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D E C I S I O N
of 23 January 2002

Case Number: W 0018/01 - 3.5.2

Application Number: PCT/US00/14031

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Language of the proceedings: EN

Title of invention:

Infant and parent matching and security system and method

Applicant:

Elpas North America Inc.

Headword:

-

Relevant legal provisions:

PCT Art. 34(3)(a)

PCT R. 13.2, 68.2

Keyword:

"Lack of unity *a posteriori* - Invitation to pay additional fee
- sufficiently reasoned (no)"

Decisions cited:

G 0001/89, W 0003/93, W 0006/97, W 0011/99

Headnote:

In raising an objection of lack of unity of invention, it is not sufficient to examine the common core of a group of inventions (see point 5).

The fact that the IPEA referred to general knowledge without citing a specific prior art document does not relieve it of the obligation to consider the possible contribution that each

of the claimed inventions makes over the prior art referred to by the IPEA (see point 7).



Case Number: W 0018/01 - 3.5.2
International Application No. PCT/US00/14031

D E C I S I O N
of the Technical Board of Appeal 3.5.2
of 23 January 2002

Appellant: Elpas North America Inc.
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Subject of the Decision: Protest according to Rule 68.3(c) of the Patent Cooperation Treaty made by the applicants against the invitation of the European Patent Office (International Preliminary Examining Authority) to restrict the claims or pay additional fees dated 7 March 2001.

Composition of the Board:

Chairman: W. J. L. Wheeler
Members: F. Edlinger
B. Schachenmann

Summary of Facts and Submissions

- I. International patent application PCT/US00/14031 was filed with sixty-two claims including several independent claims relating to matching systems and one independent claim specifying a badge device.

Claim 1 reads as follows:

"A parent and infant matching and security system comprising:

a first transmitter adapted to be secured to a newborn infant, the first transmitter including a first radiant energy transmitter and a second radiant energy transmitter, each of the first radiant energy transmitter and the second radiant energy transmitter being operable to transmit an infant identification signal;

a second transmitter adapted to be secured to a parent of the newborn infant, the second transmitter including at least one radiant energy transmitter, the at least one radiant energy transmitter being operable to transmit a parent identification signal;

a plurality of receivers distributed at least within a maternity ward of a hospital, at least one of the plurality of receivers being operable to receive the infant identification signal and the parent identification signal, the at least one of the plurality of receivers being further operable to determine from the infant identification signal and the parent identification signal that the newborn infant is correctly matched with its parent; and

wherein the plurality of receivers are arranged within the hospital to determine a continued presence of the infant within the maternity ward."

Claim 35 reads as follows:

"A dual mode badge comprising:

a housing;

an adjustable strap secured the [sic] housing;

a dual mode transmitter disposed within the housing, the dual mode transmitter operable to transmit a signal using a first radiant energy transmission and to transmit the signal using a second radiant energy transmission, wherein the signal comprises a coded identification data; and

wherein the housing is separable from the strap and reusable."

II. With communication dated 7 March 2001 the European Patent Office (EPO), acting as an International Preliminary Examining Authority (IPEA), pursuant to Article 34(3)(a) and Rule 68.2 PCT, informed the applicant that the application did not comply with the requirement of unity of invention (Rule 13.1, 13.2 and 13.3 PCT) and invited the applicant to restrict the claims or to pay one additional examination fee. The reasons given in the annex to the invitation may be summarised as follows:

Claims 1 to 34 and 45 to 62 related to an entity matching system comprising two transmitters and a plurality of receivers. Claims 35 to 44 related to a dual mode badge. The two claimed inventions shared the following features:

"A transmitter, being able to transmit a first and a second radiant energy transmission comprising identification data."

Such transmitters were well-known before the priority date, eg in the form of "cell phones, in particular dual-band cell phones". Therefore the two inventions were not so linked as to form a single general inventive concept.

