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D E C I S I O N
of 24 January 2005

Case Number: W 0040/04 - 3.2.7

Application Number: PCT/SE2004/000375

Publication Number: WO 2004/085125 A2

IPC: B27N 7/00

Language of the proceedings: EN

Title of invention:

Method for reducing emissions and method for producing a wooden product

Applicant:

Akzo Nobel Coatings International BV

Opponent:

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Headword:

-

Relevant legal provisions:

PCT Art. 17(3)(a)
PCT R. 13.2, 40.1, 40.2(c)(e)

Keyword:

"Non-unity - a posteriori (no)"

Decisions cited:

-

Catchword:

-



Case Number: W 0040/04 - 3.2.7

International Application No. PCT/SE 2004/000375

D E C I S I O N
of the Technical Board of Appeal 3.2.7
of 24 January 2005

Applicant: Akzo Nobel Coatings International BV
Velperweg 7b
P.O. Box 9300
NL-6800 SB Arnhem (NL)

Representative: Hans Bäckström
EKA Chemicals AB
P.O. Box 11556
S-100 61 Stockholm (SE)

Subject of this decision: Protest according to Rule 40.2(c) of the Patent Cooperation Treaty made by the applicants against the invitation (payment of additional fees) of the European Patent Office (International Searching Authority) dated 23 June 2004.

Composition of the Board:

Chairman: A. Burkhart
Members: P. O'Reilly
C. Holtz

Summary of Facts and Submissions

- I. In response to the invitation of the ISA of the 6 October 2004 to pay a protest fee on the basis that the invitation to pay additional search fees was justified the applicant duly paid the protest fee.
- II. The independent claims of the application as filed read as follows:

"1. Method for reducing emissions of one or more gaseous substances from an assembly of at least two pieces of wooden materials which have been glued together, comprising planing on at least one of the sides having glue lines exposed, followed by treating the at least one planed sides with one or more treating substances reactive to the one or more gaseous substances.

4. Method for producing a laminated wooden product comprising the steps of:

- (a) - applying an adhesive system onto one or more wooden lamellas,
- (b) - assembling two or more wooden lamellas into an assembly,
- (c) - pressing the assembly,
- (d) - planing at least one of the sides of the assembly having glue lines exposed, and,
- (f) - treating the one or more planed sides by application of one or more treating substances reactive to one or more gaseous substances emitted from the at least one planed side.

17. Laminated wooden product obtainable by the method according to any one of the claims 4 - 16.

18. Laminated wooden product comprising at least two lamellae, which have been joined with an adhesive system based on a formaldehyde based resin, having a formaldehyde emission, according to JAS, standard for structural glued timber MAFF, Supplement No 992, of less than about 0.5 mg/l."

III. The prior art document relevant for the present decision is:

D1: DE-A-199 49 625

IV. The ISA considered that the set of claims contained the following inventions:

1. claims 1(part) - 4(part), 5, 6, 8, 12(part) - 19(part) insofar as they are directed to an aldehyde as a gaseous substance.
2. claims 1(part) - 4(part), 7, 9, 12(part) - 19(part) insofar as they are directed to an isocyanate as a gaseous substance.
3. claims 1(part) - 4(part), 10, 11, 12(part) - 19(part) insofar as they are directed to a terpene as a gaseous substance.

The ISA considered that the common concept between the inventions was the treatment of the at least two glued wooden materials with a substance reactive to a gaseous substance. This common concept was considered to be

known from document D1 since the wooden materials disclosed therein are disclosed as being treated with urea to bind formaldehyde.

The ISA further considered that the feature that planing takes place before the treatment with a reactive substance was not a special technical feature since the applicant had not shown a technical effect for this feature. This feature was in any case considered to be known from document D1. The ISA considered that as the limiting bands 24 plane the sides of the wood materials at the same time as the wood materials are treated with urea, the reaction between urea and formaldehyde would continue even after the planing treatment.

- V. The applicant was therefore invited to pay two additional search fees pursuant to Article 17(3)(a) and Rule 40.1 PCT.

