

Case Number : W 8/87

International Application No PCT/US86/02415

D E C I S I O N
of the Technical Board of Appeal 3.2.2
of 14 December 1987

Appellant : ELECTRO-CATHETER CORPORATION
2100 Felver Court
Rahway, New Jersey 07065 (US)

Representative : Cohen, Pontani & Lieberman
551 Fifth Avenue
New York, New York 10176 (US)

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 fee) of the European Patent Office (branch at The Hague) dated 5 March 1987

Composition of the Board :

Chairman : C. Maus

Members : C. Andries

W. Moser

Summary of Facts and Submissions

- I. On 7 November 1986, the Applicant filed an International patent application PCT/US86/02415.
- II. On 5 March 1987, the European Patent Office (EPO), acting as International Search Authority (ISA), issued an invitation to pay five additional search fees in accordance with Article 17(3)(a) and Rule 40.1 PCT, in view of the fact that it considered the above identified application as not complying with the requirements of unity of invention.

Six inventions were identified:

- Claims 1, 2: The cardiac assist device of Claim 1 wherein said removal means completely bypasses the heart.
- Claims 1, 3: The cardiac assist device of Claim 1 wherein said removal means is a cannula for insertion in the femoral vein.
- Claims 1, 4: The cardiac assist device of Claim 1 wherein said reintroduction means is a cannula for insertion in the femoral artery.
- Claims 1, 5, 6: The cardiac assist device of Claim 1, comprising two cannulae and a circulatory system between said cannulae.
- Claims 1, 7: The cardiac assist device of Claim 1, comprising means to remove all venous blood by gravity means to introduce it to

the patients aorta and a circulatory system between the two means.

Claim 10: A blood pulsation device.

The reason given for this finding was that in the light of EP-A-75 606 the general inventive concept expressed in Claim 1 did not stand up to examination nor could it be considered to be new. Therefore, the various subjects indicated could no longer be considered as an inventive unity.

III. On 16 April 1987 the Applicant indicated by letter that he paid the five additional search fees under protest (Rule 40.2(c) PCT). These fees were received by the EPO on 21 April 1987.

Furthermore, the Applicant asserted that Claim 1 did stand up to examination and defined new subject-matter which was patentable in view of the cited reference and, therefore, the requirement as to unity of invention was met. The Applicant asserted furthermore that Claim 1 was the broadest statement of the invention set forth in the application and that the remaining claims set forth specific forms of that invention.

The ISA's attention was drawn to a typographical error in line 1 of Claim 8, which should read as dependent from Claim 1 instead of from Claim 10.

The Applicant requested that Claims 1 to 10 should be searched, that his protest should be considered and that the said additional fees should be reimbursed.

Reasons for the Decision

1. Pursuant to Article 154(3) EPC and Article 9 of the agreement between WIPO and the EPO, the Boards of Appeal of the EPO are responsible for deciding on a protest made by an applicant against additional search fees charged by the EPO under the provisions of Article 17(3)(a) PCT (OJ EPO 4/1978, 249). In the present case, the protest is admissible under Rule 40.2(c) PCT because, within the prescribed time limit (Article 17(3)(a) PCT), the Applicant has paid the additional fees under protest, that is accompanied by a reasoned statement emphasising the Applicant's view that the international application complies with the requirement of unity of invention.
2. The ISA has made clear in its invitation that it considers the six subjects specified above as a group of inventions not so linked as to form a single general inventive concept. However, contrary to the provision contained in Rule 40.1 PCT, the invitation sent by the ISA failed to specify in a sufficiently clear way the reasons for the above findings.
3. The Boards of Appeal of the EPO have already decided (W 04/85 of 22 April 1986 and W 07/86 of 6 June 1986, both published in OJ EPO, 2/1987, pages 63 to 69, and W 09/86 of 11 August 1986, published in OJ EPO, 10/1987, pages 459 to 464) that the indication of reasons in an invitation pursuant to Article 17(3)(a) and Rule 40.1 PCT is an essential prerequisite for such an invitation to be legally effective.

The first cited decision stated (second sentence of second paragraph in numbered section 3) that "in straightforward cases all that may be necessary to substantiate lack of

unity is a list of the application's subject-matters ... when the list makes perfectly clear that the application does not relate to a single general inventive concept within the meaning of Rule 13.1 PCT".

The second cited decision clarifies (Headnote, item 2) that such "straightforward cases in which a mere list of the different aspects of an invention's subject-matter might be regarded as substantiation constitute rare exceptions".

The last cited decision also indicated that the results of searches leading to a-posteriori lack of unity objections, being part of the reasons for the alleged non-compliance with the requirement of unity of invention, must be communicated to the Applicant.

4. In the present case, one such exceptional "straightforward case" is recognised by the Board. Indeed, independent Claim 10, which describes a fluid driven blood pump, cannot be considered, firstly, as being an alternative for the cardiac assist device according to Claim 1 and, secondly, as solving the same problem as the subject-matter defined in Claim 1.

