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Bezeichnung der Erfindung: Roller electrodes for electric resistance welding
Title of invention: machine
Titre de l'invention :

Klassifikation / Classification / Classement : H01R 39/64

ENTSCHEIDUNG / DECISION
vom / of / du 14 July 1989

Anmelder / Applicant / Demandeur : Soudronic AG

Patentinhaber / Proprietor of the patent /
Titulaire du brevet :

Einsprechender / Opponent / Opposant :

Stichwort / Headword / Référence :

EPU / EPC / CBE Art. 17(3)(a), Rule 13(1), Rule 40(2)(c) PCT

Schlagwort / Keyword / Mot clé : Non-unity "a posteriori" (Yes)

Leitsatz / Headnote / Sommaire

Europäisches
Patentamt

European Patent
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des brevets

Beschwerdekammern

Boards of Appeal

Chambres de recours



Case Number : W 46/88 - 3.5.1
International Application No. EP 88/00413

D E C I S I O N
of the Technical Board of Appeal
of 14 July 1989

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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 8 additional fees) of the European Patent Office (branch at The Hague) dated 14 September 1988.

Composition of the Board :

Chairman : P.K.J. van den Berg
Member : J.A.H. van Voorthuizen
Member : J. Stephens-Ofner

Summary of Facts and Submissions

- I. On 11 May 1988 the Applicant filed the international application PCT/EP/88/00413 with the EPO, claiming priorities of 22 May 1987 and 28 March 1988 based on US national applications.

- II. On 14 September 1988, the EPO, acting as the competent ISA, addressed to the Applicant an invitation to pay eight additional search fees as it considered that the requirement of unity of invention was not satisfied. Nine groups of claims were distinguished:
 1. Claims 1,2-5 : Conductive liquid between stator and rotor + protective coating on rotor surface.

 - 1.bis claims 1,6-8 : Conductive liquid between stator and rotor + cooling system.

 2. Claims 9-18 : Protective coating on rotor surface contacting a conductive liquid.

 3. Claim 19 : Exterior peripheral face of rotor.

 4. Claims 20-23,34: Cooling system.

 5. Claims 24,25 : Rotor and stator composition.

 6. Claims 26-29 : Cooling system and its regulation.

 7. Claims 30-33 : Cooling system + alarm means for overheating.

8. Claims 35-37 : Protective coating on the exterior peripheral rotor.
9. Claims 38-41 : Conductive liquid between stator and rotor + procedure of electrode maintenance including replacement of used conductive liquid.

In its invitation the ISA reasoned that:

The problem underlying the invention stated in the independent Claim 1 is not novel and a solution to it has already been found or does not involve an inventive step having regard to the state of the art as illustrated by DE, A1, 2 805 345.

Therefore, the original single general inventive concept also covering the subject matter(s) of the dependent claim(s) is not acceptable anymore, making it necessary to re-establish the technical relationship or interaction of the very characteristic features stipulated in the dependent claim(s).

This leads to a regrouping under different subjects as listed above, each subject now falling under its own distinct inventive concept, being a technically distinct and independent feature.

- III. On 10 October 1988 the Applicant paid under protest one additional search fee for the invention "1.bis" embracing Claims 1,6-8. The protest was received on 10 October 1988.

IV. In his protest the Applicant essentially argued as follows:

The ISA has made a statement wherein the solution of the problem underlying the invention is indicated as being already found or not involving an inventive step having regard to the state of the art as illustrated by DE, A1, 2 805 345. That means that the ISA has already decided on the merits of the present invention. However, such a decision can only be made by the national or regional Patent Offices in the national or regional examination procedure but not already in the international searching procedure. The objective of the international search is to discover relevant prior art. The determination of whether a claimed invention is new or not new, or whether the claimed invention does or does not involve an inventive step, must not be done by the ISA.

In the present case Claim 1 obviously includes a composition of a conductive liquid falling in the broader range of values indicated in said DE, A1, 2 805 345. However, the values claimed in Claim 1 of the present invention represent a composition which is not an arbitrarily chosen specimen from the prior art but another invention (purposive selection), cf. Decision of the Technical Board of Appeal 3.3.1 dated February 28, 1985, T 198/84, published in Official Journal EPO, 7/1985, p. 209-216.

Further, the claimed invention does not only consist of the composition claimed in Claim 1, but also of the further developments, at least as claimed in Claims 2 to 8, i.e. the combination of the claimed composition of conductive liquid with a special protective coating and/or a cooling system.

Since the subject-matter of Claim 1 involves a novel and inventive step having regard to the state of the art as illustrated by DE, A1, 2 805 345, the dependent Claims 2 to 8 also comply with the requirement of unity of invention. Therefore, it is not necessary "to re-establish the technical relationship or interaction of the very characteristic features stipulated in the dependent claims", namely Claims 2 to 8.

Reasons for the Decision

1. The protest complies with Rule 40.2(c) PCT and is therefore admissible.
2. The Applicant has argued in the first place that the ISA was not entitled to make a decision as to novelty or inventive step of the subject-matter of the application.
3. Article 17(3)(a) PCT states that if the ISA considers that the international application does not comply with the requirement of unity of invention, it shall invite the Applicant to pay additional fees.
4. The requirement of unity of invention is defined in Rule 13.1 PCT as follows: "The international application shall relate to one invention only or to a group of inventions so linked as to form a single general inventive concept". This definition in Chapter I of the PCT, which concerns the international application and the international search, has to be applied also in the international preliminary examination dealt with in Chapter II (cf. Article 34(3)(a) and Rule 68 PCT) and is evidently of a general nature. In the opinion of the Board nothing in the PCT could give rise to the supposition that different

criteria for novelty and inventive step were to be applied for the purposes of the international search and for those of the international preliminary examination.

5. Article 2 of the Agreement between the EPO and WIPO under the PCT, entered into force on 1 January 1988, provides that the EPO in carrying out international search shall be guided by the "Guidelines for International Search", to be carried out under the PCT. These Guidelines (cf. page 16, paragraphs 9 and 10) mention expressis verbis the case of non-unity "a posteriori", i.e. a non-unity which becomes apparent after taking into consideration the prior art.
6. From the cited passage in the Guidelines in conjunction with Article 17(3)(a) and Rule 13.1 PCT the Board can only conclude that the ISA has the power in the course of a search to form an opinion on the issues of novelty and inventive step in order to ascertain that the application under search complies with the requirement of unity. It may thus find then in certain cases that a non-unity "a posteriori" exists.
7. The Applicant's first argument, therefore, cannot lead to a reimbursement of the additional search fee.
8. It remains to be examined whether the present application complies with the requirement of unity as far as the claim groups 1. and 1.bis are concerned, the applicant not having protested the ISA's finding of non-unity for the claim groups 2. to 9.
9. Independent Claim 1 covering these two claim groups reads as follows:

"1. In a roller electrode adapted for use in electric resistance seam welding apparatus to weld overlapped edges

of a metal blank, the roller electrode having stator and rotor components, the rotor and stator components having annular surfaces spaced apart across thin gaps, bearing means for mounting said rotor to rotate relative to said stator with movement via said gaps, and a conductive liquid simultaneously contacting said annular surfaces to electrically conduct a welding current across said gaps between the components, the improvement comprising the combination of said conductive liquid being of a composite eutectic mixture of gallium (Ga), indium (In), tin (Sn) and zinc (Zn), by weight, being substantially 61% Ga, 25% In, 13% Sn, and 1% Zn."

10. DE-A-2 805 345 discloses a roller electrode falling within the terms of Claim 1. The eutectic mixture according to this document consists of 58-64% Ga, 22-28% In, 10-15% Sn, and 0,2-2% Zn by weight. The Board considers that these ranges do not distinguish themselves from the ranges stated in Claim 1 as being substantially 61% Ga, 25% In, 13% Sn and 1% Zn by weight. The Board is unable to see any "purposive selection" here. The roller electrode according to DE-A-2 805 345 is covered with a protective layer consisting of nickel. The wording of Claim 1, however, is so broad as to cover the presence of a protective layer of any composition. Therefore the Claim lacks novelty over DE-A-2 805 345.
11. As a consequence no single general inventive concept is present linking claim groups 1. and 1.bis. The invitation by the ISA to pay an additional search fee for group 1.bis was therefore correctly issued and the protest is unjustified.

Order

For these reasons, it is decided that:

The protest is unjustified and no reimbursement of the additional search fee is ordered.

The Registrar:

The Chairman:

F. Klein

P.K.J. van den Berg