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File Number: W 54/91 - 3.2.1

Application No.: PCT/US 91/03 357

Publication No.:

Title of invention: Internal pipe inspection system

Classification: F16L 55/18, F16L 55/26

DECISION
of 28 January 1992

Applicant: Niagara Mohawk Power Corporation

Headword:

EPC PCT Rules 13.1 and 13.4

Keyword: "Lack of unity "a priori" (no)"

Headnote



Case Number : W 54/91 - 3.2.1
International Application No. PCT/US 91/03 357

D E C I S I O N
of the Technical Board of Appeal 3.2.1
of 28 January 1992

Applicant : Niagara Mohawk Power Corporation
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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 fees) of
the European Patent Office (branch at The Hague)
dated 25 September 1991.

Composition of the Board :

Chairman : F. Gumbel
Members : S. Crane
M. Schar

Summary of Facts and Submissions

- I. International patent application PCT/US 91/03 357 was filed on 14 May 1991 at the United States Patent Office.

- II. On 25 September 1991 the EPO, as competent International Searching Authority (ISA), issued an invitation pursuant to Article 17(3)(a) and 40.1 PCT to pay within 45 days two additional search fees.

This invitation was accompanied by the following reasoning:

The application concerned three different subjects:

- 1. Centering of inspection/repair head by use of spring biased pivoting legs (Claims 1-7, 10-18, 21, 24-27, 31, 32, 34, 39, 40, 42, 43).

- 2. Centering of inspection/repair head by use of a plurality of bendable bristles (Claim 20).

- 3. Inspection apparatus insertable into a pipeline with viewing means, storage drum and control unit (Claims 8-9, 19, 22, 23, 28-30, 33, 35-38, 41).

In spite of the formal relationship present between independent and dependent claims the subjects, defined by the problems and their means of solution, as listed above were so different from each other that no technical relationship or interaction could be appreciated to be present so as to form a single general inventive concept.

- III. With a letter received on 9 November 1991 the Applicants paid one further search fee, for the third of the subjects identified above, under protest.

They argued that the single inventive concept on which the application was based was the use of an inspection/repair head for pipelines which was so designed as to be insertable into the pipeline through an opening smaller than the internal diameter of the pipeline, in particular through a lateral customer service line. All of the independent claims of the application included this feature. Furthermore, it was not clear how claims dependent from one independent claim could be grouped as belonging to the subject of other independent claims. This confusion showed that the single inventive concept underlying the application had not been properly recognised.

Reasons for the Decision

1. The protest conforms with the formal requirements of Rules 40.2 and 40.3 PCT and is accordingly admissible.

2. The application is concerned in general with the inspection and repair of pipelines, in particular of gas mains, and proposes the use of an inspection/repair head that can be inserted into and removed from the pipeline through a lateral opening of diameter smaller than the internal diameter of the pipeline. Especially envisaged as a suitable lateral opening is a standard customer service opening. Thus, the inspection/repair head can be used in the pipeline without the need for interruption of service.

The application describes several embodiments of inspection/repair heads meeting the above requirements and details preferred arrangements for centering the head in the pipeline, driving the head through the pipeline by means of a flexible snake, and connecting viewing and

illumination means on the head to a monitoring station outside the pipeline.

The application comprises five independent Claims 1, 16, 20, 21 and 35 with Claims 2 to 15 being dependent directly or indirectly on Claim 1, Claims 17 to 19 on Claim 16, Claims 22 to 34 on Claim 21 and Claims 36 to 43 on Claim 35.

Independent Claims 1, 16 and 20 relate to a pipeline inspection/repair head per se whereas Claims 21 and 35 relate to apparatus comprising such a head in combination with a flexible snake.

3. Since in the reasoning accompanying the invitation to pay further search fees there is no mention of any relevant state of the art it is apparent that an objection of lack of unity "a priori" is being made.

In other words, the ISA was of the opinion, having regard to what is indicated as background prior art in the description of the application, that the subject-matter of the claims was not linked so as to form a single inventive concept (Rule 13.1 PCT).

Leaving aside Claim 20, for which no further search fee was paid and which therefore need not be considered, the Board can see no justification for the objection made by the ISA.

It is apparent from the introductory description of the application that prior art pipeline inspection/repair apparatus which required the taking out of service of the pipeline was seen as disadvantageous and that this disadvantage was to be overcome in accordance with the invention by using a pipeline inspection/repair head which

could be inserted into the pipeline through an opening of diameter smaller than that of the pipeline, in particular a lateral service opening. This essential characteristic of the inspection/repair head is stated in each of the independent Claims 1, 16, 21 and 35 and is to be seen as the single inventive concept required by Rule 13.1 PCT. It is true that in Claims 1, 16 and 21 specific means are defined whereby the insertion of the inspection/repair head in the manner mentioned is enabled whereas in Claim 35 the insertability of the head is merely stated as a requirement. This distinction cannot however justify an "a priori" objection to lack of unity with respect to the subject-matter of these claims.

4. The Board shares to some extent the confusion of the Applicants concerning the grouping together by the ISA of claims dependent from independent Claim 35 with independent Claims 1, 16 and 21 as relating to a different subject from Claim 35 itself. The same applies to the grouping of claims dependent on Claims 1, 16 and 21 with the subject of Claim 35.

In all cases each of these dependent claims relates to a specific form of the invention defined in the respective independent claim. The special conditions prevailing in the cases considered in W 3/87 and W 2/88, both unpublished, where it was found that having regard to the wording of Rule 13.4 PCT lack of unity could exist "a priori" between a dependent claim and an independent claim, clearly do not apply here.

5. In summary, therefore, the Board comes to the conclusion that all of the claims of the application listed by the ISA as belonging to subjects 1 and 3, see Point II above, relate to a single invention.

It follows that the invitation to pay a further search fee for subject 3 was not justified.


Order

For these reasons, it is decided that:

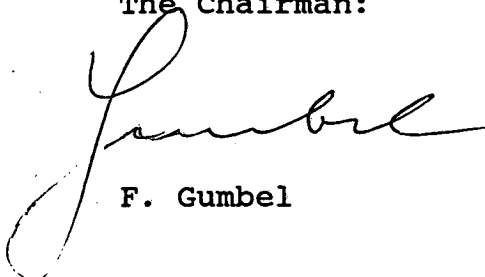
Reimbursement of the further search fee paid is ordered.

The Registrar:

The Chairman:



S. Fabiani



F. Gumbel

Flowen