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**Datasheet for the decision  
of 31 May 2007**

**Case Number:** W 0027/06 - 3.4.03

**Application Number:** PCT/GB 2006/000216

**Publication Number:** WO 2006/079788

**IPC:** G03F 7/20

**Language of the proceedings:** EN

**Title of invention:**

Method of making a photopolymer plate

**Applicant:**

Photocentric Limited

**Opponent:**

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**Headword:**

-

**Relevant legal provisions:**

-

**Keyword:**

-

**Decisions cited:**

-

**Catchword:**

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Case Number: W 0027/06 - 3.4.03

International Application No. PCT/GB 2006/000216

**D E C I S I O N**  
of the Technical Board of Appeal 3.4.03  
of 31 May 2007

**Applicant:** Photocentric Limited  
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**Representative:** Harrison Goddard Foote  
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**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 21 July 2006 .

**Composition of the Board:**

**Chairman:** R. G. O'Connell  
**Members:** E. Wolff  
T. Bokor

## Summary of Facts and Submissions

I. This is a protest against the invitation of the International Search Authority (ISA) to pay an additional search fee pursuant to Article 17(3) and Rule 40.1 PCT in respect of International application PCT/GB2006/000216.

II. The claims relevant for the purposes of this protest and review read:

"1. An exposure apparatus that is adapted to use ambient light to cure photocurable liquid polymer for use in making a polymer printing plate."

"14. A combination of an apparatus of any preceding claim with a sealed sachet of liquid photopolymer adapted to be exposed in the apparatus."

"18. A combination of any of claims 14 to 17 wherein the photopolymer preparation includes a photoinitiator."

III. The ISA found that the claims covered three groups of inventions of which only two are relevant to this protest and review:

Group I claims: 1-17, 24-39, 72, 75, 76

Exposure apparatus or unit comprising a sealed sachet for liquid photopolymer to be cured with ambient light to form a printing plate

Group II claims: 18-23, 40-61, 73, 74

Liquid photopolymer composition comprising a certain photoinitiator system e.g. on the basis of a bisacylphosphineoxide and an unsaturated polymer e.g. on the basis of polyurethanes having a certain viscosity and leading to a certain hardness.

IV. The ISA reasoned its finding of lack of unity essentially as follows:

The first invention (apparatus to cure the polymer) and the second invention (Liquid polymer composition) addressed and solved different specific problems. The apparatus was not limited to using specific polymers, while the selection criteria for specific photopolymers were viscosity and hardness. The apparatus and photopolymer compositions formed accordingly a mere aggregate and could not *a priori* form part of one single general inventive concept.

The ISA also reasoned in detail that there was lack of unity *a posteriori* in view of WO 03/014832. Claim 1 and the claims relating to the second invention lacked common novel features.

V. The applicant paid just one additional search fee, which was paid under protest, and the protest fee. The additional search fee was paid in respect of the second group of inventions and a search of these claims was requested. The applicant argued in favour of the unity of the claimed invention in a main request - that all claims of the application as filed be searched for a

single fee - and an auxiliary request - that groups I and II be searched for a single fee.

VI. The applicant's arguments can be summarised as follows.

The invention related to the use of photopolymer for forming printing plates in ambient light. Contributing features of the invention were the provision of a photoinitiator and an apparatus which has been adapted to enable curing in ambient light. The solution offered by the invention lay in forming printing plates from photopolymers using ambient light together with apparatus and methods to do so. There is no prior art which discloses using daylight activated photoinitiators in a polymer to make printing plates.

The novel and inventive concept of forming printing plates in ambient light linked all the claims. The international search should therefore be carried out on all the claims for payment of a single search fee.

The apparatus claimed in claim 1 was also novel over the cited document WO 03/014832. It was "adapted to use ambient light to cure photocurable liquid polymer". This provided a structural distinction to the known apparatus which was adapted for use with the conventional technique of curing polymer in UV light but could not be used to cure photopolymer in ambient light.

The feature of curing by ambient light linked the second invention to the first invention. Contrary to the view expressed by the ISA, the second invention was not a specific photopolymer composition selected by

viscosity and hardness but instead lay in the photopolymer being capable of being cured in ambient light.

