



Case Number : T 94/91

D E C I S I O N
of the Technical Board of Appeal 3.4.2
of 9 September 1991

Appellant : ECC International Limited
John Keay House
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Cornwall PL25 4DJ (GB)

Representative : Cheyne, John Robert Alexander
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Decision under appeal : Decision of Examining Division of the European
Patent Office dated 25 September 1990 refusing
refund of the additional search fee paid in
respect of European patent application
No. 84 300 376.5 pursuant to Rule 46(1) EPC.

Composition of the Board :

Chairman : E. Turrini
Members : C. Payraudeau
W. Hofmann

Publication in the Official Journal ~~Yes~~ / No

File Number: T 94/91
Application No.: 84 300 376.5
Publication No.: 0 117 071
Title of invention: Pressure Filters

Classification: B01D 29/14; B01D 25/12

D E C I S I O N
of 9 September 1991

Applicant: ECC International Limited

Headword: Unity/ECC

EPC Articles 82, 92; Rule 46(1) and (2)

Keyword: "Objections against non-unity a posteriori, common inventive concept" - "Combinations of claims not all covered by common concept"

Headnote

Summary of Facts and Submissions

- I. On 23 January 1984, the Appellants filed the European patent application No. 84 300 376.5 (publication No. 0 117 071) claiming priority of two UK applications respectively filed on 24 January 1983 and 21 February 1983.
- II. With a communication dated 16 December 1986, the Search Division of the EPO transmitted to the Appellants a partial European search report under Rule 46(1) EPC and informed them that if the European search report was also to cover the invention other than the invention first mentioned in the claims a further search fee had to be paid for the second invention.
- III. The Appellants paid the further search fee on 23 January 1987 indicating their intention to request a refund of this fee.
- IV. In a first communication dated 12 December 1988 notified to the Appellants pursuant to Article 96(2) and Rule 51(2) EPC, the Examining Division informed them that the lack of unity of the original set of claims was confirmed because the original Claim 1 was not patentable in view of the document BE-A-658 643, and that there was no single general inventive concept linking the groups of original Claims 11 to 16 and 17 to 23, both groups being directly dependent on Claim 1 (lack of unity a posteriori).
- V. In a letter received at the EPO on 5 February 1990, the Appellants maintained their request for a refund of the further search fee asking for an appealable decision to be rendered on this point. The Appellants argued that "even if the concept of lack of unity a posteriori" has any logical basis, the fact remains that the Search Examiner

failed to find any document relevant to Claims 4, 6 or 8 (on which both groups of Claims 11-16 and 17-23 were also dependent). Consequently, according to the Search Examiner a concept embracing all embodiments disclosed in the application was both novel and inventive with regards to the state of the art. There was therefore no justification for the Search Examiner to conclude that he had disposed of all claimed subject-matter common to all the embodiments to the extent that a further search was necessary.

VI. By an interlocutory decision within the meaning of Article 106(3) EPC, the Examining Division refused to refund the additional search fee on the ground that since the original Claim 1 was anticipated by the document BE-A-658 643 and therefore invalid, the tube pressure filter covered by Claim 11 and the plate filter press covered by Claim 17 insofar as these claims were independently of each other directly appended to Claim 1 had no more a common inventive concept - although the Appellants' argumentation could have been followed if Claims 11 and 17 had been originally limited to the combination of each of these claims with Claim 1, 4, 6 and/or 8.

VII. The Appellants filed an appeal against this decision arguing essentially as follows:

(a) the invention or the general inventive concept of Article 82 can be assessed only from a consideration of the application as a whole and cannot simply be equated with the features recited in a claim; in the present case, the invention is defined in progressively narrower terms in Claims 1 to 10, the two other groups of claims concerning inventions relating to the same concept;

- (b) except for the cases when the generic claim represents a transparently artificial attempt to link what are self evidently, from the application as a whole, different inventive concepts, it is inappropriate to apply an "a posteriori" consideration of lack of unity at the search stage of the application; assessment of "a posteriori" lack of unity in such cases is not susceptible to provisional and preliminary consideration; an assessment could only be made on the basis of full substantive examination of the application;
- (c) the treatment of European patent applications as far as requests for additional search fees are concerned, should not be harsher than the treatment of International applications by the EPO acting as an International Search Authority.

