

Internal distribution code:

- (A) [] Publication in OJ
(B) [] To Chairmen and Members
(C) [X] To Chairmen
(D) [] No distribution

**Datasheet for the decision
of 21 June 2007**

Case Number: W 0024/06 - 3.2.07

Application Number: PCT/IB 2005/002777

Publication Number: -

IPC: B65B

Language of the proceedings: EN

Title of invention:

Method and Device for filling containers

Applicant:

CAMPATENTS B.V.

Opponent:

-

Headword:

-

Relevant legal provisions:

PCT Art. 17(3)(a)
PCT R. 13.2, 40.1, 40.2
EPC Art. 150(2)(4), 154(3)
EPC R. 105(3)

Keyword:

"Admissibility of the protest - yes"
"Protest justified - no"

Decisions cited:

W 0019/06, W 0026/06

Catchword:

-



Case Number: W 0024/06 - 3.2.07

International Application No. PCT/IB 2005/002777

D E C I S I O N
of the Technical Board of Appeal 3.2.07
of 21 June 2007

Applicant: CAMPATENTS B.V.
Naritaweg 165
Telestone 8
NL-1043 BW Amsterdam (NL)

Representative: Paolo Jorio
c/o Studio Torta S.r.l.
Via Viotti, 9
I-10121 Torino (IT)

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 Searching Authority) dated 8 June 2006 .

Composition of the Board:

Chairman: H. Meinders
Members: P. O'Reilly
C. Holtz

Summary of Facts and Submissions

- I. International application No. PCT/IB2005/002777 was filed with twenty-two claims of which four are independent.

The texts of the independent and dependent claims relevant to the present decision are as follows:

"1) A method of filling a container (2) with articles (6; 6'), the method comprising a step of feeding the container (2) along a path (P) through a first filling station (4) where at least a first article (6; 6') is fed into the container (2) through an opening (7) of the container (2); and the method being characterized in that the container (2) is fed through at least a second filling station (4) where at least a second article (6; 6') is fed into the container (2) through the opening (7) of the container (2); the articles (6; 6') being fed to the first filling station (4) successively, so as to define a first stack (36) of articles (6; 6'); and the articles (6; 6') being fed to the second filling station (4) successively, so as to define a second stack (36) of articles (6; 6')."

"2) A method as claimed in Claim 1, wherein the first article (6; 6') is detached from a relative end of the first stack (36), and then fed into the container (2)."

"9) A method as claimed in one of the foregoing Claims, wherein the container (2) is fed along the path (P) through a third downstream from the first filling station (4); the method comprising a control step to determine whether the first article (6; 6') is fed into

the container (2); and, in the event the first article (6; 6') is not fed into the container (2), at least a third article (6; 6') is fed into the container (2) through the opening (7) of the container (2) at the third filling station (4).

"11) A device for filling a container (2), the device (1) comprising a conveyor assembly (3) for feeding the container (2) through a first filling station (4); and a first feed assembly (5) located at the first filling station (4) to feed at least a first article (6; 6') into the container (2) through an opening (7) of the container (2); and the device (1) being characterized in that the conveyor assembly (3) feeds the container (2) through at least a second filling station (4); the device (1) comprising at least a second feed assembly (5) located at the second filling station (4) to feed at least a second article (6; 6') into the container (2) through the opening (7) of the container (2); the first feed assembly (5) feeding the articles (6; 6') successively to the first filling station (4), so as to define a first stack (36) of articles (6; 6'); and the second feed assembly (5) feeding the articles (6; 6') successively to the second filling station (4), so as to define a second stack (36) of articles (6; 6')."

"12) A device as claimed in Claim 11, wherein the first feed assembly (5) comprises a dispenser unit (23) for detaching the first article (6; 6') from an end of the first stack (36) and the feeding the first article (6; 6') into the container (2)."

"17) A device as claimed in one of Claims 11 to 16, and comprising at least a third feed assembly (41) downstream from the first feed assembly (5) and for feeding at least a third article (6; 6') into the container (2); detecting means (39) for determining whether the first article (6; 6') is fed into the container (2); and a control unit (40) for activating the third feed assembly (41) on the basis of the findings of the detecting means (39)."

