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File No.: W 0038/92 - 3.2.2
Application No.: PCT/CA92/00063
Publication No.: -
Classification: C23F 1/02, C23F 1/08, B65D 81/34, B32B 3/10
Title of invention: Novel Demetallizing Procedure

D E C I S I O N
of 22 October 1993

Applicant: Beckett Industries Inc.
Proprietor of the patent: -
Opponent: -

Headword: -

PCT: Art. 17(3)(a)
R. 13, 40

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

Headnote
Catchwords



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Boards of Appeal

Chambres de recours

Case Number: W 0038/92 - 3.2.2
International Application No. PCT/CA92/00063

D E C I S I O N
of the Technical Board of Appeal 3.2.2
of 22 October 1993

Applicant: Beckett Industries Inc.
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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 5 June 1992.

Composition of the Board:

Chairman: G. Szabo
Members: J. Kollár
G. Davies

Summary of Facts and Submissions

I. The Applicant filed International patent application PCT/CA92/00063 on 13 February 1992. The application contained 57 claims.

II. On 5 June 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 1-10: Repeatedly etching (method)
2. Claims 11-40: Method and apparatus for continuously etching
3. Claims 41-49: Laminate
4. Claims 50-57: Element.

The subjects defined by the problems and their means of solution, as listed above, were regarded by the ISA as being so different from each other that no technical relationship or interaction could be considered to be present so as to form a single general inventive concept. The ISA further considered that the essential features of Claims 1 and 12 were not essential for making the laminate of Claims 41 to 49 and the element of Claims 50 to 57.

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 at least

Claims 1 to 40 related to the same invention, namely method and apparatus for selective demetallisation of an etchable metal layer, while Claims 41 to 57 also comprised a single invention, such claims being directed to laminate structure. It was further submitted that Claims 41 to 57 related to the same invention as Claims 1 to 40, being products produced by procedures defined in those claims.

Relying on the above submissions, the Applicant requested 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 search 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 Boards 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, provided 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 claim groups 1 to 4 listed by the ISA in its invitation (see point II above) relate to inventions concerned with methods and apparatus for selective demetallisation of an etchable metal layer (Groups 1 and 2) and with laminate structures (Groups 3 and 4) which are products produced by the procedures defined in the Groups 1 and 2. All these inventions (cf. Claims 1, 11, 41 and 50) refer to a layer of etchant-resistant material applied to the etchable metal layer corresponding to a desired pattern of non-etched metal. 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 in the Board's opinion the present application is not a straightforward case where a mere listing of the separate groups of claimed subject-matters 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.

Order

For these reasons, it is decided that:

Refund of the additional search fees is ordered.

The Registrar:



S. Fabiani

The Chairman:



G. Szabo