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File Number: T 561/91 - 3.3.3
Application No.: 86 301 051.8
Publication No.: 0 191 649
Title of invention: Heat curable composition

Classification: C08J 3/24

D E C I S I O N
of 5 December 1991

Applicant: RAYCHEM LIMITED

Headword:

EPC Rule 35(12)

Keyword: "Use of metric or SI units"

Headnote

Rule 35(12) imposes on an applicant for a European patent the obligation to express weights and measures in metric units. Consequently, in the absence of any amendment to that Rule, the organs of the EPO have no power to require an applicant to express weights and measure in terms of SI units as a condition for the grant of a patent.



Case Number : T 561/91 - 3.3.3

D E C I S I O N
of the Technical Board of Appeal 3.3.3
of 5 December 1991

Appellant : RAYCHEM LIMITED
Rolls House
7, Rolls Buildings
Fetter Lane
London, EC4 1NL (GB)

Representative : Jay, Anthony William
Raychem Limited
Intellectual Property
Law Department
Faraday Road
Dorcan
Swindon, Wilts (GB)

Decision under appeal : Decision of Examining Division of the European
Patent Office dated 27 May 1991 refusing European
patent application No. 86 301 051.8 pursuant to
Article 97(1) EPC.

Composition of the Board :

Chairman : F. Antony
Members : R. Lunzer
R. Schulte

Summary of Facts and Submissions

I. European patent application No. 86 301 051.8, Publication No. 0 191 649, was filed on 14 February 1986, having a priority date of 15 February 1985 derived from British Application No. 85 03882.

II. By its decision, given in writing on 27 May 1991, the Examining Division refused the application on the sole ground that the Applicant had refused to express certain viscosity limits, which were identified in terms of centipoises, in the recognised SI units of viscosity.

Claim 1 was a long claim defining a heat curable composition, the particles of which carried a binder, with a proviso expressed in these terms:

"provided that if the viscosity of the binder is not more than 20,000 centipoises at 25°C then"

References to centipoises were also to be found in the description, and in Claims 5, 6, 7, and 8.

III. In its decision, the Examining Division referred to its letter of 9 February 1990, which drew attention to an extract from a German language book entitled "Die neuen Einheiten" by Hans Forst (1st edn. Berlin 1977) which listed centipoises as one of the units which was no longer valid (ungültig). Reference was also made to its letter of 25 October 1990, which drew attention to the relevant provision of the Guidelines for Examination, C.II. 4.15, expressed in the following words:

'The metric system of units of weights and measures must be used or, if another system is used, the units must also be expressed in the metric system. Similarly,

temperature must be expressed at least in degrees Celsius or, in cryogenics, in kelvins. Other physical values must be expressed in the units recognised in international practice. These requirements of Rule 35, paragraph 12, should be interpreted so as to conform with EEC Directive 71/354/EEC on units of measurement as amended by EEC Directive 76/770/EEC (published in the Official Journal of the European Communities, 27 September 1976) since although this Directive is directly applicable only to Community States it corresponds to generally recognised international practice. The relevant provisions of this Directive are shown in Annex 1 to this Chapter. Thus "metric units" should be interpreted to mean "SI units".'

In fact Annex 1 to the Guidelines consists solely of Chapter A of the Directive. Its title is, "Units of measurement, the use of which must be made mandatory as from 21 April 1978 at the latest", and it consists of five sections which identify or define SI units.

IV. An appeal against that decision was lodged on 12 July 1991, the payment of the appeal fee, and the filing of the Grounds of Appeal, both being effected on the same day. In its T 561/91 Statement of Grounds of Appeal, the Appellant contended that the Examining Division was wrong in its insistence on the use of SI units, because the centipoise qualified for use under Rule 35(12) EPC, either on the ground that it was a unit of measure of the "metric system", or that it was a "physical value expressed in the units recognised in international practice".

IV. Pursuant to its duties under Article 114(1) EPC, the Board made some investigation of the factual background to the present appeal. This revealed that the search for a uniform system of units began essentially with the

adoption of the metric system by France in 1793. Since then, the trend towards uniformity in the choice of units has gathered momentum, there having been a series of international conferences directed to this goal since 1875. A short historical survey is to be found inter alia in the Encyclopedia of Chemical Technology by Kirk-Othmer, Third Edition (1980) Volume 23 at page 491.