VIII. The Appellants also requested refund of the appeal fee as they considered that the request for an additional search fee made in the present case represented a substantial procedural violation.

IX. In a communication sent to the Appellants on behalf of the Board, the Rapporteur expressed the provisional view that the application in suit related to a group of inventions so linked as to form a single general inventive concept and that consequently the further search fee paid by the Appellants should be reimbursed. However, it did not seem to the Board that the decisions of the Search and Examining Divisions could be considered as vitiated due to a substantial procedural violation rendering equitable the reimbursement of the appeal fee.

X. In answer to the communication, the Appellants withdrew their request for reimbursement of the appeal fee for the

case the Board would decide to reimburse the additional search fee.

Reasons for the Decision

1. The appeal is admissible.
2. The Examining Division refused the reimbursement of the further fee paid by the Appellants for having Claims 17 to 24 of their application searched on the ground that the subject-matter of original Claim 11 was, in particular, a tube pressure filter covered by original Claim 1 and the subject-matter of original Claim 17 was, in particular, a plate filter press covered by original Claim 1, the features of original Claim 1 being the sole common concept of these two different subject-matters. This common concept being not new in view of a document found during the search, the search examiner was entitled to ask for a further search fee irrespective of the fact that original Claims 4, 6 and 8 were not anticipated by this document.
3. The Appellants have objected that there was no basis in the EPC for an "a posteriori" lack of unity objection so that the Search and Examining Divisions were not entitled to respectively raise and maintain this objection.
4. The Board of Appeal cannot accept this interpretation. Article 82 EPC clearly provides that the European patent applications must satisfy the criteria of unity of invention without any restriction. There is no difference in the EPC between "a priori" and "a posteriori" lack of unity. Therefore, the European patent applications must fulfill the condition of unity and it is of no importance whether the non-unity appears immediately or only in view

of a document found during the search or during the examination.

This is also the interpretation given in the Guidelines (B-VII, 5; C-III, 7.6) and in the opinion G 2/89 (AB1 1991, 166) of the Enlarged Board of Appeal which, although it relates to PCT applications, may be referred to since it concerns a similar procedure.

5. The Board therefore considers that the Examining Division was entitled to raise in the decision under appeal an objection of lack of unity "a posteriori".
6. However the Board has reached the conclusion that the decision under appeal should be reversed for the following reasons:

As submitted by the Appellants, the general inventive concept such as defined in Article 82 EPC cannot be equated with the features recited in a claim or in a particular combination of claims. What should be considered is the inventive concept as defined in the claims with due regard to the description and any drawings (cf. also Article 92 EPC).

In the present case, it resulted clearly from the description and the claims considered as a whole that the subject-matter of the application was a pressure filter - of no particular geometrical overall configuration - having primarily to do with the features defined in (original) Claims 1 to 10, and that this general concept was applicable, on the one hand, in a tube pressure filter (Claims 11 to 16) and, on the other hand, in a plate filter press (Claims 17 to 23), with the respective modifications necessary to adapt them to the general

concept of the invention of Claims 1 to 10. This general concept according to Claims 1 to 10 was not shown by the documents of the European search report as completely lacking in novelty or inventive step.

The main invention (Claims 1 to 10) provided, therefore, a clear link between its applications in the two different configurations of a filter press even if some-but not all - of the possible combinations of these claims might lead to subject-matter not fully covered by this general inventive concept.

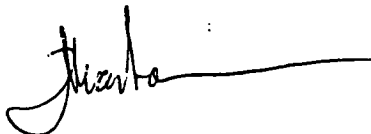
7. Consequently, the Board considers that the present patent application related to a group of inventions so linked as to form a single general inventive concept and that the conditions of Article 82 EPC were satisfied.

Order

For these reasons, it is decided that:

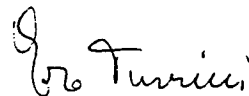
1. The decision under appeal is set aside.
2. The reimbursement of the further search fee is ordered.

The Registrar:



P. Martorana

The Chairman:



E. Turrini

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