

Abstract

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

EPO boards of appeal decisions

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Summary of Facts and Submissions

I. Following the filing on 20 December 1990 of the international PATENT APPLICATION NO. PCT/GB....., THE EPO ACTING AS International Searching Authority (ISA) on 15 April 1991 (corrected on 8 May 1991) sent to the Applicant an invitation to pay two additional search fees pursuant to Article 17(3)(a) and Rule 40.1 PCT, because it considered that the application related to the following groups of inventions which did not satisfy the criteria of unity of invention:

1. Claims 1, 2-9, 14-22: Latching means for needle protector;
2. Claims 10-13: Key hole side entry slot;
3. Claims 23-26:

Needle protector adaptor for Luerlock type syringe.

The following reasons were specified by the ISA for the above findings:

In view of the state of the art according to US-A- 4 820 277 illustrating a needle protector made of 3 hinged parts with closure means, Claim 1 of the present application appears to be lacking novelty. The remaining claims of the application can be grouped into three different subjects showing no common inventive concept:

1st subject: The Claims 2 to 9 and 14 to 22 relate to a 3-parts needle protector according to Claim 1 having improved latching means.

2nd subject: The Claims 10 (independent) and 11 to 13 relate to a 3-parts needle protector provided with a key hole side entry slot which permits the protector to be clipped onto a syringe nozzle without having to remove the needle from the nozzle. The needle protector according to Claims 10 to 13 needs not to be provided with the latching means according to Claims 2 to 9 and 14 to 22.

3rd subject: The Claims 23 (independent) and 24 to 26 relate to an adapter permitting the application to a Luer lock type syringe of a 3 parts needle protector not necessarily provided with the latching means according to Claims 2 to 9 and 14 to 22 or the side entry slot according to Claims 10 to 13.

II. The Applicant paid one additional fee amounting to DM 2200 under protest (Rule 40.2(c) PCT) stating that this was intended to cover the search for the second subject; no further search fee in respect of the third subject was paid. According to his contention, Claim 1, the first invention, and Claim 10, the alleged second invention, were directed to a single inventive concept. He argued in essence that the essential novelty of the subject-matter of Claim 1 over the document US-A-4 820 277 was that the central part of the needle protector had a slot defined by a structure constructed for snug engagement with the nozzle of a syringe when clipped onto the nozzle by being pushed thereon into a transverse direction. In contrast thereto, the needle guard disclosed in document US-A- 4 820 277, in particular the embodiment displayed in Figure 6 referred to by the ISA, had a central part in form of an adaptor fitted onto the syringe nozzle to entirely surround it by being pushed on in an axial direction. There was a through hole in the known adaptor but no slot and, more particularly, no laterally opening slot.

Reasons for the Decision

1. The demand complying with Rule 40.2(c) PCT is admissible.
2. 2.1 The basic reason delivered by the ISA why it considered that no unifying link existed between subject 1 and subject 2 as identified under point I. above was that the subject-matter of Claim 1 lacked novelty with respect to document US-A-4 820 277, in particular Figure 6, abstract, and column 2, lines 42 to 62, column 5, lines 47 to 60.

Document US-A-4 820 277 in its Figure 6 and the references to the description mentioned above discloses a needle protector made up of three parts (two jaws (52') and (54'), adaptor (78) connected by hinges (58') and (60')). The jaws have the function of complementary housing parts being shaped and arranged such that in the mutually closed condition a needle (12) including its hub (26') is substantially totally enclosed. The jaws have clips and sockets which cooperate with each other to act as closure means whereby the jaws can be fastened together. The adaptor (78) which is the central part of this known needle protector has a throughhole one side of which is adapted to fit to the syringe nozzle to entirely surround it by being pushed in axial direction. The other side

of the opening is adapted to receive the needle hub. Therefore the throughhole must have a circular cross section on both sides.

The subject-matter of Claim 1 differs from this state of the art in that the central part has a slot defined by a structure constructed for snug engagement with a nozzle of a syringe and being dimensioned so that it prevents exit of the hub therefrom. According to the conventional definition, a 'slot' is 'an elongated aperture or groove, such as one in a vending machine for inserting a coin' (cf. Collins Dictionary of the English Language, Oxford, 1985). This form is clearly distinct from the circular cross section of the throughhole disclosed in US-A- 4 820 277.

Consequently, the subject-matter of Claim 1 is novel with respect to this closest prior art.

2.2 The independent Claims 1, 10 and 14 indicate solutions to this problem. The common concept of these solutions is, in its broadest form, expressed by Claim 14 stating that the central part of the needle protector has an engagement means whereby the protector can be fitted onto a standard syringe so as to contact the syringe only on the syringe nozzle in the area between the end of the syringe band and the needle hub.

The "slot defined by a structure constructed for snug engagement with a nozzle of a syringe, which, is dimensioned so that it prevents exit of the hub therefrom" (cf. Claim 1) and the "key-hole type entry slot which permits the protector to be snapped in position onto a syringe nozzle" are particular embodiments of an engagement means as defined in Claim 14 in its broadest form and the effect of which delivers the major contribution to the solution of the basic problem stated above (cf. W 6/90, OJ EPO 1991, 438).

The known needle protector according to Figure 6 of US-A- 4 820 277 does not give a hint to this concept, because there the hub of the needle cannot be fixed to the nozzle of the syringe in the standard way but by interposition of the adapter (78) which forms the central part of the known needle protector. The other embodiments disclosed in this document involve constructional modifications of either the syringe or the needle.

2.3 It cannot at this stage be excluded that this contribution would not be relevant to the inventive steps of the three subject-matter elements, since also the other documents cited in the Notification concerning the Result of the Partial International Search or common general knowledge do not contradict this either, the independent Claims 1 and 10 (and 14) are based a priori on a common inventive concept. As a consequence, also lack of unity a posteriori is excluded

between Claims 2 to 9, appended to Claim 1 on one hand and Claim 10 on the other.

3. Following the considerations above, the matters stand as follows:

The original Search Fee and the Additional Search Fee (paid under protest) have been paid to cover the search for the Claims 1 to 22. This group of claims contains the independent Claims 1, 10, 14, 19, and 22. According to the reasoning given under point 2. above, the Claims 1, 10, and 14 are covered by a common inventive concept which deals with the fitting of a needle protector to the nozzle of a standard syringe so as to contact the syringe on its nozzle in the area between the end of the syringe band and the needle hub.

The Claims 19 and 22 concern the problem to increase the safety of the needle against contamination prior to use and against unintentional hurts (and thus infections) of the personnel by the needle after use. The features which are basic to the common inventive concept covering the Claims 1, 10, and 14 are not contained in Claims 19 and 22.

Consequently, the Claims 19 and 22, a priori have no inventive concept in common with the Claims 1, 10 and 14.

4. The ISA has used its discretion and has not objected a priori lack of unity with respect to Claims 19 and 22, obviously because the Search Examiner was able to make an international search with negligible additional work also for these claims together with Claims 1 to 9 (cf. Guidelines for International Search to be carried out under the Patent Cooperation Treaty (PCT), PCT/INT/5, Chapter VII, 12.).

5. The invitation was accordingly not justified insofar as an additional search fee was demanded for the "2nd subject" represented by Claims 10 to 13.

ORDER

For these reasons, it is decided that:

Reimbursement of the additional fee to the Applicant is ordered.