Claims 62 to 71 required the presence of a polymer package as claimed in claims relating to the "second invention" and were also linked to the common inventive concept.

For the foregoing reasons, the requirement of unity of invention was met and the search should be carried out on all claims for a single search fee.

Moreover, none of the other prior art cited in the partial search report disclosed curing in ambient light photopolymers for making printing plates.

VII. In a preliminary review of the protest, the ISA concluded that the invitation to pay an additional search fee was justified. As only one further fee had been paid, the payment of this one further fee in respect of the second invention was the only issue to be considered.

The ISA therefore did not consider the applicant's main request, i.e., to search all claims, on the grounds that the applicant had not followed the invitation to pay an additional search fee also in respect of the third invention identified in the invitation.

VIII. The preliminary review of the auxiliary request confirmed that the claims relating to the first and second groups of inventions lacked unity of invention *a priori* for the reasons stated in the invitation to pay

additional search fees, ie because the apparatus was not adapted for use with certain polymerizable material to be cured, and no synergistic effect occurred if the apparatus was used with certain photopolymers.

## Reasons for the Decision

### *Admissibility*

1. The international application under consideration has an international filing date of 23 January 2006. The protest is therefore subject to the provisions of the PCT as in force from 1 April 2005.
  - 1.1 Following decision W 20/06, points 1-9 of the reasons, the board is competent to decide on the protest. Furthermore, the protest fee was paid in time, and the protest is considered to have been made (Rule 40.2(e) PCT, second sentence) following the reasoning of the decision W 20/06, points 10-21 of the Reasons, *mutatis mutandis*.
  - 1.2 The protest is admissible.

### *Procedural issues*

2. The invitation to pay additional fees found there to be lack of unity *a priori* and, in the light of document WO 03/014832, *a posteriori*. The applicant addressed both in the reasoned statement accompanying the protest.
  - 2.1 The preliminary review of the protest upheld the objection of lack of unity of invention *a priori*. The

alleged lack of novelty of claim 1 over document WO 03/014832 and the lack of unity *a posteriori* in the light of this document were not addressed in the preliminary review.

- 2.2 As implemented by the EPO as ISA, payment of the protest fee under Rule 40.2 (e) as in force from 1 April 2005 falls due only after the preliminary review of the protest. Paying the protest fee is an option open to applicants should they disagree with an adverse preliminary review. The decision to pay the protest fee must therefore, in the view of this board, be considered a response to the outcome of the preliminary review - even if, as in the this case, the fee was already paid at the time of filing the protest.
- 2.3 In the present case, the preliminary review confirmed the statement that the application lacks unity *a priori* and that therefore the invitation to pay the additional fee was justified. There was no mention whatsoever concerning the lack of unity *a posteriori* as alleged in the original invitation.
- 2.4 In the course of the protest procedure as currently implemented, the ISA has three separate opportunities to consider the question of lack of unity of invention, and an equal number of opportunities to justify its findings as opposed to the applicant's single opportunity to submit arguments rebutting the ISA's allegation of lack of unity on filing the protest.
- 2.5 For the reasons set out in the preceding paragraphs, the board concludes that it would be inequitable if its review of the protest extended to the question of lack



of unity *a posteriori*, given that this issue was not referred to in the findings of the preliminary review, thereby depriving the applicant of an effective review in this respect. Put differently, the applicant must pay the protest fee without the benefit of the prior review which he was entitled to.

*The applicant's requests*

3. Article 17(3)(a) PCT provides that if the ISA considers that the international application does not comply with the requirement of unity of invention, it shall invite the applicant to pay additional fees. The search report is to be established only on those parts of the international application which relate to what is called the main invention, as well as those parts for which additional fees have been paid.

3.1 If the applicant disagrees with the ISA's finding of lack of unity of invention, he may pay some or all the additional fees under protest, in which case there is a re-examination as to whether the invitation to pay additional fees was justified (Rule 40 PCT). No other remedy is foreseen in the PCT. In particular, the PCT does not provide for any reassessment on the part of the ISA whether claims which were not part of the main invention and for which no additional fees have been paid should in the light of the applicant's comments be searched.

