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File Number: W 38/90 - 322  
Application No.: PCT/GB 90/00259  
Publication No.:  
Title of invention: Viewing assembly

Classification: E 06 B 7/30

DECISION  
of 13 March 1991

Applicant: Associated Western Limited

Headword:

EPC PCT Article 17(3)a, Rules 13.1 and 40.2(c)

Keyword: "Unity a priori (no)"

Headnote



Case Number : W 38 / 90 - 322  
International Application No PCT/GB 90/00259

**D E C I S I O N**  
of the Technical Board of Appeal  
of 13 March 1991

**Applicant :** Associated Western limited  
Dunraven Street, Industrial Estate  
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**Representative :** Bull, Michael Alan, et al.  
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**Subject of 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 12 July 1990

**Composition of the Board :**

**Chairman :** G. Szabo  
**Member :** M. Noel  
**Member :** F. Benussi

## Summary of facts and submissions

- I. International patent application PCT/GB 90/00259 was filed on 16 February 1990.
- II. The EPO, acting as International Search Authority (ISA), sent the Applicant an invitation to pay four additional search fees in accordance with Article 17(3)(a) and Rule 40.1 PCT.

The ISA indicated that the subject-matter claimed related to five inventions set out as follows:

1. Claim 1 : refers to a longitudinally extending portion of an inner retaining means in a viewing assembly.
2. Claims 2, 3 : refer to details of a viewing slot on the inner flap of a viewing assembly.
3. Claim 4 : refers to construction details of a transparent material as well as of the inner flap of a viewing assembly.
4. Claims 5, 6 : refer to the assembling procedure of a viewing assembly.
5. Claim 7 : refers to details of the construction of a glass (or transparent material) retaining frame of a viewing assembly.

The reasoning of the ISA was that

- (i) the subjects, defined by the problems and their means of solution, as listed above were so different from each other than no technical relationship or

interaction could be appreciated to be present so as to form a single general inventive concept.

(ii) Because the formulation "viewing assembly" was very broad (included also windows), objection of lack of unity did arise.

If a more constraint formulation had been given, e.g. "peep-hole", objection of lack of unity would not normally have arisen.

III. Within the prescribed time-limit, the Applicant paid two additional search fees, under protest, in accordance with Rule 40.2(c) PCT and requested that the fees be applied to claims 2-3 and claim 4.

The Applicant argued that the subject-matter of the inventions defined in claims 1, 2 and 4 was so close that a single search was sufficient to locate prior art documents relevant to any of those inventions. All of these claims related to the design of a retaining means, or a flap, or a plate, mounted on the inner side of a viewing assembly. The term "viewing assembly" was indeed broad, but this only meant that the single search which was necessary had to be made in respect of all viewing assemblies.

#### Reasons for the Decision

1. The protest is admissible.
2. The Board's understanding of Rule 40.2(c) PCT is that its responsibility in examining protests is limited to deciding whether the protest is justified in respect of the additional fees actually paid under protest. This means that only the independent claims 1, 2 and 4 will be considered in the following.

### 3. Unity

- 3.1 The present application relates to a viewing assembly to be inserted into a door to allow a person within a room to see people at the door, according to the embodiment of Figures 1 to 4B. Figure 5 refers only to an alternative inner retaining means of the viewing assembly.

With respect to the prior art discussed therein (pages 1 to 3), which presents a number of disadvantages, a plurality of specific problems to be solved are defined, the solutions of which are given in the respective independent claims, in particular in claims 1, 2 and 4.

As to the first disadvantage of the prior art (page 1, lines 15-18), the image seen through the glass and that seen reflected in the mirror surface, are directly adjacent. According to Claim 1 of the application which represents a first concept, this specific problem is overcome in that the two images seen through the glass 1 and reflected by the mirror surface 23, respectively, are separated by a longitudinally extending portion (bar 33).

As to the second disadvantage of the prior art (page 2, lines 5-7), the slit does not provide the user with a field of vision which extends very far in a vertical direction. According to Claim 2 of the application which represents a second concept, this specific problem is overcome in that the pivotably mounted flap 50 has a viewing slot 53 and, adjacent thereto, a protrusion 52.

As to the third disadvantage of the prior art (page 2, lines 30-33 and page 3, lines 3-7), the light from the room falling onto the inner surface of the glass is too high with respect to the light coming from the outside. According to Claim 4 of the application which represents a third concept, this specific problem is overcome in that the assembly is provided with a plate 40 having an

aperture 42, the area of which is less than the surface area of the glass 1.

Since the three aforementioned concepts have nothing relevant in common, i.e. the subject-matter of the respective claims 1, 2 and 4 refer to different specific technical features without any relationship with respect to each other and aim to solve independent specific problems, no single general concept linking the different inventions can be seen, as was rightly observed by the ISA under point II(i). This means that no single and possibly inventive common feature group is provided, and thereby no unity "a priori" between the claims exists.

3.2 The sole common link between the subject-matter of claims 1, 2 and 4 is that the respective features all contribute to the realisation of the same device: a viewing assembly for a door.

This common pre-characterising feature is confined to indicate the designation of the invention, as part of the prior art; it is not, however, a specific feature interacting with the remaining characterising features and thereby contributing to the various inventions and their effects. Therefore, this sole link has to be rejected as irrelevant for possible contribution to inventively. As already concluded, in the absence of any kind of common relevant feature, no unity "a priori", can be recognised in the present case.

3.3 The Appellant's assertion under point III is not convincing either. By the use of the conjunction "or" to specify the various claimed subject-matters he indicates clearly that the claims in suit relate to optional and independent elements of the assembly, with different functions.

- 3.4 The Board does not follow the view of the ISA under II(ii) either, since the viewing assembly is clearly confined in the claims as to be used for doors, namely for peephole devices. Therefore, there was no good reason for possibly extending the search to other fields such as windows, in separate classification units. Consequently this objection was not founded.
- 3.5 In any case, for the other preceding reasons the Board comes to the conclusion that the subject-matter of claims 1, 2 and 4 relate to the plurality of inventions which are not so linked so as to form a single general inventive concept according to the requirements of Rule 13.1 PCT. As a consequence they are lacking in unity.

#### Order

For these reasons, it is decided that:

Refund of the additional fees is refused.

The Registrar:

The Chairman:



S. Fabiani



G. Szabo

17. Nov. 18. 6. 91

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