

Europäisches  
Patentamt

Beschwerdekammern

European Patent  
Office

Boards of Appeal

Office européen  
des brevets

Chambres de recours



Case Number : W 10/87

**DECISION**  
of the Technical Board of Appeal 3.2.1  
of 9 November 1987

**Appellant :** S O.C.I.M I.  
Società Costruzioni  
Industriali Milano S.p.A.  
Via Varesina 115  
I-20156 Milan (IT)

**Representative :** Ing. Barzano' & Zanardo Milano  
S.p.A.  
Via Borgonuovo 10  
I-20121 Milan (IT)

**Decision under appeal :** 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 1 July 1987

**Composition of the Board :**

**Chairman :** P. Delbecque

**Members :** C.T. Wilson  
F. Benussi



### Summary of Facts and Submissions

I. On 24 February 1987, the Applicants filed an International patent application PCT/EP87/00104 with the European Patent Office.

II. On 1 July 1987, the European Patent Office as competent International Searching Authority issued, pursuant to Article 17(3)(a) PCT and Rule 40(1) PCT, an invitation to pay three additional search fees in view of the fact that it is considered that the above identified application did not comply with the requirements of unity of invention as set forth in Rule 13(1) PCT.

Four inventions were identified:

- |                      |  |
|----------------------|--|
| Claim 1 :            | Inertia operated block having a portion surrounding the barrel |
| Claims 2, 3, 13, 14: | Breech block having a percussion pin integral therewith        |
| Claims 4-11          | Breech-block having a radially movable percussion pin          |
| Claim 12:            | Piezoelectric ignition device.                                 |

III. On 27 July 1987, the Applicants paid two additional search fees under protest (Rule 40(2)(c) PCT) in order to have the search extended to Claims 2, 3, 13, 14 and Claims 4-11 as above defined.

An additional fee for search in respect of Claim 12 has not been paid.

The Applicants are of the opinion that the invention as claimed in Claims 1 to 11 and 13, 14 complies with the requirements of unity of invention according to Rule 13.1 PCT, for the reasons specified hereinafter.

Claim 1 of the application, which is the only independent claim in the application, defines a machine-pistol having a barrel and a breech-block movable with respect thereto for actuation of a percussion device, the machine-pistol being characterised in that the breech-block is provided with a longitudinal portion defining an at least semicylindrical chamber, surrounding, for a certain longitudinal length, the barrel, with a small radial clearance, in the forward position for the actuation of the percussion device.

As specified on page 3 of the specification, first full paragraph, such a type of configuration of the breech-block and of the barrel allows axial percussion or radial percussion to be optionally adopted, inasmuch as the percussion device can be positioned in such a way that it can be optionally actuated by an axial portion of the breech-block or by a portion able to surround, radially from outside, the barrel.

In other terms, the breech-block and the barrel of the pistol according to the invention can maintain the same basic configuration, but by optionally mounting on the weapon the breech-block and barrel of a specific desired configuration, which differs only as regards to the percussion device, the weapon is fitted for use of several cartridge types.

There is, therefore, a single general inventive concept, namely that of a breech-block having a longitudinal portion extending for a certain length of the barrel at least partially about it, which renders the pistol suitable both

for axial and radial percussion. The configurations of the breech-block, in case of axial or radial percussion, thus represent embodiments or variants of the inventive concept, which is one only.

Dependent claims claiming specific forms of the invention claimed in independent Claim 1 should therefore be permitted pursuant to PCT Rule 13.4.

In the present case, Claims 2, 3, 13, 14 relate to specific forms of the breech-block of Claim 1 for axial percussion.

Claims 4-11 relate to specific forms of the breech-block of Claim 1 for radial percussion.

The standpoint of the International Searching Authority exposed in the Invitation dated 1 July 1987 is therefore considered inappropriate and it is kindly requested that it be reversed and the search effected in respect of Claims 1-11 and 13, 14.

#### Reasons for the Decision

1. Pursuant to Article 154(3) EPC and Article 9 of the agreement between WIPO and the EPO, the Boards of Appeal of the EPO are responsible for deciding on protests made by an Applicant against an additional search fee charged by the EPO under the provisions of Article 17(3)(a) PCT (OJ EPO 4/1978, 249). Therefore, the protest complies with Rule 40(2)(c) PCT and is admissible.

2. The ISA has made clear in its invitation that it considers that the International patent application does not relate to one invention only or to a group of inventions so linked as to form a single general inventive concept. Contrary to Rule 40.1 PCT, however, it failed to specify, in the invitation, sufficient reasons for its above finding.
3. The Boards of Appeal of the EPO have already decided in many decisions (WO4/85 of 22 April 1986, WO5/86 of 9 April 1987, WO7/86 of 6 June 1986 and WO9/86 of 11 August 1986) that the indication of reasons in an invitation pursuant to Article 17(3)(a) and Rule 40.1 PCT is an essential prerequisite for such an invitation to be legally effective.
4. Moreover, the Board is also of the opinion (expressed in WO9/86) that the results of searches leading to a-posteriori lack of unity objections, being part of the reasons for the alleged non-compliance with the requirement of unity of invention, must be communicated to the Applicants.

It is a fundamental right of an applicant to be informed of the full reason for such alleged non-compliance under Article 17(3)(a) PCT.

5. In all cases, where objection is raised against two or more sets of claims, and where each set is dependent upon a common claim, (here Claim 1), so that an objection of lack of unity of invention can only be maintained if this common claim falls, e.g. due to lack of novelty, the Applicants are entitled to know why it is considered that this claim

falls. In such cases mere enumeration of subjects (as in the present case) is not sufficient to prove lack of unity, unless the subject-matter of the claim is trivial or common general knowledge, which is clearly not the case here.

6. Accordingly, the invitation lacks legal basis, because it contravenes Rule 40.1 read in conjunction with Rule 13.1 PCT, and thus cannot have any legal effect. Therefore, the additional search fee cannot be retained.

**Order**

**For these reasons, it is decided that:**

**Refund of the additional search fee is ordered.**

**The Registrar:**

**The Chairman:**

**F. Klein**

**P. Delbecque**

