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D E C I S I O N
of 10 October 1997

Case Number: W 0002/97 - 3.2.4

Application Number: PCT/NL95/00437

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Language of the proceedings: EN

Title of invention:
Domestic Fan

Applicant:
Helpman Intellectual Properties B.V. et al

Opponent:
-

Headword:
-

Relevant legal provisions:
PCT R. 40.2(c)(e)

Keyword:
"Reimbursement of the additional search fees"
"Reimbursement of the protest fee"

Decisions cited:
W 0003/93, T 0204/83

Catchword:
-



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Chambres de recours

Case Number: W 0002/97 - 3.2.4
International Application No.: PCT/NL95/00437

D E C I S I O N
of the Technical Board of Appeal 3.2.4
of 10 October 1997

Appellant: Helpman Intellectual Properties B.V. et al
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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 31 May 1996.

Composition of the Board:

Chairman: C. A. J. Andries
Members: M. G. Hatherly
B. Schachenmann

Summary of Facts and Submissions

I. On 31 May 1996 the International Searching Authority (ISA) dispatched an invitation to the Applicant to pay five additional search fees on the grounds that the international application No. PCT/NL95/00437 contained the following six inventions:

1. Claims 1 to 6 and 35
Fan comprising drive means placed outside the air flow.
2. Claims 7 and 16 to 22
Means for increasing the ventilating effect.
3. Claim 8
Mounting of the blades.
4. Claims 9 to 15
Blade construction.
5. Claims 23 to 28
Fan comprising integral heating or cooling elements.
6. Claims 29 to 34
Arrangement of a fan for changing flow direction.

The reasons in the invitation for the above finding commenced with the following passage:

"US-A-4962734 or EP-A-567688 disclose all the features of claim 1. Each of these documents deprive claim 1 from novelty and already solves the problem underlying the present invention: the central part of the fan does not take part in generating the desired air flow."

In the annexed partial search report there was with respect to the US and EP documents no indication of relevant passages but only the general indication "see the whole document".

After commenting on the features and effects of the other claims, the invitation stated that:

"Since these features are not the same or/and do not correspond there are no special technical features which could support a common inventive concept and the technical relationship as required in Rule 13.2 of the PCT is not present. Therefore the application lacks unity à posteriori."

- II. The Applicant replied to the invitation in due time by paying the five additional search fees on 27 June 1996 but stating (in a letter whose first page is dated 28 June 1996) that this payment was under protest because the international application did comply with the requirement of unity of invention. The letter continued:

"The basic idea of the present invention is the fan rotor being designed as an annular structure carrying the blades. The third characterizing feature of claim 1 is neither disclosed nor rendered obvious by any prior art reference according to the international search report. On this basis it is believed that claim 1 can be redrafted in the two-part form in a way such that it distinguishes the fan according to the invention over the prior art."

- III. On 31 July 1996 the Review Panel of the ISA dispatched the result of a prior review of the justification for the invitation to pay the disputed additional search fees. It found that the fees were not to be reimbursed and invited the Applicant to pay a protest fee for the

further examination of the protest (Rule 40.2(e) PCT). The result of the prior review included the following reasoning:

"According to the applicant the first claim is novel because the third characterizing feature of claim 1 is neither disclosed nor rendered obvious by any prior art reference according to the International Search Report.

The International Searching Authority disagrees with this opinion because the US-A-4962734 document discloses in column 7 lines 63 to 66 that "the width W being small".

For this reason refund is not justified."

IV. The Applicant enclosed a voucher for the settlement of the protest fee with the letter dated 27 August 1996 without submitting further arguments.

V. The sole independent claim, claim 1, of the international application as filed and searched reads as follows:

"Fan comprising:

a central hub;

a plurality of blades connected to this hub and extending at least more or less in radial direction, which blades take a form such that when driven rotatably round the axis of the hub an air displacement occurs; and

drive means for rotatably driving the blades with the hub round the axis of the hub,

characterized in that

the end zones of the blades are connected by a ring, which ring is supported rotatably in an annular housing;

the drive means comprise a motor which is placed at a distance from the hub outside the air flow generated by the driven blades;

the axial dimension of the ring and that of the annular housing is a maximum of 0.2 x the diameter; and

the annular housing is supported by supporting means, for instance a foot for placing on a surface."

Reasons for the Decision

1. The protest is admissible. The Board is responsible under Article 154(3) EPC for deciding on the protest.
2. In these protest proceedings it is to be decided whether, on the basis of the reasons given by the ISA under Rule 40.1 PCT (see the above section I) and the counter-reasons provided by the Applicant under Rule 40.2c PCT (see the above section II), the invitation to pay the disputed additional search fees was justified.
3. The sole independent claim of the international application as filed and searched is claim 1. Each of the other claims 2 to 35 is truly dependent, directly or indirectly, upon this claim 1.

The invitation stated that each of the cited documents US-A-4 962 734 and EP-A-567 688 disclosed all the features of claim 1 and solved the problem underlying the invention that the central part of the fan did not take part in generating the desired air flow.

4. The invitation unhelpfully contained no reasoning as to why the each of the cited documents US-A-4 962 734 and EP-A-567 688 should destroy novelty of the subject-matter of the claim 1 being searched, indeed the invitation did not list a single passage or Figure in either of these cited documents. Thus it could not be determined from the invitation which of the various embodiments of the citations the ISA considered to be novelty destroying.

