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D E C I S I O N
of 14 July 1994

Case Number: W 0009/93 - 3.3.1

Application Number: PCT/US92/08951

Publication Number: W09309074

IPC: C07B

Language of the proceedings: EN

Title of invention:

Chlorination process, alkylation of products of said process
and some products thereof

Applicant:

The DOW Chemical Co.

Opponent:

-

Headword:

Chlorination/DOW

Relevant legal norms:

PCT Rule 13.1

Keyword:

"Different problems"
"Different solutions"
"Common inventiven concept (no)"

Decisions cited:

G 0001/89

Catchword:

-



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Boards of Appeal

Chambres de recours

Case Number: W 0009/93 - 3.3.1
International Application No. PCT/US92/08951

D E C I S I O N
of the Technical Board of Appeal
of 14 July 1994

Applicant: The DOW Chemical Company
2030 DOW Center
Abbott Road
Midland MI 48640 (US)

Representative: -

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 5 March 1993.

Composition of the Board:

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

Summary of Facts and Submissions

- I. Following the filing of International Patent Application No. PCT/US92/08951 the EPO, acting as ISA, on 5 March 1993 issued an invitation to pay within 45 days an additional search fee. It considered that Claims 1 to 18 related to an improved chlorination process for preparing known compounds useful for alkylating aromatic compounds, as described e.g. in US-A-4 612 350, while Claim 19 was concerned with chemical compounds per se, not prepared by the said chlorination process, which were intended for solving a different technical problem, namely that of providing useful monomers for preparing a wide variety of polymers, or intermediates for preparing such monomers.

- II. On 7 April 1993 the Applicant paid the additional search fee under protest. He submitted that the process of Claims 1 to 18, in particular that of Claims 16 to 18, was "uniquely well suited" for preparing the products specified in Claim 19, although these compounds might possibly be made by other methods, and that, therefore, the compounds of Claim 19 were linked to Claims 1 to 18. He requested that the additional search fee be refunded.

- III. On 22 June 1993 the result of the prior review provided for in Rule 40.2(e) PCT was communicated to the Applicant, who was also invited to pay the protest fee. The Review Panel found the above invitation completely justified. On 9 July 1993 the Applicant paid the protest fee.

Reasons for the Decision

1. The protest is admissible.

2. The objection of non-unity was raised by the ISA a posteriori, i.e. taking the state of the art into account, and was inter alia based on the ground that there was no common inventive concept linking the subject-matter of Claims 1 to 18 and Claim 19, since the compounds of Claim 19 were not products of the process of Claims 1 to 18. Although the Board does not fully agree with this finding, since, as submitted by the Applicant, the compounds of Claim 19 are selected products of the two step process according to Claims 10 to 18, it nevertheless holds that in the circumstances of the present case the fact that the the compounds of Claim 19 can be obtained by the process of Claims 10 to 18 is not in itself sufficient to establish unity of invention.

3. The Applicant did not dispute the finding in the invitation to pay the additional search fee that the technical problem to be solved by the processes of Claims 1 to 18 was to improve a known chlorination process, as acknowledged in the description, page 2, lines 3 to 13, whereas the compounds of Claim 19 were intended to solve the different technical problem of providing useful monomers or intermediates therefor, as set out in the description, page 20, lines 30 to 33. The Board agrees with that finding. It is further true that the intermediate compounds produced according to Claims 1 to 9 were known e.g. from Example 1 of US-A-4 612 350, so that these products cannot serve as a common inventive concept between Claims 1 to 9 and Claim 19. Moreover, the second reaction step contained in Claims 10 to 18 is also known from the above example.

According to Rule 13.2. PCT as in force from 1 July 1992 an international patent application may relate to a group of inventions if there is a "technical relationship" among those inventions involving one or more of the same or corresponding "special technical features", i.e. such technical features that define a contribution which each of the claimed inventions makes over the prior art. However, a technical feature which already forms part of the prior art, such as the above second reaction step, cannot by definition make a contribution over the prior art and does not, therefore, qualify as a unifying element in the sense of Rule 13.1 PCT. Put another way, the fact that this reaction step is part of the prior art destroys the link between the contributions over the prior art made by the process of Claims 1 to 9 on the one hand and the compounds of Claim 19 on the other hand.

4. In these circumstances, the Applicant's submission that the process of Claims 1 to 18 was "uniquely well suited" for preparing the compounds of Claim 19 is not sufficient to establish unity of invention. Rule 13.1 does not simply require ~~some~~ link between a group of inventions claimed in an international patent application, but a common inventive concept. In the Board's judgment, this means that there must be either a common technical problem or at least, if there is more than one technical problem, there must be one single technical concept behind the solutions of these different problems. Neither of these conditions is however met in the present case.

5. Therefore the Board concludes that the application indeed clearly (see G 1/89, OJ EPO 1991, 155) relates to two different inventions which are not linked by a common inventive concept.

Order

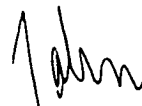
For these reasons it is decided that:

The protest is dismissed

The Registrar:


E. Gorgmaier

The Chairman:


A. Jahn