"19) A method of filling a container (2) with articles (6; 6'), the method comprising the step of feeding the container (2) along a path (P) through a first filling station (4) where at least a first article (6; 6') is fed into the container (2) through an opening (7) of the container (2); and the method being characterized in that the container (2) is fed through at least a second filling station (4); the method comprising a control step to determine whether the first article (6; 6') is fed into the container (2); and, in the event the first article (6; 6') is not fed into the container (2), at least a second article (6; 6') is fed into the container (2) through the opening (7) of the container (2) at the second filling station (4)."

"21) A device for filling a container (2), the device (1) comprising a conveyor assembly (3) for feeding the container (2) through a first filling station (4); and a first feed assembly (5) located at the first filling station (4) to feed at least a first article (6; 6') into the container (2) through an opening (7) of the container (2); and the device (1) being characterized by comprising at least a second feed assembly (41), located at a second filling station (4) downstream from

the first feed assembly (5), to feed at least a second article (6; 6') into the container (2); detecting means (39) for determining whether the first article (6; 6') is fed into the container (2); and a control unit (40) for activating the second feed assembly (41) on the basis of the findings of the detecting means (39); the conveyor assembly (3) feeding the container (2) through the second filling station (4)."

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

D1: DE-B-1 144 177

III. The European Patent Office acting as International Searching Authority (ISA) pursuant to Article 16 PCT and Article 154 EPC informed the applicant with a notification dated 8 June 2006 that the application did not comply with the requirement of unity of invention and invited the applicant to pay an additional search fee pursuant to Rule 40.1(ii) PCT.

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

1. claims 1, 2-8, 11, 12-16, wherein containers are fed through at least first and second filling stations and articles are fed to the filling stations successively to define first and second stacks of articles.
2. claims 1, 9, 10, 11, 17, 18, 19, 20, 21 and 22, wherein containers are fed through at least a first filling station at which an article is fed

into the containers and control means determine whether the article is fed into the container and, in the event that the article is not fed into container, a further article is fed into the container at a further filling station.

The ISA argued that the two inventions lacked unity of invention for the following reasons:

The subject-matter of independent claims 1 and 11 is anticipated by D1. Dependent claims 2 and 12 on the one hand and claims 9 and 17 on the other hand do not involve one or more of the same or corresponding special technical features (see Rule 30(1) EPC and EPO Guidelines for Examination, C-III, 7.6). In addition claims 2 and 12 on the one hand and independent claims 19 and 21 on the other hand also do not involve one or more of the same or corresponding special technical features (see Rule 30(1) EPC).

The ISA noted that a search of the second invention would have required searches in additional technical fields.

V. The applicant paid the additional search fee for the search to be carried out on the alleged second invention. The fee was paid under protest in accordance with Rule 40.2(c) PCT as set out in the letter of the applicant of 6 July 2006.

VI. The applicant in its letter of 6 July 2006 argued essentially as follows:

- (i) Dependent claim 9 is optionally dependent on claim 2, and dependent claim 17 is optionally dependent upon claim 12. There is therefore no reason why the ISA should not have searched the combinations of claims 1+2+9 on the one hand and claims 11+12+17 on the other hand.

- (ii) As an incidental issue - not the subject matter of the protest - the claims 19 to 21 could have been searched with negligible work and cost in accordance with EPC Guidelines for Examination, B-VIII, 2.3 and the results would have been included in the search report.

VII. With a notification dated 23 August 2006 the applicant was invited to pay the protest fee pursuant to Rule 40.1(iii) PCT. With this notification the result of the deliberation a "review panel" of the ISA was enclosed.

The review panel reviewed the justification for the invitation to pay the additional search fee and found it to be justified.

