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File Number: W 17/89

Application No.: PCT/GB 89/00181

Publication No.:

Title of invention: Apparatus including a compressor

Classification: F04B 39/12; B65 D85/68

D E C I S I O N
of 2 March 1991

Applicant: Network Electronic Industries Limited

Headword:

EPC PCT Article 17, Rule 13

Keyword: "Lack of unity (no)"

Headnote



Case Number : W 17/89
International Application No PCT/GB 89/00181

D E C I S I O N
of the Technical Board of Appeal
of 4 March 1991

Appellant : Network Electronic Industries Limited
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Representative : Shaw Lawrence
George House
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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

Composition of the Board :

Chairman : C. Szabo
Members : J. du Pouget de Nadaillac
J. van Moer

Summary of Facts and Submissions

- I. On 16 February 1989, the Applicant filed International patent application PCT/GB 89/00181.
- II. On 31 May 1989, the European Patent Office as competent International Search Authority (ISA) issued an invitation to pay one additional fee as it was considered that the requirement of unity of invention was not satisfied.

Two inventions were identified:

- Claims 1-3: Mounting of a compressor within a sealed housing;
- Claims 4-8: Method of packing a plurality of refrigeration apparatus into a container and bulk or shipping container therefor.

As reasons given for these findings, it was stated that the subjects, defined by the problems and their means of solution, as listed above are so different from each other that no technical relationship or interaction can be appreciated to be present so as to form a single general inventive concept.

- III. The Applicant paid the additional search fee under protest pursuant to Rule 40.2(c) PCT and requested a full refund of this fee because in his opinion all the Claims 1-8 relate to the same inventive concept, namely the problem of transporting a refrigerator including a compressor on its side without damage, and moreover the Claims 4-8 are all dependent on Claim 1, since they require the presence of all the means given in this claim.

Reasons for the Decision

1. The protest complies with Rule 40.2(c) PCT and is therefore admissible.

2. From the reasons given by the ISA, i.e. the two listed invention groups and the reason that they have no technical relationship, it appears that the objection of the ISA is not based on the lack of inventiveness of a common concept, but on the absence of any common concept. The primary issue to be decided is therefore whether such a common concept between the apparently independent Claims 1 (product), 2 (method), 6 (container) and 8 (shipping container) exists or not.

3. Claim 1 of the present case does not relate to the mounting of compressor within a sealed housing as stated, but to an apparatus comprising not only the compressor within said housing, but also an evaporator and a reservoir of refrigerant fluid. When establishing the list of the claimed subject-matters or different inventions, it is not correct to leave out some features from a claim since by doing so the subject-matter of the claim can be distorted or partly ignored. The combination of the above-mentioned components clearly shows that, in fact, the subject-matter of Claim 1 is a refrigeration apparatus, such as a refrigerator, freezer or the like. Thus a certain link exists undoubtedly with the second invention, as defined by the ISA, which concerns a method of packing exactly such refrigeration apparatuses into a container or the like.

Moreover, the Claims 4-8 of the second group of inventions each contain an unambiguous reference to Claim 1 so that all the features of the latter are to be found in these claims. A second, and, this time, absolute structural link is thereby provided.

4. Furthermore, the description of the present application discloses that the object of the invention is "to provide an apparatus including a compressor..., wherein restraining means are arranged to restrain the compressor against excessive movement likely to damage the apparatus when the apparatus is laid on one side for transport or the like" Thus a third link, the common effects of the internal structure of the apparatus on package and namely the protective transport thereof, is clearly given.

5. The wording of the method Claim 4 makes it clear that the use of the improvement according to Claims 1-3 is for transporting several refrigerators or the like on their side within a container, while avoiding damage to the compressors of said apparatuses. Claim 4 is, therefore, a use claim for articles according to Claims 1-3. Pursuant to Rule 13.2(i) PCT such claims qualify for unity. This is not the case where the method claim, here the use claim, is not co-extensive with the independent product claim, in other words it is broader, which implies a different inventive concept, since it covers the use of unclaimed, i.e. non-inventive products, or of products with a different inventive concept than the one of the independent product claim.

Since Claim 4 is properly limited in scope to the use of the products defined in Claims 1-3, there can be no doubt about unity in respect of Claim 4 and its dependent Claim 5.

6. Claim 6, which refers to a container containing the apparatus according to Claim 1 or 2, is, in fact, the result of the method Claim 4. It represents, moreover, a combination with the product of Claim 1 and no difference in scope can be seen between an apparatus, characterised by

being part of the content of a container, and the container containing such an apparatus.

The same applies to Claim 8, which also concerns a container transporting an apparatus having all the features mentioned in Claim 1. All claims in the case incorporate the apparatus of Claim 1. Thus a single concept is provided.

7. Once such a single, i.e. common concept, is established, it is necessary to consider whether or not the same could contribute to the inventiveness of the various subject-matters claimed in the case. Nothing indicates that this concept is known or belongs to the general knowledge of the man skilled in the art, and since the search examiner has not indicated that the the documents cited in the case could exclude such a contribution, it cannot be assumed that this cannot be the case (cf. W 6/90, 19 December 1990, to be published). In view of this, a single inventive concept must be attributed to all claims linking all their subject-matters. The protest is therefore justified.

8. In view of the above, it appears to be clear that the enumeration of the two different inventions, wrongly defined, followed by a mere allegation of substantial difference, was quite insufficient to explain the objection of the ISA, and amounts to a lack of proper reasoning. Therefore the invitation to pay an additional search fee made by the ISA according to Article 17(3)(a) PCT does not meet the requirement of Rule 40.1 PCT either.

Order

For these reasons, it is decided that:

Reimbursement of the additional fee to the applicant is ordered.

The Registrar

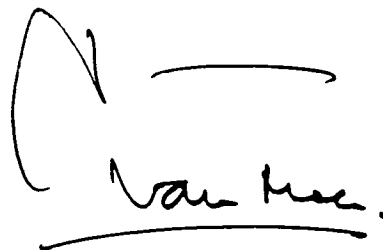
The Chairman



S. Fabiani



G. Szabo



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