

Internal distribution code:

- (A) Publication in OJ
(B) To Chairmen and Members
(C) To Chairmen
(D) No distribution

D E C I S I O N
of 5 October 2005

Case Number: T 0735/03 - 3.4.03

Application Number: 98917491.7

Publication Number: 1086475

IPC: H01G 7/00

Language of the proceedings: EN

Title of invention:

The method of obtaining the adjustable capacitor

Applicant:

Zakharian, Manvel

Opponent:

-

Headword:

Adjustable capacitor/ZAKHARIAN

Relevant legal provisions:

EPC Art. 123(2), 85

PCT. Art. 3(3), 27, 19(2), 34(2)(b), 28(2), 41(2)

Keyword:

"Amendments filed during the international phase have to comply with the substantive requirements of the EPC, in particular that of Article 123(2) EPC, (reasons 2.3)"

Decisions cited:

T 0169/83, T 0246/86, T 0901/01

Catchword:

-



Case Number: T 0735/03 - 3.4.03

D E C I S I O N
of the Technical Board of Appeal 3.4.03
of 5 October 2005

Appellant:

Zakharian, Manvel
3812 Marquette Rue
Fabreville, Laval
Quebec H7P 1S4 (CA)

Representative:

Lauw, Rudolf C. W.
Karwinskistrasse 1
D-81247 München (DE)

Decision under appeal:

Decision of the Examining Division of the
European Patent Office posted 13 May 2003
refusing European application No. 98917491.7
pursuant to Article 97(1) EPC.

Composition of the Board:

Chairman: G. L. Eliasson
Members: E. Wolff
T. Bokor

Summary of Facts and Submissions

I. This is an appeal against the decision of the examining division to refuse European patent application 98 917 491.7 (published as international application WO 99/59171) on the ground that amendments made to the application contravene Article 123(2) EPC.

II. The only independent claims 1 and 25 of the application, which formed the basis of the decision under appeal, have the following wording:

"1. The method of obtaining the adjustable capacitor including the step of connecting at least a first and a second capacitors [sic] or a first and a second groups [sic] of capacitors, which have first and second output terminals, in series, characterized in that each of said capacitors can be any type and the method includes the steps of:

choosing the capacity of the first capacitor or the first group of capacitors no more than the capacity of the second capacitor or the second group of capacitors;

connecting capacitor plates of said first capacitor or said first and second output terminals of said first group of capacitors through at least one cell, which changes its resistance or reactance, and/or at least one switching device and/or at least one adjustable resistance and/or at least one adjustable reactance device;

then converting at least one of said cells or switching devices or adjustable resistance or adjustable reactance devices into a non-conducting state or into a state with higher impedance within charging of said second capacitor or said second group of capacitors;

and then connecting electrically the capacitor plates of said first capacitor or said first and second output terminals of said first group of capacitors."

"25. The method of obtaining the adjustable capacitor including the step of connecting at least a first and a second capacitors [sic] or a first and a second groups [sic] of capacitors, which have first and second output terminals, in series, characterized in that each of said capacitors can be any type and the method includes the steps of:

choosing the capacity of the first capacitor or the first group of capacitors less than the capacity of the second capacitor or the second group of capacitors;

connecting capacitor plates of said first capacitor or said first and second output terminals of said first group of capacitors through at least one cell, which changes its resistance or reactance, and/or at least one adjustable resistance device and/or at least one adjustable reactance device;

connecting capacitor plates of said second capacitor or said first and second output terminals of said second group of capacitors through at least one additional cell, which changes its resistance or reactance, and/or

at least one adjustable resistance device and/or at least one adjustable reactance device;

and changing a capacity of the adjustable capacitor by changing a value of resistance or reactance of at least one of said cells or by changing a value of resistance of at least one of said adjustable resistance devices or by changing a value of reactance of at least one of said adjustable reactance devices

or changing a capacity of the adjustable capacitor by changing a value of resistance or reactance of at least one of said additional cells or by changing a value of resistance of at least one of said additional adjustable resistance devices or by changing the reactance of at least one of said additional adjustable reactance devices."

