

Internal distribution code:

- (A) [] Publication in OJ
(B) [] To Chairmen and Members
(C) [X] To Chairmen

D E C I S I O N
of 21 November 1994

Case Number: W 0008/94

Application Number: PCT/EP93/02380

Publication Number: W09405727

IPC: C08K 11/00

Language of the proceedings: EN

Title of invention:

Composite material for the screening of radiation

Applicant:

Hyplast N.V.

Opponent:

-

Headword:

-

Relevant legal provisions:

PCT R. 13.1 and 2, 40.2

Keyword:

"Invitation to pay an additional search fee - not sufficiently motivated and not justified"

Decisions cited:

W 0011/84, W 0016/92, W 0011/93, W 0005/94

Catchword:

-



Case Number: W 0008/94
International Application No. PCT/EP93/02380

DECISION
of the Technical Board of Appeal
of 21 November 1994

Applicant: Hyplast N.V.
St. Lenaartseweg 26
B-2320 Hoogstraten (BE)

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 11 January 1994.

Composition of the Board:

Chairman: C. Gérardin
Members: P. Kitzmantel
M. Aúz Castro

Summary of Facts and Submissions

I. International application PCT/EP93/02380 comprising 11 claims was filed on 31 August 1993.

II. Claims 1, 6, 7, 8, 10 and 11 of the application as filed read as follows:

"1. Composite material for the selective screening of radiation, comprising a polymer, an additive and the customary stabilizers and processing aids necessary for the particular polymer."

"6. Composite material according to one of the Claims 1 to 5, **characterized** in that the polymer is an organic or inorganic polymer."

"7. Composite material according to Claim 6, **characterized** in that the organic polymer is a low-density polyethylene, ethylene-vinylacetate copolymer, polytetrafluorethylene, polyvinylidene-chloride, polyvinyl chloride, polycarbonate, polymethacrylate or mixtures thereof."

"8. Composite material according to claim 6, **characterized** in that the inorganic polymer is glass."

"10. Greenhouse containing composite materials according to Claims 1 to 9."

"11. Use of the composite material according to Claims 1 to 9 for growing and plant cultivation."

Claims 2 to 5 and 9 are directed to preferred embodiments of the composite material according to Claim 1.

III. On 11 January 1994 the European Patent Office, acting as International Search Authority (ISA), invited the Applicant to pay an additional search fee within a time limit of 30 days, because - in contravention of the requirement of unity of the invention laid down in Rules 13.1 and 13.2 PCT - the application comprised the following two inventions:

- "1. Claims 1-5, 6 (organic polymer), 7, 9-11 (organic polymer)
Claims 1-5 and the depending Claims 9-11 in so far as they refer to an organic polymer as mentioned in Claim 6.
2. Claims 1-6 (inorganic polymer); 8, 9-11 (inorganic polymer)
Claims 1-6 and the depending Claims 9-11 in so far as they refer to an inorganic polymer as mentioned in Claim 6."

As reason for this finding the ISA stated:

"The cited document DE-A-2 544 245 which has already been cited in the application takes away the novelty of Claim 1: In example 1 it discloses a composite material for the selective screening of radiation containing an organic polymer (polymethylmethacrylate) and a mica additive which is surface coated with TiO₂.

Therefore, none of the technical features of the composite material according to Claim 1 can be the common special technical feature in the sense of Rule 13(2) PCT.

Therefore the application does not fulfil the requirement of Rule 13(1) PCT and a non-unity a posteriori exists between the sets mentioned above."

- IV. With its response of 31 January 1994 (received 3 February 1994) the Applicant paid the additional search fee under protest.
- According to its opinion unity of the invention "relies on the fact that all of the composite materials according to the invention are suited for the selective screening of radiation in order to influence plant growth and the morphogenesis of plants."
- To reinforce his case the Applicant filed an amended Claim 1.
- V. On 27 April 1994 the ISA communicated to the Applicant the result of its review under Rule 40.2 (e) PCT, according to which its invitation of 11 January 1994 (cf. section III above) was completely justified, and invited the Applicant to pay within one month a protest fee of DEM 2000,-.
- VI. The Applicant paid the protest fee in due time thereby maintaining its dissent with the lack of unity objection raised in the ISA's invitation of 11 January 1994. Although not explicitly stated, this can only be interpreted as a request for the refund of the additionally paid search fee.

Reasons for the Decision

1. The protest is admissible

Although the reasoning contained in Applicant's protest to the invitation of 11 January 1994 is very short, and deals with only one of the aspects relevant to the issue of unity of invention (the object to be attained: cf. section IV above), it is considered sufficient within the provisions of Rule 40.2(c) PCT, since the argument

goes beyond a mere allegation, is comprehensible and thus susceptible to a reasoned counter-argumentation (cf. W 16/92 OJ EPO 1994, 237).

