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D E C I S I O N
of 7 February 2006

Case Number: T 1170/03 - 3.4.01

Application Number: 92901743.2

Publication Number: 0561967

IPC: G21B 1/00

Language of the proceedings: EN

Title of invention:
Energy/matter conversion methods and structures

Applicant:
MILLS, Randell Lee

Opponent:
-

Headword:
-

Relevant legal provisions:
EPC Art. 84, 111(2), 112, 123(2)
EPC R. 89

Keyword:
"Requirements Article 84 EPC (no) - main request"
"Request aimed at revision of ratio decidendi of decision of remitting board rejected as inadmissible, Article 111(2) EPC - first and second auxiliary request"
"Referral of question to Enlarged Board of Appeal - rejected"

Decisions cited:
G 0001/97, T 1032/97

Catchword:
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Beschwerdekammern | Boards of Appeal | Chambres de recours

Case Number: T 1170/03 - 3.4.01

D E C I S I O N
of the Technical Board of Appeal 3.4.01
of 7 February 2006

Appellant: MILLS, Randell Lee
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Decision under appeal: **Decision of the Examining Division of the European Patent Office posted 30 June 2003 refusing European application No. 92901743.2 pursuant to Article 97(1) EPC.**

Composition of the Board:

Chairman: B. Schachenmann
Members: R. Bekkering
G. Assi

Summary of Facts and Submissions

I. European patent application 92 901 743.2 (publication Nos. WO-A-92 10838 and EP-A-0 561 967) was refused pursuant to Article 97(1) EPC by a decision of the examining division dispatched on 30 June 2003, on the grounds of Article 84 EPC.

II. The applicant (appellant) lodged an appeal against the decision on 18 August 2003 and paid the appeal fee on the same day. The statement setting out the grounds of appeal was received on 4 November 2003.

III. Oral proceedings, requested as an auxiliary measure by the appellant, were held on 7 February 2006.

IV. The appellant requested that the decision under appeal be set aside and a patent be granted on the basis of the following documents:

Main request:

Claims: 1 to 21 filed with letter dated 6 January 2006 with the insertion of the term "ion" after potassium and rubidium, respectively, and the correction of the term "milliamps" as requested in the oral proceedings of 7 February 2006;

Description: pages 1, 2, 2a, 3 to 16 filed with letter dated 6 January 2006;

Drawings: Sheets 1/3 to 3/3 filed with letter dated 6 January 2006;

First auxiliary request:

Claims: 1 to 22 filed with letter dated 6 January 2006, with the insertion of the term "ion" after potassium and rubidium, respectively, and the correction of the term "milliamps" as requested in the oral proceedings of 7 February 2006;

Description and drawings as for the main request.

Second auxiliary request:

Claims, description and drawings as originally filed.

Moreover, the appellant requested that the following question be referred to the Enlarged Board of Appeal:

"*Is a previous decision of an Appeal Board, and in particular the reasons for said decision, binding for a later Appeal Board if this would force applicant to introduce new subject-matter which extends beyond the original disclosure even if the previous Appeal Board stated without basis and incorrectly that no new matter was added in conflict with facts showing the contrary?*".

V. The decision under appeal follows the remittal of the case to the examining division for further prosecution by the board of appeal (in a different composition) as per decision T 1032/97 of 6 December 2000 in a prior appeal lying from an earlier decision of the examining division dispatched on 28 April 1997 refusing the

application under Article 97(1) EPC for lack of clarity (Article 84 EPC).

The appellant's requests for re-opening of the appeal proceedings and for modifying the reasons for the decision T 1032/97 of 6 December 2000 were refused as inadmissible in a decision of the board of appeal of 5 September 2001.

VI. Independent claims 1 and 15 according to the main request read as follows:

"*1. An electrolytic cell operated with a cathode current density in the range of 5 to 400 milliamps per square centimeter comprising:*
a vessel containing at least one cathode, at least one anode, and an electrolytic solution connecting the cathode to the anode;
a source of hydrogen atoms; and
a source of potassium ion or rubidium ion as catalyst."

