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Aktenzeichen / Case Number / N° du recours : W 29/88

Anmeldenummer / Filing No / N° de la demande : PCT/EP 88/00296

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Bezeichnung der Erfindung: New perfluoroalkanes obtained by photochemical
Title of invention: fluorination and use thereof as polymerisation
Titre de l'invention : initiators

Klassifikation / Classification / Classement : C08F 4/00

ENTSCHEIDUNG / DECISION

vom / of / du 28 November 1988

Anmelder / Applicant / Demandeur : Ausimont S.p.A.

Patentinhaber / Proprietor of the patent /
Titulaire du brevet :

Einsprechender / Opponent / Opposant :

Stichwort / Headword / Référence :

PCT Art. 17, Rules 13,40

Schlagwort / Keyword / Mot clé : "unity of invention - identity of structural
scope in claims of different categories -
unnecessary"

Leitsatz / Headnote / Sommaire



Case Number : W 29/88

International Application No PCT/EP 88/00296

D E C I S I O N
of the Technical Board of Appeal 3.3.1
of 28 November 1988

Appellant : Ausimont S.p.A.
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Subject to 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 20 June 1988

Composition of the Board :

Chairman : K. Jahn

Members : F. Antony
G.D. Paterson

Summary of Facts and Submissions

- I. On 8 April 1988, the Applicant filed International patent application PCT/EP 88/00296 with the European Patent Office. The EPO was the designated office within the meaning of Article 2 (xiii) PCT.

- II. On 20 June 1988, the European Patent Office as competent International Searching Authority (ISA) issued, pursuant to Article 17(3)(a) PCT and Rule 40.1 PCT, an Invitation to pay two additional search fees in view of the fact that it considered that the above identified application did not comply with the requirements of unity of invention as set forth in Rule 13.1 PCT. It was stated that, according to Rule 13.2(i) PCT, the scope of the products claimed on the one hand and of the products manufactured according to the process claim(s) and/or the products used as stipulated in the use claim(s) on the other hand had to be substantially identical. This being not the case, a single general inventive concept covering the different categories of claims could not be considered to be present.

The following three subjects constituted separate inventive concepts:

1. Claims 1 (in part), 4-8 : compounds of formulae (V) and (VI), their preparation, and their use as polymerisation initiators;

2. Claims 1 (in part), 2-3 : use of compounds with formulae (I), (II), (III), (IV) as polymerisation

"inhibitors" (sic; in fact
"initiators" was meant);

3. Claim 1 (in part) : polymerisation process in which the
initiator is not covered by
subjects 1 or 2.

IV. On 19 July 1988 the Applicant paid both additional search
fees under protest (Rule 40.2(c) PCT) and asserted that
the International application related to chemical
products, a process for their preparation and their use,
which according to Rule 13.2(i) PCT should meet the unity
requirements of the PCT. The different scope of Claims 4
and 6 to 8 concerning novel compounds on the one hand, and
Claims 1 to 3 and 5 concerning novel and old compounds on
the other hand, should not violate Rule 13.2(i) PCT. As
ruled in decisions of the Boards of Appeal such as T 35/87
(OJ EPO 1988, 134) and W 07/85 (OJ EPO 1988, 211), claims
might have a different scope and still be uniform.

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 1985, 320, 324).
2. The Protest, complies with Rule 40.2(c) PCT and, is
therefore, admissible.
3. Claim 1 relates to a polymerisation process using, as

polymerisation initiator, "a branched perfluoroalkane or a mixture of branched perfluoroalkanes having a certain structure, i.e.

(i) having adjacent two quaternary carbon atoms or a quaternary and a tertiary carbon atom and

(ii) having at least nine carbon atoms.

The ISA has not given the slightest reason why this definition of the structure of the polymerisation initiator, or why the polymerisation process characterised by its presence, should lack unity in itself, nor can the Board recognize the existence of any such reason.

4. Claims 2 and 3 relate to the process of Claim 1 in which the polymerisation initiator has one of a number of specific structures fully embraced by its definition in Claim 1. Equally there exists no reason, either stated by the ISA or otherwise recognizable, why Claims 2 and 3 should not relate to the same invention as Claim 1.
5. The same is true for Claim 5, which relates to the process of Claim 1 in which the polymerisation initiator has one of two further specific structures, again embraced by the definition of Claim 1, and in which process the polymerisation temperature (left open in Claim 1) is said to be higher than 70°C.
6. There can thus be no question that Claims 1 to 3 and 5 together form one single invention, and it cannot be understood how the ISA could have come to a different result.
7. Although the ISA drew the dividing line(s) in a different manner, it did give reasons why, in its view, the

compound-per-se Claim 4 (together with the appendant Claims 6 to 8 relating to a process for preparing the compounds of Claim 4) did not form a single general inventive concept with Claim 1:

- 7.1. The ISA has concluded from Rule 13.2(i) EPC - apparently from the words "a given product" in line 1 and the phrase "use of the said product" (emphasis added) in the last line thereof - that the structural scope of the products claimed per se on the one hand (here: those of Claim 4) and of those used according to use claims on the other hand (here: those of Claims 1 to 3, and 5) must be "substantially identical".

- 7.2. The Board has already decided in its Decision W 03/88 of 8 November 1988 "Lubricants/Lubrizol" (to be published) that such a conclusion is based on a double misunderstanding (see section 11 of cited Decision): Firstly, the wording of Rule 13.2 makes it quite clear that its list of possible circumstances in which there is unity of invention between claims of different categories is in no way excluding the possibility of other circumstances where there is such unity (cf. the words "in particular" in line 1 of Rule 13.2); secondly, the Board does not follow the narrow and restrictive interpretation by the ISA of Rule 13.2(i) to the effect that the respective structural scopes of independent product and use claims must be "substantially identical".

- 7.3. To expand on the latter point, the Board is of the opinion that a particular use of a class of compounds on the one hand and, on the other hand, a claim to the said class of compounds per-se or to certain members of the said class of compounds can form a single general inventive concept. The salient point is not identity of the respective structural scopes, but the question whether the compounds

claimed per se (and processes for their manufacture) contribute to the solution of the problem underlying the use invention. In the present instance, where - in the framework of the ISA's only task to carry out a search - the problem and solution are not to be analysed (cf. cited Decision W 03/88, section 8, second paragraph), there prevails the irrefutable presumption that the compounds of Claim 4 (and thus the processes for their manufacture - Claims 6 to 8) do contribute to the solution of the problem underlying the process in which they could be used, i.e. the process of Claim 1. They, therefore, form part of the same general inventive concept in terms of Rule 13 PCT. Accordingly the additional search fees cannot be retained.

- 8. The above finding is also in accordance with the decision of another Board to which the Applicant has correctly drawn this Board's attention, viz. W 07/85 (loc. cit.), even though in that case the legal point concerned here was not so much in the foreground of considerations. The further decision relied on by the Appellant (T 35/87, loc. cit.) is less relevant because it related to substantive examination, to which somewhat different criteria apply.

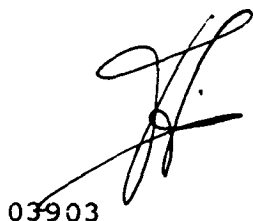
Order

For these reasons, it is decided that:


The reimbursement to the Applicant of the two additional search fees paid is ordered.

The Registrar

The Chairman



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