- III. In the decision under appeal, the examining division had concluded, inter alia,
- (a) that no basis could be found in the application as originally filed for inserting the phrase "each of said capacitors can be of any type" in claims 1 and 25;
 - (b) that the wording of newly added claim 25 was not directly and unambiguously derivable from, and consequently had to be considered as going beyond, the content of the application as filed, because claim 25 did not refer to some of the features which it appeared from the description were necessary features of the invention; and

(c) that in the acknowledgement of the prior art on the amended page 1 of the application the discussion of the shortcomings of the prior art were contrary to Article 123(2) and Rule 27(2)(b) EPC.

- IV. The Board summoned the appellant to oral proceedings. The summons was accompanied by a written communication setting out why the amendments made to the application appeared to introduce new subject matter.
- V. Neither the statement setting out the grounds of appeal nor the reply to the communication accompanying the summons contained a full response to the objection that claim 25 went beyond the contents of the application as filed.
- VI. The appellant requested in writing that the decision under appeal be set aside and that the examination procedure should continue on the basis of the claims 1 to 27 which were received on 16 October 2000 and formed the basis of the decision under appeal.
- VII. During a telephone conversation with the appellant's representative in advance of the oral proceedings, the representative was reminded that the objections raised in the communication under Article 123(2) were directed to the claims presently on file, not to the originally filed claims.
- VIII. The duly summoned representative stated in his letter dated 29 September 2005 that he would not attend the oral proceedings. No amendments were filed.

IX. Oral proceedings were held in the absence of the appellant on the basis of the appellant's written submissions and the request implied in these submissions that the patent be granted on the basis of claims 1 to 27 which were received on 16 October 2000.

Reasons for the Decision

1. The appeal is admissible.
2. *Article 123(2) EPC*
 - 2.1 Claim 1 of the request, as compared to claim 1 as originally filed, contains the added feature that "each of said capacitors can be of any type".
 - 2.1.1 In response to the Board's written communication in which the Board indicated its preliminary view on this point, the appellant cited the text in lines 23 and 24 of page 1 of the published international application as being a clear and unambiguous disclosure of the feature concerned. The text in lines 23 and 24 reads "An object of the invention is to transform all types of capacitors (including Electrolytic, Vacuum, high-voltage capacitors) into adjustable capacitors ...". The appellant also cited the corresponding text in lines 1 and 2 of the abstract as providing the necessary disclosure.
 - 2.1.2 The Board does not consider the appellant's argument to be persuasive. In the Board's view, the statement in lines 23/24 on page 1 merely states what the invention is trying to achieve; it does not state by which means

or in which manner the stated object of the invention is achieved.

2.1.3 Moreover, if the passage concerned were to be considered, which it is not, to state how the invention achieves its object, then the skilled person reading it would make his choice of capacitors knowing full well that not every type of capacitor is suitable for every type of application. Hence, contrary to the appellant's submission, the skilled person would not consider the passage to mean that **any** two types of capacitors could be combined indiscriminately. The requirement that "each of said capacitors can be of any type" cannot therefore be derived from the application as filed. On the contrary, the passage concerned must be considered to contradict what the skilled person would understand on reading the application as a whole.

2.1.4 The appellant also relied on the corresponding phrase in lines 1 and 2 of the abstract. According to Article 85 EPC, the abstract merely serves to provide technical information; it "may not be taken into account for any other purpose..." In the words of the corresponding text of Article 3(3) PCT, the abstract "cannot be taken into account for any other purpose ...". It follows that the question whether the feature that "each of said capacitors can be of any type" is or is not disclosed in the application as filed, cannot be resolved by having recourse to the text of the abstract. This conclusion is confirmed by the jurisprudence of the Boards of Appeal (see, e.g., T 246/86, OJ EPO 1989, 199).

2.2 The disputed claim 25 contains a complex combination of features. Like claim 1, claim 25 also contains the added feature that "each of said capacitors can be of any type". It also contains further features which the appellant argued were supported by the features shown in Figure 58.