Therefore, Claim 1 on the one hand and Claim 10 on the other hand are not linked to each other so as to form a single general inventive concept.

In this case, the mere listing of the set of Claims 1, 2 on the one hand and Claim 10 on the other, is sufficient to make clear that non-unity is at stake.

Therefore, the additional search fee to search the subject-matter of Claim 10 has to be paid.

5. Furthermore, the ISA has cited EP-A-75 606 and has indicated that the subject-matter of Claim 1 of the present application cannot be considered to be novel with respect to this document.

EP-A-75 606 describes a system for extracorporeal circulation of blood. One object of the invention (page 3, lines 18 to 24) is to assist the intracorporeal circulation of the blood by an extra-corporeal circulation system while the blood is being spontaneously circulated through the body by the cardiac force of the patient. Venous blood is withdrawn from the patient's body through cannulas (15) which are inserted into the superior and inferior venae cavae (page 7, lines 10 to 12). An extracorporeal pulsatile pump (14) applies a pulsating flow to said removed blood. Said pulsated blood (blood supply line 4) is introduced into the ascending aorta of the patient through a cannula (page 11, lines 16 to 25).

In the case of spontaneous circulation (by the force of cardiac contraction), the pump (14) assists the heart of the patient in supplying the blood, so that the two blood supplies must be in synchronism. The description furthermore (page 16, lines 22 to 24) states that it is preferable that the pump (14) supplies the blood with a time delay after the arterial blood is supplied by the heart. To a man skilled in the art that means that the system involved is so constructed that the pumped blood is introduced into the arteries (ascending aorta) after the supply of blood by the heart has been stopped. If the supply of blood by the heart is finished, the aortic valve allowing such a supply is closed. Therefore, the description (page 16, lines 22 to 24) of EP-A-75 606 implicitly indicates that the pulsated blood is introduced into the aorta while the aortic valve is closed. The Board

cannot agree with the Applicant's argument according to which the structural requirement of the pulsated blood being introduced into the aorta while the aortic valve is closed is not suggested in EP-A-75 606. Indeed, as already indicated above, EP-A-75 606 teaches implicitly that the pulsatile pump (14) supplies the blood with a time delay after the arterial blood is supplied by the heart. If the heart is not supplying blood any more, the aortic valve allowing such a supply has to be closed.

EP-A-75 606 therefore describes all the features present in Claim 1 of the present application.

The subject-matter of Claim 1 therefore is not novel (Article 33.1 PCT).

The ISA correctly cited EP-A-75 606 to prove this lacking novelty.

6. Since the subject-matter of Claim 1 is not novel, lack of unity may become apparent (a-posteriori) if the remaining claims (2 to 9) leave two or more independent claims without a common inventive concept.

The ISA enumerated in its invitation five subjects (Claims 1, 2; 1, 3; 1, 4; 1, 5, 6 and 1, 7) but failed to specify why these subjects did not have the same common inventive concept.

Contrary to the "straightforward case" with respect to non-unity between the Claims 1 and 10 as indicated in above point 4, the Board is of the opinion that the sets of Claims 1, 2; 1, 3; 1, 4; 1, 5, 6 and 1, 7 do not form such an exceptional "straightforward case", since the mere

enumeration of the different subjects even together with the statement that the various subjects can no longer be considered as inventive unity, does not make the absence of a single general inventive concept "perfectly clear".

On the contrary, it is not clear at all why there should be no common inventive concept linking the subject-matter of these different sets of Claims. For example, in the embodiments according to the set of Claims 1, 3 on the one hand and the set of Claims 1, 4 on the other a cannula adapted for insertion in the body is used together with the same cardiac assist device.

Furthermore, it becomes quite clear from the description that an object of the invention is to obtain a device which can assist or replace the natural heart beat and which maintains a natural pulsatile pressure. This object of the invention does not exclude, at least prima facie, that it can be obtained by the subject-matter of Claim 2 (1, 2) as well as by the subject-matter of respectively Claims 3 (1, 3), 4 (1, 4), 5 (1, 5) or 7 (1, 7).

Without an explanation the remarks in the invitation do not enable the Applicant and the Board to establish whether the invitation to pay the additional fees was correctly issued.

7. Accordingly, the invitation lacks legal basis with respect to the a-posteriori non-unity objection according to above point 6, because it contravenes Rule 40.1 read in conjunction with Rule 13.1 PCT, and thus cannot have any legal effect, with respect to the lack of unity a-posteriori as indicated in above point 6.

Therefore, the corresponding four additional search fees cannot be retained.

8. According to Rule 91.1 PCT obvious errors of transcriptions may be rectified on the request of the Applicant.

The Board agrees with the Applicant that Claim 8 should be read as dependent on Claim 1 because the reference in Claim 8 to Claim 10 has to be regarded as an obvious error of transcription; otherwise it would not have been necessary to repeat in Claim 8 all the features already present in Claim 10.

Order

For these reasons, it is decided that:

Refund of four additional search fees is ordered.

The Registrar

The Chairman

F.Klein

C.Maus