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File Number: W 50/91 - 3.2.3

Application No.: PCT/CA 91/00047

Publication No.:

Title of invention: Solar Roof Collector

Classification: F24J 2/04, F24J 2/14, F03G 7/02

D E C I S I O N
of 20 July 1992

Applicants: 116736 (Canada) Inc.

Headword:

EPC Article 17(3)(a) and Rule 40

Keyword: "Lack of unity a priori" (no) - "Lack of reasons in the invitation"



Case Number : W 50/91 - 3.2.3
International Application No. PCT/CA 91/00047

D E C I S I O N
of the Technical Board of Appeal 3.2.3
of 20 July 1992

Applicants : 116736 (CANADA) Inc.
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Representative : Mitchell, R. et al.
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Subject of the 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 June 1991.

Composition of the Board :

Chairman : C.T. Wilson
Members : H. Andrä
W. Moser

Summary of Facts and Submissions

- I. International patent application PCT/CA 91/00047 was filed on 14 February 1991 with the Canadian Patent Office.
- II. On 5 June 1991, the European Patent Office as competent International Search Authority (ISA) issued an invitation pursuant to Article 17(3)(a) and Rule 40.1 PCT to pay within 45 days two additional search fees, as it was considered that the requirement of unity of invention was not satisfied.

The three groups of inventions identified were:

1. Claims 1 to 6: Solar focussing collector
2. Claims 7 to 31: Solar roof collector
3. Claims 32 & 33: Hybrid solar collector.

As grounds given for these findings, the ISA stated that the subjects, defined by the problems and their means of solution, as listed are so different from each other that no technical relationship or interaction can be appreciated to be present so as to form a single general inventive concept.

- III. With a telex of 28 June 1991, confirmed by letter dated 15 July 1991 and received on 23 July 1991, the Applicants enclosed one additional search fee for the purpose of searching group 2 of the claims, namely, Claims 7 to 31, paying this fee under protest and referring to their letter of 28 June 1991, received on 5 July 1991.

In this letter they requested that group 2, Claims 7 to 31, be reconsidered. They put forward that Claim 7 was essentially subordinate to Claim 1 and that Claim 7 had all of the limitations of Claim 1 and, therefore, this

independent claim may be considered dependent from Claim 1.

With letter dated 27 April 1992, received on 2 May 1992, the Applicants sent a copy of a registered mail receipt of the Canada Post Corporation dated 15 July 1991 arguing that the cheque concerning the additional search fee which was received in the European Patent Office only on 23 July 1991 was deemed to have been sent in time according to Rule 82.1 PCT.

Reasons for the Decision

1. The registered mail receipt of the Canada Post Corporation dated 15 July 1991 submitted by letter received on 2 May 1992 (cf. above paragraph III) is regarded by the Board as satisfactory evidence that the Appellants posted the letter containing the cheque for the additional search fee on 15 July 1991, i.e. five days prior to the expiry of the time limit which occurred on 20 July 1991, namely, 45 days from the date of posting of the invitation pursuant to Article 17(3)(a) and Rule 40.1 PCT of 5 June 1991.

Under these circumstances, the delay in arrival of the additional search fee shall be excused pursuant to Rule 82.1 PCT and the fee is deemed to have been paid in due time.

Consequently, the appeal complies with the formal requirements of Rules 40.2 and 40.3 PCT and is admissible.

2. In accordance with Rule 40.1 PCT the invitation provided for in Article 17(3)(a) PCT to pay additional fees must specify the reasons for which the International

application is not considered to comply with the requirement of unity of invention. It is the established jurisprudence of the Boards of Appeal (cf. decisions W 4/85, OJ EPO 2/1987, 63-68, and W 7/86, OJ EPO 2/1987, 67-69) that in the absence of adequate reasoning such an invitation cannot be regarded as justified. The first mentioned decision states that in straightforward cases all that may be necessary to substantiate a lack of unity is a list of the different groups of subject-matter claimed in the application. However, in the latter decision (W 7/86), it was deemed appropriate to add that such is rarely the case.

3. In the present case, the invitation of the ISA contained besides the three groups of subject-matter identified (cf. above paragraph II) the remark that the subjects, defined by the problems and their means of solution as listed are so different from each other that no technical relationship or interaction can be appreciated to be present so as to form a single general inventive concept. This remark concerns essentially the definition of lacking unity of invention pursuant to Rule 13.1 PCT and cannot therefore be considered as containing an acceptably reasoned statement setting out the considerations for the decision in a way which could be readily understood.

The ISA did not give any reason to be verified as to why the first two groups of subject-matter being the object of the present protest were considered as relating to separate inventive concepts.

4. As the ISA did not make any reference to the prior art in the invitation the Board concludes that an objection of lack of unity a priori is intended. In the case of a protest under Rule 40.2 PCT where an objection a priori is raised, no results of an examination of the merits of the

claimed subject-matter in comparison with the prior art are available. In this case, only the technical problem as viewed by the Applicant can be taken as a basis for assessing unity of invention including the provisional acknowledgement of the prior art in the description.

The application is concerned with the conversion of solar energy into other forms of energy and has as general object the increase of efficiency of known solar energy conversion systems.

The first group of subject-matter indicated by the ISA comprises independent Claim 1 which pertains to a solar focussing collector and Claims 2 to 6 which are dependent on Claim 1.

The second group of subject-matter indicated by the ISA pertains to a solar roof collector and comprises Claims 7 to 31.

It appears that the above-cited object is solved by all the Claims 1 to 31, no evidence to the contrary having been presented by the ISA or being recognisable by the Board.

Besides, it can be seen that all the features of the independent Claim 1 of the first group of subject-matter are recapitulated in the first independent Claim 7 of the second group of subject-matter. The latter claim has therefore to be regarded in substance as being dependent on Claim 1 of the first group. Under these conditions, the subject-matter of Claim 1 of the first group constitutes a unifying link between independent Claim 1 of the first group and independent Claim 7 of the second group. Since unity of invention between the subject-matter

of the first independent Claim 7 and the second independent Claim 28 of the second group has not been doubted by the ISA in its invitation, the Board sees no reason to question these findings.

As it is not derivable from the present application or from the a priori objection made in the invitation of the ISA that the subject-matter of Claim 1 in its entirety is either known or not inventive, the Board comes to the conclusion that the solar focussing collector as claimed in the independent Claim 1 (first group of subject-matter) and the solar roof collector as claimed in the independent Claim 7 (second group of subject-matter) are linked by a single general inventive concept.

- 5. Therefore there is no basis for an a priori objection as to lack of unity of the invention. Consequently, the invitation to pay an additional search fee for Claims 7 to 31 is not legally effective and the additional search fee paid by the Applicants cannot be retained.

Order

For these reasons, it is decided that:

Refund of the additional search fee is ordered.

The Registrar:



N. Maslin

The Chairman:



C.T. Wilson