An important development in the direction of achieving a uniform system of units was the 11th General Conference on Weights and Measures in 1960, which established the International System of Units, now known generally as "SI units", based on the French language "Le Système International d'Unités". Since 1960, there have been developments and refinements of the SI units, with the trend towards their adoption in preference to other units continuing worldwide.

Nevertheless, it was clear from that work of reference, and equally from other works referred to by the Board, that the metric system is a known system of units, which is still in use, even if at the present time it is gradually being replaced by the SI system.

- V. The Appellant requested that the examination of the application should proceed, despite the fact that it wished to refer to viscosity in terms of centipoises, without conversion to SI units.

Reasons for the Decision

1. The appeal complies with Articles 106 to 108 and Rule 64 EPC and is admissible.

2. For the purposes of the present appeal, the essential issue is the correct interpretation of Rule 35(12) EPC. So far as is material, that Rule is in the following terms:

"Units of weights and measures shall be expressed in terms of the metric system. (A reference to temperature measurements follows).

For the other physical values, the units recognised in international practice shall be used."

3. The Board has looked at the French and German texts, and finds that they correspond so closely with the English text as to call for no further comment. The first term which requires interpretation is the expression "weights and measures" in the opening line of the Rule. As already noted in point IV. above, the SI system was itself the creation of the General Conference on Weights and Measures. The composite term "weights and measures" is in fact an all embracing expression used to describe a system of units, such as the Imperial system, the metric system, and the SI system. Any unit which is prescribed by one of these systems is to be regarded as falling with the general category of weights and measures.

4. ~~These standard systems of units can usefully be contrasted with some aspects of physical measurement which do not form part of a recognised system, but are nonetheless recognised in specific industries, or specific areas of technology. Such measurements are the subject of the fifth sentence of the Rule, and are referred to as "other physical values", which are to be measured by "units recognised in international practice".~~

5. The next expression which requires interpretation is the requirement that weights and measures, as above interpreted, "shall be expressed in terms of the metric

system". The metric system is well known, and was a well known system of units at the time when this Rule was formulated. It is distinct from the SI system, which was also known at the relevant time. If it had been the intention of the Rule to impose an obligation to use SI units, and not metric units, the Board would have expected to see a clear statement to that effect.

7. The present appeal is concerned with the measurement of viscosity, which has been expressed by the Appellant in terms of centipoises. It was common ground between the Appellant and the Examining Division that the centipoise is a well known metric unit, but not an SI unit. The Examining Division's reference to the book by Forst does no more than show that, when using the SI system, a metric unit such as the centipoise is invalid and should not be used. However, it does not shed any light on the matter here in issue, which is whether, under the terms of the EPC and the Rules thereunder, the Examining Division can require an applicant who has used metric units to include SI units in addition.

8. Although the intention behind the indicated policy expressed in the Guidelines for Examination of interpreting "metric units" as meaning "SI units" may be a laudable one, intended to contribute towards the socially desirable goal of promoting the use of SI units, in line with the objective of the EEC Directive, the Board is firmly of the view that all organs of the EPO, including the Boards of Appeal, are bound strictly by the provisions of the EPC, and the Rules made thereunder.

9. Consequently, where, as in the present case, the Rule requires the use of metric units, and the Appellant has indisputably used metric units, that is decisive of the point at issue. If there is to be a change from the

mandatory requirement for the use of metric units, in favour of SI units, that change can only be brought about if the Rule is amended by the Administrative Council.

10. From the foregoing it follows that the present appeal must be allowed. Having regard to its decision in this case, the Board adds that it can see no objection to the Examining Division continuing to encourage applicants to use SI units, so long as it is appreciated that the use of any units, other than the prescribed metric units, can not be demanded of an applicant.

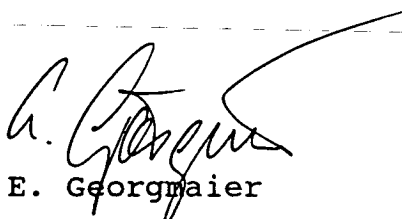
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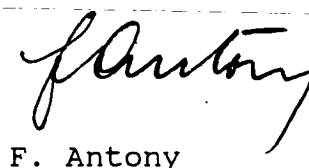
For these reasons, it is decided that:

1. The decision under appeal is set aside.
2. The case is remitted to the Examining Division for it to continue the substantive examination of the application.

The Registrar:

The Chairman:


E. Georgmaier


F. Antony