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Application No.: PCT/JP88/00113
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Title of invention: Self-routing switching system

Classification: H04L 11/20

D E C I S I O N
of 8 August 1991

Applicant: Fujitsu Ltd.

Headword:

EPC PCT Rules 13, 40

Keyword: "Lack of unity "a posteriori" (no)"
"Inadequate reasons (no)"

Headnote



Case Number : W 33/88 - 3.5.1
International Application No. PCT/JP88/00113

D E C I S I O N
of the Technical Board of Appeal 3.5.1
of 8 August 1991

Applicant : FUJITSU LIMITED
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Subject of the 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 May 1988.

Composition of the Board :

Chairman : P.K.J. van den Berg
Members : J. van Voorthuizen
F. Benussi

Summary of Facts and Submissions

I. On 5 February 1988 the applicant filed the international application PCT/JP88/00113 at the JP Patent Office, claiming priorities of 6 February 1987, 18 March 1987, 19 May 1987, 20 May 1987, 15 July 1987, 16 July 1987 and 16 September 1987 based on nine previous JP national applications.

II. On 20 May 1988 the EPO, acting as the competent ISA, addressed to the applicant an invitation to pay five additional search fees as it considered that the requirement of unity of invention was not satisfied. Six groups of claims were distinguished:

- Claims: 1-9; 16-20: A self-routing multipath switching system with a first embodiment of a self-routing switch module
- Claims: 10-15: An optional service module
- Claims: 21,22: A second embodiment of a self-routing switch module
- Claims: 23,24: A third embodiment of a self-routing switch module
- Claims: 25-27: A fourth embodiment of a self-routing switch module
- Claims: 28-29: A fifth embodiment of a self-routing switch module.

To support its finding the ISA cited the article by Feng et al in "6th Annual Symposium on Computer Architecture", April 23-25, 1979, pp. 202-215 (D1).

III. On 28 June 1988 the applicant paid the additional fees under protest. The protest was received at the EPO on 4 July 1988.

- IV. In his protest the applicant essentially argued as follows:

Claim 2 prescribes a particular control method (consisting in the addition of a header to each packet to be transmitted) and claims 3, 21, 23, 25, 28, which all depend from claim 2, prescribe respective examples of switch modules, all of which have a common basic function, i.e. reading the header, so that there is a common invention here. Furthermore claim 3 states a further essential feature of the invention and claims 4-20, which all depend from claim 3, comprise additions and improvements to this feature so that again there is a common invention.

- V. Exercising the power given to it under Article 114(1) EPC the Board on 11 August 1989 addressed a communication to the applicant drawing his attention to the sole document cited in the application as prior art, i.e. Muise et al, Zurich Seminar 1986, pp. 135-139 (D2), and stating as its provisional opinion that the application did not comply with the requirement of unity of invention.

- VI. In his reply to the said communication received on 4 January 1990 the applicant essentially argued as follows:

A combination of the network call setting means of citation D1 with the packet switching system of D2 would not result in the subject-matter of the present application. The basic concept of the present invention lies in coding each received packet in the switching device itself so that it can arrive at the appropriate output port via a self-routing switch.

In item 6 of the aforementioned communication, the Board considers that the call processor of the present application is equivalent to the trunk controller of D2. The applicant disagrees with this view. In the present invention, a plurality of routes exist with respect to one outgoing line and thus it is possible to control the selection of an optimum route according to the state of congestion at each route. Regarding this point, D2 discloses that when one destination is specified, only one route is available which means that the control function of controlling the selection of an optimum route is not necessary nor present in the trunk controller of D2. Accordingly, the applicant also disagrees that the subject-matter of claim 2 lacks novelty or inventive step.

Further, with reference to older decisions such as W 4/85 and W 7/86, a distinction has to be made between applications in which non-unity is relatively obvious and those in which it is not so straightforward. In the latter case, the reasons for considering that the application is non-unitary must be detailed and correct. The applicant considers that the present application belongs to the latter sort of application in which the question of non-unity is not straightforward and that the reasons given for non-unity in the invitation were not adequate.

As argued above, the applicant considers that even a combination of D1 and D2 does not demonstrate non-unity. Therefore, in line with reasons 5 and 6 of the decision W 7/86, the applicant considers that the reasons provided with the invitation to pay an additional fee were unable to establish the non-unity of the present application and therefore, the invitation was issued incorrectly.

VII. On 5 April 1990 the applicant was informed that the proceedings would be suspended until the Enlarged Board had decided on questions of law submitted to it and concerning the responsibility of the ISA in non-unity a posteriori cases.

