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D E C I S I O N
of 24 March 1994

Case Number: W 0008/93 - 3.2.4

Application Number: PCT/US 92/06402

Publication Number: WO 93/02600

IPC: A47G 21/18

Language of the proceedings: EN

Title of invention:

Package system for fluids and manufacture thereof

Applicant:

Minnesota Mining and Manufacturing Company

Opponent:

-

Headword:

-

Relevant legal norms:

PCT R. 40.2(c)(e)

Keyword:

"Scope of the examination according to Rule 40.2(c) PCT"
"No reimbursement of the protest fee"

Decisions cited: -

G 0001/89, W 0006/90, W 0032/92, W 0003/93

Catchword:

-



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Boards of Appeal

Chambres de recours

Case Number: W 0008/93 - 3.2.4
International Application No. PCT/US 92/06402

D E C I S I O N
of the Technical Board of Appeal 3.2.4
of 24 March 1994

Applicant: Minnesota Mining and Manufacturing Company
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Representative: Binder, Mark W.
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Subject of the Decision: Protest according to Rule 40.2(c) of the Patent
~~Cooperation Treaty made by the applicant~~
against the invitation (payment of additional
fee) of the European Patent Office (branch at
The Hague) dated 30 November 1992.

Composition of the Board:

Chairman: C.A.J. Andries
Members: M.G. Hatherly
J.-P. Seitz

Summary of Facts and Submissions

I. On 30 November 1992 the International Searching Authority (ISA) dispatched an invitation to the Applicant to pay two additional search fees on the grounds that the international application contained the three following inventions:

Invention I: Claims 1 to 11 and 26 to 42:
A wrapped tube which is, at least in part, resiliently, axially compressible.

Invention II: Claims 12 to 16:
An apparatus on which wrapped tubes can be formed.

Invention III: Claims 17 to 25:
Process for forming a wrapped tube.

The ISA stated that the cited document FR-A-1 307 693 disclosed the feature common to the above claims, namely a tube (which might be resiliently, axially compressible) having a series of wraps of material (formed from a single, generally flat strip) with successive wraps having overlapping edge portions. Thus the technical link between the independent claims was broken, resulting in non-unity *a posteriori*.

II. The Applicant replied to the invitation in due time on 13 January 1993 by paying the two additional search fees but under protest arguing:

- that there were differences between the claimed device and the cited document FR-A-1 307 693; and

- that at least the apparatus claims (i.e. invention II) and the process claims (i.e. invention III) did comply with the unity of invention requirements as they related to each other, thus at most only one additional search fee should have been charged.

III. On 21 April 1993 the Review Panel of the EPO dispatched the result of a prior review of the justification for the invitation to pay additional search fees. It found that:

- what was common to inventions I, II and III was known from document FR-A-1 307 693;
- however, within inventions II and III, the independent Claims 12 and 17 were linked by the use of an apparatus having a slot and an axially aligned arcuate internal surface for forming the wrapped tube, which was not known from the cited prior art;
- thus inventions II and III were one invention; and
- thus the invitation was only in part justified and one additional search fee would be refunded.

IV. A letter by facsimile, requesting the examination of the protest and without further arguments, was received from the Applicant on 18 May 1993 and the protest fee (Rule 40.2(e) PCT) was paid on this day.

Reasons for the Decision

1. The protest is admissible.
2. In the invitation to pay additional search fees the ISA made a lack of unity objection "*a posteriori*" having regard to the cited document FR-A-1 307 693. Such objections are permissible in clear cases (see Decision G 1/89, OJ EPO 1991, 155).

The ISA objected that the application contained three inventions (I, II and II) and so invited the Applicant to pay two additional search fees.

3. *Scope of examination by the Board*

- 3.1 From the wording of Rule 40.2 PCT it appears that the Board has to examine the **protest** (Rule 40.2(e) PCT: examination of the protest) which the Applicant made when paying the additional fees (Rule 40.2(c) PCT). The Board therefore has to take account of the points set out in sections I and II above.

- 3.2 Protest proceedings according to Rule 40.2(c) PCT are provided in order to decide whether, on the basis of the reasons given by the ISA (above section I) and the counter-reasons provided by the Applicant (above section II), the invitation to pay an additional search fee or fees was justified. The Board is not entitled to investigate of its own motion whether a unity of invention objection could have been raised for some reason other than that already given (see section 4 of Decision W 3/93 - to be published).

4. The ISA objected that the claims covered three inventions, essentially a tube, an apparatus on which a tube can be made and a process for making a tube.

The mere fact that there are claims of different categories is in itself no reason for an objection of lack of unity. It can be seen that all claims have a single general concept - a tube, indeed a tube comprising a strip arranged in a plurality of wraps with overlapping edge portions. It seems from the application that the Applicant considered that such a tube formed the contribution to the state of the art.

