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**Datasheet for the decision
of 4 March 2009**

Case Number: W 0038/08 - 3.2.07

Application Number: PCT/IB 2007/002843

Publication Number: WO 2008/041082

IPC: B65B 65/00

Language of the proceedings: EN

Title of invention:
Aparatus for packaging a product

Applicant:
SYMPAK CORAZZA S.p.A.

Opponent:
-

Headword:
-

Relevant legal provisions:
EPC 1973 Art. 154
PCT Art. 16
PCT R. 13(2), 40.1, 40.2

Keyword:
"Claims optionally dependent or independent - independent
option considered"
"Lack of unity - yes"

Decisions cited:
-

Catchword:
-



Case Number: W 0038/08 - 3.2.07

International Application No. PCT/IB 2007/002843

D E C I S I O N
of the Technical Board of Appeal 3.2.07
of 4 March 2009

Applicant: SYMPAK CORAZZA S.p.A.
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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 29 February 2008.

Composition of the Board:

Chairman: H. Meinders
Members: P. O'Reilly
T. Bokor

Summary of Facts and Submissions

I. International application No. PCT/2007/002843 was filed with 111 claims.

II. 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 29 February 2008 that the application did not comply with the requirement of unity of invention and invited the applicant to pay seventeen additional search fees pursuant to Rule 40.1(ii) PCT.

III. The prior art documents cited in the present decision are:

D1: WO-A-2004/063017

D2: EP-A-0 268 917.

IV. The ISA considered that the sets of claims contained the eighteen inventions. The first invention and the inventions for which two additional search fees have been paid are the following:

1. claims 1-3, 106-108, and 111: packaging apparatus characterized by a longitudinal or flat wall which separates the operating means from the drive means;

6. claims 1 (preamble), 37-45, 110: packaging apparatus characterized by means for placing a label on a site of a means for feeding parts of a wrapper;

16. claims 1 (preamble), 96-99: packaging apparatus characterized by means for positioning a cup-shaped wrapper at a height such that the top of a product is at a predetermined height;

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

The subject-matter of independent claim 1 is anticipated by each of D1 and D2. Claims 1, 37 and 96 do not comprise any common special technical features and they solve different technical problems (Rule 13(2) PCT).

V. The applicant paid two additional search fees for the search to be carried out on the alleged inventions of claims 1 (preamble), 37-45, 110 (sixth invention); and claims 1 (preamble), 96-99 (sixteenth invention). The fees were paid under protest in accordance with Rule 40.2(c) PCT as set out in the letter of the applicant of 27 March 2008.

VI. The applicant in its letter of 27 March 2008 argued as follows:

Claims 4, 16, 23, 32, 37, 46, 52, 63, 69, 73, 75, 82, 89, 96, 100 and 105, each contain a clear statement referring them back to "any of the foregoing claims". Therefore all of the claims should have been searched. All of the features contained in these claims relate to a packaging apparatus for pasty food products such as processed cheese and are synergetic. It is clear from the International Search Guidelines that lack of unity of invention should be considered only with respect to independent claims and not with respect to dependent

claims. Also, the subject-matter of these claims could have been searched with little or no additional search effort.

VII. With a notification dated 26 June 2008 the applicant was invited to pay the protest fee pursuant to Rule 40.1(iii) PCT. With this notification the result of the deliberation of a review panel of the ISA was enclosed.

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

VIII. The appellant paid the protest fee on 18 July 2008.

Reasons for the Decision

1. *Competence of the Boards of Appeal and whether the protest has been made*

1.1 The application in suit was filed on 27 September 2007. Therefore, the protest is subject to the provisions of the PCT as in force from 1 April 2007. The Boards of Appeal are responsible for deciding on protests relating to PCT applications pending at the time of entry into force of the EPC 2000 (13 December 2007). Details of the procedure are guided by the Decision of the President of the EPO dated 24 June 2007, Article 3 (OJ EPO 2007, Special edition No. 3, 140), for more details see also W 16/08, points 1.1-1.5 of the reasons.

1.2 The protest fee has been paid in time and the protest contains a reasoned statement why the inventions for which the additional search fees have been paid should

fulfil the requirement of unity. Accordingly, the protest was properly made (Rule 40.2(c) and (e) PCT).

