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Aktenzeichen / Case Number / N^o du recours : W 05/87

Anmeldenummer / Filing No / N^o de la demande : PCT/US 86/02315

Veröffentlichungs-Nr. / Publication No / N^o de la publication :

Bezeichnung der Erfindung: Multi-Fiber Optic Cable Connector and
Title of invention: Cable Apparatus
Titre de l'invention :

Klassifikation / Classification / Classement :

ENTSCHEIDUNG / DECISION

vom / of / du 11 January 1988

Anmelder / Applicant / Demandeur : Rockwell International Corporation

Patentinhaber / Proprietor of the patent /
Titulaire du brevet :

Einsprechender / Opponent / Opposant :

Stichwort / Headword / Référence :

PCT Rules 13 and 40

Kennwort / Keyword / Mot clé : General inventive concept (no)

Leitsatz / Headnote / Sommaire

Europäisches
Patentamt

Beschwerdekammern

European Patent
Office

Boards of Appeal

Office européen
des brevets

Chambres de recours



Case Number : W 05/87
International Application
No. PCT/US 86/02315

D E C I S I O N
of the Technical Board of Appeal 3.4.1
of 11 January 1988

Appellant : Rockwell International Corporation
Patent Department, Mail Code AD06
3370 Miraloma Avenue
Anaheim, California 92803
USA

Representative :

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 17 July 1987

Composition of the Board :

Chairman : K. Lederer
Members : H. Reich
C. Payraudeau

Summary of Facts and Submissions

I. On 30 October 1986 the applicant filed international patent application PCT/US 86/02315 with the United States Patent Office.

II. On 17 July 1987 the European Patent Office acting as International Searching Authority (ISA) issued an invitation to pay an additional search fee since it considered that the above-mentioned application did not comply with the requirements of unity of invention.

The given reasons were that a first group of claims (group I), consisting of Claims 1-17, 29-42 and 43-48, belongs to the realm of optical couplings and their alignment problems while a second group of claims (group II), consisting of Claims 18-27, belongs to the realm of optical cables and their protection and strengthening problems. The two groups do not share the same inventive concept.

III. The applicant thereupon paid the fee required for the search of one additional invention. In his letter dated 12 August 1987, received on 17 August 1987, the applicant stated that he was paying the fee under protest because he believed that all claims of group I and II were so linked as to form a single general inventive concept. In order to support his view he mainly put forward the following arguments:

(a) Claims 5, 6 and 10 of group I would relate to the same subject-matter as encompassed by group II;

- (b) a search of Claims 29-42 in group I would necessarily include the subject-matter of Claims 18-26 in group II, the features of Claims 18-26 being substantially incorporated in the combination of Claims 29-42;
- (c) Claim 27 relating to the combined utilisation of a connector and of the multifibre cable was nevertheless included in group II and Claim 28 dependent on Claim 27 was not attributed to any group;
- (d) Claims 43-44 were erroneously stated in the invitation as being method claims although they were drawn to the apparatus of the invention.

The applicant requests total or partial reimbursement of the additional fee.

IV. The international application comprises 7 independent claims, to some of which dependent claims are related:

- | | |
|---|-----------|
| 1. An apparatus for aligning and terminating: | Claim 1 |
| 2. A multifibre optic cable: | Claim 18 |
| 3. A communication system: | Claim 27 |
| 4. A termination assembly: | Claim 43 |
| 5. A connector assembly: | Claim 45 |
| 6. A method of forming a termination: | Claim 47 |
| 7. A method of interconnecting: | Claim 48. |

Reasons for the Decision

1. The protest complies with Rule 40.2.c PCT.

2. In the invitation to pay an additional search fee not only the claims of the two separate inventions are listed but the reasons for the findings are also explicitly indicated, i.e. that the two groups of inventions have no subject-matter in common, on which a single general inventive concept could be based. Thus, the invitation satisfies Article 17(3)(a) and Rule 40.1 PCT; see also W 04/85, OJ EPO 1987,63.

- 3.1 The aligning and terminating apparatus claimed in Claim 1 comprises: two rigid tubular body parts, an alignment sleeve, an alignment sleeve holder, means securing the two body parts and means for aligning at least two optical fibres. The multifibre optic cable claimed in independent Claim 18 comprises: a centre strength member, optical fibres, a fibre covering, crimping material around the covered fibres and an outer jacket. The only technical feature which independent Claims 1 and 18 have in common, is a "fibre optic cable". However, since fibre-optic cables are generally known, a single general concept for Claims 1 and 18, which concept is inventive, cannot be seen. It is obvious that the apparatus as claimed in Claim 1 (connector) can be assembled with many known optic cables (for example, cables having a single fibre) and that the optic cable as claimed in Claim 18 can be used with various known types of connector. For the above reason the Board is convinced that Claim 18 relates to a different invention than Claim 1 and that there is no link between the subject-matters of the two claims as to form a single general inventive concept.

- 4.2 Since the Board agrees with the findings of the ISA that the Claims 1 and 18 of the international application relate to two independent inventions, there is no need to examine

the argumentation of the applicant as regards the possible relationship between some of the claims and subclaims of both groups and the alleged inconsistencies of the invitation to pay.

5. Thus, it follows that the invitation of 17 July 1987 to pay an additional search fee was correctly issued and that the protest is not justified.

6. As regards the subsidiary request of the applicant for partial reimbursement of the additional fee, the Board considers that, on the true interpretation of Rules 13 and 40 PCT, such partial reimbursement cannot be ordered in the present case. The provision of Rule 40 relating to the total or partial reimbursement of the fee is to be read in conjunction with the requirements of Rule 13 relating to unity of invention. Therefore, it is only when the Board, on examination of the protest, finds that the application, although not fully satisfying the requirements of unity of invention, comprises less independent inventions than the number for which a fee has been paid, that a partial reimbursement - of one or more basic fees - may be ordered. Contrary to the Applicant's opinion, the possibility of a partial reimbursement of a single additional search fee, e.g. on the ground of a minimal additional search effort, is not covered by the provisions of the PCT as is clear from the wording of the official French text of Rule 40 PCT.

Order

For these reasons it is decided that:

The reimbursement of the additional fee, in toto or partially, is refused.

The Registrar:

The Chairman:

F. Klein

K. Lederer