

EW0011.99-003671000

Decision of Technical Board of Appeal 3.3.5 of 20 October 1999

W 11/99 - 3.3.5*

(Translation)

Composition of the board:

Chairman: R. Spangenberg
Members: G. Wassenaar
R. Teschemacher

Applicant: N.N.

Headword: Percarbonate

Article: 34(3) PCT

Rule: 13.2 PCT

Keyword: "Unity of process claims and product claims, and between product claims themselves (yes)"

Headnote

If, in an international patent application, there are claims directed to products and to a process for the manufacture thereof, it cannot be assumed that there are no corresponding special technical features within the meaning of Rule 13.2 PCT simply because the process can also be used to manufacture other products (see Reasons, points 2.1 to 2.7).

Summary of facts and submissions

I. A search was carried out by the International Searching Authority (ISA) in respect of international patent application PCT/DE 97/... comprising 35 claims with no objection of non-unity being raised. The search report listed, among others, the following document:

D1: FR-A-...

II. Following the request for international preliminary examination, the European Patent Office as the International Preliminary Examining Authority (IPEA) invited the applicant to limit the claims or to pay additional fees, as the application contained four inventions, A to D, which could not be regarded as having unity.

Invention A related to process claims 1 to 15.

Invention B related to product claim 16 and claims 19 to 35, in so far as they relate to claim 16.

Invention C related to product claim 17 and claims 19 to 35, in so far as they relate to claim 17.

Invention D related to product claim 18 and claims 19 to 35, in so far as they relate to claim 18.

Claims 1, 16, 17 and 18 read:

"1. Process for manufacturing sodium percarbonate (PCS), characterised in that ...

16. Sodium percarbonate (PCS), characterised in that ...

17. Sodium percarbonate (PCS), characterised in that ...

18. Sodium percarbonate (PCS), characterised in that"

By way of substantiation the Office stated that the claimed process did not necessarily lead to the manufacture of products in accordance with claims 16 to 18. It also stated that the sole common feature of inventions B, C and D was known from D1.

III. The applicant paid the requested additional fees under protest and also the protest fee. The grounds for the protest may be summarised as follows:

The essence of the invention and its linking element was a new process for manufacturing sodium percarbonate (PCS) according to claims 1 to 15, whereby PCS was obtained with the advantageous properties defined in claims 16, 17 and 18. The invention related to the solution to a single problem, namely the provision of a new, advantageous process for manufacturing PCS with advantageous, improved properties. To demand that the requirement of unity of invention only be considered fulfilled if the process according to claim 1 led exclusively to PCS with features according to claims 16 to 18 was unjustifiable. The special properties of the products according to claims 16 to 18 were additional advantages resulting from the application of the new process.

IV. A review board within the meaning of Rule 68.3(e) PCT confirmed the IPEA's opinion regarding lack of unity and ruled that the request for payment of additional fees should be maintained. In response to the applicant's arguments, it stated that the subject-matter of claim 1 was not new over D1, and the claimed process could not therefore be considered to be the patentable solution to one single problem.

V. In its first notification (IPEA/408) the IPEA said that the subject-matters of claims 1-9, 16-21 and 24-28 were not new over D1 and those of claims 10-15, 22, 23 and 29-35 lacked inventive step over the same document. No other citations were mentioned.

VI. The applicant requests reimbursement of the additional fees paid as well as of the protest fee.

Reasons for the decision

1. The protest complies with Rule 68.3(c) and (e) PCT and is therefore admissible.
2. The IPEA found that the application contained four inventions and that these inventions lacked unity. It first of all found that there was no unity of invention A (process) with inventions B to D (products) on the sole grounds that the process was also suitable for manufacturing other products. The objection was therefore raised without reference to any prior art arising from the search ("a priori").

