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**Datasheet for the decision
of 15 June 2007**

Case Number: T 1640/06 - 3.2.07

Application Number: 02015830.9

Publication Number: 1308423

IPC: C03B 37/012

Language of the proceedings: EN

Title of invention:

A method of producing glass of optical quality

Applicant:

Degussa GmbH

Opponent:

-

Headword:

-

Relevant legal provisions:

EPC Art. 54, 84, 111(1), 113(2), 123(2)

EPC R. 29(2), 86(4)

Keyword:

"Admissibility of amendments (main request not allowable under Rule 29(2) EPC; auxiliary request - yes)"

"Novelty (auxiliary request - yes)"

"Remittal to department of first instance for further prosecution (yes)"

Decisions cited:

-

Catchword:

-



Case Number: T 1640/06 - 3.2.07

D E C I S I O N
of the Technical Board of Appeal 3.2.07
of 15 June 2007

Appellant: Degussa GmbH
Rodenbacher Chaussee 4
D-63457 Hanau (DE)

Representative: -

Decision under appeal: Decision of the Examining Division of the
European Patent Office posted 1 June 2006
refusing European application No. 02015830.9
pursuant to Article 97(1) EPC.

Composition of the Board:

Chairman: H. Meinders
Members: H. Hahn
E. Lachacinski

Summary of Facts and Submissions

- I. The applicant lodged an appeal against the decision of the Examining Division to refuse the European patent application No. 02 015 830.9.

The Examining Division held that claims 1 and 2 as filed with letter of 10 January 2006 lacked novelty over D1 (= EP-A-0 863 108). It further stated that the feature added to the claims concerning the manner in which the starting material could be prepared had not been the object of the European search so that Rule 86(4) EPC was considered to be contravened. The applicant argued in its appeal that the latter ground was communicated to it for the first time only with the decision, i.e. in violation of Article 113(1) EPC.

- II. With a communication dated 23 January 2007 the Board presented its preliminary opinion with respect to the claims 1 and 2 as filed together with the grounds of appeal dated 7 September 2006 and in respect of the procedural violation as alleged by the appellant.

The Board stated that the impugned decision cannot be considered to have been based on a ground on which the applicant did not have the opportunity to present its comments and cannot therefore be seen as flawed by a substantial procedural violation since the part of the decision concerning Rule 86(4) EPC can only be seen as an *obiter dictum*, i.e. not forming part of the decision under appeal, but meant as a voluntary information to the applicant so that it knows what to expect in case it decides to amend the claims in the manner indicated, since at that time the feature in question concerning

the provenance of the starting material was only mentioned in these claims as optional. However, when the applicant subsequently filed, with the grounds of appeal, these claims with the feature now as mandatory feature, the correct procedure for the Examining Division would have been to grant interlocutory revision according to Article 109 EPC as the new claims apparently overcame the objection of lack of novelty raised in the decision, as no prior art was available, for that feature, according to the decision. In not doing so, the Examining Division committed a procedural violation, as the appropriate procedure has not been followed. It would, however, not be equitable to reimburse the appeal fee as the decision itself was not flawed in respect of the assessment of novelty of the subject-matter of the then valid claims.

The Board further stated that claims 1 and 2 appeared to meet the requirements of Rule 86(4) and of Articles 123(2) and 54 EPC but that they did not meet the requirement of Rule 29(2) EPC. Furthermore, claim 1 should be amended to meet the requirements of Article 84 EPC.

Moreover, the appellant was requested to express its opinion on the proposals of the Board and whether its request for oral proceedings was maintained in the light of the suggested further procedure.

III. With letter dated 20 March 2007 the appellant submitted an amended main request and an auxiliary request, both requests comprising claims 1 and 2, in combination with further arguments. The appellant clarified its request in that the decision should be set aside and a patent

should be granted on the basis of the submitted documents. Furthermore, the appellant withdrew its requests for reimbursement of the appeal fee and for oral proceedings.

