

Abstract

Protest of the payment of an additional search fee. Appeal of the decision by the IPEA on lack of unity of invention. Protest was only partly justified.

**BESCHWERDEKAMMERN DES EUROPÄISCHEN PATENTAMTS
BOARDS OF APPEAL OF THE EUROPEAN PATENT OFFICE
CHAMBRES DE RECOURS DE L'OFFICE EUROPEEN DES BREVETS**

DECISION
of 9 April 2001

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 (International Preliminary Examining Authority) to restrict the claims or pay additional fees dated 10 May 2000.

Summary of Facts and Submissions

I. On 10 May 2000 the International Examining Authority (IPEA) dispatched an invitation to the Applicant to pay two additional fees on the grounds that the international application contained the following three separate groups of inventions:

Claims 1 to 17 (first group):

"1. A dispenser for dispensing medicament comprising a housing having a support; a container, locatable within said housing, having an outlet member, wherein said container is movable relative to the housing to enable dispensing therefrom and said outlet member is connectable with said support to prevent relative movement therebetween; and an inductive displacement transducer including one or more inductive elements wherein said container is comprised of, or has attached thereto a component comprised of, a material capable of disturbing the magnetic field creatable by the flow of electric current in said one or more inductive elements."

Claims 18 to 24 (second group):

" 18. An actuation indicating device for use with a dispenser comprising a housing and a container, locatable within said housing, having an outlet

member, the actuation indicating device comprising an inductive displacement transducer having mounting means to enable mounting to the housing."

Claim 27 (third group):

"27. An inhalation device for dispensing medicament comprising a housing support; a container, locatable within said housing, having an outlet member, wherein said container is movable relative to the housing to enable dispensing therefrom and said outlet member is connectable with said support to prevent relative movement therebetween; and first and second pressure tubes, locatable within said housing, wherein each tube is connectable to a pressure transducer."

The IPEA stated that the only technical feature common to the first and second group of claims was represented by the inductive displacement transducer (feature A) which, taken per se, was not new. The only technical feature common to the first and third group of claims was found to be a dispenser for dispensing medicament comprising a housing with a support and a container with an outlet member (features B) which, however, was already disclosed in document WO96/16686 and, therefore, was not novel. No common technical features were found for groups 2 and 3. Moreover, all three groups of inventions were found to address different problems.

According to the IPEA, the requirement for unity of invention pursuant to Rule 13.1 and 13.2 PCT, therefore, was not met.

II. The Applicant replied to the invitation in due time on 10 June 2000 by paying two additional fees but under protest.

He argues that it is the "inductive displacement transducer" which defines a contribution that the claimed invention, as called for in claims 1 to 17 and 18 to 24, makes over the prior art. The requirements of Rule 13.2 PCT are, therefore, satisfied.

Despite the fact that the inhalation device forming the subject-matter of claim 27 does not comprise the "inductive displacement transducer" which is common to claims 1 and 18, this device nevertheless comprises many of the technical features of the invention defined in claims 1 to 24 and addresses the same technical problem of training the patient in the correct usage of the aerosol dispenser. Given that the subject-matter claim 27 is so similar to that of the claimed invention defined in claims 1 to 24, the demand for a separate examination for this claim is regarded as unfair. As a consequence the additionally paid fees should be reimbursed.

III. On 27 October 2000 the Review Panel of the EPO dispatched the results of a review of the justification for the invitation to pay additional examination fees and invited the applicant to pay a protest fee for examination of the protest (PCT Rule 68.3(e)). The Review Panel found that:

- the problems underlying the first and second group of inventions are different;
- the inductive displacement transducer common to claims 1 to 24 cannot be considered as being a special technical feature under Rule 13.2 PCT, because it is known per se and does not make any contribution over the prior art,
- the second and third group of inventions relate to different problems
- the technical feature common to the first and third group of inventions (the dispenser for dispensing medicament) is known from the prior art.

No common special technical features for all three groups were found to exist which could form a single general inventive concept, as required in Rule 13.2 PCT.

IV. A letter requesting the examination of the protest and without giving further arguments was received from the Applicant on 28 October 2000 and the protest fee (Rule 68.3 e) was paid on this day.

Reasons for the Decision

1. The protest is admissible.

2.1 In its approach to the question of unity of invention, the IPEA identified - in a first step - three different groups of inventions and the technical problems addressed by each group. In this step, the IPEA did not base its considerations on a document or documents which were regarded as representing the closest prior art. Therefore, the objection is rated as an "a priori" objection within the meaning of the PCT Preliminary Examination Guidelines PCT/GL/3/1993, Chapter III, 7.5. In a second step, the IPEA identified the technical features which were common to the three different groups of inventions and concluded that feature A common to the first and second group "clearly was not new" (without citing a document) and that feature B common to the first and third group "was known from the prior art, for example from document WO-A-96/16686".

According to the established case law of the Boards of Appeal, determining the unity of invention "a priori" requires as a mandatory pre-condition an analysis of the technical problem (or problems) underlying the respective groups of inventions by starting from what is considered in the description of the application as having been achieved by the invention. It also has to be decided whether or not the subject-matter claimed as solution to such a problem represents a single general inventive concept.

