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**D E C I S I O N**  
**of 25 March 1994**

**Case Number:** W 0013/93 - 3.3.2

**Application Number:** PCT/US 92/10159

**Publication Number:** WO 9315906

**IPC:** B32B 7/02

**Language of the proceedings:** EN

**Title of invention:**

Multicomponent, Multilayer Polymeric Reflective Bodies

**Applicant:**

The Dow Chemical Company

**Opponent:**

-

**Headword:**

Reflective body/DOW.

**Relevant legal norms:**

PCT Art. 17(3)(a)

PCT R. 13.2, 40.2(c), 40.2(e)

**Keyword:**

"Lack of unity a posteriori (yes)"

**Decisions cited:**

-

**Catchword:**

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Boards of Appeal

Chambres de recours

**Case Number: W 0013/93 - 3.3.2**  
**International Application No. PCT/US 92/10159**

**D E C I S I O N**  
**of the Technical Board of Appeal 3.3.2**  
**of 25 March 1994**

**Applicant:** The Dow Chemical Company  
2030 Dow Center, Abbott Road  
Midland, Michigan 48640 (US)

**Representative:** Hessenaur, Lloyd E. Jr.  
The Dow Chemical Company  
Patent Department  
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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 13 September 1993.

**Composition of the Board:**

**Chairman:** P.A.M. Lançon  
**Members:** I.A. Holliday  
S.C. Perryman

## Summary of Facts and Submissions

- I. The Applicant filed international patent application PCT/US 92/10159 containing eight claims.
- II. The EPO, acting as International Search Authority (ISA), sent to the Applicant an invitation to pay an additional search fee in accordance with Article 17(3)(a) and Rule 40.1 PCT.

The ISA indicated that EP-A-0 404 463 (1) destroyed the novelty of Claim 1 of the application. Since the unifying technical feature was no longer considered to be novel, a lack of unity *a posteriori* arose and in the opinion of the ISA the claims related to six separate groups of subject-matter without any unifying feature. However, the ISA indicated that the subject-matter of Claims 2 to 7 was also disclosed in document (1) and drew up a partial search report in respect of Claims 1 to 7. The additional search fee was requested for the invention defined by Claim 8.

- III. The Applicant paid the additional search fee under protest in accordance with Rule 40.2(c) PCT. The Applicant denied that the subject-matter of Claim 1 of the application, i.e. a body of at least three diverse polymeric materials comprising alternating layers of certain thicknesses, was disclosed in document (1).
- IV. The Review Panel of the EPO supported the view taken by the ISA and invited the Applicant to pay a protest fee for the examination of the protest pursuant to Rule 40.2(e) PCT.
- V. The Applicant paid the protest fee and in an accompanying letter maintained the argument that

document (1) did not disclose the specific reflective polymeric body claimed in Claim 1 of the application.

### Reasons for the Decision

1. The protest is allowable.
2. The Applicant has argued that document (1) does not disclose the invention claimed in Claim 1 of the present application. The Board cannot share this view.
  - 2.1 Claim 1 of the application relates to a reflective polymeric body of at least first, second and third diverse polymeric materials. It is admitted that Claim 1 of (1) refers only to first and second polymeric materials. However, a third polymeric material is referred to in Claim 9 of (1). Bodies comprising three polymeric materials are discussed in detail in the description of (1) on page 3, lines 26ff.
  - 2.2 Document (1) refers to "a sufficient majority" of the individual layers having an optical thickness of not more than  $0.09 \mu\text{m}$  or not less than  $0.45 \mu\text{m}$ . The application refers to "a sufficient number" of the individual layers having the same optical thickness values. According to (1), the difference between the refractive indices of the polymeric materials having the lowest and highest values is at least 0.03. A corresponding restriction is also present in Claim 1 of (1).
  - 2.3 It is also to be noted that Examples 1, 3 and 4 of the present application appear to be substantially the same as Examples 4, 5 and 6 respectively of document (1).

2.4 Accordingly, in the judgment of the Board, the ISA's objection concerning the lack of novelty of Claim 1 of the application is well founded.

3. Rule 13.2 PCT specifies that a group of inventions contained in the same international application can only form a single general inventive concept within the terms of Rule 13.1 PCT when there is a technical relationship among those inventions involving one or more of the same or corresponding technical features.

3.1 The unifying feature conferring the said technical relationship between the individual features currently claimed was the reflective polymeric body defined by Claim 1. Once the novelty of Claim 1 has been destroyed, there is no longer an "umbrella" to link the separate features forming the subject-matter groups of the remaining claims, all of which were originally dependent upon Claim 1. The Board accordingly agree that the six separate groups of subject-matter set out by the ISA on Form PCT/ISA/206 relate *a posteriori* to separate inventive concepts. The said inventive concepts *prima facie* represent distinct solutions to different technical problems. By merely contesting the novelty of Claim 1, the Applicant failed to show how the various claimed inventions might be linked to form a single general inventive concept as required by Rule 13.1 PCT.

3.2 The ISA stated that the first five subject-matter groups are also disclosed in document (1) and requested only one further search fee. The Board has not deemed it necessary to verify the lack of novelty alleged; this is a matter of substantive examination beyond the ambit of the present protest. However, the request for a further search fee in respect of the sixth subject-matter group based on Claim 8 appears to be wholly justified and accordingly the protest must be dismissed.

Order

For these reasons, it is decided that:

The protest is dismissed.

The Registrar:

The Chairman:

P. Martorana

P.A.M. Lançon