Reasons for the Decision

1. The protest complies with Rule 40.2(c) and 40.3 PCT and is therefore admissible.
2. The Board will deal first with the applicant's argument that the invitation to pay additional fees was inadequately reasoned and for that reason these fees should be reimbursed, following the decisions in cases W 4/85 and W 7/86.
3. Rule 40.1 PCT prescribes that the reasons why non-unity has been found shall be specified in the invitation. Neither the PCT nor the "Guidelines for International Search to be carried out under the PCT" contain any indication as to how this prescription has to be implemented in practice.
4. The decisions W 4/85 and W 7/86, referred to by the applicant, concern cases in which the "reasons" consisted only in an enumeration of the claim groups between which non-unity was considered to exist. They do therefore, strictly speaking, not apply to the present case. It appears, however, from these two decisions (cf. in particular paragraph 3 of W 4/85) that they lay down as an essential requirement that the reasoning must be such as to permit the applicant and (in case of a protest) the appellate instance to verify whether the invitation was justified i.e. to understand which considerations were decisive for the finding of non-unity.

5. The Board is of the opinion that a sharp distinction should be made between cases in which a reasoning is given in the invitation which after consideration of the technical arguments of the protest is found to be unconvincing as to substance (e.g. because a prior art document has been incorrectly interpreted) and cases in which the reasoning is so enigmatic that it is not possible to understand without undue effort how the search division arrived at its conclusion of non-unity. Only in the latter case should the invitation be regarded as not complying with Rule 40.1 PCT.

6. The principal task of the Board in this matter therefore is to examine carefully in each individual case whether the reasoning contained in the invitation is sufficient when read in conjunction with the application, including the prior art acknowledged therein, to make the finding of non-unity understandable to a skilled person.

7. In the present case the invitation does not include a detailed reasoning comparing the application with the prior art cited in the invitation, thereby explicitly supporting the finding of non-unity. Such a reasoning is not specifically required either by Rule 40.1 PCT or by the Guidelines for International Search, and its necessity clearly depends on the complexity of the case.

8. The search division has cited a single document D1. That this document is relevant can already be surmised by merely comparing Figure 3 of the application with Figure 2 of the document. Moreover it is evident from D1 (cf. its "Abstract") that this document is concerned, like the application, with the provision of independent multiple paths for any pair of source and destination in a switching network. Finally it is clear from the

interdependence of the claims that if claims 2 and 3 were found to be lacking novelty or inventive step, the claims would have to be regrouped substantially as indicated in the invitation. The Board is therefore satisfied that in the present case the reasoning given was sufficient for understanding the finding of non-unity. Indeed the applicant has been able to establish a reasoned protest on the basis of the contents of the invitation.

9. In its communication the Board has made specific reference to D2, which is the sole document cited in the application as representing the state of the art set out in detail in the description. This, however, is a matter of discretion rather than of principle and it cannot be deduced merely from the Board's slightly different approach that the invitation is so deficient that it can reasonably be regarded as violating Rule 40.1 PCT.

10. The objection of lack of unity made by the ISA only arose after a preliminary search had been carried out and was accordingly made "a posteriori", i.e. after taking prior art into consideration. The question of whether the EPO when acting as an ISA is entitled to raise an "a posteriori" lack of unity objection or whether such an objection pre-empts the separate preliminary examination under Chapter II PCT was referred to the Enlarged Board of Appeal of the EPO. In its recent decision G 1/89 of 2 May 1990 (OJ EPO 1991, 155), the Enlarged Board concluded that "a posteriori" objection of lack of unity was allowable since the ISA only formed a provisional opinion on novelty and inventive step for the purpose of carrying out an effective search which did not constitute a substantive examination in the normal sense of that term. The Enlarged Board added that consideration of the requirement of unity of invention should always be made with a view to giving the applicant fair treatment and that the charging of

additional fees under Article 17(3)(a) PCT should be made only in clear cases; restraint should be exercised in the assessment of novelty and inventive step and borderline cases preferably resolved in favour of the applicant.

11. Turning now to the issue of non-unity in the present case, it is clear from the interdependence of the claims that any non-unity could only arise if at least the subject-matter of claim 2 were not novel or did not involve an inventive step.

12. Looking therefore first at claim 2 it is noted that this claim adds three technical features to the subject-matter of claim 1, which interpreted in the light of the description can be summarised as follows:
 - (a) a single call processor for all incoming lines to a switch network is provided,
 - (b) in a first (call setting) phase the call processor selects one out of all possible paths between the incoming line and the outgoing line defined by identification information contained in the incoming call and stores this path in a table,
 - (c) in a further (transfer) phase control information relating to the selected path is read out from the table and in addition circuits added to the incoming call.

13. None of these features is unambiguously disclosed in the prior art acknowledged in the application (even taking into consideration the contents of D2) or in the document D1 cited in the invitation. Bearing in mind the recommendation formulated by the Enlarged Board in its decision in case G 1/89, the Board of Appeal is of the opinion that the present case is not so clear that a finding of non-unity can fairly be considered as justified.

14. Under these circumstances there is no need for the Board to consider the novelty and inventive step of the subject-matter of claim 1.

Order

For these reasons, it is decided that:

Reimbursement of all the additional search fees paid is ordered.

The Registrar:

The Chairman:

M. Beer

P.K.J. van den Berg