III. By fax dated 19 March 2001, the applicant paid the additional fee under protest (Rule 68(3)(c) PCT) and argued as follows:

The single inventive concept was the utilization of at least two differing types of radiant energy transmission for providing both matching and surveillance of persons and/or articles. As such, the claimed inventions shared the same or corresponding special technical features of including, as appropriate, sources or receivers of the two differing types of radiant energy transmission. Dual mode badge devices as claimed were not well-known before the priority date in view of cellular telephone technology. Cellular telephones utilized in each mode of operation radiant energy in the radio frequency spectrum. Such operation was not consistent with the inventive concept of the application.

IV. The IPEA, pursuant to Rule 68.3(e) PCT, issued a communication dated 18 April 2001 informing the applicant that, after a prior review of the justification for the invitation to pay the additional fee, the requirement of payment of the additional fee was upheld. The applicant was thus invited under Rule 68.3(e) PCT to pay the protest fee. A written opinion under Rule 66 PCT was sent with the same date of mailing 18 April 2001. The communication of the review panel repeated the reasons given in the invitation and included additional observations which may be summarized as follows:

A transmitter having the features shared by claim 1 and claim 35 was also disclosed in D1, page 3, lines 6 and 7 (D1 apparently refers to WO-A-95/01617). Claims 1 and 35 did not share the features of utilizing different types of radiant energy transmission or the other features mentioned in the applicant's fax and they did not exclude that the radiant energy emitted was within the radio frequency band, as it was the case for the cited mobile phones. Radiant energy transmission of a first infrared type and a second radio-frequency type was not specified in claim 35. The two radiant energy transmissions of the one transmitter specified in claim 35 could well be identical in respect to their frequency, modulation, etc.

The written opinion under Rule 66 PCT expressed, *inter alia*, the opinion that the subject-matter of claim 1 was inventive over D1 because it was not obvious to include, within a first transmitter, two different radiant energy transmitters which solved conflicting problems: the matching of an infant and a parent required energy radiation over a relatively short

distance, and the detection of the presence of an infant within the maternity ward needed highly reliable energy transmission throughout the entire ward. The term "dual mode" in claim 35, however, was not clear and the subject-matter of claim 35 differed from D1 only in that it had an adjustable strap instead of a bracelet, and thus was not inventive. Any other portable transmitter transmitting radiant energy bursts and having an adjustable strap, such as a mobile phone, would be covered by the wide scope of claim 35.

- V. By fax received on 1 May 2001, the applicant paid the protest fee.

Reasons for the Decision

1. According to Article 155(3) EPC, the Board of Appeal is competent to decide upon the present protest.
2. The protest complies with the requirements of Rule 68.3(c) and (e) PCT and is therefore admissible.
3. According to Rule 68.2 PCT, an invitation to restrict or pay additional fees "shall specify at least one possibility of restriction which, in the opinion of the International Preliminary Examining Authority, would be in compliance with the applicable requirement, and shall specify the amount of the additional fees and the reasons for which the international application is not considered as complying with the requirement of unity of invention."
4. Rule 13.1 PCT requires that the international application shall relate to one invention only or to a

group of inventions so linked as to form a single general inventive concept. According to Rule 13.2 PCT, this requirement of unity of invention is "fulfilled only when there is a technical relationship among those inventions involving one or more of the same or corresponding special technical features". The expression "special technical features" is defined as "those technical features that define a contribution which each of the claimed inventions, considered as a whole, makes over the prior art". The PCT International Preliminary Examination Guidelines (as in force from 9 October 1998; paragraphs III-7.5 and III-7.6) set out that the reasoning in the invitation to pay additional fees should reflect the provisional opinion regarding novelty and/or inventive step for the purposes of an effective examination when an objection is made *a posteriori*, that is, after taking the prior art into consideration, for example, a document cited, and that an objection should be raised in clear cases, not on the basis of a narrow, literal or academic approach. There should be a broad, practical consideration of the degree of interdependence of the alternatives presented with the benefit of any doubt being given to the applicant.

