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File No.: W 0034/92 - 3.2.2
Application No.: PCT/GB91/02028
Publication No.:
Classification: B29C 47/68, B29C 47/92, B29C 47/58
Title of invention: Filtering Method and Apparatus

D E C I S I O N
of 23 November 1993

Applicant: Process Developments Ltd.
Proprietor of the patent: -
Opponent: -

Headword:

PCT Art. 17(3)(a)
PCT Rules 13, 40

Keyword: "Lack of unity (no) - inadequate reasons"

Headnote
Catchwords



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Boards of Appeal

Chambres de recours

Case Number: W 0034/92 - 3.2.2
International Application No. PCT/GB 91/02028

D E C I S I O N
of the Technical Board of Appeal 3.2.2
of 23 November 1993

Applicant: Process Developments Ltd.

Representative: Butler, Michael John
Frank B. Dehn & Co
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Subject of the Decision: Protest according to Rule 40.2(c) of the Patent Cooperation Treaty made by the applicant against the invitation (payment of additional fee) of the European Patent Office (branch at The Hague) dated 4 March 1992.

Composition of the Board:

Chairman: G.Szabo
Members: J. Kollár
J. van Moer

Summary of Facts and Submissions

- I. The appellant filed International patent application PCT/GB 91/02028 on 18 November 1991.

The application contained 68 claims.

- II. On 4 March 1992 the EPO, acting as International Search Authority (ISA), issued to the applicant an invitation to pay two 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 application related to three inventions claimed in the following three groups of claims:

1. Claims 1 to 4, 8 to 11, 37 to 39, 65, 67, 68:

Apparatus and process for filtering flowable substances using flow control means.

2. Claims 5 to 7, 12 to 20, 22 to 28, 30 to 36, 40 to 46, 48 to 64, 66:

Devices for flow control, using sealing plugs.

3. Claims 21, 29, 47:

Hydraulic intensifier.

The ISA further specified the subject-matter of the afore-mentioned three groups of claims in paragraphs 1) to 5) of the invitation. According to paragraph 3) of that invitation there is **a possible** "lack of unity a

posteriori" because having found Claims 1, 38 39, the kind of flow control means do not effect the scope disclosed in claims cited under group 1. above.

III. The applicant paid under protest a single additional search fee concerning a further search of the second invention as specified in group 2 of the invitation issued by the ISA. In support of his protest the applicant substantially submitted that the subject-matter of the second invention was closely related to the subject-matter of the invention according to the first set of claims specified in group 1 of the ISA invitation and that many of claims relating to the second alleged invention were dependent on the first group of claims.

Relying on the above submissions, the applicant requested reimbursement of the appropriate fee.

Reasons for the decision

1. According to Rule 40.2 (c) PCT, the applicant may pay the additional fees under protest, "that is, accompanied by a reasoned statement to the effect that the international application complies with the requirement of unity of invention or that the amount of the required additional fee is excessive".
2. In the present case, a payment of a single additional fee has been made by the applicant as concerned claim group 2 as identified by the ISA.
3. 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 the established jurisprudence of the Board of Appeal (see 04/85, OJ EPO 2/ 1987, pages 63 to 66, and W 07/86, 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 simple general inventive concept within the meaning of Rule 13.1 PCT.

4. The present application includes a total of seven independent claims, of which according to the search examines Claims 1, 38 and 39 relate to the first group of inventions whilst Claims 40, 41, 42 and 55 relate to the second group. Of the claims of the alleged first group, Claim 1 relates to an apparatus for filtering a flowable substance, whilst Claims 38 and 39 claim a process for filtering a flowable substance. Claims 40 and 41 of the alleged second group are also concerned with a process for filtering a flowable material, whilst Claim 42 claims an apparatus for filtering fluid polymeric substance and Claim 55 relates to flow control means for controlling a flow of fluid through a conduit. All these claims include means for selectively permitting or restricting a flow of the substance from a source thereof through a conduit or through a side passage of said conduit. 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).

5. 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.

6. Accordingly, it follows from the above comments that in the Board's opinion the present application is not a straightforward case where a mere listing of the separate groups of claimed subject-matter suffices to show lack of unity. Consequently, the invitation to pay additional fees does not meet the requirement of Rule 40.1 PCT that the reasons be specified and the fee must be reimbursed in accordance with Rule 40(2)(c) PCT.

7. It is observed that since the objection of lack of unity of invention was raised *a priori* no examination of the merits of the claimed subject-matter in comparison with the state of the art has been carried out. Therefore, the Board takes the view that the statement of the ISA in paragraph 3.) of the invitation according to which there is a **possible** "lack of unity *a posteriori*" constitutes only an unsupported allegation without any legal effect.

Order

For these reasons, it is decided that:

Refund of the additional search fee is ordered.

The Registrar:



S. Fabiani

The Chairman:


G. Szabo