2. *Substance of the protest*

- 2.1 The ISA argued that each of D1 and D2 took away the novelty of at least claim 1. The appellant has not disputed this view and the Board sees no reason to consider this point itself. This would also mean that these documents each disclose the features of the preamble of claim 1.
- 2.2. The ISA further argued that there were eighteen groups of claims which did not involve one or more of the same or corresponding special technical features thus forming separate inventions.
- 2.3 With the exception of claim 1, each of the leading claims of the alleged inventions started with the following phrase "The apparatus according to any of the foregoing claims or according to the preamble of claim 1, characterized in that it comprises...". This is the case for the leading claims 37 and 96 for which additional search fees have been paid.

This wording implies two options. In the first option referring to the foregoing claims the claims take on the form of dependent claims since they refer back to preceding claims in their entirety. In the second option referring to the preamble of claim 1 these claims each take on the form of an independent claim since they do not include all the features of a preceding claim, in particular they do not include the characterizing feature of claim 1.

2.4 In the statement of the ISA regarding these claims it made specific reference to "claims: 1 (preamble), 37-45, 110" and "claims: 1 (preamble), 96-99". This statement is thus directed to the second option.

In the letter of the appellant dated 27 March 2008 it stated that the additional search fees were being paid "for the group 6 (claims: 1 (preamble), 37-45, 110) and the group 16 (claims: 1 (preamble), 96-99)". This statement is thus also directed to the second option.

The Board notes that there is thus a common understanding that reference was being made to the claims 37 and 96 in their option of referring back to the preamble of claim 1.

This means that when considering the question of whether the invitation to pay additional fees was justified it is the option of claims 37 and 96 taking on the form of independent claims that must be considered.

2.5 The three independent claims for which search fees have been paid all have the same preamble, (the one of claim 1) but have differing characterizing features which are the following:

1. partition means (120) which extend lengthways along the apparatus, and from which the corresponding operating means in turn extend and which separate the operating means from the drive means;

37. means (22) for placing a label on a respective site of a means for feeding parts of a wrapper;

96. means (147) for positioning a cup-shaped, filled wrapper at a height such that the top of a product is at a predetermined height.

The characterizing feature of claim 1 is apparently intended to solve the problems of improving packaging hygiene and accessibility to machine parts (see page 3, lines 27 to 31 and figure 1 of the application as originally filed).

The characterizing feature of claim 37 is apparently intended to solve problems concerning the application of labels to the wrapper (see page 8, line 36 to page 9, line 2 and figure 5 of the application as originally filed).

The characterizing feature of claim 96 is apparently intended to solve problems concerning obtaining a straighter or a more rounded edge for the cap retaining tabs (see page 8, line 36 to page 9, line 2 and figure 6 of the application as originally filed).

The three characterizing features therefore provide differing solutions to differing problems. No interactions between the features have been shown other than that they can be independently provided on the same apparatus.

2.6 The arguments of the appellant are essentially based on its view that the claims of the inventions for which the additional fees have been paid should have been searched

as dependent claims. As noted above, however, the Board considers that the claims have to be considered in their independent form.

The appellant has also argued that the characterizing features of the disputed claims are synergistic (see page 3 of the letter of the appellant). This argument would only apply if the features were being provided simultaneously. However, the claims are being considered as independent claims so that this argument does not apply either. In addition, the respective characterizing features function independently of each other.

- 2.7 In the opinion of the appellant the International Search Guidelines indicate that lack of unity of invention should be considered only with respect to independent claims and not with respect to dependent claims. This argument does not apply to the present case since it is the independent option of the claims that is being considered, not the dependent option, as explained above.
- 2.8 It is noted that the PCT does not foresee an additional search for those inventions for which no additional search fee was paid, irrespective of the finding concerning unity of the inventions actually examined in the protest. The Board cannot therefore consider whether or not a search should have been performed on the claims in their alternative reference back to "any of the foregoing claims".
- 2.9 The Board therefore concludes that the protest is not justified.

Order

For these reasons it is decided that:

The protest is rejected.

The Registrar:

The Chairman:

G. Rauh

H. Meinders