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D E C I S I O N
of 13 October 1999

Case Number: W 0014/99 - 3.5.2

Application Number: PCT/US 98/06200

Publication Number: -

IPC: -

Language of the proceedings: EN

Title of invention:

Trip mechanism for an overload relay

Applicant:

Siemens Energy & Automation, Inc

Opponent:

-

Headword:

-

Relevant legal provisions:

PCT Art. 34(3)

RFees Art. 1(b), 10c

PCT R. 13.2, 40, 68.1, 2, 68.3(c), (e)

Keyword:

"Lack of unity of invention a posteriori (yes)"

"Definition of the technical problem"

"Insufficient reasoning (no)"

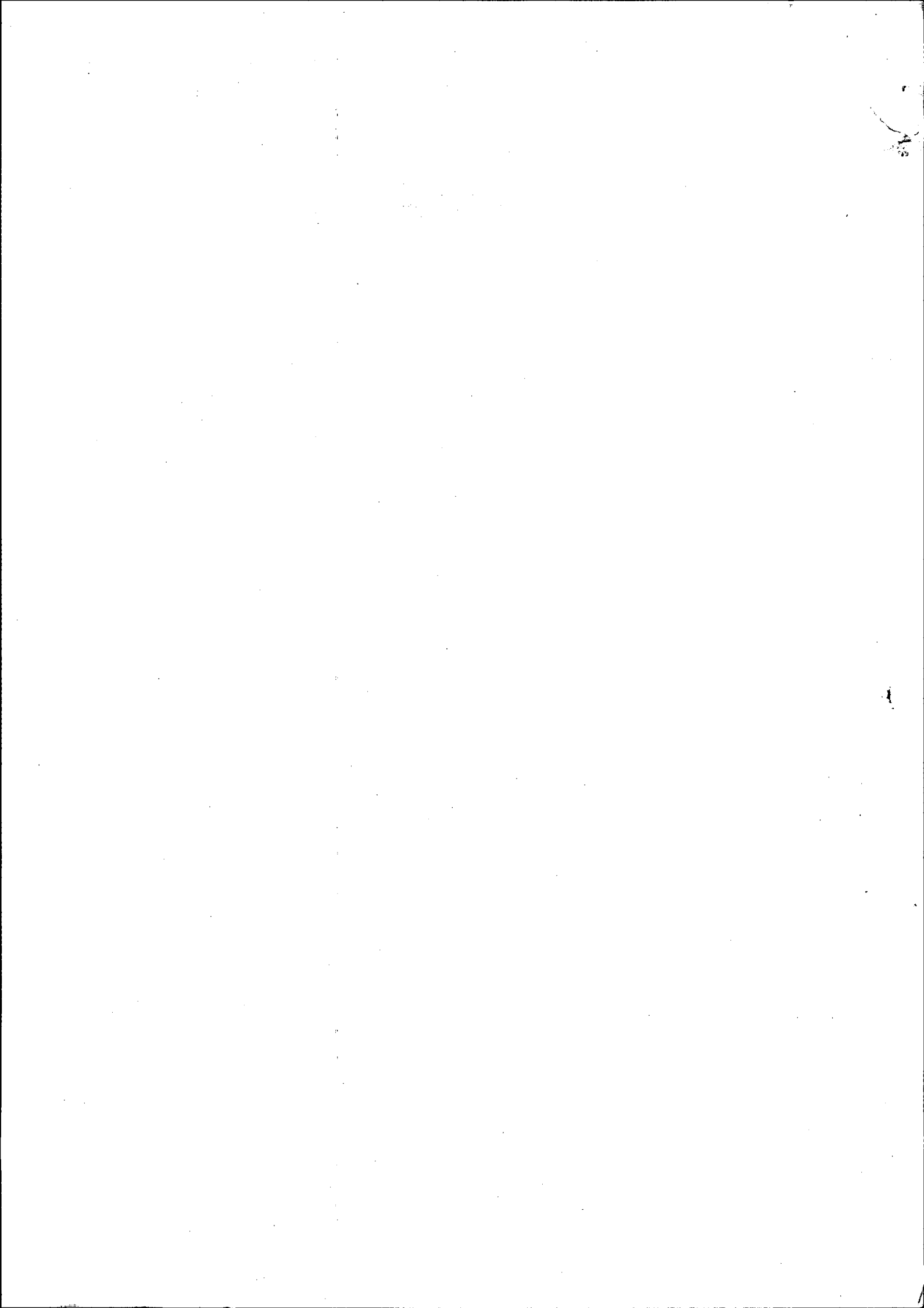
"Amount of excess fee insignificant"