2.1. According to Rule 13.2 PCT in the version of 1 July 1998 valid for the present case, the requirement of unity of invention is fulfilled for a group of inventions, such as the one in this case, when there is a technical relationship between the process and the products involving one or more of "the same or corresponding special technical features". The IPEA obviously interpreted this requirement to mean that the process had to be suitable for the manufacture of the claimed products **only**. This view is, however, not supported by the International Preliminary Examination Guidelines, which are binding on the interpretation of Rule 13.2, analogously to proceedings before the ISA (see G 1/89, OJ EPO 1991, 155, Reasons, 6), for proceedings before the IPEA and hence also for the protest procedure under Rule 68 PCT. Guideline III-7.2 (PCT Gazette S-07/1998, Section IV, p. 22), which is the most relevant to the present case, gives a product and a process "specially adapted" for manufacturing it as an example of a group of linked inventions. However, it cannot be concluded from this that "corresponding technical features" can only be said to be present if the process is limited to the manufacture of the claimed products. Rather, the board interprets the requirement for the presence of corresponding special technical features in cases where a manufacturing process and products are being claimed in the same application to mean that they can usually be assumed to be present where the production process is **new** and actually **suited** to making the claimed products (where appropriate in addition to further

products) accessible. In such cases the board regards the process as being "specially adapted" to the manufacture of the claimed products. A narrower interpretation of the terms "specially adapted" and "corresponding special technical features" would not fulfil the legislative purpose of Article 34(3) and associated Rule 13.1 PCT, which, in the board's view, is the same as that of Article 82 EPC, namely to prevent subject-matters which are not interconnected being claimed in one and the same application (see, for example, T 110/82, OJ EPO 1983, 274, Reasons, 5).

2.2. This interpretation accords with Annex B to the Administrative Instructions under the PCT mentioned in PCT Guideline III-7.2 in the version of 1 July 1998, where it is stated in Part 1, item (e), that a process is specially adapted for the manufacture of a product if it inherently results in the product. If this condition is met, it is irrelevant whether other products can be obtained using the process.

2.3. In Section III-7.6 of the Guidelines (*loc.cit.*, p. 23) it is stated that, although lack of unity should be raised in clear cases, it should not be raised on the basis of a narrow, literal or academic interpretation of the relevant provisions. This follows the Guidelines for Examination in the European Patent Office with regard to the requirement of Article 82 EPC (see Chapter C-III, 7.7). In the opinion of the board, the narrow interpretation of the relevant provisions on which the request for payment was obviously based is incompatible with this guideline too, as it results in subject-matters which contribute to the solution of one and the same technical problem and therefore belong together (see also W 11/89, OJ EPO 1993, 225, Reasons, 4.1) being deemed to lack unity. However, a manufacturing process which permits, at least amongst other things, the manufacture of a claimed product generally contributes to the solution of the problem which the product itself is intended to solve.

2.4. A manufacturing process and its product may not be regarded as lacking unity simply by virtue of the fact that the manufacturing process is not restricted to the manufacture of the claimed product. The grounds given in the invitation to pay thus

do not justify the request for payment of two examination fees for "inventions" A and B to D.

2.5. These considerations apply equally to the necessary technical relationship between the process according to claims 1 to 15 and each individual product according to claims 16, 17 and 18. Consequently, provided no reasons are given as to why it should not be seen as new and involving an inventive step, the process must be deemed to be the link between the various products within the meaning of Rules 13.1 and 13.2 PCT.

2.6. The grounds put forward by the applicant in support of the protest are thus well founded.

2.7. This approach accords with the case law of the boards of appeal in similar cases. In W 2/95 (cited in "Case Law of the Boards of Appeal of the European Patent Office", 3rd edition, 1998, II-C, 7.2, and IX-B, 2.1) the international application related to a product and a process for its manufacture. The board held that the lack of identical wording for the technical features in a product claim and in the independent claim relating to the manufacture of the product cannot in itself justify raising non-unity of the inventions concerned. When comparing features in claims which may possibly lack unity or which are suspected of lacking unity, reference should be made to the description when investigating the effects to be attributed to the individual features of a claim. Only then can a decision be taken as to whether, on the basis of "corresponding" technical features, there is a technical relationship among the inventions. In T 94/91 of 9 September 1991 (cited in Case Law of the Boards of Appeal, loc.cit., II-C, 7.2), the board made it clear that the required general inventive concept could not be equated with the technical features recited in a claim or in a particular combination of claims, but should be ascertained with due regard to the description and any drawings. The board therefore held that it was sufficient for two independent claims for particular filters to have common features which had been recited in preceding claims directed generally to filters of any kind and were not shown by the documents found in the search report to be **completely**

lacking in novelty or inventive step (see Reasons, 6). In decision W 12/87 of 11 January 1988 (unpublished) the board held, with regard to the earlier version of Rule 13.2 PCT, which explicitly stipulated that a "specially adapted" process for manufacturing a claimed product was a requirement for unity, that the claimed process did not have to be the only technical option for realising the claimed product, and that what mattered was whether the claimed process steps contributed to the formation of those structural elements which were necessary if the aim of the invention were to be achieved.

