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D E C I S I O N
of 19 July 2005

Case Number: W 0003/05 - 3.2.3

Application Number: PCT/NL2003/000541

Publication Number: WO2004/009910

IPC: E02B 3/14

Language of the proceedings: EN

Title of invention:

Protective Element for a Breakwater or Wave-Retarding
Construction

Applicant:

HBG CIVIEL B.V.

Opponent:

-

Headword:

-

Relevant legal provisions:

PCT Art. 34(3)(a)

PCT R. 13, 68

Keyword:

"Unity - a posteriori (no)"

Decisions cited:

W 0006/98, W 0006/97

Catchword:

-



Case Number: W 0003/05 - 3.2.3

International Application No. PCT/NL2003/000541

D E C I S I O N
of the Technical Board of Appeal 3.2.3
of 19 July 2005

Applicant: HBG CIVIEL B.V.

Representative: Van Westenbrugge, Andries

Decision under appeal: 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 Preliminary Examination Authority) dated 3 August 2004.

Composition of the Board:

Chairman: U. Krause
Members: G. Ashley
S. Hoffmann

Summary of Facts and Submissions

I. International patent application PCT/NL2003/000541 (international publication number WO2004/009910) relates to protective elements for breakwater or wave-retarding constructions, and was filed on 24 July 2003 with 23 claims, of which the following claims are recited:

"1. Protective element for a breakwater or wave-retarding construction, comprising a body that has at least two projections (2,3), characterised in that the body consists of a plate-shaped base (1), from the two plate sides of which the projections (2,3) extend."

"15. Protective element according to claim 14, wherein a regular polygon, with n corner points, of a projection (2,3) is of identical shape to a regular polygon of the base (1) and that the polygon of said projection (2,3) is turned through the order of 360 divided by 2n degrees of an arc with respect to the polygon of the base (1)."

"18. Protective element according to one of claims 1 - 16, wherein the material from which the element is made comprises at least a residue material from oil refining, sand, rock-like granulate or gravel."

II. On 15 October 2003, the European Patent Office (EPO), acting as the International Searching Authority (ISA), issued an invitation, pursuant to Article 17(3)(a) and Rule 40.1 PCT. The applicant was informed that the application did not comply with the requirements of unity of invention (Rules 13.1, 13.2 and 13.3 PCT), and

was invited to pay two additional fees. On 14 November 2003, the applicant paid the two additional fees, and consequently an International search report was established for all the claims 1 to 23.

The EPO in its capacity as an International Preliminary Examination Authority (IPEA) proceeded to examine the application. On 3 August 2004 the IPEA concurred with the finding of the ISA regarding lack of unity of invention, and in accordance with Article 34(3)(a) and Rule 68 PCT, invited the applicant to either restrict the claims or pay two additional fees. The groups of claims were held to relate to the following inventions:

- (1) Claims 1 to 17, 19 and 20 are directed to a protective element characterised by its form and an in situ method of making the same.
- (2) Claims 1, 18 and 21 are directed to a protective element characterised by consisting of residue material and a method of making the same.
- (3) Claims 22 and 23 are directed to a prefabrication method for a protective element characterised by the use of split-shuttering and the split shuttering used in the said method.

The IPEA held that US-A-3 614 866 (D1) discloses the subject-matter of claim 1, and dependent claims 2 to 14, but D1 does not disclose the subject-matter of claims 15, 18 and 22. The features of claim 15 were considered to be the "Special Technical Features" (STF) for the first group of inventions, which are directed to solving the problem of water-breaking and wave

retardation. The features of claim 18 were considered to be the STF of the second group of inventions, solving the problems of improving the strength of the element and simplifying the method of producing an element made from the defined material. The features of claim 22 were considered to be the STF for the third group of inventions, solving the problems of how to remove easily the shuttering from the freshly made element and the reuse of the shuttering for the production of further elements. The IPEA argued that since the STFs of the three groups of inventions are different and solve unrelated problems, there is no technical relationship between the inventions and the requirements of unity as defined in Rule 13.1 PCT are not met.

On 3 September 2004 the applicant paid under protest the two additional fees. He argued that the material referred to in claim 18 merely constitutes one of several possibilities, which are all encompassed in the preceding claims, in particular claim 1. He stated that there is no question of a separate invention in claim 18 and 21. The applicant submitted that the method defined in claim 22 merely constitutes an alternative for the method according to claim 20, and that the same applies to the shuttering according to claim 23.