Decisions cited:

G 0001/89, W 0004/85, W 0011/89, W 0004/94, W 0009/94,
W 0012/94, W 0004/95

Catchword:

-





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Case Number: W 0014/99
Internation Application No. PCT/US 98/06200

D E C I S I O N
of the Technical Board of Appeal 3.5.2
of 13 October 1999

Appellant: Siemens Energy & Automation, Inc
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Decision under appeal: Protest pursuant to Rule 68.3(c) of the Patent Cooperation Treaty made by the applicant against the invitation of the European Patent Office (International Preliminary Examining Authority) dated 27 April 1999 pursuant to PCT Article 34(3)(a) and Rule 68.2 to restrict the claims or pay additional fees (for the international preliminary examination).

Composition of the Board:

Chairman: W. J. L. Wheeler
Members: F. Edlinger
B. Schachenmann

Summary of Facts and Submissions

I. International patent application PCT/US98/06200 was filed with twenty-eight claims. Five of these claims take the form of independent claims:

"1. A trip mechanism for an overload relay comprising:
a housing;
a bistable armature mounted in said housing on a pivot for pivotal movement between two stable positions;
fixed contacts within said housing;
moveable contacts carried by said armature for movement to a closed position with said fixed contacts for one of said two stable positions and for movement to an open position relative to said fixed contacts for the other of said two stable positions;
a latch surface carried by one of said armature and said housing; and
a spring mounted on the other of said armature and said housing and having a latch finger for engaging said latch surface and retaining said armature in one of said two positions."

"13. A trip mechanism for an overload relay comprising:
a housing;
an elongated armature on a pivot in said housing for pivotal movement between two positions;
a post extending from one side of said armature at a location spaced from said pivot;
a fulcrum on said post;
an elongated contact bar mounted intermediate its ends on said post;
a spring carried by said armature and biasing said contact bar against said fulcrum;
a pair of spaced, fixed contacts mounted in said housing and positioned to be bridged by said contact bar for one of said two positions and spaced from said

contact bar for the other of said two positions; and a contact levelling rib on said housing for engaging said contact bar when said armature is in said other of said two positions."

Claim 19, although worded as an independent claim, has all the features of claim 1 and comprises additional features, such as a push button.

"20. A trip mechanism for an overload relay comprising; a housing; an armature mounted for movement in said housing between two positions; fixed contacts in said housing; movable contacts carried by said armature for movement toward and away from said fixed contacts; a moveable lever associated with said armature and operable to shift said armature from at least one of said two positions to the other of said two positions; an operator for said lever including an element movable toward and away from said lever; a spring finger carried by one of said lever and said operator and extending at an acute angle therefrom toward the other of said lever and said operator; and a stop surface on the other of said lever and said operator positioned to be engaged by said spring finger when said armature is in said one position and said operator is moved toward said lever and to disengage and release said spring finger when said armature has moved to the other of said two positions."

"28. A trip mechanism for an overload relay comprising: a housing; an armature on a pivot in said housing for pivotal movement between a first position and a second position; a post extending from one side of said armature at a location spaced from said pivot;

a first contact resiliently mounted on said post; and a second contact mounted in said housing and positioned to be engaged by said first contact when said armature is in said first position and spaced from said first contact when said armature is in said second position; wherein movement of said armature from said first position to said second position or reverse causes a wiping action between said fixed and movable contacts."

II. On 27 April 1999 the European Patent Office (EPO), acting as an International Preliminary Examining Authority (IPEA), pursuant to Article 34(3)(a) and Rule 68.2 PCT, informed the applicant that the application did not comply with the requirement of unity of invention (Rule 13 PCT), indicated a possibility of restriction which would be in compliance with the requirement and invited the applicant to restrict the claims or to pay two additional fees of DEM 3000. The invitation gave the following reasons:

(i) The common concept linking the independent claims and consisting of the following features:

"A trip mechanism for an overload relay comprising a housing,
an armature mounted for movement in said housing,
fixed contacts within said housing,
movable contacts carried by said armature for
movement toward and away from said fixed contacts"

was found to lack novelty in view of document DE-A-2 830 390.