"15. *Use of an electrolytic cell according to any one of the preceding claims for the production of heat.*"

VII. Claim 1 according to the first auxiliary request contains the following additional feature at the end of the claim: "*for catalyzing the reaction of hydrogen atoms to lower-energy hydrogen and release energy from the atoms*".

Furthermore, a new claim was added which reads as follows:

"22. *Use of an electrolytic cell according to claim 15 comprising catalyzing the reaction of hydrogen atoms to lower-energy hydrogen and release of energy from the atoms.*"

VIII. Independent claims 1 and 4 according to the second auxiliary request read as follows:

"*1. A method of releasing energy, comprising the steps:*
selecting an element of matter having a nucleus and at least one electron comprising an electron orbital;
determining the resonance shrinkage energy of the electron orbital and the energy hole which will stimulate the electron to undergo a resonance shrinkage transition to relax to a quantized potential energy level below that of the ground state, providing an orbital of smaller dimensions forming a shrunken orbital of the element of matter;
providing an energy hole substantially equal to the resonance shrinkage energy of the element of matter;
juxtaposing said element of matter and said energy hole, wherein;
energy is released as the electron of the element of matter is stimulated by said energy hold [sic] *to undergo at least one shrinkage transition.*"

"*4. Apparatus for providing the release of energy, comprising:*
means for providing an element of matter in a selected volume, said element having a nucleus and at least one electron comprising an orbital having a resonance shrinkage energy; and
a means introduced into said selected volume for providing an energy hole in juxtaposition with said

element of matter, said energy hole having magnitude substantially equal to said resonance shrinkage energy, wherein:
energy is released from said element of matter when the orbital of said element of matter is reduced due to removal of orbital energy by said energy hole permitting the electron of the element of matter to be stimulated to undergo at least one shrinkage transition providing the release of energy."

Reasons for the Decision

1. The appeal complies with the requirements of Articles 106 to 108 and Rule 64 EPC and is, therefore, admissible.

2. *Main request*

2.1 The present application was refused by the examining division for a first time with the decision dispatched on 28 April 1997 refusing the application under Article 97(1) EPC for lack of clarity (Article 84 EPC). Against this decision the appellant filed an appeal resulting in decision T 1032/97 of 6 December 2000.

In decision T 1032/97 of 6 December 2000 the board ruled that the claims 1 to 21 as amended, which correspond to those presently on file as main request, complied with the requirement of clarity according to Article 84 EPC. However, the board found that the description had to be adapted to the claims so as to fulfil all the requirements of Article 84 EPC (see

Reasons for the Decision, 3.4) and remitted the case to the first instance for this purpose.

In particular, the board held that, based on its dictionary meaning, the term "*catalyst*" in the expression "*a source of potassium ion or rubidium ion as catalyst*" in claim 1 defined the role of the elements potassium and rubidium, which contributed to and increased the rate of the electrolytic reaction in the cell without being consumed or chemically modified in the reaction. Moreover, the expression in claim 15 "*for the production of heat*" was held to relate to the well-known ohmic heat which was produced when a current flowed through an electrolytic cell (see Reasons for the Decision, 3.2 and 3.3).

Any other meanings attributed to the term "*catalyst*" in the originally filed application documents was regarded as speculative and not in conformity with the subject-matter of claim 1 for which protection was sought.

Furthermore, as far as the expression "*for the production of heat*" referred to the speculative and controversial phenomenon described as "*excess heat*" in the original application, the description was not considered to be in conformity with the subject-matter of claim 15.

Moreover, the board was satisfied that the amendments to the claims were admissible under Article 123(2) EPC and that the skilled person would be able to carry out the invention as specified in claims 1 and 15 so that the requirements of Article 83 EPC were met.

In summary, the claims on file were considered to comply with Articles 3, 84 and 123(2) EPC. However, their subject-matter had not yet been examined with respect to all other requirements of the EPC, in particular with respect to novelty and inventive step. Furthermore, the description still contained references to speculative subject-matter which needed to be deleted during the further prosecution of the case to bring it in conformity with the claims in order to comply with all requirements of Article 4 EPC (see Reasons, 5).

