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D E C I S I O N
of 12 November 2001

Case Number: W 0023/01 - 3.2.3

Application Number: PCT/GB 00/04203

Publication Number: -

IPC: F41H 11/16

Language of the proceedings: EN

Title of invention:
A blade for a digging assembly, and related apparatuses

Applicant:
J. R. French Limited

Opponent:
-

Headword:
-

Relevant legal provisions:
PCT Art. 17(3)(a); 33(2) and (3)
PCT R. 13.1; 13.2; 40.2(c)(e); 64.3

Keyword:
"Reimbursement of the additional fees"
"Reimbursement of the protest fee"

Decisions cited:
G 0001/89, W 0006/90

Catchword:
-

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Beschwerdekammern | Boards of Appeal | Chambres de recours

Case Number: W 0023/01 - 3.2.3
International Application No. PCT/GB 00/04203

D E C I S I O N
of the Technical Board of Appeal 3.2.3
of 12 November 2001

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Subject of the Decision: **Protest according to Rule 40.2(c) of the Patent Cooperation Treaty made by the applicant against the invitation (payment of additional fee) of the European Patent Office (branch at The Hague) dated 12 February 2001.**

Composition of the Board:

Chairman: C. T. Wilson
Members: J. B. F. Kollar
B. Schachenmann

Summary of Facts and Submissions

I. Following the filing of international application No. PCT/GB 00/04203 the EPO, acting as ISA (International Search Authority), on 12 February 2001 issued an invitation to pay within 30 days four (4) additional fees (Article 17(3)(a) PCT and Rule 40.1 PCT).

II. The said international application contained 35 claims. The claims were considered to include five separate alleged inventions/groups of alleged inventions which were:

Group 1 (claims 1 to 10) directed to a blade for a digging assembly, said blade having a base portion and a terminal portion, the base portion being wider than the terminal portion.

Group 2 (claims 11 to 17) referred to a blade for a digging assembly, said blade having a base portion and a terminal portion, the terminal portion being wider than the base portion.

Group 3 (claims 18 to 32) relate to a moveable vehicle having a digging assembly, a hopper and a conveyor.

Group 4 (Claims 33 and 34)referred to a method of clearing a minefield, and

Group 5 (claim 35) directed to a method of clearing ordnance from ordnance-infested soil.

The ISA held in the Invitation to Pay Additional Fees (IPAF) that the technical features of both independent

blade claims 1 and 11 of groups 1 and 2, respectively, were mutually exclusive. Either the base was wider than the terminal portion or the terminal portion was wider than the base; there was no blade conceivable that could satisfy both requirements at the same time. Consequently, there was no unity of invention between claims 1 to 10 of group 1 and claims 11 to 17 of group 2.

None of the independent vehicle or method claims 18, 33 and 35 of groups 3, 4 and 5 respectively, comprised in their wording the special technical features of the blades according to either group 1 or group 2 of claims. Consequently there was no unity of invention between the subject-matter of the claims according to group 1 or 2 on the one hand and the subject-matter of the claims according to groups 3, 4 and 5 on the other hand.

Independent vehicle claim 18 of group 3 of claims comprised a digging assembly, a hopper and a conveyor, which technical features were not present in any of the independent claims of the other groups of claims. Consequently there was no unity of invention between the vehicle according to group 3 of claims and the other groups of claims.

The independent method claims 33 and 35 of groups 4 and 5, respectively, had no special technical features in common. Whilst independent claim 33 referred to the separation of debris created by the digging assembly, independent method claim 35 related to the effect of the (unspecified) blades and tines on the transport of the debris created by said blades. Hence there was no unity between independent method claims 33 and 35.

The ISA further stated in IPAF that the subjects of the group of claims, defined by the problems posed and their means of solution were so different from each other, if not mutually exclusive, that no technical relationship or interaction (beside the common feature of the application in digging operations, which was known *per se*, see for example DE-A-197 24 753 for mineclearing) could be appreciated to be present in the wording of the groups of claims so as to form a single general inventive concept.

III. On 13 March 2001 the Applicant paid four additional search fees of which two, namely for group 2 and group 4 of claims, were paid under protest pursuant to Rule 40.2(c) PCT.

In support of the protest the Applicant submitted that the common technical principle of claims 1 and 11, ie groups 1 and 2 of claims, respectively, was based on the presence of comparatively broad flanks resulting from a tapered blade shape, which broad flanks gave rise to a lifting effect on the rotation of the blade through soil. The Applicant referred to lines 18 to 23 on page 14 and lines 5 to 13 on page 19 as well as to Figures 4 and 5 of the application documents, with respect to claims 1 and 11 according to the groups 1 and 2 of claims, respectively.

The Applicant further pointed out that the method of claim 33 of group 4 of claims was a means of operating a vehicle as defined in claim 18 of group 3 of claims. Therefore, the unity of inventions existed between group 3 and group 4 of said claims.

The Applicant requested that the additional fees in

respect of group 2 and group 4 of claims be refunded.

IV. On 2 May 2001 the Applicant was notified that, with regard to the protest filed on 13 March 2001 the International Searching Authority ,after the Review Board had performed the prior review pursuant to Rule 40.2(e) PCT of the justification for the invitation to pay 4 additional search fees, found that the common technical feature of the subject-matter of the claims according to group 1 and group 2, namely the presence of comparatively broad flanks resulting from a tapered blade shape, was known from the documents cited in the search report (W0-A-0045 119 and GB-A-827 999), so that the common technical feature was part of the state of the art and that said common feature thus was not special anymore as required by Rule 13.2 PCT. Therefore, there was no common technical principle underlying groups 1 and 2 of said claims.