(ii) The invitation referred to the "special technical features" of the following three separate groups of inventions:

(a) Claims 1 and 19

(b) Claims 13 and 28

(c) Claim 20.

III. By letter received on 19 May 1999, the applicant paid two additional fees under protest (Rule 68(3)(c) PCT) and argued essentially as follows:

- (i) The International Search Report, referring to claims 1 to 7 as to the relevance of the cited documents, did not indicate that the present application lacked unity. None of the cited documents was listed as being of particular relevance. It appeared to the applicant that a single claim as suggested by the examiner would not have been searched. This could not "be the case unless the features of these claims" fell "within the inventive concept of the claims" which had been searched.
- (ii) The amount of the required additional fees appeared excessive since, according to the Supplement to Official Journal No. 1/1999 the fee for an "international search" (*sic*) was "DM2198.35 and not DM3000".

IV. On 25 June 1999, the IPEA issued a communication informing the applicant that, after a prior review of the justification for the invitation to pay additional fees, the requirement of payment and the amount thereof was upheld. The applicant was thus invited under Rule 68.3(e) PCT to pay the protest fee. The IPEA explained the calculation of the fees, admitting that the wrong amount of each examination fee (DM 3000 instead of the correct fee DM 2998,29) had been requested. Moreover, for the reasons given, they found that the application lacked unity although the search

report did not indicate so. Although the subject-matter of all the claims had been searched as confirmed by the International Search Authority (ISA), this would be irrelevant for the objection raised since lack of unity was already apparent from the cited documents.

V. On 6 July 1999 (letter dated 5 July 1999) the applicant paid the protest fee without further comment.

VI. The applicant requests an explanation of the calculation or a refund of the difference in fees as set out above. It can also be deduced from the payment of the fees under protest based on the arguments set out under point III(i) above that the applicant requests reimbursement of the additional fees.

Reasons for the Decision

1. Admissibility of the protest

1.1 Rule 68.3(c) PCT requires that payment under protest 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".

1.2 It may be disputed whether the arguments under point III(i) above fulfil this requirement in that the applicant did not comment on the technical relationship among the claimed inventions involving one or more of the same or corresponding special technical features (Rule 13.2 PCT; see the unpublished decisions W 9/94, points 2.4 and 3, and W 12/94, points 1.1 and 1.2, which both had to deal with similar questions).

1.3 The statement undoubtedly contains reasons with respect to the amount of the additional fees which is considered to be excessive (see point III(ii) above). Even if the applicant does not contest the number of the additional fees, a wrong amount for individual fees may arguably fall under the terms of Rule 68.3(c) PCT and is thus sufficient to qualify as a reasoned statement. Since the required fees have also been paid in time, the protest is admissible.

2. *Sufficiency of reasoning in the IPEA invitation*

2.1 The first question to be decided is whether the invitation issued by the IPEA was sufficiently reasoned to enable the applicant to examine whether the request to pay additional fees was justified. To this end it is necessary, according to established case law of the boards of appeal, to take account of the problem(s) solved by the alleged inventions. Only in exceptional and straightforward cases can a mere list of the different subject-matters constitute a sufficient substantiation (see W 4/85, OJ 1987, 63, point 3; W 11/89, OJ 1993, 225, point 4.1; W 4/94, OJ 1996, 73, point 4.1).

2.2 The invitation essentially refers to the common concept in terms of technical features contained in each of the claims of groups (a), (b), (c), see paragraph II(i) above. This concept is found to lack novelty in view of DE-A-2 830 390. The invitation then lists the "special technical features" of each of the groups without explicitly setting out why there is no technical relationship among these groups involving one or more of the same or **corresponding** special technical features (Rules 13.2 PCT; emphasis added by the board).

2.3 The different "special technical features" listed in the invitation obviously relate to different parts of the known bistable overload relay. Group (a) comprises features shown in the upper region of the drawings, in particular a latch finger for engaging a latch surface carried by the armature or housing for retaining the armature in one of two stable positions. Group (b) relates to the arrangement of the contacts shown in the lower region of the drawings. Group (c) specifies features shown in the central region of the drawings, in particular the arrangement of a spring finger and a stop surface for engagement and disengagement between a moveable lever and an operator as specified in the last paragraph of claim 20.

