

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 1 March 1995

Case Number: W 0012/94 - 3.2.2

Application Number: PCT/US 93/00604

Publication Number: -

IPC: B23K 20/08

Language of the proceedings: EN

Title of invention:

A process for explosively bonding metals

Applicant:

E.I. DU PONT DE NEMOURS AND COMPANY

Opponent:

-

Headword:

-

Relevant legal provisions:

EPC Art. 34(3)(a)

EPC R. 68.2, 68.3(c), (e)

Keyword:

"Additional examination fee paid under protest"

"Statement 'reasoned'"

"Unity - no"

Decisions cited:

-

Catchword:

-



Case Number: W 0012/94 - 3.2.2
International Application No. PCT/US 93/00604

D E C I S I O N
of the Technical Board of Appeal 3.2.2
of 1 March 1995

Applicant: E.I. DU PONT DE NEMOURS AND COMPANY

Representative: M. K. Boyer
E.I. DU PONT DE NEMOURS AND COMPANY
Legal/Patent Records Center
1007 Market Street
Wilmington Delaware 19898 (US)

Subject of the Decision: Protest according to Rule 68.3(c) of the Patent Cooperation Treaty made by the applicant against the invitation of the European Patent Office dated 25 October 1993 pursuant to PCT Article 34(3)(a) and Rule 68.2 to restrict the claims or pay additional fees (for the international preliminary examination).

Composition of the Board:

Chairman: H. Seidenschwarz
Members: R. Lunzer
J. Van Moer

Summary of Facts and Submissions

I. On 28 May 1993, the European Patent Office, acting as International Searching Authority (ISA) in respect of International Application No. PCT/US 93/00604 issued its search report. Reference was made to certain prior art, and to a lack of unity of invention, Claims 1 to 12 being directed to an explosive cladding method with **heating** of the cladding layer before explosive bonding, while Claims 13 to 18 were directed to explosive cladding in which a **sealing strip** of metal was located between **at least two parallel cladding layers**. Nevertheless, no invitation was made to pay any additional search fees. Instead the box on the standard form was ticked against the words, "As all searchable claims could be searched without effort justifying an additional fee, this Authority did not invite payment of any additional fee."

II. Claims 1 and 13 took the following form:

"1. A process for producing a metal composite comprising:

 providing at least one cladding layer;

 locating a backer layer adjacent to said cladding layer;

 heating at least one cladding layer to a temperature which increases the ductility of said cladding layer;

 explosion bonding the cladding and backer layers together, thereby forming said metal composite."

"13. A process for producing a metal composite comprising:

providing a backer layer;

providing a batten strap adjacent to the backer layer;

positioning at least two cladding layers parallel to each other and adjacent to said batten strap, and;

explosion bonding the backer layer, batten strap, and said at least two cladding layers, wherein the seam between said cladding layers is substantially sealed by the batten strap."

III. On 5 August 1993 the Applicant requested the European Patent Office to act as International Preliminary Examining Authority (IPEA) pursuant to Article 31 PCT and Article 155 EPC, paying at the same time the preliminary examination fee of DM 3 000.

IV. In response to that request, on 25 October 1993 the IPEA issued an invitation to the Applicant (pursuant to Article 34(3)(a) and Rule 68.2 PCT) to pay one additional examination fee of DM 3 000, or to restrict the application by deleting Claims 13 to 18. The reasons given for alleging lack of unity were expressed in the following terms:

"Claims 1 to 12 concern an explosive cladding method with heating of the cladding layer before explosion bonding.

Claims 13 to 18 concern an explosive cladding method with sealing between the cladding layers via a strip of metal."

On 11 January 1994 the IPEA issued its first written opinion raising substantive objections to the application, including lack of unity of invention, and

- lack of novelty, as well as lack of clarity of Claims 1 to 12, the use of non-SI units in the description, and an inadequate acknowledgment of relevant prior art.
- V. By two letters dated respectively 11 and 18 April 1994, the Applicant responded to those objections, replacing the original set of 18 claims with a new set of 15 claims, and filing replacement pages for the description which included SI units. So far as concerned the objection of lack of unity, it contested the view of the IPEA, and quoting the words used by the ISA set out at the end of paragraph I above, it relied on the fact that the ISA had not required any additional fees as substantiating the unity of invention.
- VI. By a telefax dated 22 April 1994 the IPEA issued a second invitation to pay the additional examination fee. On the same day, the additional fee was paid under protest.
- VII. On 29 June 1994 the International Preliminary Examination Report was issued. Apart from other substantive objections, attention was again drawn to the fact that in accordance with the amended set of 15 claims filed on 11 April 1994, Claims 1, 3, 5 to 8 and 12 to 15 related as before to explosive cladding with **heating**, while Claims 2, 4 and 9 to 11 related to the sealing between cladding **layers via a strip of metal**. That report was supplemented by an addendum dated 22 July 1994, which dealt in detail with objections to the second of the two alleged inventions, and which had not been fully covered by the first report.
- VIII. Following the procedure established by Rule 104(a)(3) EPC, which came into force on 1 October 1992, on 29 August 1994 the IPEA issued an invitation to pay a protest fee in the sum of DM 2 000, accompanied by two

sheets of supporting reasoning. That reasoning referred to the original Claims 1 to 18, rather than the later filed claims 1 to 15. It found that the Applicant had not filed a reasoned statement as to why the application complied with the requirement of unity of invention (as is required by Rule 68.3(c) PCT) i.e. what common technical link there was between the two methods claimed, with the result that the protest had to be rejected as inadmissible.