VIII. The appellant paid the protest fee on 21 September 2006.

Reasons for the Decision

1. *Competence of the Board to hear the protest*
 - 1.1 The competence of the Boards of Appeal to decide upon protests against the payment of an additional search fee charged by the EPO under Article 17(3)(a) PCT is set out in Article 154(3) EPC in the version of the EPC which applies to the protest under consideration, i.e. EPC 1973.
 - 1.2 In accordance with Article 150(2) EPC in the case of conflict the provisions of the PCT (including also its Regulations, pursuant to Article 150(4) EPC) shall prevail over the EPC. There is, however, no conflict of Article 154(3) EPC with the provisions of the PCT as a result of the Boards of Appeal exercising this competence.
 - 1.2.1 In accordance with the version of the PCT Regulations applicable to the present case, i.e. those adopted from the 1 April 2005, the protest "shall be examined by a review body constituted in the framework of the International Searching Authority" (Rule 40.2(c)) and further "The membership of the review body referred to in paragraph (c) may include, but shall not be limited to, the person who made the decision which is the subject of the protest" (Rule 40.2(d)).
 - 1.2.2 The Boards of Appeal are such a review body constituted within the framework of the International Searching Authority (ISA). This fact emerges both from the wording of the rule and the intent of its drafters as will be shown. The agreement with the World

Intellectual Property Organisation (WIPO) for the EPO to act as ISA was effected by the European Patent **Organisation** on behalf of the European Patent **Office** as illustrated for example at the last notice in the PCT Gazette concerning the EPO as ISA before the present application was filed (see PCT Gazette 28/2005, 14 July 2005, pages 18223 and 18226).

1.2.3 The Boards of Appeal are part of the European Patent Office, as is set out in Article 15(f) EPC, and hence are part of that office as an ISA. When Rule 40.2 PCT was changed with effect from 1 April 2005 it was the express intention of the Working Group on the Reform of the PCT that for review of the protest "a board of appeal would be a review body within the meaning of the Rules" (see PCT/A/33/1, Annex I, section 12).

1.2.4 There is thus no conflict between Rule 40.2 PCT on the one hand and Article 154(3) EPC on the other hand. In this respect the composition of the present Board complies with Rule 40.2(c) PCT since, although it does not include the person who made the decision under protest, the rule specifically states that this inclusion is an option.

1.3 In Decision W 26/06 (not published in OJ EPO) the deciding Board 3.3.08 concluded that there was a conflict between Rule 40.2 PCT and the presence in the procedure of a review by a "review panel" in addition to the review by the Board of Appeal. That Board considered that Rule 40.2 PCT provided for only one instance of review (see point 3 of the reasons) and that this review had been performed by the review panel (see point 13 of the reasons), leaving no room for a

further review by the Board of Appeal, and hence depriving it of any competence in such cases.

The present Board cannot agree with that decision. For reasons which will be explained below the present Board considers that the review by the review panel which took place before the payment of the protest fee was not a review by a review body in accordance with Rule 40.2(c) PCT, but a voluntary service provided by the EPO as ISA upon the legality of which the Board is not competent to judge.

The prior review by the review panel in the present case does not therefore affect the competence of the present Board to consider the protest.

1.4 In Decision W 19/06 (not published in OJ EPO) a different Board (3.3.04) also considered the effect of the review panel in a protest case to which amended Rule 40 PCT applied. Without referring directly to Article 150(2) EPC the Board in question nevertheless did not see a conflict between the EPC and the PCT and saw itself competent to decide upon the protest (see points 4 to 10 of the decision).

1.5 In view of the legal situation as explained above and the lack of conflict between the PCT and the EPC as regards the competence of the Boards of Appeal to hear protests the present Board is satisfied that it is competent to hear the present protest.

2. *Procedure followed by EPO as ISA*

2.1 Rule 40.1 PCT in the version applicable to the patent in suit requires that:

"The invitation to pay additional fees provided for in Article 17(3)(a) PCT shall:

(i) specify the reasons for which the international application is not considered as complying with the requirement of unity of invention;

(ii) invite the applicant to pay the additional fees within one month from the date of the invitation, and indicate the amount of those fees to be paid;

(iii) invite the applicant to pay, where applicable, the protest fee referred to in Rule 40.2(c) within one month from the date of the invitation, and indicate the amount of those fees to be paid."

The invitation should include the three elements (i)-(iii). The third element is applicable to the EPO as ISA since it requires such a protest fee in accordance with Rule 40.2(e) PCT.

It is clear from the fact that Rule 40.1 PCT starts off with the words "The invitation to pay additional fees provided for in Article 17(3)(a) shall:" and is followed by the above mentioned three elements that there should normally be a **single** invitation containing the three elements.

