

EJ0024.96 - 011420025

## **DECISIONS OF THE BOARDS OF APPEAL**

**Decision of the Legal Board of Appeal dated 27 April 2001**

**J 24/96 - 3.1.1**

(Language of the proceedings)

Composition of the board:

Chairman: J.-C. Saisset

Members: B. J. Schachenmann

M. K. S. Aúz Castro

**Applicant: G.D. SOCIETA' PER AZIONI**

**Headword: Unity of invention/G.D. SOCIETA' PER AZIONI**

**Article: 21(3)(c) EPC**

**Rule: 46(1), (2) EPC**

**Keyword: "Unity of invention - yes" - "Procedural violation - no"**

*Headnote*

*Within the framework of Rule 46 EPC it is the task of the examining divisions (and the boards of appeal) to examine whether communications of the search divisions under Rule 46(1) EPC asking for further search fees were justified. It is therefore not necessary for an examining division to deal in a decision under Rule 46(2) EPC with other objections raised by the applicants in connection with the search in question.*

## **Summary of facts and submissions**

I. The present appeal lies from a decision of the examining division of the EPO rejecting a request under Rule 46(2) EPC for refund of seven search fees paid by the applicant (appellant) on demand of the search division.

II. In its communication of 15 April 1993 the search division had pointed out that the inventions claimed in European patent application No. 92 120 123.2 lacked unity a posteriori. In its view the invention defined in independent claims 1 and 8 was anticipated by the disclosure of the prior art documents cited in the partial search report (GB-A-2 213 456 and EP-A-0 071 736). As a consequence, the inventions defined by each of the dependent claims 2 to 6 and 12 to 14 were not linked by a single inventive concept. The applicant was informed that if the search report was to cover these inventions a further search fee had to be paid for each invention involved.

III. The applicant thereupon asked for a complete search and paid seven additional search fees. The search division therefore made a complete search and transmitted it to the applicant.

IV. During examination the examining division maintained the objection of lack of unity. In its opinion the invention defined in independent claims 1 and 8 was anticipated by the disclosure of another prior art document (EP-A-0 031 515) and the dependent claims were no longer so linked as to form a single inventive concept as required by Article 82 EPC.

V. The applicant replied by filing new claims 1 and 8 limited against EP-A-0 031 515 thereby removing the objection of lack of unity. In addition, the applicant filed a request for refund of the further search fees he had paid.

VI. On 20 June 1996 the examining division issued a decision refusing the applicant's request for refund of the search fees on the following grounds:

The limitation added to claims 1 and 8 during examination, even if apparent from the description and the drawings, was not present in original claim 1. Thus, its subject matter had to be searched per se by the search division. Although the application related to a narrow technical field, at least some of the different inventions involved concepts, the search of which implied an extra effort. The principles set out in paragraph B-VII, 2.3 of the Guidelines for Examination in the EPO did not therefore apply. In contrast, if an independent claim appeared to be not patentable, the Guidelines (C-III, 7.8, last paragraph) required that the question of whether there was still an inventive link between the dependent claims needed to be carefully considered. Thus, the question of unity had to be examined also for the claims dependent from claims 1 and 8. For these reasons, the objection of lack of unity of invention raised by the search division was justified.

VII. The appellant filed an appeal against this decision on 25 July 1996 paying the full appeal fee on 31 July 1996. In the statement of grounds filed on 1 August 1996 the appellant pointed out with regard to the issue of unity of invention that the search division had classified the patent application and all the related inventions in a single subgroup of the International Patent Classification (B65B-41/06) and that all relevant documents cited in the search report were classified in three subgroups, namely B65B-41/06, B65B-41/12 and B65B-41/14. This showed that the alleged different inventions all related to the same very narrow technical field which could have been searched without particular extra effort. The appellant also contested the finding that the original independent claims 1 and 8 lacked novelty over the documents cited in the partial search report. In particular, none of these documents contained the step of drawing the portions (8) of wrapping material via the gripping means (47) along the transportation surface. Since, therefore, the original independent claims 1 and 8 were novel, the objection of lack of unity a posteriori was not justified.

In addition, the appellant pointed to alleged procedural violations committed by both the search division and the examining division.

A first procedural violation concerned the drawing up of the partial search report. Since it was drawn up only for claims 1, 2, 8 and 9, it was incomplete as it should also have covered, according to paragraph B-III, 3.8 of the Guidelines, all the claims dependent from the searched claims 2 and 9. A second procedural violation followed from the fact that the examining division disregarded this objection in its decision although it had been raised in the request for refund of the search fees.

Based on these arguments the appellant requests that the contested decision be set aside and that

- the alleged non-unity be reconsidered,
- the further search fees be reimbursed,
- the appeal fee be reimbursed.

