 and 68.3 PCT

Lack of Unity of Invention

## PART I

Rule 40.2

Lack of unity of invention  
(International Search)

40.1 [No change]

40.2 *Additional fees*

(a) to (d) [No change]

(e) Where the applicant has, under paragraph (c), paid an additional fee under protest, the International Searching Authority may require that the applicant pay a fee for the examination of the protest (“protest fee”), provided that there has been a prior review of the invitation to pay an additional fee, taking the protest into account, by the instance having issued the invitation. The protest fee shall be paid within one month after notification to the applicant of the result of the review. If the protest fee is not so paid the protest shall be considered withdrawn.

Rule 68.3

Lack of unity of invention  
(International Preliminary Examination)

68.1 [No change]

68.2 [No change]

68.3 *Additional fees*

(a) to (d) [No change]

(e) Where the applicant has, under paragraph (c), paid an additional fee under protest, the International Preliminary Examining Authority may require that the applicant pay a fee for the examination of the protest (“protest fee”), provided that there has been a prior review of the invitation to pay an additional fee, taking the protest into account, by the instance having issued the invitation. The protest fee shall be paid within one month after notification to the applicant of the result of the review. If the protest fee is not so paid, the protest shall be considered withdrawn.

**PART II****Reasons****I. INTRODUCTION**

1. During the first part of its fourth session (Geneva, 10-14 December 1990), the PCT Committee for Administrative and Legal Matters ("PCT/CAL-Committee") discussed a proposal of the EPO to create in Rules 40.2 and 68.3 PCT a legal basis empowering any International Searching Authority (ISA) or International Preliminary Examining Authority (IPEA) to require a fee for examination of a protest filed by an applicant under Rule 40.2(c) or 68.3(c) when paying additional fees in cases of lack of unity of invention (see document PCT/CAL/IV/4).
2. The report of that meeting appearing in document PCT/CAL/IV/6 sets out the content of that discussion on page 10, paragraphs 68 to 71.

**II. AMENDED EPO PROPOSAL**

3. Part I of the present document contains an amended EPO proposal of Rules 40.2(e) and 68.3(e). The reasons which follow refer to the amended proposal of Rule 40.2(e), it being understood that they apply *mutatis mutandis* to Rule 68.3(e).
4. In reconsidering its proposal, the EPO has taken into account the following argument made by the nongovernmental organizations: If a fee is charged for the examination of the protest by a three-member board or other specific instance, the applicant should be given a prior opportunity for a free review of the invitation to pay additional fees by the instance-having issued the invitation, taking into consideration the arguments put forward by the applicant in the protest.

To the extent that the instance having issued the invitation is convinced by the arguments of the applicant, it will withdraw the invitation and reimburse the additional fees paid.

5. Therefore the EPO amended proposal of Rule 40.2(e) provides for the following steps to be taken free of any charge before the applicant has to pay a protest fee:

- (a) If the applicant pays additional fees under protest in accordance with Rule 40.2(c) the protest is at first submitted to the instance which issued the invitation with the duty to review the requirement to pay additional fees in the light of the arguments of the applicant;
- (b) The ISA then notifies the applicant of the result of the review;
- (c) To the extent that as a result of the review, the ISA cancels totally or partially the invitation to pay additional fees, then it shall reimburse any additional fee to the applicant.

6. Where, as a result of the review, the ISA maintains totally or partially the invitation to pay additional fees, the applicant is given one month to pay the protest fee if he wants to maintain the protest.

If the protest fee is paid within that one month time limit, the protest is promptly transferred to the three-member board or other special instance for decision;

If the protest fee has not been paid within the prescribed time limit, the protest is considered withdrawn.

7. It is worth underlining that the EPO proposal maintains without any change the current scheme of carrying out the international search in case of lack of unity of invention.

As soon as the applicant has paid the additional fees at the time he files a protest, the search can continue and the international search report can be established on the “main” invention and other inventions for which additional fees have been paid subject to prompt reimbursement where the review ends with a positive result for the applicant. If the result is negative for the applicant, he has one month to decide whether he wants the protest to be forwarded to the three-member board or higher instance; only where he decides to maintain the protest must the protest fee be paid.

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