3. The objection of non-unity between invention A (process) on the one hand and inventions B to D (products) on the other was only actually raised "a posteriori", in the result of the review of the invitation to pay under Rule 68.3(e) PCT, and was based on a comparison with the prior art, namely document D1. However, additional reasons for the invitation to pay put forward in the result of the review cannot be taken into account in the examination of a protest (see W 4/93, OJ EPO 1994, 939, Reasons, 2).

3.1. However, even if it were to be assumed in the present case that document D1 was mentioned in the invitation to pay in connection with the products (inventions B to D), such that an "a posteriori" objection of lack of novelty at least with respect to process claim 1 could have been implicitly derived therefrom, such an interpretation of the content of the invitation to pay would not be sufficient to support an objection of lack of unity. The above considerations apply not only with regard to the presence of a new and prima facie inventive process defined in the independent process claim, but also if such a process is defined by features contained in one or more of the claims dependent thereon, at least where such a process continues to permit the manufacture of **all** the claimed products. The first time any comments were made on the dependent process claims, however, was in the notification (IPEA/408) of 5 November 1998.

3.2. The invitation to pay is furthermore also based, with regard to the products according to claims 16 to 18 (inventions B to D), solely on the fact that products with the active oxygen content mentioned in all three claims were known from D1. The

other features in these claims are defined by parameters in different ways. Whether or not these different definitions relate to different structural features was not investigated. However, it is apparent from the description that the parameters given in these claims may relate to the same product. Thus the product according to example 2 fulfils the conditions not only of claim 17 but also of claim 18, and the product according to example 4.1 fulfils the conditions of both claim 16 and claim 18 (see Tables IIb and IV). The alleged lack of a relationship between the product claims is thus in no way obvious, and more detailed grounds should have been provided, since, as stated above (see 2.3), PCT Guidelines III, 7.6 does not permit objections of lack of unity based on a literal approach. For this reason too, the grounds given in the invitation to pay do not justify the payment of three further examination fees.

4. From the above-mentioned communication (IPEA/408) the board deduces that the IPEA regards not only the process according to claim 1, but also the other inventions B, C and D in their broadest claims as lacking novelty over one and the same document, namely D1. Under these circumstances there is no "special technical feature over the prior art" as required by Rule 13.2 PCT. Nevertheless, in the opinion of the board the fact that a single document discloses all the claimed subject-matters is a very strong indication that there is a technical relationship between them, such that, in these circumstances, because of PCT Guidelines III, 7.6, no invitation to pay further examination fees may be issued, at least not without further grounds (see also T 501/91 of 10 October 1991, Reasons, 6). The board notes in this connection that the communication (IPEA/408) of 5 November 1998 states that the process for manufacturing the claimed products was known from D1 and that the products obtainable according to D1 must thus also have the same properties, thereby rendering them implicitly, rather than explicitly, disclosed. If, however, a direct relationship between process and product is assumed in conjunction with the examination for novelty, this same relationship must be assumed when assessing the unity of the present application. Indeed, it is clear from PCT Guidelines III, 7.6 that Rule 13.2 PCT may only be applied if "special technical features" are recognisable over the prior art. Where, as in the present case, a single publication belonging to the prior art jeopardises the novelty of all the subject-matters of the

independent claims, it makes no sense, and is not justified, to raise an objection of non-unity. In the opinion of the board, the question of unity does not arise unless the application contains claims which differ clearly from the prior art.

Order

For these reasons it is decided that:

The reimbursement of the additional examination fees and the protest fee is ordered.

* Since the decision relates to proceedings before the International Preliminary Examining Authority (IPEA), passages in the decision relating to the technical details of the invention will not be published. Copies of the unabridged decision are not available.