The applicant paid a single additional search fee for the search to be carried out on the alleged second invitation. The fee was duly paid under protest in accordance with Rule 40.2(c) PCT.

- VI. The applicant argued essentially as follows:

- (i) There is no prior art disclosing treating visible glue lines which is the key feature of the invention. The special technical features of the claims are planing at least one of the sides having glue lines exposed and treating the planed side. There is no disclosure of planing in

document D1. The limiting bands 24 have no planing effect.

(ii) Claim 1 is novel over document D1 and the technical problem is not found in the prior art so that the subject-matter of the claim involves an inventive step.

(iii) The additional search fee should be refunded or at least partially refunded. A main part of the search for the first invention would already have covered the embodiment of the isocyanate so that part of the additional search fee can be reimbursed even if the whole cannot be reimbursed.

VII. The ISA reviewed the justification for the invitation to pay additional search fees. In their reasons why the invitation was justified the ISA pointed out that the chipboards known from document D1 would have glue lines. The ISA considered that planing took place in the method known from document D1 due to the pressing action of the steel bands or strips 3, 4 and 24. They concluded that the subject-matter of claim 1 was not novel and hence also not inventive. The ISA therefore invited the applicant to pay the protest fee pursuant to Rule 40.2(e) PCT.

Reasons for the Decision

1. The protest is admissible.

2. According to the teaching of document D1 chipboard passes between steel bands 3, 4 and then between limiting bands 24. While the chipboard is passing between the limiting bands 24 it is subjected to a water spray cooling treatment. During this treatment urea or ammonium carbonate solution may be added to the spray water to bind formaldehyde (see claim 4 of the document and column 4, lines 44 to 54). Thereafter, the chipboard is subjected to a second cooling treatment. After the second cooling treatment the chipboard may be subjected to an abrading process ("schleifen").

It appears that the ISA both when inviting to pay additional search fees and when reviewing the justification for the invitation has misunderstood the meaning of the term "planing" as used in the application and consequently identified a planing action in document D1 when no planing in fact was disclosed or at least not disclosed at that stage. The term "planing" in its normal usage in the English language means to render a surface flat by removal of material, e.g. Concise Oxford Dictionary which refers to "pare down or pare away (irregularities) with a plane". This action is performed by a tool called a plane which has a blade for this purpose and is part of every carpenter's toolkit (cf. German "Hobel" or French "rabet"). The term thus requires the removal of material. There is no indication in the application that anything other than the normal sense of the term is meant and there is no usage of the term in the

application that is inconsistent with the normal sense of the term. The ISA considered that the pressing by bands 3, 4 and 24 performed a planing function. This conclusion was reached however on the basis of a misunderstanding of the meaning of the term. The ISA apparently considered that the term simply meant to render a surface plane, i.e. flat. However, this is not case since the term requires that material be removed in order to achieve the plane surface.

The application of the correct meaning of the term "planing" to the disclosure of document D1 leads to the conclusion that the document does not disclose a planing followed by a treatment as required in the application. The document rather discloses a treatment followed by a removal of material by "schleifen".

The suggestion by the ISA that reactions due to the treatment in the method of document D1 would still be occurring after the planing stage is made without any basis that this actually is the case. Moreover, the application specifies when the treatment is effected, not when the reaction takes place.

The ISA has argued that the planing has not been shown to have a technical effect. The burden of proof in this respect lay with the ISA and this burden has not been discharged.

The Board concludes therefore that the special technical features common to the three inventions as identified by the ISA comprise at least the planing treatment followed by a treatment with a substance which binds gaseous substances in the glued wooden

materials. The Board also concludes that this special technical feature is not disclosed in document D1 so that there is unity of invention in the sense of Rule 13.2 PCT. The disclosure of this feature in document D1 was the basis for justification for the invitation to pay additional search fees so that the Board concludes that the invitation should not have been issued on this basis.

Order

For these reasons it is decided that:

Reimbursement of the additional search fee and the protest fee is ordered.

The Registrar:

The Chairman:

G. Rauh

A. Burkhart