2.2 According to the description as originally filed of the application in suit, based on a novel atomic theory, energy was released from hydrogen atoms by stimulating their electrons to relax to a quantized potential energy level below that of the ground state and to thereby shrink to smaller dimensions by providing an energy hole resonant with this transition (see in particular "summary of the invention" and "detailed description of the invention", section "theory"). The energy hole was provided by an electrocatalytic couple with an appropriate redox energy. Furthermore, by repeating this shrinkage reaction controlled nuclear fusion was caused. The energy which was released produced excess heat in an electrolytic cell.

2.3 According to the above decision T 1032/97 of 6 December 2000 of the board of appeal, all references in the description to the speculative and controversial phenomena described as "*excess heat*" as well as to speculative meanings of the term "*catalyst*" had to be deleted.

Accordingly, from the above decision it follows that all parts of the description relating in particular to the underlying novel atomic theory, the relaxation of electrons to energy levels below the ground state and the shrinkage of the atoms, the absorption of energy holes (or emission of energy), the electrocatalytic couple and the nuclear fusion should be removed.

This finding forms part of the *ratio decidendi* of the above decision, ie the reasons for the decision. Following remittal, the first instance was bound by this *ratio decidendi* as prescribed in Article 111(2) EPC, and so is the present board which can only act within the constrained competence of the first instance, the facts of the case having remained the same.

The necessity to delete the speculative subject-matter constitutes *res judicata* for these proceedings as it is matter finally judged by the previous board of appeal in the course of the examination proceedings. Such a final judgment constitutes an absolute bar to any subsequent legal action involving the same matter in the same proceedings (see Case Law of the Boards of Appeal of the EPO, fourth edition, 2001, VII.D.10).

2.4 Considerable parts of the description as amended according to the main request, eg the section providing the summary of the invention and the theory section of the detailed description of the invention, still contain the speculative matter which should have been deleted. Accordingly, the description is not in conformity with the claims of the main request, contrary to the requirements of Article 84 EPC, in

keeping with the above decision T 1032/97 of 6 December 2000.

2.5 The appellant argued that the doctrine of *res judicata* was not applicable under the circumstances of the case in suit. An underlying premise in applying *res judicata* with regard to a particular issue was that the party against whom that doctrine was asserted had a full and fair opportunity to discuss that issue. In the present case the previous board misconstrued the claims in its decision T 1032/97 contrary to an agreement that had been reached with the applicant during the Oral Proceedings held on 6 December 2000, in which the previous board agreed to withdraw all pending objections against the claims as amended, no contrary amendments to remove references to lower-energy hydrogen being agreed to or even discussed. The previous board then denied the applicant the opportunity to request correction of the reasons for the decision. The possibility of a correction of the reasons of a decision was discussed in the G 1/97 decision of the Enlarged Board of Appeal, see in particular EPO Journal 7/2000 page 340, 4th paragraph.

Given the denial of a full and fair opportunity for a hearing on the applicant's objections to the previous board's T 1032/97 decision, the issues raised by those objections, regarding the interpretation of claims 1 to 21 and the requirement to amend the description in conformance with that interpretation, were not subject to *res judicata*. On the contrary, those issues were still highly relevant to the present appeal and, having never been given a fair hearing, should be heard in the present appeal.

In submitting the present application, the applicant expressly disclosed and claimed his invention based upon novel hydrogen chemistry forming lower-energy hydrogen. It was a violation of the applicant's right to disclose and claim what he considered to be his invention for the previous appeal board to require unintended and in fact undisclosed amendments to his application changing the very nature of that invention. Indeed, the proposed amendments would introduce new matter into the case, violating Article 123(2) EPC. From the application as originally filed it was absolutely clear that mere ohmic heating and the presence of a catalyst in the classic sense was never intended and indeed never disclosed.

Accordingly, it was requested that the present board set aside the unwarranted demand of the previous board that the applicant amend the description contrary to the agreement reached during the oral proceedings of 6 December 2000.