5. It follows from these definitions in the Regulations Under the PCT and the PCT International Preliminary Examination Guidelines (which are binding on the EPO; see G 1/89, OJ 1991, 155, point 6) that it is normally not sufficient to merely define and examine the common core of a group of inventions, for example by indicating the features which are specified in all the claims defining the inventions of the group. Rule 13.2 PCT requires an examination of the technical relationship among the inventions of the group. Such a

relationship may exist even if the inventions do not involve the same technical features if they involve corresponding special technical features. The definition of the "special technical features" given in Rule 13.2 PCT requires an analysis of the contribution which each of the claimed inventions makes over the prior art. As a first step, this requires an analysis as to which of the features distinguish the claimed inventions from the cited prior art before their contribution can be examined in the light of the description, in particular the problems solved and effects achieved by the claimed inventions. Only in simple cases where it is clearly implicit from a mere listing of the common and distinguishing features that there is no technical relationship among the claimed inventions involving the same or corresponding special technical features, may such a listing be considered as a sufficient reasoning for the non-compliance with Rule 13.1 and 13.2 PCT. This is in line with established jurisprudence of the boards of appeal (see W 3/93, OJ EPO 1994, 931, points 3.1 and 3.2, W 11/99, OJ EPO 2000, 186, points 2.1 and 2.7 and W 6/97, points 6.1 and 6.2).

6. In the present case, the invitation of the IPEA set out the features which claim 1 and claim 35 have in common, ie the features which are explicitly recited in these claims and shared by them (see paragraph II above). This concept was stated to be well-known and found for example in dual-band cell phones. No consideration of any "special technical features" was given in the invitation of the IPEA, nor any consideration of the problem solved by each of the alleged inventions. For example, it was not indicated whether a dual mode badge comprising a dual mode transmitter was considered by

the IPEA as differing from a dual-band cell phone at all.

7. It should be remembered that according to the PCT Guidelines, paragraph III-7.5 (see point 4 above), an *a posteriori* objection is an objection which is made after taking prior art into consideration. Although the invitation of the IPEA did not refer to a document of the search report, it did take some prior art into consideration, namely dual-band cell phones. The fact that the IPEA did not cite a specific prior art document does not relieve it of the obligation to consider the possible contribution that each of the claimed inventions makes over the prior art referred to by the IPEA.

8. For these reasons, the IPEA's invitation to restrict or pay an additional fee did not give sufficiently detailed reasons as to why there was no technical relationship among the claimed inventions such that they were not so linked as to form a general inventive concept within the meaning of Rule 13.1 and 13.2 PCT. Contrary to what is required by Rule 68.2 PCT, it did not specify a possibility of restriction either. The additional observations made by the review panel and the reasoning set out in the communication under Rule 66 PCT (see point IV above) cannot cure these defects, but they show that consideration of the problem mentioned in the description (see eg pages 3 and 4) and a restriction to two different radiant energy transmitters within the first transmitter to be secured to an infant, to solve the conflicting problems of matching and detecting the presence of an infant, could have rendered the payment of the additional examination fee and the protest fee unnecessary.

Moreover, since the PCT Guidelines require the applicant to be given the benefit of doubt, the term "dual mode transmitter" as interpreted in the light of the description could have been considered as a "special technical feature" distinguishing the dual mode badge from a transmitter which is merely capable of emitting a signal in different frequency bands. Of course, such a "broad, practical consideration of the degree of interdependence of the alternatives presented" as required by the PCT Guidelines for the examination of unity of invention, would not prevent the IPEA from raising other objections, eg concerning clarity or inventive step of a claim which is not sufficiently delimited with respect to the prior art (as was done in the written opinion of the IPEA, see point IV above).

9. For these reasons, the invitation to pay an additional fee for one of the claimed inventions is not legally effective, and the protest is entirely justified.

Order

For these reasons it is decided that:

The refund of the additional examination fee and the protest fee is ordered.

The Registrar:

The Chairman:

M. Hörnell

W. J. L. Wheeler