2.4 The description of the present application ("Substitute Sheets (Rule 26)") discloses that the different aspects described may be combined in a reliable, mechanical trip mechanism that can be economically manufactured (page 3, lines 6 to 8). The summary of the invention refers to three different "facets of the invention" (page 3, lines 18 to 28; page 4, lines 10 to 21; page 4, line 26 to page 5, line 7) essentially corresponding to groups (a), (b), (c). The description of the "embodiments" following each of these "facets" and the description of the drawings disclose that the features of group (a) provide a latch acting between the armature and the housing for latching the armature in a manual reset mode so that automatic resetting would be prevented (page 12, lines 5 to 16). The features of group (b) are aimed at providing a wiping action of the contacts to achieve good electrical conductance, as is apparent from the description of the second "facet", page 4, lines 19 to 21. The features of group (c), providing selective engagement between a moveable lever and an operator (push button 26),

address the problem of achieving a "trip free mode" of operation, ie to assure that the contacts may open in the event of an overload even when the push button is held down or jammed (page 2, lines 15 to 23; page 13, line 24 to page 14, line 1).

2.5 In this particular situation where it is immediately apparent that the three groups (a), (b), (c) identified in the invitation correspond to the three "facets" described in the application as addressing different problems, the board considers that it needed no further explanation as to why there was no correspondence in the "special technical features" of the different groups (a), (b), (c), so that it followed that they related to separately claimed inventions which did not fulfil the requirement of unity of invention. Thus the IPEA gave sufficient reasons in the invitation.

3. *Justification of the protest*

3.1 It remains to be decided whether the protest was justified by the presence of a single general inventive concept linking groups (a), (b), (c).

3.2 An invitation under Rule 68.2 PCT may be issued by the IPEA whether or not the question of unity has been raised by the ISA. However this requirement must in principle be judged by the same objective criteria by both the ISA and the IPEA (see PCT International Preliminary Examination Guidelines, III-7.10 and G 1/89, OJ 1991, 155, points 4 and 8.1, which also confirmed, under point 6, the binding nature of the PCT Guidelines). Both the ISA and the IPEA may exercise a discretion whether or not to issue an invitation (PCT International Search Guidelines, VII-12 and PCT International Preliminary Examination Guidelines, III-7.10 and VI-5.9). If no invitation is issued, the

ISA, contrary to the IPEA (Rule 68.1 PCT), need not necessarily indicate that the requirement of unity of invention is not fulfilled (cf Rule 40 PCT). Moreover, the ISA may only form a provisional opinion on novelty and inventive step for the purpose of carrying out an effective search which is in no way binding on the IPEA (G 1/89, *supra*, point 8.1). The fact that the Search Report does not indicate a lack of unity does not therefore imply that the requirement of unity of invention is fulfilled (cf W 9/94, *supra*, points 2.3 and 2.4). Nor does it imply that a single general concept has been searched and that this concept was found to be inventive by the ISA.

3.3 The applicant has not presented any arguments contesting the accuracy of the common concept specified in the invitation, nor the finding that it lacks novelty in view of DE-A-2 830 390. The board sees no reason to disagree with this finding.

3.4 It is clear to the skilled reader of the present application that the three different groups of claimed inventions may be provided independently in a trip mechanism for an overload relay and that they solve different problems (see above comments). They do not therefore contain corresponding technical features in the meaning of Rule 13.2 PCT.

4. *Amount of the required additional fees*

4.1 The invitation issued by the IPEA correctly referred, on its covering sheet, to the applicable regulations for International Preliminary Examination (Article 34(3) and Rule 68.2 PCT). It was therefore clear that the invitation was for the payment of additional examination fees (not search fees; see also Rule 104a(2) EPC).

4.2 The applicant does not contend that an excessive number of additional examination fees was requested. The IPEA admittedly requested a wrong amount of additional examination fees in the present case (see paragraph IV above), but the difference of DM 1,71 per additional fee paid in excess is to be considered as an insignificant amount, the refund of which falls under the provisions of Article 10c in combination with Article 1(b) of the Rules Relating to Fees and needs no decision by this board (see also W 4/95, unpublished, points 10 and 12, concerning refund of a part of additional fees under Rule 68.3(c) PCT).


5. The invitation by the IPEA to pay two additional fees was therefore justified.

Order

For these reasons it is decided that:

The protest according to Rule 68.3(c) PCT is dismissed.

The Registrar:



M. Kiehl

The Chairman:



W. J. L. Wheeler