However it follows from Rule 13.1 PCT that the single general concept must have inventive character otherwise there is lack of unity (see also Decision W 6/90, OJ EPO 1991, 439).

5. Turning now to the document FR-A-1 307 693 cited by the ISA, it is immediately apparent that Figure 1 shows a bottle 10 containing a beverage and a tube 12 (drinking straw) held axially compressed by a cap 11 (also see page 1, right-hand column, lines 8 to 19). When the cap is removed the straw axially extends (see Figure 2 and page 1, right-hand column, lines 19 to 22). According to lines 22 to 24 of the same column, this result can be obtained in different ways including those described with reference to Figures 13 and 14. Page 2, right-hand column, last paragraph to page 3, left-hand column, line 11 states that the straw of Figure 13 is made in one piece by rolling a band of e.g. plastic into a helix, that the straw is cylindrical and that the overlapping spirals are pressed narrowly together to form a liquid tight joint.

Accordingly it is clear that the single general concept linking the present independent claims, namely a tube

comprising a strip arranged in a plurality of wraps with overlapping edge portions, cannot be an **inventive** concept as required by Rule 13.1 PCT since it is in fact known from the cited document FR-A-1 307 693.

6. The Applicant's first argument that there are (unspecified) differences between the claimed device and the cited document FR-A-1 307 693 does not counter the ISA's objection which is based, not on the subject-matter of any **particular** claim being known, but on the **common** subject-matter of the independent claims being known. This common subject-matter defines not only a technical entity but also what was intended to be the contribution to the state of the art. It follows from Rule 13.1 PCT that the claims of an application must at least be linked by a single general inventive concept, otherwise there would be lack of unity. Moreover the Applicant has given no reasons for, or examples of, differences between what is claimed and what the citation discloses and the Board is unable to see that ~~the subject-matter of some of the claims, i.e. Claims 1 to 3 and 6 to 11, differs from the disclosure.~~

7. The Applicant's second argument, that at least the apparatus claims (i.e. invention II) and the process claims (i.e. invention III) did comply with the unity of invention requirements as they related to each other and thus that at most only one additional search fee should have been charged, has been accepted by the Review Panel which envisaged the return of one additional search fee. The Board sees no reason to deviate from the Review Panel's conclusions in this respect.

8. Apart from the arguments set out in sections 6 and 7 above, the Applicant has presented no other arguments as to why the inventions I on the one hand and II and III on the other hand should be seen as one invention.

9. In Decision W 32/92 the relevant Board found that the subject-matter of a first of two independent claims lacked novelty and went on to examine whether unity of invention would exist between the subject-matter of the second independent claim and the combination of the first independent claim and the first mentioned of its dependent claims.

Following this approach in the present case the Board concludes that those claims in the group I (the product claims) which have subject-matter which is not disclosed by the document FR-A-1 307 693 (see above section 6, last sentence) relate to a package with retention means for the tube (Claims 4 and 5) and to a tube or a package wherein the tube has a specific new construction of a non-collapsible portion (Claims 26 to 42).

On the other hand the claims in groups II and III concentrate on the features of the apparatus (the forming jig's shape), the chemical material and the conditions of the process e.g. the temperature used.

The apparatus and process claims in groups II and III lack the features necessary either to result in the retention means of the package according to Claims 4 and 5 or to result in a tube having also a non-collapsible portion according to Claims 26 to 42. Therefore the Board considers the inventions of the groups II and III on the one hand and group I (after consideration of document FR-A-1 307 693) on the other hand as being totally different.

The Board thus sees no unity of invention between the group I (after consideration of document FR-A-1 307 693) on the one hand and the groups II and III on the other hand.

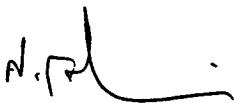
10. The international application accordingly does not comply with the unity of invention requirement of Rule 13.1 PCT. The Board however is of the opinion that the invitation to pay additional search fees was only justified for only one additional search fee. The second additional search fee paid by the Applicant has to be reimbursed. The protest fee however, which according to the last sentence of Rule 40.2(e) PCT has to be refunded to the Applicant when the protest was **entirely** justified, cannot be refunded due to the fact that one additional search fee was correctly requested by the ISA.

Order

For these reasons, it is decided that:

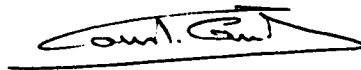
1. The protest is only partly justified.
2. One of the two additional search fees has to be reimbursed.
3. The protest fee shall not be refunded.

The Registrar:



N. Maslin

The Chairman:



C. Andries

Beschäftsstelle
 Registry/Grafik
 10. APR. 1994