2.2 According to the IPEA, the technical problem underlying claims 1 to 17 (the first group), namely providing a patient with a medicament in the form an aerosol so that the actuation of the dispenser can be detected, is different to that addressed by claims 18 to 24 (the second group) of training the patient in the correct usage of the aerosol dispenser.

2.3 As set out in the description on page 3, lines 19 to 22, the present application addresses the problem of providing an inhalation device or dispenser which allows for the patient or physician monitoring the actuation profile and which - in a more preferred embodiment - can be used in combination with a system for training the correct usage of the dispenser. Effective monitoring is achieved by using an inductive displacement transducer which

(i) may be directly attached to the housing of the dispenser, as shown in Figure 2 and 3, or, alternatively,

(ii) is mounted on a carrier means mountable on the dispenser but separable therefrom, as depicted in Figures 6 and 7 (cf. description, page 2, lines 22 to 27).

While the first embodiment forms the subject-matter of claims 1 to 16, the second embodiment is claimed in claims 18 to 24. It is, therefore, concluded that the first and second group of inventions identified by the IPEA actually address and solve the same technical problem.

2.4 Furthermore, it is also possible to discern a single general concept from the common function of the identical structural element which in the present case is represented by the inductive displacement transducer. On actuation of the device, the movement of the protruding portion of the aerosol container relative to the housing causes a change in the inductance of the transducer coil such that the circuit oscillates at a different frequency which can be recorded by various means. This inductive displacement transducer is common to the claims 1, 18 and also to claim 24 which relates to a "kit of parts comprising a dispenser and an actuation indicating device". Hence, the subject-matter of claims 1 to 24 (first and second group) are linked by a single general concept.

2.5 A further issue to examine is whether the identified single general concept is "inventive" as required in Rule 13.1 PCT. In this connection, the IPEA has argued that, given that the inductive displacement transducer is not novel "per se", it does not represent a special technical feature since this feature alone does not make a contribution over the prior art as required in Rule 13.2 PCT.

2.6 There is, however, no requirement for the identical structural part (ie. the inductive displacement transducer) to be per se inventive and, therefore, claimable as such. Rather more, it has to be decided whether or not the common technical feature(s) can make a contribution to the inventive step on substantive examination. Only in cases where the possibility of such contribution must be excluded beyond reasonable doubt, is the objection of non-unity justified.

The IPEA has not shown that the single general concept mentioned above was known or belonged to the general knowledge of a skilled person. More specifically, a document has not been identified as representing the closest prior art and no documents were cited in the present case which could exclude such an inventive contribution of the inductive displacement transducer over the prior art.

2.7 In view of these considerations, there is no basis for concluding or implying that the subject-matter given in claims 1 to 24 (first and second group) fails to meet the requirements of Rule 13.1 and 13.2 PCT. The invitation of the IPEA to pay the first additional examination fee, therefore, was not justified.

3.1 The inhalation device defined in claim 27 (group 3 according to the IPEA) would, in its broadest sense, also contribute to the problem of "monitoring the actuation profile" of a dispenser. Study of the description, however, reveals that the inhalation device designed according to claim 27 is more specifically concerned with the problem of determining the pressure profile (or release profile) on propelled release of medicament from the aerosol container. This problem differs from that underlying the dispenser comprising the technical features given in claims 1 to 24 (groups 1 and 2).

3.2 The solution to this problem consists in the use of a pressure transducer which allows measuring the pressure drop in the mouthpiece of the inhalation device and thereby enables measuring the airflow as the patient inhales. The pressure transducer is, however, unrelated to the technical features defining the dispenser given in claims 1 to 24, since a totally different process parameter is monitored by the pressure transducer. Moreover, the inhalation device claimed in claim 27 does not comprise the technical feature of a inductive displacement transducer which is common to claims 1 to 24. The applicant's attention is drawn in this context to the PCT Gazette, S03/1998 (E), Section IV, Annex B, part 2,

II, example 10 which describes an combination of claims (a conveyor belt (i) with feature A, or (ii) with feature B, or (iii) with features A + B) that is comparable to the present situation. However, unity was found not to exist between embodiment (i) and (ii).

3.3 The applicant has argued in this context that the invention defined in claim 27 is in the same technical field and comprises many of the features of the invention defined in claims 1 to 24.

As can be immediately seen, the only technical feature common to all claims under consideration is the dispenser which comprises a housing and a container within said housing and which is generally known in the art. However, Rule 13.1 PCT does not simply require some link between a group of inventions claimed in an international patent application, but a common inventive concept. 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 to the different problems. Given that the problem and the technical concept underlying claim 27 are found to be different from those addressed by claims 1 to 24, it, therefore, must be concluded that a "single general inventive concept" between claims 1 to 24 and 27 does not exist.

3.4 Hence, contrary to the position of the applicant, the requirements of Rule 13.1 and 13.2 PCT are not met by claim 27 (third group of inventions). Consequently, the invitation of the IPEA to pay one additional fee for the third group of inventions was justified.

4. Given that the protest has been successful only in part, reimbursement of the protest fee cannot be ordered.

Order For these reasons it is decided that:

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