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Aktenzeichen / Case Number / N° du recours : T 101/88 - 3.2.1

Anmeldenummer / Filing No / N° de la demande : 83 308 035.1

Veröffentlichungs-Nr. / Publication No / N° de la publication : 0 113 256

Bezeichnung der Erfindung: Improvements in or relating to labelling apparatus
Title of invention:
Titre de l'invention :

Klassifikation / Classification / Classement : B65C 9/18, B65C 9/42, B65C 9/36

ENTSCHEIDUNG / DECISION

vom / of / du 21 May 1990

Anmelder / Applicant / Demandeur : Sinclair International Limited

Patentinhaber / Proprietor of the patent /
Titulaire du brevet :

Einsprechender / Opponent / Opposant :

Stichwort / Headword / Référence :

EPÜ / EPC / CBE Article 82; Rule 46(1)

Schlagwort / Keyword / Mot clé : "Unity of invention to be assessed on the basis of the valid documents" - "Introduction of unsearched features from the description".

Leitsatz / Headnote / Sommaire

Europäisches
Patentamt
Beschwerdekammern

European Patent
Office
Boards of Appeal

Office européen
des brevets
Chambres de recours



Case Number : T 101/88 - 3.2.1

D E C I S I O N
of the Technical Board of Appeal 3.2.1
of 21 May 1990

Appellant : Sinclair International Limited
22 Hellesden Hall Industrial Park
Norwich, NR6 1DR (GB)

Representative : Low, Peter John et al
Wilson, Gunn, Ellis & Co.
41 Royal Exchange
Manchester, M2 7BD (GB)

Decision under appeal : Decision of Examining
Division 2.3.08.080 of the European
Patent Office dated 8 September 1987
refusing European patent application
No. 83 308 035.1 pursuant to
Article 97(1) EPC

Composition of the Board :

Chairman : F. Gumbel
Members : S. Crane
J.-C. Saisset

Summary of Facts and Submissions

- I. European patent application 83 308 035.1 was refused by a decision of the Examining Division dated 8 September 1987.
- II. The decision was based on new Claims 1 and 2 received on 20 December 1986 together with original Claims 3 to 18.
- III. The reason given for the refusal was lack of unity of invention (Article 82 EPC). The Examining Division argued that the subject-matter of the new Claim 1 lacked unity with that of the original Claim 1, since they were not linked by a single general inventive concept, the features common to the two claims not being novel. Furthermore, the Appellants (Applicants) had been informed by the Search Division, in a communication under Rule 46(1) EPC, that the application lacked unity and had been invited to pay further search fees. Since the Appellants had not paid these further search fees and the Examining Division found the objections of the Search Division to be justified, the Appellants had foregone the right to pursue not only claims to the further unsearched inventions listed in the Search Report, but also claims, such as the new Claim 1, to additional inventions derived by combining features of the claims that had been searched with features not appearing in the original claims, which consequently had not been searched. The Examining Division based its position essentially on the Guidelines, C-III, 7.6 and C-VI, 3.2(c) in the version of July 1987.
- IV. A Notice of Appeal was filed by telex on 16 November 1987, duly confirmed by letter received on 20 November 1987, and the appeal fee was paid on 17 November 1987. A statement setting out the grounds of appeal was filed by telefax on 15 January 1988 and confirmed by letter received on 22 January 1988.

- V. The Appellants request, by implication, that the decision of the Examining Division be set aside and the case be remitted to the Examining Division for continuation of substantive examination. They argue that the position taken by the Examining Division is unjustified and finds no support in the EPC.
- VI. The new Claim 1 received on 20 December 1986 has the following wording:

"A high speed labelling apparatus for sequentially applying labels to fruit and vegetables, said apparatus comprising a label applying means, means for rotating the label applying means between a label receiving position and a label applying position, means for supplying labels from a carrier to the label applying means at the label receiving position, said label applying means including label handling means adapted to receive and retain a label at the label receiving position and adapted to move outwardly from said label applying means at least at said label applying position to deposit a label on an item of fruit or a vegetable characterised in that the means for supplying labels is adapted to supply a label after separation thereof from the carrier to the moving applying means in a direction substantially the same as the direction of movement of the label applying means and a speed not less than the linear speed of the label applying means."

