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D E C I S I O N
of 24 September 2004

Case Number: T 0241/02 - 3.2.7

Application Number: 94919818.8

Publication Number: 0657561

IPC: C23C 2/28

Language of the proceedings: EN

Title of invention:

Alloyed hot dip iron-zinc alloy plated steel plate having excellent press moldability

Patentee:

NKK CORPORATION

Opponent:

Corus Staal BV
Thyssen Krupp Stahl AG

Headword:

-

Relevant legal provisions:

EPC Art. 82, 83, 84, 123(2), 123(3)
EPC R. 57a

Keyword:

"Reinsertion of portion of description"

Decisions cited:

T 1149/92

Catchword:

-



Case Number: T 0241/02 - 3.2.7

D E C I S I O N
of the Technical Board of Appeal 3.2.7
of 24 September 2004

Appellant: NKK CORPORATION
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Respondent: Corus Staal BV
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Representative: -

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Decision under appeal: **Decision of the Opposition Division of the
European Patent Office posted 14 December 2001
revoking European patent No. 0657561 pursuant
to Article 102(1) EPC.**

Composition of the Board:

Chairman: A. Burkhart
Members: H. E. Felgenhauer
C. Holtz

Summary of Facts and Submissions

I. Background

In a communication from the Examining Division of 19 March 1997, the applicant was *inter alia* advised that the application was not unitary, since it aimed to solve at least two completely different problems, ie the product claims 1 to 5, which solved problems in "prior arts 1-4" cited in the application, on the one hand, and the process claims 6 to 11, which provided a solution to other problems in methods of the so-called "prior arts 5-7" cited in the application, on the other hand.

The communication cited both Articles 82 and 84 EPC as reasons why the application had to be amended.

In response to this communication, the appellant on 18 September 1997 filed a letter containing several requests for amendments, in which it also stated in point 4 that: "The subject matter of claims 6 to 11 shall be no longer part of the new claims. Therefore, also the description has been restricted to the subject matter of claims 1 to 5. However, the applicants reserve the right to further prosecute the subject matter of claims 6 to 11 in one or more divisional applications."

II. The appellant (patent proprietor) filed an appeal against the decision of the Opposition Division revoking European patent No. 0 657 561.

Oppositions were filed against the patent as a whole based on the grounds of opposition according to Article 100(a) EPC (lack of novelty and of inventive step) and Article 100(b) EPC (insufficiency of disclosure).

Responding to the ground of opposition according to Article 100(b) EPC the patent proprietor amended the description of the patent in suit. The requested amendment aimed at a portion of the description of the application as filed to be reinserted. The content of this portion of the description relates to methods for manufacturing alloying-treated iron-zinc alloy-dip plated steel sheets, whereas claims 1 to 5 of the patent in suit are directed to a product, namely an alloying-treated iron-zinc alloy-dip plated steel sheet. The portion of the description concerned had been excised from the patent application in response to the objection with respect to Article 82 EPC (lack of unity) referred to above.

The Opposition Division examined the proposed amendment and found that it satisfied the Article 123(2) EPC, since the parts to be reinserted had all been part of the description of the application as filed (reasons, point 2).

The Opposition Division held however that the patent has to be revoked due to this amendment, for the reason that it created inconsistencies (Article 84 EPC) and contravened Article 123(3) EPC (reasons, point 2.1.7). In the decision under appeal it referred to decision T 1149/97 citing "If, in view of Articles 84 and 69 EPC, the application documents have been adapted to amended

claims before grant, thereby deleting part of the subject-matter originally disclosed in order to avoid inconsistencies in the patent specification, as a rule subject-matter deleted for this reason can neither be reinserted into the patent specification nor into the claims as granted without infringing Article 123 (3) EPC."

III. Oral proceedings before the Board of Appeal were held on 24 September 2004.

(i) The appellant (patent proprietor) requested that the decision under appeal be set aside and that the case be remitted to the first instance for further prosecution.

(ii) The respondent (opponent 02) requested that the appeal be dismissed.

IV. The arguments of the appellant given in writing and in the oral proceedings can be summarised as follows:

(i) The requested amendment of the description consists of a part of the description of the application as filed excised during the examination proceedings to be reinserted, this portion of the description being directed to methods for manufacturing a product as defined by claims 1 to 5 of the patent in suit. The amendment was occasioned by the ground of opposition according to Article 100(b) EPC so that the requirement of Rule 57a EPC was satisfied. Since the amendment was a part of the description of

the application as filed and, since it was not abandoned with substantive effect, the amendment likewise satisfied the requirement of Article 123(2) EPC. Finally the requirement of Article 123(3) EPC was satisfied, considering that claims 1 to 5 of the patent in suit were product claims directed to an alloying-treated iron-zinc alloy dip-plated steel sheet, whereas the amendment related to methods for manufacturing such steel sheets.