*The main request*

4. As a result of its "prior review", the ISA informed the applicant that the main request to search all claims would not be considered by it because no additional fees had been paid in respect of the third invention identified in the invitation to pay additional search fees. For the reasons set out in paragraphs **Error! Reference source not found.** and **Error! Reference source not found.** above, it was correct not to consider the main request during the prior review.

*The auxiliary request*

5. The auxiliary request was for the claims relating to the first and second invention to be searched for payment of a single search fee, and the additional search fee and the protest fee to be refunded. This request complies with the provisions of the PCT concerning the payment of additional search fees under protest.
6. The ISA concluded that *inter alia* claim 18 related a *priori* to a second invention which did not share a single inventive concept with the group I inventions.
  - 6.1 Claim 18 claims "a combination of any of claims 14 to 17 wherein the photopolymer preparation includes a photoinitiator". Claim 14 itself is for a combination of the apparatus claimed in the preceding claims 1 to 12 in combination "with a sealed sachet of liquid polymer adapted to be exposed in the apparatus."

6.2 Claim 18 is thus a multiply dependent claim which includes all the features of any claimed combination of features of the claims preceding it. It is therefore without doubt a dependent claim as defined in Rule 29(4) EPC. In its broadest form, that is when dependent from claim 14 with claim 14 itself dependent from claim 1 and with the editorial changes required by combining claims 1, 14 and 18 into one sentence, claim 18 claims "An exposure apparatus that is adapted to use ambient light to cure photocurable liquid polymer for use in making a polymer printing plate, in combination with a sealed sachet of liquid polymer adapted to be exposed, wherein the photopolymer preparation includes a photoinitiator.

6.3 No objection has been ever been raised that claim 14 lacks unity of invention with the invention claimed in claim 1. Nor did the invitation of the ISA raise any novelty objection against claim 14 (or any other claim relating to the first group of inventions except claim 1). Against this background Claim 18 merely adds to the combination in claim 14 of apparatus and polymer sachet the specific feature that the polymer (in the sachet) includes a photoinitiator.

6.4 The relevant PCT guidelines which are binding on the EPO acting as ISA (G01/89) state (PCT-Guidelines, paragraph 10.07): "If the independent claims avoid prior art and satisfy the requirement of unity of invention, no problem of lack of unity arises in respect of any claims that depend on the independent claims. In particular, it does not matter if a dependent claim itself contains a further invention ...". This applies *a fortiori* to a dependent

- claim which itself depends on an independent claim and its dependent claim, these latter being mutually unitary (i.e., satisfying the requirement of unity).
- 6.5 Being a truly dependent claim which is restricted to all the features in the claims preceding it, the board concludes that claim 18 cannot lack unity of invention *a priori* with the invention claimed in claims 1 to 17.
7. It is the established jurisprudence of the boards of appeal acting in their capacity as review body under Rule 40.2(c) PCT, that what is to be reviewed is whether the reasoning accompanying the invitation to pay further fees is correct. It is not the purpose of the review to speculate whether some other course of reasoning by the ISA would have provided an acceptable justification for the invitation or whether there is lack of unity between some other sets of claims.
- 7.1 The invitation to pay additional fees was based *inter alia* on the assertion that the invention claimed in claims 18 to 23 lacked unity *a priori* with the invention claimed in claims 1 to 17. Because claim 18 as a true dependent claim cannot lack unity of invention with the claims it depends from, the board in its capacity of review body under PCT concludes that the invitation to pay further fees was not properly reasoned as required by Rule 40.2 (c) PCT.
- 7.2 After arriving at the conclusion that part of the reasoning was incorrect, it becomes irrelevant that other claims of the application may relate to other inventions.

**Order**

**For these reasons it is decided that:**

1. The additional search fee paid by the applicant shall be refunded.
2. The protest fee shall be refunded.

Registrar

Chair

R. Schumacher

R. G. O'Connell