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D E C I S I O N
of 17 August 1998

Case Number: W 0004/98 - 3.2.2

Application Number: PCT/EP97/00709

Language of the proceedings: EN

Title of invention:

Sawing machine for dividing blocks of stone material into slices

Applicant:

Brocco Emilio et al.

Opponent:

-

Headword:

-

Relevant legal provisions:

PCT Art. 17(3)(a)

PCT R. 13(1), (2), (4); 40(1), (2), (c), (e)

Keyword:

"Lack of unity of invention a posteriori - not established"

"Definition of the technical problem"

Decisions cited:

G 0001/89, W 0005/85, W 0011/89, W 0006/90, W 0006/91,

W 0003/91, W 0003/92

Catchword:

-



Case Number: W 0004/98 - 3.2.2
International Application No. PCT/EP97/00709

D E C I S I O N
of the Technical Board of Appeal 3.2.2
of 17 August 1998

Applicant:

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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. November 1997.

Composition of the Board:

Chairman: W. D. Weiß
Members: R. Ries
C. Holtz

Summary of Facts and Submissions

- I. The applicants filed an international patent application PCT/EP97/00709 with 26 claims. The single independent claim 1 reads as follows:

"1. Sawing machine for dividing blocks of stone material into slices, in which each cut is executed by a cutting tool consisting of a metal cable, termed a "wire", formed into a closed loop and caused to travel between a drive pulley and a driven pulley, the machine being characterized in that it comprises a plurality of cutting wires (16) separated from each other by guide means (17.1, 17.2, 17.3) in such a way that each cutting wire (16) is kept by these guide means in its own plane, for example a vertical plane, essentially parallel to the planes in which the adjacent wires (16) lie, while the distance between adjacent wires (16) and, therefore, the thickness of the slices cut by the wires, is also determined."

Claims 2 to 26 which were directly or indirectly dependent upon claim 1 related to preferred embodiments of the sawing machine defined in claim 1.

- II. On November 5, 1997, the EPO, acting as an International Search Authority (ISA) sent to the applicant an invitation to pay five additional search fees pursuant to Article 17(3)a and Rule 40(1) PCT.

The invitation to pay additional search fees stated that the subject matter of claim 1 was essentially known from the document (1) US-A-2 958 323 and that the common technical features of claims 2, 3, 9, 14, 15, 22 directly depending upon claim 1 could not be considered as being special technical features within the meaning

of PCT Rule 13.2, second sentence, since they made no contribution over the prior art. Rule 13.1 PCT was not held to be satisfied and the requirement of unity not to be fulfilled. At this stage of the procedure, the ISA discerned six groups of inventions G1 to G6.

G1: claims 1, 2, 3, 4, 5, 6, 7, 8, 9, 10, 15, 16, 17, 18, 19, 20

G2: claims 1, 3 to 26

G3: claims 1, 9, 10, 11, 12, 13, 15, 16, 17

G4: claims 1, 14, 15, 16, 17

G5: claims 1, 15, 16, 17

G6: claims 1, 22, 23, 24.

The search was restricted to the subject matter of the combinations of group G1.

III. On December 1, 1997, the applicant paid five additional search fees under protest pursuant to Rule 40(2)c PCT. In support of the protest, the applicant submitted the following arguments:

Taking into account document (1) US-A-2 958 323 which was considered to be relevant to the subject matter of claims 1 to 3, the applicant discerned only two groups of inventions, namely:

G1: claims 1,2,3-21

G2: claims 1, 22, 23, 24, 25, 26.

Either of groups G1 and G2 formed a single inventive concept. Reimbursement of the overpaid fees was requested.

- IV. On 28 April 1998, the Review Panel of the ISA concluded after examination of the protest that the protest was only partly justified. In Group G1 defined by the applicant (claims 1, 2, 3 to 21), the Review Panel discerned two groups of inventions:

G1A: claims 1 to 14, 19 to 21,

G1B: claims 15 to 18.

Consequently, the reimbursement of three of the search fees additionally paid was ordered. The applicant was invited to pay the protest fee within one month.

- V. On 20 May 1998, the applicant paid the required protest fee.

Reasons for the Decision

1. The protest is admissible.
2. Rule 13.1 PCT requires that the international application shall relate to one invention only or to a group of inventions so linked as to form a single inventive concept.

In his response dated 1 December 1997, the applicant did not contest that the international patent application related to two inventions, namely groups G1 and G2. Since for the latter, no refund of the additional search fee was requested, the Board, therefore, understands the protest to be limited to the

question of unity of invention of groups G1A and G1B as defined in the annex to the notification of 28 April 1998, regarding review of justification for invitation to pay additional search fees under PCT Rule 40.2(e).

