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File Number: W 33/92 - 3.3.1
Application No.: PCT/US91/08149
Publication No.: WO 9208838
Title of invention: Polyamide dyeing process utilizing controlled dye
addition

Classification: D06P 1/00, D06P 3/24

D E C I S I O N
of 12 August 1992

Applicant: E.I. Du Pont De Nemours + Co.

Headword: Dyeing process/DU PONT

PCT Article 17(3)(a), Rule 40.2

Keyword: "Unity of invention (yes)"



Case Number : W 33/92 - 3.3.1
International Application No. PCT/US91/08149

D E C I S I O N
of the Technical Board of Appeal 3.3.1
of 12 August 1992

Applicant : E.I. Du Pont De Nemours + Co.
1007 Market Street
Wilmingtone
Delaware 19898 (US)

Representative :

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 20 May 1992.

Composition of the Board :

Chairman : K. Jahn
Members : R. Spangenberg
J. Stephens-Ofner

Summary of Facts and Submissions

- I. Following the filing of International Patent Application No. PCT/US91/08149 the EPO, acting as ISA, on 20 May 1992 issued an invitation to pay, within a time limit of 45 days, an additional search fee because it considered that Claims 1 to 16 related to a process for dyeing articles and an article dyed following that process, while Claims 17 to 21 were concerned with a dyed fabric having front and back fabric surfaces and a fabric interior comprising fibers which are asymmetrically ring-dyed, this fabric being not related to the subject-matter of Claims 1 to 16, and that, therefore, the application did not comply with the requirement of unity of invention.

- II. On 1 July 1992 the Applicant paid the additional search fee under protest. He submitted that the process of Claims 1 to 15 was the only one by which it was possible to obtain the products specified in Claims 17 to 21 and that, therefore, the subject-matter of the application was in conformity with Rule 13.2 PCT. He requested that the additional search fee be refunded.

Reasons for the Decision

1. The protest is admissible.

2. The reasons contained in the invitation are short, but it was clear from them to the Applicant which case he had to answer. Thus in these circumstances the invitation may be regarded as complying with the requirement of Rule 40.1 PCT.

3. The objection of non-unity was raised by the ISA a priori, i.e. without taking the state of the art into account, and was based on the sole ground that there was no relation between the subject-matter of Claims 1 to 16 and 17 to 21. However, in the Board's judgment the subject-matter of these claims is technically related, although independent Claim 17 does not contain any express pointer to the process of Claims 1 to 15. However, Rule 13.1 PCT does not require that the link between the subject-matter of two independent claims must be expressly stated in their wording. All that is required is that there should be a single general inventive concept. In the Board's judgment, in determining whether or not this requirement is met, a formalistic approach should be avoided. This means that even if, as in the present case, the wording of two independent claims might at first glance give the impression that they related to two different inventions, an objection should only be raised if this impression is also supported by the description.

This is, however, not the case here. On the contrary, it is expressly stated in the description, see the paragraph bridging pages 25 and 26, that the product of Example 8B is a product according to Claim 17 which is obtained by a process according to Claim 1, while conventional dyeing according to Example 8A (comparative) yielded a different product (see also Figures 4 and 5). The same information can be derived from e.g. Example 12. Thus, the products of Claims 17 to 21 are products of the process of Claims 1 to 15 and, a priori, i.e. without considering the state of the art, the subject-matter of Claims 1 to 15 and 17 to 21 is linked by a single general inventive concept, namely to make available the specifically dyed products of the latter claims.

Order

For these reasons, it is decided that:

Reimbursement of the additional search fee is ordered.

The Registrar:

The Chairman:

E. Görgmaier

K.J.A. Jahn