Claim 1 as originally filed reads as follows:

"A labelling apparatus for sequentially applying labels to objects, said apparatus comprising a label applying means, means for rotating the label applying means between a label

receiving position and a label applying position, means for supplying labels to the label applying means at the label receiving position, said label applying means including label handling means adapted to receive and retain a label at the label receiving position and adapted to move outwardly from said label applying means at least at said label applying position to deposit a label on an object."

Reasons for the Decision

1. The appeal complies with Articles 106 to 108 and Rule 64 EPC and is admissible.
2. The question as to whether lack of unity of invention can exist between subsequently filed claims and the original claims has been considered at length in Decision T 178/84 (OJ EPO 1989, 157). The present Board supports the conclusion made there that unity of invention according to Article 82 EPC is a requirement that can only be judged on the basis of the valid documents that at any particular point in time constitute the application. The objection made by the Examining Division that the subject-matter of valid Claim 1 received on 20 December 1986 lacked unity of invention with the subject-matter of Claim 1 as originally filed is not supported by the EPC and cannot, therefore, be allowed to stand.
 - 3.1 However, it still has to be considered whether the subsidiary argument advanced by the Examining Division, pertaining to the effects of Rule 46(1) EPC, might nevertheless in fact present a hurdle to pursuance of the application on the basis of this new Claim 1.
 - 3.2 The case considered in Decision T 178/84 is different from the present one in that there, no objection to lack of

unity had been raised by the Search Division. Nevertheless, this earlier decision considers in detail what the effects of an applicant not paying the further search fees required by the Search Division with a communication under Rule 46(1) EPC are and comes to the conclusion that the unsearched subject-matter cannot be pursued in the original application.

According to the above decision, Guidelines C-VI, 3.2(c), in the version of July 1987 which requires that any amendment "must not result in claims for an invention or inventions not forming unity with the invention or inventions originally claimed and in respect of which search fees have been paid (see III, 7.10 and 7.11)," had to be interpreted as referring to such a situation mentioned above and not to lack of unity per se as understood by the Examining Division.

Since the issuance of Decision T 178/84, this section of the Guidelines (C-VI, 3.2(a)) has in fact been amended to reflect the views expressed in the decision and now reads:

"If the applicant has not responded to an invitation of the Search Division under Rule 46, paragraph 1, to pay a further search fee in respect of certain subject-matter and the Examining Division considers that the objection of the Search Division was justified, the application will not be allowed to proceed with claims for that subject-matter. The applicant may, however file a divisional application for that subject-matter."

- 3.3 The present Board shares the view that in the circumstances mentioned above, the Examining Division may refuse to allow the application to proceed with claims to subject-matter that should be deemed to be abandoned.

The question is whether these circumstances prevail in the present case.

The Search Report sets out three inventions which the Search Division has identified. These are:

- "(1) Claims 1-7, 17, 18: Rotating label applying means combined with a label supplying means delivering labels from a backing strip.
- (2) Claims 1, 8-10: Apparatus as in Claim 1, where the supply of labels is stored in a detachable housing.
- (3) Claims 1, 11-16: Labelling apparatus as in Claim 1 where bellows connected with high or low air pressure supply are used as label handling means."

In accordance with Rule 46(1) EPC, the search was limited to the first of these inventions. There is no requirement that a communication under Rule 46(1) EPC be reasoned, but it is in any case clear from the context of the Search Report as a whole that an objection of lack of unity a posteriori has been made, the subject-matter of Claim 1 not being considered novel.

The new Claim 1 of 20 December 1986 contains in its preamble all of the features of the original Claim 1, together with the limitations that

- (a) the labelling apparatus is a "high-speed" apparatus for applying labels to "fruit and vegetables";
- (b) the labels are supplied from a "carrier".

The characterising clause of the claim states that

- (c) "the means for supplying labels is adapted to supply a label after separation thereof from the carrier to the moving applying means in a direction substantially the same as the direction of movement of the label applying means and a speed not less than the linear speed of the label applying means."