3. The invitation by the ISA to pay two additional search fees was based on document (1) US-A-2 958 323 which was considered to be detrimental for the novelty of claims 1 to 3, 9 to 12 (cf. international search report, date of mailing 28 April 1998). This document discloses a "long wire" sawing machine for cutting stone material into slices, comprising a plurality of wires (cf. column 3, lines 36 to 40; lines 65, 66) separated by replaceable guide means (cf. column 3, lines 19/20; lines 68 to 74), a movable frame comprising a horizontal platform 30 (ie. a supporting columnar structure), a mobile cutting head that can travel vertically up and down 28 and a geared down motor means 38 for control of the motion of the cutting head (cf. (1), column 3, lines 10 to 36, Figure 1). The rim portion of the wire-guiding wheels is provided with a large number of circumferential grooves 76 (cf. (1) column 4, lines 55 to 62; Figures 2 to 4).

4. The Board has verified the novelty objection to claims 1 to 3, 9 to 12 finding that, in the light of the above teachings, the sawing machine as defined in claims 1 to 3, 9 to 12 was already known from document (1). The respective statement of the ISA in the international search report is therefore not objectionable. In his letter dated 1 December 1997, the applicant did not contest the novelty objection of the ISA, at least not with respect to the subject matter of claims 1 to 3.

5. The ISA's non-unity objection was based on the disclosure of document (1) and thus was made "a posteriori". As stated in the decision G 1/89 (OJ EPO, 1991, 155), the ISA is empowered to raise an objection for lack of unity "a posteriori" i.e. after having taken the prior art into consideration. Decision G 1/89 makes also clear that an objection of this kind can only be based on a provisional opinion on novelty and inventive step which is in no way binding upon the authorities subsequently responsible for the substantive examination (cf. G 1/89, point 8.1 of the grounds).

6. According to Rule 40.1 PCT the invitation to pay additional search fees shall specify the reasons for which the international application is not considered as complying with the requirement of unity of invention and shall indicate the amount to be paid. Furthermore, decision G 1/89 concludes in point 4 that the requirement of unity of invention under the PCT must in principle be judged by the same objective criteria by both the ISA and the IPEA (International Preliminary Examining Authority) or the designated Office under the PCT and the Examining Division under the EPC, respectively. Therefore, and according to the established case law of the Boards of the Appeal, determining unity of the invention requires as a mandatory precondition the analysis of the technical problem or problems underlying the respective groups of inventions (see W 11/89, point 4.1 of the reasons, OJ EPO 1993, 225; W 6/90, point 3.1 of the reasons, OJ EPO, 1991, 438).

If, as in the present case, the search revealed prior art more relevant than that already acknowledged in the description of the international patent application, it is necessary to define, on the basis of the disclosure

of document (1), the technical problem(s) to be solved by the different invention(s). Thus, unity of invention can be assessed only after having determined the technical problem in such a manner (see W 6/91, point 4, of the reasons, unpublished; W 3/92, point 3, of the reasons).

In the present case, the ISA did not specify the reasons for which the international application was considered as not complying with the requirements of unity. Neither the annex to the invitation to pay additional search fees of 5 November 1997 nor the Decision of the Review Panel of 28 April 1998, comprised any detailed analysis of the technical problem underlying the identified groups of inventions in view of both, the disclosure of the international application and the closest document of the state of the art. Moreover, the possible result of such an analysis is not considered to be immediately evident from the case itself, so that it could be regarded as being a "straight forward case" in the sense of decision W 3/92, point 5 of the reasons.

Specifically, the annex to the invitation to pay additional search fees merely presents a list of those technical features common to all claims, and further technical features characterizing the groups of inventions. The same statement applies to the Decision of the Review Panel which essentially summarizes the technical features of dependent claim 15 without, however, specifying the different technical problems solved by the inventions of group G1A and group G1B.

7. Given this situation, the ISA's statement in the decision of the Review Panel, that claim 15, when depending **only** on claim 1, belongs to a different invention, cannot be accepted as a sufficient reasoning

in support of the finding of lack of unity of invention. This statement of the decision of the Review Panel fails to define the technical problem underlying the present application, since it relates exclusively to the technical features characterizing a claimed solution. This means that the decision of the Review Panel failed to give conclusive reasons for the absence of single common inventive concept in the subject matter of the present international application. In the Board's view, an investigation of that kind is not to be carried out for the first time by the Boards of Appeal (see W 3/91, points 5 and 6 of the reasons).

8. The facts of the present case are, therefore, at least partly in line with the facts of decisions W 6/91 and W 3/92, where the justification for the reimbursement of the additional search fees was based on the lack of the definition of the problem to be solved.
9. It follows from the above that the invitation to pay additional search fees was issued in violation of the requirements laid down in Rule 40.1 PCT. Hence, one additional search fee shall be reimbursed.
10. The Board, therefore, finds that the applicant's protest (see point 2 of this decision) was entirely justified. Given this situation, also the protest fee is refunded to the applicant pursuant to Rule 40.2(e) of the Regulations under the PCT.

Order

For these reasons it is decided that:

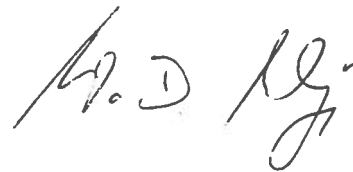
- Reimbursement of one additional search fee and of the protest fee paid by the applicant is ordered.

The Registrar:



N. Maslin

The Chairman:



W. D. Weiß