### **Reasons for the decision**

1. The appeal complies with the provisions mentioned in Rule 65(1) EPC and is therefore admissible.
2. The decision of the examining division under appeal was limited to the issue of a refund of further search fees under Rule 46(2) EPC. It did not, therefore, concern the refusal of the application or the grant of the patent. Thus, according to Article 21(3)(c) EPC, the Legal Board of Appeal is responsible for the examination of the present appeal.
3. The only issue at stake is whether or not the communication of the search division of 15 April 1993 (see point II., supra) was justified (Rule 46(2) EPC). The examining division answered this issue in the affirmative.

The communication of the search division was based on an assessment of unity a posteriori, i.e. after taking the prior art into consideration. Thus, lack of unity was a consequence of the finding of the search division that "from the prior art, see search report, a method and device for feeding portions of wrapping material to a wrapping machine as described in claims 1 and 8 are known". Only if and to the extent that this finding was correct, was the communication of lack of unity justified. It has therefore to be examined whether original claims 1 and 8 were indeed anticipated by the prior art cited in the partial search report, i.e. by the disclosure of the documents GB-A-2 213 456 (D1) and EP-A-0 071 736 (D2).

3.1 The invention according to original claim 1 concerns a method of feeding portions (8) of a wrapping material (e.g. pieces of paper) to a wrapping machine. The wrapping machine has a transfer station (5) in which the portions of the wrapping material are folded about the products (4) to be wrapped.

One of the characterising features of this claim is that the portions of the wrapping material "**are drawn** ... towards the transfer station" (emphasis added). In particular, gripping means (47) are brought "successively into engagement ... with the portions ... and so **drawing** the portions, via said gripping means, along the transportation surface" (emphasis added). According to the description the advantage of the claimed method results from the fact that the portions of wrapping material are transported **by drawing** (=pulling), whereas in the prior art they were transported by **pushing** (see e.g. column 1, lines 34 ff) which could result in curling. Thus, it is clear from the application as filed that the feature of transporting the portions of wrapping material **by drawing** as opposed to pushing is an important feature. It implies that the transportation forces are only applied to the front region of the portions of wrapping material.

3.2 According to the prior art documents D1 and D2 cited by the search division the wrapping material is fed by means of endless vacuum conveyor belts pneumatically holding the portions of wrapping material along the side margins over their whole

length. Thus, the feeding of these portions involves pushing forces applied to the end region of each portion so that the risk of curling cannot be avoided.

3.3 By virtue of the feature referred to in para 3.1 the subject matter of independent claims 1 and 8 is therefore distinguished over the cited prior art. It seems that the search division did not recognise the importance of this aspect because it did not attribute to the expression "draw" (=pull) the specific technical meaning which follows from the teaching of the application. However, as set out above, this feature constitutes a general inventive concept common to all the claims (Article 82 EPC). Consequently, the objection of lack of unity of the dependent claims was not justified. The further search fees have therefore to be refunded.

4. Since the appeal is allowable, the further question arises whether the requested reimbursement of the appeal fee is equitable by reason of a substantial procedural violation (Rule 67 EPC) as submitted by the appellant (paragraph VII., supra).

As far as the communication of the search division under Rule 46(1) EPC is concerned, the Board agrees with the appellant that the assessment of lack of unity of invention was not correct (paragraph 3.3, supra). However, this was a mere error in judgement which cannot be regarded as a procedural violation. As to the alleged incompleteness of the partial search report, it has to be considered that the failure of a department of the EPO to follow a procedure set out in the Guidelines is not in itself a procedural violation as the Guidelines are not legally binding (see e.g. decision T 42/84, OJ 1988, 251).

The second objection of the appellant raises the issue of whether, in its decision, the examining division should have dealt with the alleged incompleteness of the partial search report. Within the framework of Rule 46 EPC it is the task of the examining divisions (and the boards of appeal) to examine whether communications of the search divisions under Rule 46(1) EPC asking for further search fees were justified. Rule 46(2) EPC does not, however, refer to any acts of the search divisions other than communications issued under Rule 46(1) EPC. It is therefore not necessary for

an examining division to deal in a **decision under Rule 46(2) EPC** with other objections raised by the applicants in connection with the search such as for example the objection that the partial search report was not drawn up in accordance with the Guidelines. To avoid any misunderstanding, the Board observes that the examining divisions of course have the possibility of arranging for an additional search to be performed, if they consider a search report delivered by the search division incomplete. But this has nothing to do with a formal decision issued under Rule 46(2) EPC concerning refund of further search fees upon request.

The Board cannot therefore find a substantial procedural violation by reason of which the reimbursement of the appeal fee would be equitable.

### **Order**

#### **For these reasons it is decided that:**

1. The decision under appeal is set aside
2. Refund of the further search fees paid by the applicant is ordered.
3. The request for reimbursement of the appeal fee is rejected.