2.2 In the procedure adopted by the EPO as ISA after the amendment to Rule 40 PCT on 1 April 2005 (see Notice of the European Patent Office dated 1 March 2005, OJ EPO

2005, 226) the invitation is divided into **two parts**. There is a first invitation to pay the additional fee(s) which includes the first and second elements (i) and (ii) mentioned above. There may subsequently be a second invitation to pay the protest fee thus including the third element, if the applicant has paid the additional search fees under protest. The second invitation also includes an opinion of a "review panel" as to whether it concurs with the reasons for lack of unity set out in the first invitation. The review panel comprises members of the EPO as ISA, but not members of the Boards of Appeal.

2.3 In the opinion of the present Board a protest may only then be considered by the Board when all the conditions set out in Rule 40.1(i)-(iii) PCT have been fulfilled. When the first invitation is sent out only the conditions (i) and (ii) are fulfilled. This means that the opinion of the review panel cannot be considered to be the review body mentioned in Rule 40.2(c)-(e) PCT. The **review body** can only then be active when condition (iii) is also fulfilled.

2.4 In this respect the present Board disagrees with the findings of Board 3.3.08 in decision W 26/06 (*supra*) which considered that the EPO as ISA committed a procedural violation by inviting the applicant to pay a protest fee after the review by the review panel had already taken place. In the view of the present Board a review of a protest according to the PCT can only then take place when all the requirements for admissibility of the protest in accordance with Rule 40.1 PCT have been fulfilled. In the present case the requirement (iii) had not been fulfilled when the review panel

carried out its review. The review panel cannot therefore be considered to be the review body foreseen in Rule 40.2(c) PCT. This view is reinforced by the fact that in accordance with Rule 40.2(e) PCT the review **body** may order the reimbursement of the protest fee. The review **panel** cannot do this as the stage at which it looks at the protest is before the protest fee has been paid.

- 2.5 In accordance with Article 154(3) EPC the Boards of Appeal are responsible for deciding on a protest. This means that once the conditions set out in Rule 40.1 PCT have all been fulfilled it is the task of the Boards of Appeal to decide upon the protest.

In the present case all these conditions have individually been fulfilled.

3. *Extent to which the Board may examine procedures not expressly foreseen in Rule 40 PCT*

- 3.1 In its decision W 26/06 (*supra*) Board 3.3.08 examined the procedure adopted by the review panel and concluded that a procedural violation had occurred (see points 10 to 14 of the decision reasons).

With regard to the procedure adopted by the EPO as ISA in accordance with the above mentioned Notice in the Official Journal of the EPO the present Board does not consider itself competent to examine that procedure. As a consequence of this limitation of competence the Board also considers that it cannot take any account of statements made by the review panel since, in accordance with Rule 40.1(i) PCT, it is restricted to

the reasons given for lack of unity which led to the invitation to pay an additional search fee, and hence it is these reasons which form the basis for the applicant paying the additional search fee under protest. Any remarks by the review panel come after the invitation to pay additional search fees and hence do not form part of the reasons specified in Rule 40.1(i) PCT.

- 3.2 As a logical consequence of the above expressed view the Board is also not competent to consider whether the continuing presence of Rule 105(3) EPC in the Convention could conflict with the PCT as amended and whether or not the EPO should continue to apply the rule.

In reaching the above conclusion the Board agrees with the finding of Board 3.3.04 in its decision W 19/06 (see point 10 of the reasons) that the Board is not competent to approve or disapprove the practice of the EPO as ISA with respect to the continued involvement of a review panel in the protest procedure.

- 3.3 Finally, the Board notes that the applicant in the present case when paying the additional search fee under protest made a specific reference to the above mentioned Notice of the European Patent Office in its Official Journal. The applicant therefore had a legitimate expectation that its protest would be processed in the announced manner and be reviewed by a Board of Appeal.

4. *Admissibility of the protest*

4.1 In accordance with Rule 40.2(c) PCT the protest shall be examined by a review body which may order the reimbursement of part or all of the additional search fee(s), as well as the protest fee in the case that the protest was entirely justified (Rule 40.2(e) PCT).