It is clear that the reasoning for inviting an Applicant to pay an additional search fee or fees must be contained already in the invitation. Reasoning contained in the prior review reaches the Applicant only after he has decided to pay the additional search fee or fees and thus only helps him to decide whether or not to pay the protest fee.

Indeed in the present case, it was only after the Applicant had paid the disputed additional search fees that he received the prior review which drew attention to column 7, lines 63 to 66 of the cited document US-A-4 962 734 (but made no mention of the other cited document EP-A-567 688).

5. *The cited document US-A-4 962 734*
 - 5.1 While the information in the prior review necessarily arrived too late to be of help to the Applicant in deciding whether to pay the additional fees, the cited

passage of document US-A-4 962 734 refers to Figure 4 and thus implies that the ISA must have considered the embodiment of Figure 4 to be novelty destroying.

5.2 This Figure 4 is a cross-sectional view along the line 3 to 3 of Figure 1. The fan 18 of this embodiment has a central region (see Figure 1 and column 3, line 6) where a plurality of blades 20 are coupled with their ends to each other, extend more or less in radial direction and are of a form such that when driven rotatably round the axis of the central region an air displacement occurs. The radial end zones of the blades 20 are connected by a ring 22 which is supported rotatably by a fan support assembly 11 which itself is supported (see the description of the embodiment of Figures 1 to 3, in particular column 2, line 67 to column 3, line 2 and frame member 16 shown on Figure 1 and described in column 3, lines 65 to 68). The blades 20 are rotatably driven round the axis of the central region by magnetic regions 48 (in a flange 41 extending from the ring 22) interacting with field windings 46 on the fan support assembly 11 (see column 7, lines 57 to 60 and Figures 4 and 6) and thus forming a motor located at a distance from the hub outside the air flow generated by the driven blades.

5.3 Claim 1 includes one requirement that has not been mentioned in the analysis in the above section 5.2, the third feature of the characterising part, namely that:

"the axial dimension of the ring and that of the annular housing is a maximum of 0.2 x the diameter".

Column 7, lines 63 to 66 of the cited document US-A-4 962 734 state that:

"The flange 41 of FIG. 4 is longer than the width W of ring 22. The total fan package thickness can be significantly reduced by having relatively thin fan blades 20, the width W being small. For a thin ...".

It can be seen from Figure 4 that the width W of the ring 22 means the same as the term "the axial dimension of the ring" used in claim 1. Thus the cited passage teaches that the axial dimension of the ring can be small.

However the cited passage does not compare the axial dimension of the ring with its diameter. The passage neither states that the axial dimension of the ring shall be a maximum of 0.2 x the diameter nor does it specify dimensions for the ring from which it could be calculated that the ring satisfies this requirement.

Moreover the cited passage, apart from stating that the total fan package thickness can be significantly reduced, does not give any specific information about the axial dimension of the annular housing and its relationship to the diameter. It should also be noted that Figure 4 is a diagrammatic representation of the fan support assembly 11 and so cannot be measured to obtain dimensions and ratios, see the decision T 204/83 (OJ EPO 1985, 310).

Thus the cited passage does not disclose the third feature of the characterising part of claim 1. The Board moreover cannot find a disclosure of this feature anywhere else in the cited document US-A-4962734, either for the embodiment of Figure 4 or for any other embodiment.

6. *The cited document EP-A-567 688*
- 6.1 As stated in section 4 above the invitation specified no passage or Figure in the cited document EP-A-567 688. However it is clear that in each embodiment the drive means comprises a rotor 5 consisting of a ring at the periphery of the blades 2 as well as a ring shaped stator 6.
- 6.2 On the other hand there is no information in the document to show, in the words of the third feature of the characterising part, that "the axial dimension of the ring and that of the annular housing is a maximum of 0.2 x the diameter". No dimensions are quoted in the cited document to calculate the ring and housing ratios for either embodiment. Once again Figures 1 and 2 are diagrammatic representations (see column 2, lines 41 and 42: "Es zeigen in einem schematischen Längsschnitt") and so cannot be measured to obtain dimensions and ratios.
7. Thus, for the reasons given in the above sections 5.3 and 6.2, the Board finds the subject-matter of claim 1 to be novel over the disclosures of the cited documents US-A-4 962 734 and EP-A-567 688.

Consequently the reasoning in the invitation is incorrect and the whole basis for arguing that six inventions are claimed by the set of 35 claims collapses.

The third feature of the characterising portion of claim 1 makes the subject-matter of claim 1 novel and so forms a novel link between all the claims 1 to 35. This technical feature defines a difference over the prior art.

Accordingly the five additional search fees must be reimbursed. The protest is entirely justified and so the protest fee must be refunded (Rule 40.2(e) PCT).

8. The Board is not entitled to investigate of its own motion whether a unity of invention objection could have been raised for some other reason other than that given in the invitation, see section 4 of decision W 3/93 (OJ EPO 1994, 931). Accordingly, the objection of lack of unity could be raised again for different reasons (e.g. lack of inventive step) in the event of subsequent proceedings under PCT Chapter II.

Order

For these reasons it is decided that:

1. The protest is entirely justified.
2. The five additional search fees paid under protest shall be reimbursed.
3. The protest fee shall be refunded.

The Registrar:



N. Maslin

The Chairman:

