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Bezeichnung der Erfindung:
Title of invention:
Titre de l'invention : New perfluoroalkenes and fluorination products thereof

Klassifikation / Classification / Classement : C 07 C 21/18

ENTSCHEIDUNG / DECISION

vom / of / du 11 April 1989

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

Patentinhaber / Proprietor of the patent /
Titulaire du brevet :

Einsprechender / Opponent / Opposant :

Stichwort / Headword / Référence :

EPÜ / EPC / CBE PCT Art. 17, Rules 13, 40

Schlagwort / Keyword / Mot clé : "Unity of Invention - the possibilities of R. 13.2 are not exhaustive; intermediate and process for obtaining it are cognate with end product, its preparation and use"

Leitsatz / Headnote / Sommaire

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Case Number : W 03 - 89 - 3.3.1
International Application No. PCT/EP 88/00768

D E C I S I O N
of the Technical Board of Appeal
of 11 April 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 additional fee) of the European Patent Office (branch at The Hague) dated 07 October 1988.

Composition of the Board :

Chairman : K. Jahn
Member : F. Antony
Member : J. Stephens-Ofner

Summary of Facts and Submissions

I. On 26 August 1988, the Applicant filed International patent application PCT/EP 88/00768 with the European Patent Office.

II. On 7 October 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, within 30 days from the date thereof, an additional search fee 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 PCT. In particular, it was stated

(i) that the combination of categories of independent claims did not belong to any of those mentioned in Rule 13.2 PCT;

(ii) that the subjects defined by the problems and their means of solution as listed did not present a sufficient technical relationship or interaction so as to form a general inventive concept, the subjects listed being

Invention 1 - Claims 1 and 2, covering certain monomers and their preparation, and

Invention 2 - Claims 3 to 5, covering an initiator, its preparation and its use;

(iii) the said use was not restricted to the monomers in Invention 1.

III. On 4 November 1988, the Applicant paid the additional search fee under protest (Rule 40.2(c) PCT) and asserted

that all claims as filed complied with the unity requirements. While it was true that use Claim 5 was not limited to the monomers claimed in Claim 1, these could be used as starting materials in the process of Claim 4, thus both subjects were sufficiently related to establish unity.

Reasons for the Decision

1. Pursuant to Art. 154(3) EPC, the Boards of Appeal of the EPO are responsible for deciding on protests raised by Applicants against additional search fees charged by the EPO under Art. 17(3)(a) PCT.

2. The protest complies with Rule 40.2(c) PCT. Although the reasoning of the protest, as far as it goes beyond mere unsubstantiated assertions (last five lines), is extremely short if not rudimentary, it is in the present case, where the facts are quite clear to the Board, considered sufficient for the purpose of admissibility of the protest. The protest is admissible.

3. According to Rule 40.1 PCT, the Invitation to pay additional fees provided for in Art. 17(3)(a) PCT shall, inter alia, specify the reasons for which the application is not considered to comply with the requirements of unity of invention.

3.1. In the present case, the ISA has based all its reasoning on the three statements referred to in section II hereinabove.

3.1.1 Statement (ii), as far as it exceeds the list of subjects contained therein (Inventions 1 and 2), is a mere assertion in no way supported by reasons, and as such cannot contribute to the reasoning of the Invitation; as far as

the said list itself is concerned, this case is not so exceptionally simple for such list alone to suffice (cf. section 4 of the decision "Lithiumsalze/Mückter", OJ EPO 1987, 67).

3.1.2 Statement (iii) is likewise irrelevant, because it cannot be understood why absence of a restriction as indicated should have any bearing on the question of unity of invention.

3.1.3 On the other hand, statement (i) can be accepted as a bona fide attempt to specify reasons within the meaning of Rule 40.1 PCT, which is therefore met to a sufficient extent for the Invitation to be legally effective.

4. However, it is quite clear from the wording of Rule 13.2 PCT "that the list of possible circumstances in which there is unity of invention between claims of different categories (there set out in sub-paragraphs (i) to (iii)) is in no way excluding the possibility of other circumstances where there is unity of invention between claims of different categories" (section 11 of decision W 03/88 of 8 November 1988; to be published in the Official Journal). Accordingly, statement (i) is not sufficient to justify the ISA's finding of lacking unity. The additional fee cannot therefore be retained.

5. The Board consider it appropriate to add, leaving aside the insufficient reasoning of the ISA, that and why they consider unity of invention indeed to be given.

5.1. In the Board's judgement - obviously shared by the ISA's - it is quite clear that the subject-matters of Claim 4 (relating to a fluorination process), of Claim 3 (relating to a compound obtainable by such process), and of Claim 5 (relating to a polymerisation process in which products of said fluorination process are used as initiators) together

form a single general inventive concept within the meaning of Rule 13 PCT.

5.2. Claim 1 relates to chemical intermediates which serve as starting compounds for the fluorination process of Claim 4 and thereby have a share - on the basis of their important contribution to the structure of the fluorinated products - in solving the problem underlying the invention, i.e. to provide novel compounds suitable as polymerisation initiators. The subject-matter of Claim 1, therefore, falls under the same general inventive concept as that of Claims 3 to 5.

5.3. Claim 2 relates to a process by which the intermediates of Claim 1 can be obtained. If the said intermediates per se contribute to solving the problem underlying the invention (see sub-section 4.2), so does clearly also a process for preparing such intermediates. Besides, under a more practical viewpoint, a search directed towards the said intermediates will necessarily reveal all prior art relative to processes for their preparation; thus also equity speaks against requiring an extra search fee.

Order

For these reasons, it is decided that:

Refund of the additional fee paid is ordered.

The Registrar: The Chairman:

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