

Internal distribution code:

- (A) [] Publication in OJ
(B) [] To Chairmen and Members
(C) [] To Chairmen
(D) [X] No distribution

**Datasheet for the decision
of 15 September 2011**

Case Number: T 1276/10 - 3.3.09

Application Number: 97928656.4

Publication Number: 0951383

IPC: B32B 3/00

Language of the proceedings: EN

Title of invention:

Retroreflective articles having microcubes, and tools and methods for forming microcubes

Applicant:

Avery Dennison Corporation

Opponent:

-

Headword:

-

Relevant legal provisions:

EPC R. 137(5)

Relevant legal provisions (EPC 1973):

-

Keyword:

"Amended claims relating to unsearched subject-matter"

Decisions cited:

G 0002/92

Catchword:

-



Case Number: T 1276/10 - 3.3.09

D E C I S I O N
of the Technical Board of Appeal 3.3.09
of 15 September 2011

Appellant: AVERY DENNISON CORPORATION
150 North Orange Grove Boulevard
Pasadena
CA 91103 (US)

Representative: Hooiveld, Arjen Jan Winfried
Arnold & Siedsma
Sweelinckplein 1
NL-2517 GK Den Haag (NL)

Decision under appeal: Decision of the Examining Division of the
European Patent Office posted 2 February 2010
refusing European application No. 97928656.4
pursuant to Article 97(2) EPC.

Composition of the Board:

Chairman: W. Sieber
Members: J. Jardón Álvarez
R. Menapace

Summary of Facts and Submissions

I. This appeal lies from the decision of the examining division dated 2 February 2010, refusing European patent application No. 97 928 656.4.

II. The decision under appeal was based on a set of 33 claims filed with letter dated 3 October 2008. Claim 1 read as follows:

"1. An article comprising an array of microcubes (100), such that for every plane in space there are two adjacent microcubes (100) for which at the place of the adjacency none of the face edges is parallel to that plane, at least one of the microcubes (100) having a projected area of less than 1mm^2 , the at least one microcube (100) being either canted edge-more-parallel or canted face-more-parallel."

Claims 2 to 33 were dependent claims.

III. As grounds for the decision the examining division stated that the applicant had been informed in the communications dated 25 March 2008 and 23 October 2009 that the application did not meet the requirements of the European Patent Convention and that the applicant was also informed of the reasons therein. The examining division also noted that the applicant had not filed comments or amendments in reply to the latest communication but had requested a decision according to the state of the file by a letter received on 22 January 2010.

In particular the examining division raised the objection in its communication dated 23 October 2009 that the subject-matter of the pending claims did not fulfil the requirements of Articles 84 and 123(2) EPC. Under these circumstances, the examining division did not consider it appropriate to examine the application with respect to Articles 52 to 56 EPC.

IV. On 30 March 2010 the applicant (appellant) filed a notice of appeal and paid the appeal fee on the same day. The statement setting out the grounds of appeal was filed on 26 May 2010.

With the statement setting out the grounds of appeal the appellant filed a set of ten amended claims to replace the previous claims.

The set of claims included two independent claims, claims 1 and 5, reading as follows:

"1. A method for making an article having a non-rulable pattern of microcubes, said method comprising providing a plurality of about microthick plates, each plate having at least one end provided with a plurality of microcube faces by providing a plurality of grooves in the end of said plate, and arranging said plurality of plates such that said microcube faces define a non-rulable pattern of microcubes, said pattern being comprised of the faces of said grooves in said ends of said plates."

"5. An article comprising a non-rulable array of microcubes, said article being obtained by providing a plurality of about microthick plates, each plate having

at least one end provided with a plurality of microcubes by providing a plurality of grooves in the end of said plate, and arranging said plurality of plates such that said microcubes define said non-rulable array of microcubes."

- V. On 1 August 2011 the board dispatched the summons to oral proceedings scheduled to take place on 10 November 2011. In the annexed communication pursuant to Article 15(1) of the Rules of Procedure of the Boards of Appeal, the board indicated that, in its preliminary view, the appeal was likely to be dismissed, because the claims now on file had not been searched and could not be pursued in the present application.
- VI. With a letter dated 29 August 2011, the appellant informed the board that it would not attend the oral proceedings scheduled for 10 November 2011 and withdrew its request for oral proceedings.
- VII. By communication dated 15 September 2011 the oral proceedings were cancelled.

Reasons for the Decision

1. The appeal is admissible.
2. The examining division refused the application because the subject-matter of the then pending claims did not fulfil the requirements of Articles 84 and 123(2) EPC.
3. The appellant has replaced the claims before the examining division with a new set of claims.

Independent claims 1 and 5 of the present set of claims are essentially based on the disclosure of original claim 68. They relate to a method of making an article having a non-rulable pattern of microcubes using a plurality of microthick plates (claim 1) and to an article comprising a non-rulable array of microcubes obtained by carrying out the process of claim 1 (claim 5). The remaining claims are directly or indirectly dependent on these claims.

4. *Status of the claims*

- 4.1 In the partial European search report under Rule 46(1) EPC 1973, the search division found that the application lacked unity of invention and identified thirteen inventions or groups of inventions in the application. The eleventh invention concerned claims 68 to 109 as originally filed and was directed to microthick plates for use in the manufacture of an article having microcubes and a method of making them (see communication dated 25 October 2000).
- 4.2 The appellant applicant paid under protest one additional search fee to have the second invention or group of the inventions identified by the search division searched. The appellant did not contest the finding that the other inventions indicated in the communication of the search division lacked unity and no additional search fee was paid for the subject-matter of the further inventions including the eleventh invention mentioned above (claims 68 to 109).
- 4.3 The supplementary search report was drawn up for the first two inventions, that is to say, for claims 1, 2,

4-28, 40-43 and 110-112 (see supplementary European search report dated 3 April 2001). However, no search was carried out for the further inventions. Claim 68, which is the base of the present set of claims, relates to an invention for which no further search fee was paid and therefore has not been searched.

4.4 According to G 2/92 (OJ EPO 1993, 591) "An applicant who fails to pay the further search fees for a non-unitary application when requested to do so by the Search Division under Rule 46(1) EPC [1973] cannot pursue that application for that subject-matter in respect of which no search fees have been paid. Such an applicant must file a divisional application in respect of such subject-matter if he wishes to seek protection for it." (See Headnote)

4.5 The ruling of G 2/92, i.e. that an applicant who fails to pay the further search fees for a non-unitary application when requested to do so by the search division cannot pursue that application for the subject-matter in respect of which no search fees have been paid, applies to the present case since the subject-matter of claims 1 to 10 is directed to an unsearched invention. The claims thus contravene the requirements of Rule 137(5) EPC.

4.6 As pointed out in G 2/92, the appellant may continue to pursue the subject-matter of such claims only in the form of a divisional application in accordance with Article 76 EPC.

4.7 The appellant was informed by the board that the claims could not be pursued in the present application and it

has not commented on that finding. In fact the appellant had already filed a divisional application with the claims which are the subject of the present appeal (cf. European patent application number 10166036.3).

5. In summary, the present claims relate to unsearched subject-matter, and are therefore not allowable; there are no further requests on file.

Order

For these reasons it is decided that:

The appeal is dismissed.

The Registrar:

The Chairman:

G. Röhn

W. Sieber