In the view of the present Board the examination of the protest is limited to examining whether the protest is considered "to have been made" according to Rule 40.2(e) PCT and whether it is founded in substance. The examination as to admissibility is essentially an examination whether the requirements of Rule 40.1 (ii) and (iii) PCT, as applicable to the protest in question, have been complied with by the appellant.

4.2 The appellant paid the additional search fee under protest on 6 July 2006, i.e. within one month of the relevant invitation of the EPO as ISA dated 8 June 2006. Thus the requirements of Rule 40.1 (ii) PCT are fulfilled.

4.3 Contrary to the requirement of Rule 40.1 (iii) PCT, the EPO as ISA did not invite, simultaneously with the invitation to pay additional search fees, the applicant to pay the applicable protest fee. Instead it applied the procedure as mentioned in the above mentioned Notice in the Official Journal, in which the invitation is divided into one for paying the additional search fees and one for paying the protest fee, with a prior review by a "review panel" in between.

The applicant thus had a legitimate expectation that it would be invited separately to pay the protest fee. As that invitation was sent out on 23 August 2006 and the protest fee was paid on 21 September 2006, also the requirements of Rule 40.1 (iii) PCT as applicable to the protest in question are fulfilled.

Thus, the protest is considered to have been made.

5. *Substantiation of the protest*

5.1 The ISA argued that D1 took away the novelty of claims 1 and 11. The appellant has not disputed this view.

5.2 The ISA further argued that claims 2 and 12 on the one hand and claims 9 and 17 on the other hand did not involve one or more of the same or corresponding special technical features, referring to Rule 30(1) EPC and to the EPO Guidelines for Examination, C-III, 7.6.

The Board would first note that the EPC rules and the EPO Guidelines for Examination do not apply to searches carried out by the ISA. However, the PCT regulation which does apply is Rule 13.2 PCT. This rule has identical wording to the corresponding rule under the EPC so that the Board considers that this erroneous reference to the EPC does not have an effect on the merits of the case. Also, the erroneous reference to the EPO Guidelines does not affect the merits of the case since the PCT contains a similar instruction in the Administrative Instructions, Annex B, Section (c)(ii).

5.3 The Board also notes that the appellant has not argued that claims 2 and 12 on the one hand and 9 and 17 on the other hand have unity of invention when they are directly dependent on their respective independent claims. Similarly the appellant has not argued that claims 1 and 11 have unity with claims 19 and 21.

Therefore, the appellant acknowledges that the application contains two inventions as set out by the ISA and hence that the finding of the ISA was in so far correct.

5.4 The argument of the appellant is an argument as to the extent of the search of the first invention. In particular, the appellant argues that the search should not have stopped at claims 8 and 16 but should have continued to claims 9 and 17 in their dependence on claims 2 and 12 respectively. Such a search could in theory have led the appellant not to pay the additional search fee under protest, as it might have been satisfied with a search so performed.

5.5 The reasons given in the protest therefore do not concern the possible lack of unity, but rather concern the extent of the search of the first invention. In essence the argument of the appellant is based on how the two inventions were divided into two parts, i.e. whether claims 9 and 17 should be seen to be wholly part of the second invention or to be at least partially part of the first invention by virtue of their optional dependence on claims 1 and 10 respectively.

This argumentation does not provide reasons as to why the application "complies with the requirement of unity of invention" or why "the amount of the additional fees is excessive" (cf. Rule 40.2(c) PCT) on which the Board could find that the protest is justified.

5.6 The Board therefore concludes that the protest has been made but is not sufficiently substantiated.

6. *Incidental issue*

6.1 In the protest grounds the appellant made comments which were entitled "INCIDENTAL ISSUES NOT SUBJECT MATTER OF THE PROTEST". The comments concerned the question of whether the search on claims 19 to 22 could be completed with negligible effort. The review panel in its opinion made reference to these comments.

6.2 These comments according to the appellant are expressly not part of the protest and the opinion of the review panel is also not part of the protest procedure (see above). The Board therefore has no reason to take account of them.

Order

For these reasons it is decided that:

The protest is dismissed.

The Registrar:

The Chairman:

G. Rauh

H. Meinders