

BESCHWERDEKAMMERN  
DES EUROPÄISCHEN  
PATENTAMTS

BOARDS OF APPEAL OF  
THE EUROPEAN PATENT  
OFFICE

CHAMBRES DE RECOURS  
DE L'OFFICE EUROPEEN  
DES BREVETS

A		B		C	X
---	--	---	--	---	---

File No.: W 0029/92 - 3.2.2

Application No.: PCT/US 91/08316

Publication No.:

Classification: A61M 1/36, B01D 3/14, B01D 39/16, A61M 1/34,  
B01D 71/00

Title of invention: System and Method for Processing Biological Fluids

**D E C I S I O N**  
of 19 October 1993

Applicant: Pall Corporation

Headword:

**EPC:** PCT 17(3) (a), PCT Rules 13 and 40

**Keyword:** "Lack of unity (no); inadequate reasons" - "Unity of invention  
acknowledged to the extent requested in the protest"

**Headnote**  
**Catchwords**



**Europäisches  
Patentamt**

**European  
Patent Office**

**Office européen  
des brevets**

Beschwerdekammern

Boards of Appeal

Chambres de recours

**Case Number:** W 0029/92 - 3.2.2

**D E C I S I O N**  
**of the Technical Board of Appeal 3.2.2**  
**of 19 October 1993**

**Appellant:** Pall Corporation  
30 Sea Cliff Avenue  
Glen Cove, New York 11542 (US)

**Representative:** Bundren, William J.  
LEYDIG, VOIT & MAYER  
700 Thirteenth Street, NW  
Suite 300  
Washington, D.C. 20005 (US)

**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 13 May 1992.

**Composition of the Board:**

**Chairman:** G. Szabo  
**Members:** J. Kollár  
J. Van Moer

## Summary of Facts and Submissions

- I. The Applicant filed international patent application PCT/US 91/08316 on 6 November 1991. The application contained 107 claims.
- II. On 13 May 1992 the EPO, acting as International Search Authority (ISA), issued to the Applicant an invitation to pay three additional search fees in accordance with Article 17(3)(a) and Rule 40.1 PCT.

The ISA considered that the application did not comply with the requirement of unity of invention as set forth in Rule 13 PCT. It indicated that the subject-matter of the application related to four inventions claimed in the following four groups of claims:

1. Claims: 1, 5-7, 10-19, 21-25, 31, 35-44, 46-57, 59-62, 64, 67, 70, 73, 77, 78, 85-90, 91-93, 95-98, 103, 106, 107: A biological fluid processing system and method with two flow paths having a porous medium in back of them.
2. Claims: 2, 3, 9, 20, 26-30, 32, 33, 66, 67, 69, 70, 72, 74-76: A blood collection and processing system and method using a centrifuge, a container which fits in a bucket, and a bracket to receive a filter.
3. Claims: 4, 8, 34, 45, 58, 63, 65, 68, 71: A blood collection and processing system and method with a leucocyte deflection medium

.../...

in the red cell flow path between two containers.

4. Claims: 79-84, 94, 99-101, 102, 104, 105: A biological fluid processing system comprising a red cell barrier in a flow path between two containers.

The ISA further considered that the following different problems arising during transfer of the components of centrifugated blood from a first container were solved in the application:

- A. Depletion of leucocytes from the supernatant layer by passing it through an (appropriate) filter during transfer to a second container.
- B. Depletion of leucocytes from the sediment layer by passing it through an (appropriate) filter during transfer to a third container. (see **no. 3** of list of inventions.)
- C. Blocking the passage of red blood cells at the end of the supernatant-layer-transfer using a red cell barrier. (see **no. 4** of list of inventions.)
- D. The problem of the forces acting on a filter linked to a blood container during centrifuging. (see **no. 2** of list of inventions.)

The ISA held that the first invention combined the solutions for the problems A, B or C.

The combination of categories of independent claims of this application was regarded by the ISA to relate to subject-matters which did not present a sufficient

.../...

technical relationship or interaction so as to form a single general inventive concept.

- III. The Applicant paid the additional fees under protest pursuant to Rule 40.2(c) PCT. In support of the protest the Applicant submitted in essence that the claims in Groups 1, 3 and 4 presented a sufficient technical relationship or interaction since they all related to the single general inventive concept of a biological fluid (e.g. blood) processing system which included a flow path and a porous medium in the flow path.

Relying on the above submissions, the Applicant requested partial reimbursement of the appropriate fees.

#### **Reasons for the Decision**

1. The protest complies with the requirements of Rules 40.2 and 40.3 PCT and is accordingly admissible.
2. In accordance with Rule 40.1 PCT, the invitation provided for in Article 17(3)(a) PCT to pay additional fees must specify the reasons for which the international application is not considered as complying with the requirement of unity of invention. It is established jurisprudence of the Board of Appeal (see W 4/85, OJ EPO 2/1987, pages 63 to 66, and W 7/86, OJ EPO 2/1987, pages 67 to 69) that, in the absence of adequate reasoning, such an invitation cannot be regarded as legally effective. In the first of the above-mentioned decisions it was held, moreover, that in straightforward cases all that may be necessary to substantiate lack of unity is a list of the claimed subject-matters, particularly when the list makes in

.../...

itself **perfectly clear** that the application does not relate to a single general inventive concept within the meaning of Rule 13.1 PCT.

3. The present application includes a large number of independent claims, of which according to the search examiner Claims 1, 5 to 7, 85, 91, 92, 95, 97, 98 and 103 relate to the first invention whilst Claims 4, 8 and Claims 79, 94, 99, 102 relate to the third and fourth invention, respectively.

All these claims relate to inventions concerned with biological fluid (blood) processing systems and methods which include a flow path and a porous medium in the path. These common features in the claims can be interpreted as representing a "sole concept" linking the various subject-matters. The remaining question is whether or not any of these specific features or their combination can make a contribution to the inventive steps relating to each claimed subject-matter (cf. W 6/90, OJ EPO 8/1991, 438 to 445). This would render the concept also "inventive" in the context (cf. also new Rule 13 PCT which requires such contribution by the suggested common "special technical features" over the prior art, i.e. not just providing bare novelty).

4. However, the ISA has given no reason for its conclusions about dis-unity, i.e. why the common features must all, *a priori*, be denied the possibility of making any contribution to the inventive steps later on when this is examined in the substantive examination. Without being in the position to exclude the possibility clearly in the light of common general knowledge and the character of the features, unity cannot yet be denied for the cases linked by the concept.

.../...

5. Accordingly, it follows from the above comments that the present application is not a straightforward case where a mere listing of claimed subject-matters and problems to be solved suffices to show lack of unity.
6. Consequently, the invitation to pay the two additional fees for the claim groups 3 and 4 does not meet the requirements of Rule 40.1 PCT that the reasons be specified and the two fees must be reimbursed in accordance with Rule 40.2(c) PCT.

**Order**

**For these reasons, it is decided that:**

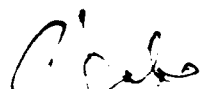
Reimbursement of two of the additional search fees to the Applicant is ordered.

The Registrar:



S. Fabiani

The Chairman:

  
G. Szabo