Of these features, only feature (b) appears anywhere in the original claims, i.e. in a somewhat more precise form in Claim 2. Accordingly, it does not seem possible to argue that the subject-matter of the new Claim 1 has effectively been abandoned through non-payment of further search fees required under Rule 46(1) EPC, since this subject-matter did not actually appear in those claims for which the fees would have had to have been paid.

In this respect, the Examining Division argues that the new Claim 1 effectively constitutes a fourth independent invention in addition to the three inventions listed in the Search Report and that since this invention has not been searched the Appellants have lost the right to seek protection for it, except in a divisional application. However, it would not correspond to the normal principles of a fair procedure that an applicant be deemed to lose a right for not meeting a requirement that he in fact was never required to meet, i.e. in this case to pay a further search fee for the invention defined in new Claim 1. Moreover, apart from this fundamental principle, it is by no means clear that if, in particular, the features of the present characterising clause had been present in a claim dependent on original Claim 1, then the Search Division would not have considered them as belonging to the first invention listed in the Search Report and have searched them accordingly. The subsidiary line of argument of the Examining Division therefore fails.

- 3.4 The logical extension of the line of argument advanced by the Examining Division would be to refuse any amendment which consisted of adding features from the description, which had not appeared in the original claims, to form a new main claim, this quite irrespective of whether a communication under Rule 46(1) EPC had been issued at all. It is, however, the established case law of the Boards of Appeal, see for example Decision T 169/83 (OJ EPO 1985, 193) and Decision T 17/86 (OJ EPO 1989, 297) that, subject of course to the provisions of Article 123(2) EPC, amendments of this nature are not objectionable. If, in the opinion of the Examining Division, the amendment necessitates an additional search, then this should be ordered, as clearly provided for in the Guidelines C-VI, 8.5.

In contrast to the belief of the Appellants who have offered to pay such a fee, the EPC does not provide for an additional search fee in these circumstances.

4. Concerning the status of the second and third inventions listed in the Search Report, the deletion of which has been required by the Examining Division on the basis of Guidelines C-III, 7.10, the Board considers it necessary to make some observations.

Although there might well be situations in which the requirement of deleting inventions which have not been searched is justified, the present case does not belong to them. The three inventions listed in the Search Report all have in common the subject-matter of original Claim 1, the objection of lack of unity of the Search Division having been made a posteriori, and relate to different aspects of the single preferred embodiment described in the application. These aspects are the features of original dependent Claims 8 to 10 and 11 to 16 for the second and

third inventions respectively. Having regard to the above, the deletion of the second and third inventions would seem to require, therefore, as a matter of logic, the deletion of the subject-matter of original Claim 1, which, of course, is impossible since it would leave nothing in the application. Even if the more limited interpretation is applied that only the features defined in Claims 8 to 16 should be excised, this would so decimate the disclosure of the single preferred embodiment that it would no longer be understandable. Clearly, this is impractical and unrealistic.

5. As is stated in the decision under appeal, the Examining Division has not yet investigated whether the subject-matter of the new Claim 1 involves an inventive step, since it is not clear whether this subject-matter has been fully searched. If the Examining Division considers an additional search to be necessary, this should be ordered, as indicated above. The Examining Division should also consider the allowability of the amended claims with regard to formal requirements, such as those according to Articles 123(2) and 84 EPC.

In the given circumstances, the Board deems it appropriate to remit the case to the first instance in accordance with Article 111(1) EPC, second phrase.

Order

For these reasons, it is decided that:

1. The decision under appeal is set aside.

2. The case is remitted to the first instance for further examination on the basis of the following documents:

Claims 1 and 2 received on 20 December 1986;

Claims 3 to 18 as originally filed;

page 3 of the description received on 20 December 1986;

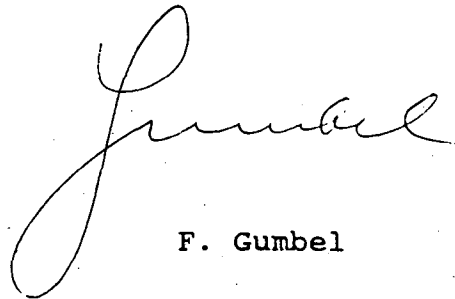
the remainder of the description and drawings as originally filed.

The Registrar:



S. Fabiani

The Chairman:



F. Gumbel

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