IX. In a document dated 28 September 1994 and entitled,

"Response to Invitation to Pay Protest Fee", the Applicant contended that the IPEA had failed to specify in the communication dated 29 August 1994 the reasons substantiating its objection that there was a lack of unity of invention, contrary to Rule 68.1 PCT. It argued that there was unity of invention, and in relation to the IPEA's request for a "protest fee for the examination of the protest, in the amount of DM 2,000", it contended:

"Should you disagree with the previous statements, in order to advance prosecution of this application please charge the examination [sic] fee of DM 2,000 to Deposit Account Number 28300101."

X. That response was interpreted by the IPEA as a request that the protest be referred to a Board of Appeal under Article 155(3) EPC and Rule 104(a)(3) EPC for a ruling that there is unity of invention, justifying the repayment of the extra examination fee of DM 3 000 and possibly repayment of the protest fee of DM 2 000 under Rule 68.3(e) PCT.

Reasons for the Decision

1. *Admissibility*

1.1 The first point to be decided on admissibility is whether the Applicant had paid an additional fee "under protest", within the meaning of Rule 104(a)(3) EPC, it being a condition precedent under Rule 68.3(c) PCT that a valid protest is one which is, "accompanied by a reasoned statement". Although the protest of 22 April 1994 mentioned in paragraph VI above did not contain any reasoning, it must be read in the context of the letter of 11 April 1994, in which the same representative of the Applicant had set out his reasoning on the issue of unity, viz. that as a search could be conducted without the effort justifying an additional fee, there was inherently unity. In these circumstances the reasoning in the earlier letter must be regarded as implicitly contained in the second, which dealt with exactly the same issue. Though that reasoning is totally unconvincing, in the Board's view it is nonetheless sufficient to qualify as "a reasoned statement" within the meaning of Rule 68.3(c) PCT.

1.2 Accordingly, the Board finds that the conditions of Rule 104(a)(3) EPC are satisfied to the extent that the Applicant had paid an additional fee under protest. Hence the finding by the first instance that there was no reasoned statement, which led to its holding that the protest was inadmissible, is set aside. The protest is therefore admissible.

2. *Sufficiency of reasons given by the IPEA*

As indicated in paragraph IX above, the Applicant has challenged the sufficiency of the reasons given by the IPEA pursuant to its obligation under Rule 68.1 PCT. The only reasoning given by the IPEA is that set out at paragraph IV above, which did no more than identify the content of the two sets of claims. However, in the Board's view, in a case as simple as the present, such a statement as was made, i.e. to the effect that one set of claims relate to one identified invention, and another set relate to another, is hardly capable of further useful amplification or reasoning. The Board finds that the reasons given by the IPEA were sufficient, with the consequence that the Applicant's objection under this head is rejected.

3. *The different alleged inventions*

3.1 The present application describes two distinct problems which are solved by two equally distinct solutions. The first problem concerns explosive cladding when using a brittle cladding material, and is solved by heating to a temperature such that the brittle sheet becomes less so. The second concerns explosive cladding with sheets which are too small to cover the whole of the desired area, and the solution is to use a plurality of adjacent sheets, optionally with a metal strip to cover the joint. It is acknowledged that explosive cladding per se is a well known technique.

3.2 Although those two solutions are distinct, the reader might have expected to find some examples showing that they are capable of being combined. However, in the description, Examples 1 to 6 inclusive concern the use of brittle cladding materials and the application of heat, i.e. they relate solely to the first of the two

alleged inventions. In contrast, Example 7 refers to cladding with two pieces of low carbon steel, without the use of heat, and is thus an exemplification of the second alleged invention alone. Examples 8 and 9 relate to cladding with a **single** sheet of **gold** and **platinum** respectively; i.e. these last two examples are apparently unrelated to either of the two alleged inventions.

- 3.3 In these circumstances the Board regards it as clear beyond doubt that the application in suit relates to two distinct alleged inventions. There is not even a hint that the two could be used in combination. It follows that the Board regards the invitation to pay an additional examination fee as being justified, with the consequence that the present protest must fail.

Order

For these reasons it is decided that:

The protest is dismissed.

The Registrar:



S. Fabiani

The Chairman:



H. Seidenschwarz