The protest was reviewed in accordance with Rule 68.3(e) PCT by a review panel of the European Patent Office. The review panel agreed with the reasoning that the features of claim 1 are known from D1 and hence this claim has no STF, as set out in the invitation to restrict or pay additional fees. The review panel also

concluded that the material defined in claim 18 forms the STF of the second invention. Concerning the third invention, the review panel did not dispute the applicant's assertion that there is unity between the third and first inventions, and ordered the refund of one additional fee.

Hence, on 19 November 2004, the IPEA held that the payment of one additional examination fee was justified and invited the applicant to pay a protest fee for the examination of the protest in accordance with Rule 68.3(c) PCT. The applicant paid the protest fee on 17 December 2004 without submitting any further arguments.

Reasons for the Decision

1. The protest is admissible.

2. Since the review board found unity between the first and third group of inventions, and ordered a refund of one of the fees, it only remains to determine whether unity exists between the first and second group.

D1 discloses a protective element for a breakwater or wave-retarding construction (see column 1, lines 28 to 33), which comprises a body that has at least two projections (indicated as 3a in Figures 1 to 3 of D1), wherein the body consists of a plate-shaped base (made up of blocks 2, 3 and 4 in Figures 1 to 3), from the two sides of which projections 3a extend. Insofar as claim 1 is concerned, the Board shares the view that

the protective element is known from D1, as expressed in the invitation to restrict or pay additional fees.

Annex B, Part 1(c)(ii) of the Administrative Instructions under the PCT, as was in force from 1 July 1998, states that if an independent claim does not avoid the prior art, as in this case, then the question whether there is still an inventive link between all the claims dependent on that claim needs to be carefully considered. If each of the dependent claims directly refers back to a fully anticipated independent claim, then there may be lack of unity a posteriori, however only in case there is no inventive link between the remaining dependent claims (see W 6/98 point 3.2 of the Reasons)

Of particular relevance here are dependent claims 15 and 18. Claim 15 defines an element according to claim 14, which in turn refers back to claims 1 to 13. The subject-matter of claim 1 appears to lack novelty; hence the combination of features defined in claims 1, 14 and 15 is novel over D1 only by virtue of the polygon shape defined in claims 14 and 15. This feature was designated by the IPEA as being the STF for the first group of inventions.

Dependent claim 18 refers back to claims 1 to 16, and defines a residue material from which the protective element is made. A combination of features defined in claims 1 and 18 is distinguished from D1 by the material defined in claim 18, and this was considered by the IPEA as being the STF for the second group of inventions.

It is therefore necessary to consider whether there is an inventive link between the subject-matters of claims 15 and 18. According to Rule 13.3 PCT, the requirement of unity of invention is only fulfilled when there is a technical relationship between inventions, which involves one or more of the same or corresponding special technical features. It is also established case law of the Boards of Appeal that the determination of unity of invention requires, as a precondition, an analysis of the technical problem or problems underlying the respective group of inventions (see, for example, W 6/97, point 6.2 of the Reasons for the Decision, not published in the OJ of the EPO).

The starting point for the Applicant's invention is a concrete protective element. The concrete is not reinforced, as such reinforcing tends to rust, especially in salt water. Thus, the strength of the protective element is derived only from the concrete material itself (see page 1 of the description, lines 10 to 17). The problem underlying the invention as defined in claim 1 is to improve the strength of such protective elements (see page 1, lines 15 to 19).

Regarding dependent claim 15, the particular polygonal shapes of the base and projections guarantee a high stability, making the protective element difficult to roll under the influence of water forces (see page 1, lines 19 to 21 and 27 to 28, and page 3, lines 31 and 32). Thus, the inventive concept at the heart of the combination of features defined by claims 1, 14 and 15 (as set out above) is to give the protective element a particular shape that improves the stability of the element, whilst maintaining its strength.

According to claim 18, the protective elements are made from a residue material from oil refining, sand and rock-like granulate or gravel. It is stated in the application that protective elements are usually made from concrete (see page 1, line 10), but no explanation is given for using the residue-based material. It is not apparent that an improvement in either strength or stability would be achieved as a result of using this material. Rather, it appears from the description at page 2, lines 16 to 22, that this material allows the protective elements to be produced by a certain heat-fusing method.

It must therefore be concluded that there is no link in inventive concept between solving the problem of improving the stability of a protective element by giving it a particular shape, and choosing the material from which to make it.

There is thus a lack of unity of invention between claim 18 when dependent on claim 1 on the one hand and claim 15 on the other. Such a lack of unity could have been remedied by drafting differently the dependencies of the claims, as suggested in the invitation to restrict or pay additional fees of 3 August 2004 (see point 3).

Order

For these reasons it is decided that:

The protest is dismissed.

The Registrar:

The Chairman

R. Schumacher

U. Krause