

Abstract

Applicant filed a protest following a lack of unity of invention determination. The lack of unity of invention was upheld because the two independent claims failed to contain a single inventive concept that links the two subject matters.

EPO boards of appeal decisions

Date of decision 22 March 1991

Summary of Facts and Submissions

I. Following the filing of the international patent application PCT/GB....., the EPO acting as International Search Authority (ISA) sent to the Applicant an invitation to pay an additional search fee 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 1-10:

A stenter apparatus comprising a main stenter and a film hold-back means for the biaxial treatment of the film.

2. Claims 11-32:

A film clip for use in stenter apparatus.

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

(a) The apparatus claimed in Claim 1-10 is not conditional to the presence of the clips of Claims 11 and 22.

(b) Similarly the clips, subject-matter of Claims 11 and 22, are not dependent on their presence in the apparatus of Claim 1-10 and could be used in other stenter apparatuses.

(c) The combination of the apparatus of Claims 1-10 with the clips of Claims 11 and 22 does not introduce a synergetic effect.

II. The Applicant paid the additional fee but under protest and together with his protest filed a new set of twenty- one claims, contending that unity of invention is present between all of the new claims. The clips covered by Claims

11-21, although capable of being used in other stenters, are specially devised for the stenter apparatus of Claims 1-10, which is intended preferably for use with edge-beaded films. The claimed clips are especially beneficial with this kind of film. The Applicant was advised by the ISA that the new set of claims cannot be accepted at this stage according to Article 19 and Rule 46 PCT and should therefore not be considered as forming part of the application.

Reasons for the Decision

1. The demand is admissible. The claims to be considered are those as originally filed.

2. These claims contain two independent claims, namely Claims 1 and 22. The other claims are all formally dependent, Claims 2 to 21 on Claim 1 and Claims 23 to 32 on Claim 22, respectively.

Claim 1 is directed to a stenter apparatus and its dependent claims 11 to 21 relate more particularly to a stenter apparatus with film clips having special features. All these special features are also found in the independent claim 22 and following dependent claims, which are directed to the film clip per se.

From above, it appears clearly that the applicant, although he had already claimed the combination of the stenter apparatus with the particular film clip, has chosen to obtain in addition a separate protection for the clip itself. PCT Rule 13.3 allows the inclusion in the same international application of two or more independent claims of the same category, however under the condition that the requirement of Rule 13.1 must be met, that is to say a single and inventive concept should link the two or more subject-matters of the independent claims. Such a requirement goes beyond the preference that the apparatus is to be used together with a certain tool or vice versa, which is the main argument of the Appellant.

3. Such a link is found with Claims 2 to 21, since these claims are formally dependent on Claim 1 and contain all the features of the apparatus in the broadest sense according to the main claim. The latter forms the common link between all these claims, which therefore relate to a single concept.

4. However, no such single link can be recognised between the stenter apparatus of Claim 1 and the specific film clip of Claim 22:

(a) The stenter apparatus according to Claim 1 comprises a film clip in a general sense, and is characterised by a film holder up-line of the main stenter, which itself comprises two sections, an initial and parallel one for longitudinal

stretching followed by a second and diverging one for transverse stretching, with "control means being provided for the film clips, operable to create machine direction draw in film in said initial section". The expression "operable to create machine direction draw in film" can be interpreted as requiring clips having the sole function of gripping the film to allow the longitudinal stretching to take place. Indeed, in the introductory part of the description relative to the prior art, film clips, which are able to provide hold back or pull on the film in the machine direction, as well as control means for these clips, are said to be known. Thus the features concerning the film clips in Claim 1 are not necessarily new, and the film clips of the prior art with their control means could be used in the stenter apparatus of Claim 1, since they provide the same functions.

(b) On the other hand, film clips, which are the subject-matter of Claim 22, have a film holding element which swings. However, this swinging movement now takes place in a plane parallel to the stenter machine direction, and not in the transverse direction, as it has already been known from the prior art. It seems that the purpose of this change of direction for the swinging movement is to improve the gripping effect of the clips (see page 6, second paragraph) and to allow the handling of edge beaded films with upwardly directed edge-beads.

Consequently, the subject-matter of Claim 22 neither shares any structural features with those of Claim 1 nor is the function of its specific clip identical with those of the clips according to the prior art which are referred to in the preamble of Claim 1.

5. The applicant's arguments are mainly based on the use of edge beaded films in the stenter apparatus according to Claim 1. However, such a use is not part of the independent Claim 1 and appears only in the features of the dependent Claim 4. The description in page 2 indicates that, preferably, the stenter apparatus is adapted for handling edge beaded film and that the film clip is especially but not exclusively intended for use with this kind of film. Therefore, when the Applicant argues that the claimed clips are especially devised for the stenter apparatus of Claims 1-10, he refers to the apparatus as claimed in dependent Claim 4, and not to the one of Claim 1. Preferable embodiments or objects, since they are not exclusive, bringing no clear limitations, cannot serve to build a common, i.e. single inventive concept between the inventions. According to PCT Rule 13, this concept is to be found in the subject-matter of all the independent claims, and not only partially in some of the dependent claims.

6. Thus, the subject-matter of independent Claim 1 and that of Claim 22 do not meet the requirement of unity prescribed by PCT Rule 13.1.

ORDER

For these reasons, it is decided that:

The protest under Rule 40.2(c) PCT is dismissed as inadmissible.