- (ii) The subject-matter concerned was excised from the application as filed during the examination proceedings, in response to an objection of the Examining Division concerning lack of unity between the subject-matter of product claims 1 to 5 and method claims 6 to 11, with declaration of letter dated 18 September 1997 (paragraphs 3 to 5) Whether based on its wording or on the circumstances under which it was given, this declaration can not be interpreted as an abandonment of the subject-matter excised from the application with substantive effect.

- (iii) Although decision T 1149/97, upon which the decision under appeal was based, correctly defined criteria to be met by an amendment by which a portion of the description of the application was to be reinserted, the criteria given by Article 123(3) EPC had been applied to the present case in an incorrect manner, since the subject-matter

to be reintroduced was excised due to an objection with respect to the requirement of Article 82 EPC (unity of invention), whereas excision in decision T 1149/97 was made in order to avoid inconsistencies in the patent specification, relating to Article 84 EPC. While the finding in that decision, that as a rule subject-matter deleted for this reason can neither be reinserted into the patent specification nor into the claims as granted without infringing Article 123(3) EPC was considered to be correct, its application in the decision under appeal was not appropriate, since the reason for the reinsertion in the present case was of an entirely different nature.

V. The arguments of the respondent (opponent 2) given in writing and in the oral proceedings can be summarised as follows:

- (i) Although the declaration of the appellant given with letter dated 18 September 1997 did not lead immediately to the subject-matter excised from the application being abandoned with substantive effect, it must be considered to have had effect at the latest with the grant of the patent following the applicant approving the text specified in the Communication under Rule 51(4) EPC. In the interest of third parties, which should be able to rely on a patent in the text in which it has been

granted, the requested amendment was therefore inadmissible.

- (ii) Furthermore, in the particular situation given, in which the claims of the patent in suit defined products whereas the subject-matter having been abandoned with substantive effect concerned methods for the manufacturing of products, it could not be excluded that reinsertion of this subject-matter could lead to the protection conferred by the product claims being extended.

Reasons for the Decision

- 1. Abandonment of deleted subject-matter
 - 1.1 The first point to decide is whether the appellant by the declaration in point 4 of its letter of 18 September 1997 abandoned the excised parts mentioned there.
 - 1.2 The respondent, while not claiming that the declaration had any immediate substantive effect, contends that an abandonment effect occurred at the latest at the time the patent was granted, following the approval by the appellant of the text for grant specified in the communication under Rule 51(4) EPC.
 - 1.3 Firstly, the Board observes that the declaration could not have any effect as a final abandonment of the excised subject matter, since the appellant expressly

reserved its right to prosecute the same matter. That this was intended at the time to follow in one or more divisional applications does not restrict the appellant.

1.4 Secondly, the Board agrees in general that third parties should be able to rely on the text of a granted patent, so that they are protected against surprises in the form of extensions. However, the legal basis for the principle that the protection conferred by a patent can only be restricted but not extended, is solely provided for by Article 123(3) EPC. Thus neither the fact that the appellant approved the text of the patent in suit, nor considerations with respect to legal certainty add to the requirements relating to amendments in Rule 57a or Article 123(2) EPC. The grant of a patent therefore does not necessarily constitute a final and automatic cut-off point excluding any reinsertion of deleted subject matter.

2. *Requirements in the EPC on amendments*

It is common ground among the parties that for an amendment of a patent to be admissible the requirements of Rule 57a, Article 123(2) and Article 123(3) EPC have to be satisfied. The request for reinsertion therefore has to be examined against each of these provisions.

2.1 Rule 57a EPC

It is clear that the amendment (reinsertion of portions of the description relating to the process claims) was occasioned by a ground of opposition, ie the one raised under Article 83 (100(b)) EPC by both opponents.

The requested reinsertion therefore in principle meets the requirements of Rule 57a EPC.

2.2 Article 123(2) EPC.

The Opposition Division examined the requested reinsertion and concluded (reasons point 2) that it satisfied Article 123(2) EPC, since all excised portions had been part of the application as filed. The Board sees no reason to disagree with the Opposition Division on this point. Possible amendments to the portions to be reinserted need of course be examined in this respect.