2.6 It is to be considered in this connection that, in the present case, both the first instance and the present board are furthermore bound by the *ratio decidendi* of second decision T 1032/97 dated 5 September 2001 of the previous board *inter alia* refusing the appellant's request for modification of the reasons for the decision T 1032/97 of 6 December 2000 as inadmissible. The absence of any obvious mistakes in the decision for correction under Rule 89 EPC has, thereby, been finally settled as well. The appellant's renewed request for correction of the reasons of the decision under Rule 89 EPC, accordingly must be refused as inadmissible, the

above second decision being final on this matter and having the force of *res judicata*. It should, furthermore, be noted in this respect that the passage cited by the appellant of G 1/97 makes it clear that a legal error, if any, no matter whether it concerns substantive or procedural aspects, cannot be corrected under Rule 89 EPC.

Incidentally, it is noted that as far as the appellant's contention is concerned that the previous board by its decision of 6 December 2000 breached an agreement reached during the oral proceedings, despite the fact that the appellant may have gained the impression to have convinced at least part of the members of the board to abandon a previously raised objection, this cannot constitute an "agreement" of any binding nature. Decisive is only the decision of the board as a whole reached after due deliberation. The decision as notified leaves no doubt that the description then on file (consisting of pages 1 to 8 and 10 to 16 as originally filed with an amended page 9 filed with letter of 18 August 1995) was still considered to be deficient. Furthermore, clearly, the decision was based on the text submitted by the appellant (Article 113(2) EPC).

2.7 For the reasons given above the main request is not allowable.

3. *First and second auxiliary request*

The amendments to the claims according to both the first and the second auxiliary request re-introduce subject-matter relating to the phenomena described as

"*excess heat*" in the application and attributing a meaning to the term "*catalyst*" at variance with its conventional, generally recognised meaning, and thus re-introduce subject-matter considered speculative and requiring deletion according to the preceding decision T 1032/97 of 6 December 2000. These requests, therefore, are aimed at a revision of the *ratio decidendi* of the decision of the remitting board (see point 2.3, *supra*). Since the present board is bound by this *ratio decidendi*, the facts of the case having remained unchanged, these requests have to be rejected as inadmissible, Article 111(2) EPC.

4. Referral of a question to the Enlarged Board of Appeal

In accordance with Article 111(2) EPC in combination with Article 111(1) EPC, second sentence, a previous decision of a board of appeal in examination proceedings has a binding effect on a later appeal board in case the facts are the same. The EPC does not provide for a revision of the previous decision. This applies to cases in which an error of judgement on the facts of the case is alleged as well as to cases in which a violation of a fundamental procedural principle is alleged, as confirmed by decision G 1/97 of the Enlarged Board of Appeal (see paragraph cited by appellant above).

As far as the applicability of the above legal principles in the particular situation described in the appellant's question is concerned, it is noted that in the board's view no fundamental conflict as implied by the appellant arises as a matter of fact. Where a previous appeal board decision in the examination

proceedings finally states that no new matter would be added by a given amendment, making that amendment cannot, in the same proceedings, be questioned by any organ of the EPO as a violation of Article 123(2) EPC by virtue of the binding effect of the *ratio decidendi* of this decision. Furthermore, such a decision of an appeal board cannot be said to force the applicant/appellant to make an amendment, the decision whether to make an amendment or not still resting, according to Article 113(2) EPC, with the applicant/appellant.

Finally, the fact that the previous board may have stated without basis and incorrectly that no new matter was added, is immaterial at this point as it constitutes *res judicata* not open to revision as already pointed out.

The referral under Article 112 EPC of the question submitted by the appellant to the Enlarged Board of Appeal, therefore, is not considered to be required in the circumstances of the present case. The request for referral is, therefore, rejected.

Order

For these reasons it is decided that:

1. The request for referral to the Enlarged Board of Appeal of the question filed at the oral proceedings is rejected.

2. The appeal is dismissed.

The Registrar: The Chairman:

R. Schumacher B. Schachenmann