2.2.1 The EPC does not prohibit amendment of claims to include features taken from the drawings. This is confirmed by the jurisprudence of the Boards of Appeal. However, the amendment is permissible only "if the structure and the function of such features is clearly, unmistakably and fully derivable from the drawings in terms of structure and function by a person skilled in the art and so relatable by him to the content of the description as a whole as to be manifestly part of the invention" (see T 901/01, paragraph 2.2, citing with approval decision T 169/83, OJ EPO 1985, 193). Claims based solely on the disclosure in a drawing thus may not cover any embodiments which are not disclosed there and are clearly different from what appears in the drawing in question.

2.2.2 The appellant argued that features such as

(i) that the capacity of the first capacitor ... is chosen less than the capacity of the second capacitor...;

(ii) that the first and second capacitors are connected in series;

- (iii) that the capacitor plates of the second capacitor are connected through the adjustable resistances R5 and R6; and
- (iv) that the capacitor plates of the first capacitor are connected through a diode which is installed "against the current of charging" the of the first capacitor

were based on Figure 58.

With reference also to page 12, sixth-last line to fourth-last line - where it is stated that the step of converting the adjustable resistance 5 or the adjustable reactance 6 (Fig. 5, Fig. 6a and Fig 6b) into a non-conducting state or into a state of higher impedance is realized by control unit 64 (Fig. 58) in a moment t_1 (Fig. 15) - the appellant further argued that this passage disclosed

- (v) that the capacitor plates of the first capacitor are connected through an adjustable resistance device or through an adjustable reactance device, and
- (vi) that the control unit 64 can change the impedance of the adjustable resistance device 5 or the impedance of the adjustable impedance device 6.

2.2.3 However, these arguments do not address the objection, raised originally by the examining division and repeated by the Board in its written communication, that claim 25 refers neither to the function of converting the adjustable resistance or reactance into

- a state of higher impedance, nor to the use of the control unit which is described with reference to and shown in Fig. 58 (control unit 64) and which is necessary to perform this function.
- 2.2.4 The wording of claim 25 refers to "at least one cell" and "at least one additional cell", but it is not clear what in Figure 58 is "a cell" and what is "an additional cell". Figure 58 and its associated description therefore do not disclose the features in the form and combination in which they are claimed in claim 25.
- 2.3 In support of the all the amendments made, the applicant further argued that they were made during the international phase and could not therefore be objected to under the provisions of the EPC. The Board does not accept this argument.
- 2.3.1 Amendments made in the international phase are subject to Articles 19(2) and 34(2)(b) PCT which require that amendments must not go beyond the disclosure in the international application as filed. Articles 28(2) and 41(2) PCT relate to amendments made to the international application before the designated and elected offices respectively, and require amendments not to go beyond the original disclosure, except where the law of the state concerned permits it. The relevant law in the present case is the EPC, and in particular the provisions of Article 123(2) EPC which do not permit amendments to go beyond the original disclosure. It follows that there are no provisions in the PCT which would permit an amendment to go beyond the

contents of the application as filed if the designated or elected office is the EPO.

- 2.3.2 Furthermore, introducing a claim such as claim 25 in the international phase does not exempt it from having to comply with the requirements of the EPC. Article 27 PCT ("National Requirements") draws a clear distinction between formal and substantive aspects of an application.

According to Article 27(1) PCT, no national office is permitted to require compliance with requirements relating to form or contents of the application over and above those set out in the PCT; however, according to Article 27(5) PCT, nothing in the PCT is intended to prescribe any substantive conditions of patentability.

- 2.3.3 The Board has no doubts that the subject matter claimed in a claim, and the determination whether or not that subject matter was contained in the application as originally filed, must be considered to be among the substantive condition of patentability, and that it is therefore well within the competence of the examining division to consider and if necessary reject amendments made in the international phase on the grounds that they contravene the provisions of Article 123(2) EPC.
3. Amendments filed during the international phase have to comply with the substantive requirements of the EPC, in particular that of Article 123(2) EPC. It is the judgement of the Board, for the reasons given that some of the amendments made do the application in suit during the international phase do not meet that requirement.

Order

For these reasons it is decided that:

The appeal is dismissed.

Registrar

Chair

D. Meyfarth

G. Eliasson