2. This decision is based on the claims as originally filed.

Since the present examination by the Board, carried out in accordance with Rule 40.2(c) PCT, relates to the protest against the invitation of the ISA to pay additional search fees, which invitation was based on the claims as originally filed, there is no room for taking into account during that examination any later amendment of these claims. The amended Claim 1 submitted with Applicant's letter of 31 January 1994 must therefore be disregarded.

3. Claim 1 is directed to
 - (a) a composite material for
 - (b) the selective screening of radiation, comprising
 - (c) a polymer,
 - (d) an additive, and
 - (e) customary stabilizers and
 - (f) processing aids necessary for the particular polymer.

4.

- 4.1 As set out in the ISA's invitation of 11 January 1994, Example 1 of the DE-A-2 544 245 (hereinafter "DE-A") discloses a composite material comprising an organic polymer and a mica additive, which is surface coated with TiO₂.

Due to the ability of the TiO₂ coating layer to reflect infrared but to allow transmission of the other portions of the light, the said material can be regarded to possess the property of "selective screening of radiation" (cf. page 3, line 11 to page 5, line 17).

- 4.2 Thus, according to the ISA's invitation, the materials disclosed in the DE-A comprise features (a) to (d) of the subject-matter of Claim 1.
- 4.3 No mention was made in the invitation of features (e) and (f) and no explication was offered justifying this omission, nor was such explication self-evident.
- 4.4 The lack of novelty objection in the invitation of 11 January 1994 was therefore insufficiently motivated and so was therefore the lack of unity objection raised as a *posteriori* consequence of the alleged novelty anticipation of the subject-matter of Claim 1.
5. The ISA's invitation of 11 January 1994 was defective for another reason as well.
- 5.1 According to the constant jurisprudence of the Boards of Appeal (e.g. W 11/89 OJ EPO 1993, 225), denial and also acknowledgement of unity of invention according to Article 3(4)(iii) PCT requires a discussion of the problem underlying the claimed subject-matter, because only then it is possible to decide whether or not a common special technical feature in the sense of Rule 13.1 and 13.2 PCT exists for different embodiments.
- 5.2 The ISA in its invitation concluded from the assumption of lacking novelty of the material according to Claim 1 that the claimed subject-matter would break up into two "sub-inventions", for materials comprising organic and inorganic polymers, respectively. No explanation was given for this conclusion, nor can an explanation be derived in an obvious way from the assignment of the claims to the respective "sub-inventions".

- 5.3 Before examining the substantive correctness of the ISA's aforementioned conclusion, it should be observed that the definition of the two "sub-inventions" 1 and 2 is formally defective; according to the novelty criteria in the ISA's invitation, "sub-invention" 1 must lack novelty in the same way as the subject-matter of Claim 1 as a whole, because it comprises the use of any organic polymer, including the polymethyl methacrylate compositions disclosed in the DE-A. In a formally correct way, the definition of sub-invention 1 should exclude the use of polymethyl methacrylate.
- 5.4 As set out in Claim 1 of the application in suit, it was its object to provide a material for the selective screening of radiation. According to page 3, line 34 to page 4 and page 6, line 8 to page 8, line 18, line 6 this screening should be used for three different purposes, all useful for different aspects of the light irradiation of plants: (1) to separate the infrared and green portion from the rest of the light rays, (2) to prevent the transmission of photosynthetically active radiation or (3) to change the spectral distribution of the light.
- 5.5 The object set out in the preceding paragraph was attained according to Claim 1 of the application in suit by the incorporation of an additive into a polymer material. According to the skilled person's understanding, the additive used must have the ability of "selective screening of radiation" and the polymer is a transparent matrix material, which may be organic or inorganic. There is no evidence in the application in suit for an influence of the polymer on the process of "selective screening of radiation" (exercise of the known optical properties of the matrix polymer is not considered an "influence" here).

5.6 In view of this lacking "influence", the polymer is not a part of the inventive contribution underlying the application in suit; rather, the quality of the polymer, organic or inorganic, is a feature apart and does not play any role for the inventive concept underlying the subject-matter of the application. However, lack of unity of the invention can only occur with respect to those features which in some way are related to the solution of the problem underlying the invention. The allegedly novelty destroying disclosure of the polymethyl methacrylate compositions of the DE-A cannot, therefore, split the subject-matter of the application in suit into materials based on organic and inorganic polymers, respectively.

5.7 The allegation in the ISA's invitation of 11 January 1994, namely that the sets of Claims 1 and 2 identified therein would relate to two different inventive concepts, can therefore not be accepted.

6. In view of the conclusions drawn in sections 4 and 5 above, the statement in the ISA's invitation of 11 January 1994, with regard to the sufficiency of the reasoning for the alleged lack of unity, did not comply with the requirements of Rule 13.1 and 13(2)(c) PCT, and the additional search fee cannot therefore be retained.

Order

For these reasons it is decided that:

The additionally paid search fee and the protest fee shall be refunded.

The Registrar:


E. Gorgmaier

The Chairman:


C. Gérardin