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WORLD INTELLECTUAL PROPERTY ORGANIZATION
GENEVA

**INTERNATIONAL PATENT COOPERATION UNION
(PCT UNION)**

**MEETING OF INTERNATIONAL AUTHORITIES
UNDER THE PCT**

**Sixth Session
Canberra, February 17 to 21, 1997**

**ADDITIONAL SEARCH AND PRELIMINARY EXAMINATION FEES
WHERE LACK OF UNITY OF INVENTION IS FOUND**

Document prepared by the International Bureau

1. Under PCT Rules 40.2(c) and 68.3(c), in cases where the applicant is invited to pay an additional fee for each additional invention to be subjected to international search or international preliminary examination, respectively, as a result of a finding of lack of unity of invention, any such additional fee may be paid under protest, accompanied by a reasoned statement which may, *inter alia*, assert “that the amount of the required additional fee is excessive.” That phrase, which appears in both of the above-mentioned Rules, seems to have been intended to mean that the applicant may protest on the basis that the International Searching Authority or International Preliminary Examining Authority, as applicable, has requested the payment of too many (that is, an excessive number of) additional search or preliminary examination fees, but it does not seem to have been intended that the applicant may protest on the basis that the amount fixed by the Authority concerned for the additional search or preliminary examination fee is itself excessive.

2. It is noted that the PCT Search Guidelines, Chapter VII, paragraph 3 (referring to PCT Rule 40.2(c)), reflect the above-mentioned interpretation: “The applicant may protest the allegation of lack of unity of invention or that *the number of required additional fees is excessive* and request a refund of the additional fee(s) paid ...” (emphasis added). That

interpretation, even though not specifically reflected in the PCT Preliminary Examination Guidelines, would clearly also apply to the question of lack of unity in respect of international preliminary examination. The *PCT Applicant's Guide* contains references to that interpretation both in respect of international search (Volume I, paragraph 219) and international preliminary examination (Volume I, paragraph 323, penultimate sentence).

3. The International Bureau is of the view that neither the amount fixed by an Authority for the additional search or preliminary examination fee (PCT Rules 40.2(a) and 68.3(a), respectively), nor the search or examination fee (PCT Rules 16.1 and 58.1(a), respectively) charged for the main invention, was intended to be open to challenge under the provisions of PCT Rules 40.2(c) and 68.3(c). The Meeting, if it agrees, may wish to consider the desirability of clarifying the position by amendment of those Rules.

4. It may be useful to recall that the PCT Search Guidelines and PCT Rule 68.1, as well as the PCT Preliminary Examination Guidelines, provide that, even in a case where unity of invention is lacking in the international application, the examiner has the option (based, for example, on "reasons of economy") of whether or not to issue an invitation to pay additional fees (see PCT Search Guidelines, Chapter VII, paragraphs 11 and 12, and PCT Preliminary Examination Guidelines, Chapter III, paragraph 7.10 and Chapter VI, paragraphs 5.5 and 5.9).

5. It is, however, noted that the fee charged by certain Authorities for an additional search or preliminary examination is lower than the corresponding fee for the search or preliminary examination of the main invention. The Meeting may wish to consider whether it would be desirable for other Authorities to follow a similar approach.

6. The Meeting is invited to discuss the matters outlined above and to consider whether, and along what lines, amendments would be desirable to PCT Rules 40.2(c) and 68.3(c), and also to discuss whether it would be desirable for additional search and preliminary examination fees to be set at lower levels than the corresponding fees for search and preliminary examination of the main invention.

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