As to claims 18 to 32 of group 3 and to claims 33 and 34 of group 4 the Review Board found that said groups of claims should be considered as one invention as they claimed a device and a method for operating said device.

The Review Board further noticed that the Applicant did not contest the objections of non unity concerning claim 35 (group 5).

The Applicant was invited on 2 May 2001 to pay a protest fee pursuant Rule 40.2(e) PCT for further examination of the protest because the invitation to pay additional search fees was justified in part. To the extent the invitation was not justified, 1 (one) additional search fee concerning claims 33 and

34 (group 4) paid under protest would be refunded.

V. The Applicant paid the protest fee on 31 May 2001.

Reasons for the Decision

1. The protest is admissible.

2. According to Rule 13.1 PCT, the international patent application shall relate to one invention only or to a group of inventions so linked as to form a single general inventive concept.

Pursuant to Rule 13.2 PCT the requirement of unity of invention referred to in Rule 13.1 shall be 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" shall mean those technical feature that define a contribution which each of the claimed inventions, considered as a whole, makes over the prior art.

If the ISA considers that the claims lack this unity, it is empowered, under Article 17(3)(a) PCT, to invite the Applicant to pay additional fees.

3. Lack of unity may be directly evident **a priori**, ie before the examination of merits of the claims in comparison with the state of the art revealed by the search (c.f. for example, decision W 0006/90, OJ EPO 1991, 438).

Alteratively, having regard to decision G 0001/89 of

the Enlarged Board of Appeal, dated 2 May 1990 (OJ EPO 1991, 155), the ISA is also empowered to raise an objection **a posteriori**, ie after having taken the prior art revealed by the search into closer consideration. The Enlarged Board of Appeal indicated that such consideration represents only a provisional opinion on novelty and inventive step which is in no way binding upon the authorities subsequently responsible for the substantive examination of the application (point 8.1 of the Reasons of the Decision).

This practice is laid down in the PCT International Search Guidelines, Chapter VII, 9 (PCT Gazette, special issue, 8 October 1998) which are the basis for a uniform practice of all International Searching Authorities.

4. The claims of the present application may be grouped in groups 1 to 5 of claims specified in point II above.

Since the review of justification for invitation to pay additional search fees pursuant PCT Rule 40.2(e) issued by the ISA on 2 May 2001 resulted in finding that the invitation was justified in part and that the additional search fees paid under protest for group 4 regarding claims 33 and 34 should be refunded, only the remaining group 2 of claims 11 to 17 for which the additional fee was paid under protest will be taken into consideration.

5.1 The ISA's non-unity objection was originally based on the finding that the technical features of independent blade claims according to group 1 and group 2, respectively, were mutually exclusive and was thus made **a priori**. In the Board's judgement taken on the basis

of the contents of the claims as interpreted in the light of the description and of the drawings, there exist common technical features underlying the first subject-matter (claims 1 to 10) according to group 1 and the second subject-matter(claims 11 to 17) according to group 2, namely blades comprising a base portion and a terminal portion remote from the base portion, said blades having comparatively broad flanks resulting from a sharpened and tapered blade shape, which flanks give rise to a lifting effect on rotation of the blades through the soil. The Board holds that the afore-mentioned common features constitute **a priori** the link between group 1 and 2.

5.2 The invitation to pay additional fees (PCT Article 17 (3)and Rule 40.1) issued by ISA on 12 February 2001 unhelpfully contained no reasoning as to why the documents cited in the search Report should destroy novelty of the subject-matter of the main claim of group 1 of the claims being searched. Thus it could not be determined from the invitation which of the citations the ISA considered to be novelty destroying.

It is clear that the reasoning for inviting an Applicant to pay an additional search fee or fees must be contained already in the invitation. Reasoning contained in the prior review according to Rule 40.2(e) PCT reaches the Applicant only after he has decided to pay the additional search fee or fees and thus only helps him to decide whether or not to pay the protest fee.

Indeed in the present case it was only after the Applicant had paid (on 13 March 2001) the disputed additional search fees that he received the prior

review (issued on 2 May 2001) which drew attention to W0-A-45 119 (document 1) and GB-A-827 999 (document 2).

5.3 A closer examination of said documents by the Board reveals that document 1 belongs to the category of Certain Published Documents which pursuant to Rule 64.3 PCT shall not be considered part of the prior art for the purpose of Article 33(2) and (3) PCT related to Relevant Prior Art for the International Search. Document 2 discloses shear plates 23 which lift the soil so that the rotating knives 52 can cut up the weeds, roots and large organic matter in the soil into small pieces (see page 4, line 84 ff). There is no suggestion that the tapered knives can lift any objects and indeed on page 4, line 95, reference is made to the fact that the degree to which the knives enter the soil may be adjusted so that they do not destroy the soil structure. This clearly is not what is required to lift objects. Therefore, the common feature referred to in paragraph 5.1 are not known from document 2 so that the **a posteriori** objection of lack of unity to groups 1 and 2 of claims was not justified.

6. Thus the invitation by the ISA to pay the disputed search fee concerning group 2 of claims was unjustified. Thus in addition to the additional search fee for group 4 of claims the reimbursement of which has already been ordered by the Review Board, the additional search fee for group 2 of claims is to be reimbursed as well.

The protest was thus entirely justified. Accordingly, the protest fee is to be refunded (Rule 40.2(e) PCT).

Order

For these reasons it is decided that:

1. The protest is entirely justified.

2. The additional search fee for group 2 of claims paid under protest shall be reimbursed.

3. The protest fee shall be refunded.

The Registrar: The Chairman:

A. Counillon C. T. Wilson