2.3 Article 123(3) EPC.

2.3.1 It remains therefore to examine whether or not the requested reinsertion satisfies Article 123(3) EPC. On this point, the respondent has argued before the Board that it cannot be excluded that the reinsertion of the parts relating to methods for the manufacturing of products could lead to an extension of the protection conferred by the product claims.

2.3.2 The opposition division concluded on the basis of decision T 1149/97 that reinsertion would not be possible, since it would contravene Article 123(3) EPC, but without referring to any specific parts or making any connection between parts to be reinstated and any concrete conclusion as to how the product claims would be extended in contravention of Article 123(3) EPC. The references made to specific inconsistencies relate to objections arising under Article 84 EPC.

2.3.3 Decision T 1149/97 is interpreted by this Board to apply only to the situation where parts of the description have been deleted in order to adapt it to amended claims, in order to avoid inconsistencies (Article 84 EPC). The Board in that decision concluded that reinstatement of such parts would, as a rule, infringe Article 123(3) EPC. But it also held the view that cut-off effects from the grant of a patent could only be based on Article 123(3) EPC (point 6.1.10 of the reasons). On the contrary, in the present case, the parts to be reinstated relate to methods for producing, *inter alia*, the products defined by claims 1 to 5. It is not obvious why such a reinsertion would contravene Article 123(3) EPC in principle. To put it simply, the appellant deleted too much of the description, overlooking the relevance of parts of it to these remaining claims.

2.3.4 The inconsistencies that may be created by a reinsertion in the present case apparently were understood by the Opposition Division as being of the same nature as those referred to in T 1149/97. The Board cannot agree to this interpretation. The excision of claims 6 to 11 and the corresponding portion of the description was made as a response to objections under Article 82 EPC, whereas T 1149/97 considered matter excised in order to overcome objections under Article 84 EPC, ie matter that had been excised when adapting the description to amended claims in order to avoid inconsistencies.

2.3.5 As to parts relating to an objection of insufficient disclosure (Article 83 EPC) or to an objection of lack of unity (Article 82 EPC), decision T 1149/97 is silent.

The present Board also notes that that decision does not lay down a strict rule. It was only observed that Article 123(3) EPC as a *rule* must be infringed by inconsistencies falling under Article 84 EPC. This is a recommendation to be vigilant, in order that reinstatements having an extending effect on the protection conferred will be prevented, rather than a generally applicable rule.

2.3.6 Therefore, decision T 1149/97 requires that an examination of a request for reinsertion must be carried out with a view to establishing whether or not Article 123(3) EPC *on the facts of each case* has indeed been infringed.

In the present case, the Opposition Division has pointed to some inconsistencies which in its mind arose under Article 84 EPC (points 2.1.5.1 to 2.1.5). In point 2.1.5.4 the Opposition Division concludes that some of the processes to be reinserted could mean that products which were only cited as comparative ones and thus not part of the invention could be obtained by these processes and thus be covered by the still remaining product claims. However, it is not explained why this would make the entire reinsertion inadmissible, nor whether it would be possible by other means to avoid this construction (eg noting the processes as comparative only). With regard to Article 123(3) EPC no further detailed examination seems to have taken place. The Opposition Division merely concluded that as a consequence (of offensive inconsistencies noted in point 2.1) "the sole request is not allowable with respect to Article 123 (3) EPC."

However, since the requested reinsertion has to be examined in detail, the above observation is not sufficient to reject the reinsertion as a whole and to revoke the patent.

3. *Remaining questions*

The question still remains whether there are passages of the portions requested to be reinserted which should still not be admitted because when examined in detail are found not to be relevant for the objection of insufficient disclosure (Rule 57a EPC) or would contravene Article 84 EPC or possibly create problems as to the extent of the claims now on file (Article 123(3) EPC). Possible amendments to portions to be reinserted need to be examined with respect to Article 123(2) EPC. Such matters should be examined by the Opposition Division as first instance.

4. Remittal for further prosecution

Since at this point it is uncertain which parts of the requested reinsertion still may offend one or more requirements of the EPC (Article 84 and 123(3) EPC in particular) and the further patentability criteria have not yet been examined in the opposition proceedings, the Board exercises its discretion under Article 111(1) EPC to remit the case for further prosecution.

5. With regard to Rule 57a and Article 123(2) EPC, the Board observes that although they have been found to be satisfied in principle, see points 3 and 4 above, the parts now concerned should be examined against these requirements on a factual basis, see point 5.6 above.

Order

For these reasons it is decided that:

1. The decision under appeal is set aside.
2. The case is remitted to the first instance for further prosecution.

The Registrar:

The Chairman:

G. Nachtigall

A. Burkhart