IV. Claims 1 and 2 according to the main request read as follows (emphasis in bold and comments added by the Board):

"1. A method of producing glass of optical quality by melting or optionally by purifying a presintering composition which is granules of metaloxides or metalloïdioxides, which are prepared by dispersing the metaloxides or metalloïdioxides in water, spray drying it and heating the granules obtained at a temperature of from 150 to 1100°C for a period of 1 to 8 h, in which a plasma or a flame from a heat energy supply means is fed by a first feed duct with **grains of a** [sic] presintering composition, wherein optionally a second feed duct feeds the plasma or flame with a fluorine or chlorine compound mixed with a carrier gas, the feed conditions of the two ducts are adjusted to cause alkali or alkaline-earth elements contained in the presintering composition **grains** [sic] to react with the fluorine or the chlorine of the fluorine or chlorine compound."

"2. A method of depositing a presintering composition which is granules of metaloxides or metalloïdioxides, which are prepared by dispersing the metaloxides or metalloïdioxides in water, spray drying it and heating the granules obtained at a temperature of from 150 to 1100°C for a period of 1 to 8 h, on optical devices, in which a preform extending in a longitudinal direction

is set into **move** [sic] about its axis in front of a plasma or flame coming from a heat energy supply means which moves back and forth substantially parallel to the longitudinal direction of the preform, and in which a first feed duct feeds the plasma or flame with **grains of a** [sic] presintering composition, wherein optionally a second feed duct feeds the plasma or flame with a fluorine or chlorine compound mixed with a carrier gas, the feed conditions of the two ducts being adjusted to cause alkali or alkaline-earth elements contained in the **grains of a** [sic] presintering composition to react with the fluorine or the chlorine of the fluorine or chlorine compound."

V. Claims 1 and 2 according to the auxiliary request differ from those according to the main request in that claim 2 has been made dependent upon claim 1 by inserting the wording "**using the method according to claim 1**" in the sixth line between the terms "on optical devices" and ", in which a preform extending ...".

VI. The appellant argued essentially as follows:

A substantial procedural violation has occurred in that the decision under appeal was based on an objection pursuant to Rule 86(4) EPC, to which the applicant had not been heard before, thus infringing the requirements of Article 113(1) EPC.

As Rule 86(4) EPC only concerns non-unitary applications the Examining Division did not apply its provisions correctly. This is so because firstly the search report is silent with respect to non-unity of the searched application and secondly it is also silent

on the question whether only a part of the application would have been the object of the search. Consequently, the applicant could have confidence that the European search report was drawn up for the entire application. Furthermore, claim 2 is related to an application of the process of claim 1 so that there exists only one unitary inventive idea.

Since the wording of claims 1 and 2 "can be prepared" has now, on appeal, been replaced by "**are** prepared" the optional feature was changed into a compulsory one so that the requirements of Article 123(2) EPC are met.

It is admitted that Rule 29(2)(a) to (c) EPC does not foresee the case of two independent process claims and therefore an auxiliary request has been submitted, in which claim 2 has been made dependent upon claim 1.

The subject-matter of claims 1 and 2 of both requests is novel over the processes of D1 which use only natural or synthetic silica granules (see page 3, lines 19 to 21).

Reasons for the Decision

1. *Admissibility of amendments (Article 123(2), Rule 86(4) and Rule 29(2) EPC)*

Main request

- 1.1 The passage at page 6, lines 10 to 15 of the description as originally filed represents a basis for incorporating the steps of preparing the starting

material - the presintering composition - into the independent claims 1 and 2 of the main request. In said passage of the description these steps are presented as being a preferred, i.e. an optional feature. It is not objectionable under Article 123(2) EPC to change such a preferred and optional feature into a compulsory one in order to more precisely define how the starting material is obtained. Consequently, the incorporation of this feature into the subject-matter of claims 1 and 2 as originally filed is considered to meet the requirements of Article 123(2) EPC.

- 1.2 With respect to the objection under Rule 86(4) EPC raised by the Examining Division as an *obiter dictum* in the decision the Board concludes that the European search report is silent with respect to non-unity. The search report cites two "X"-documents for both claims; it does not state that only part of the subject-matter of the application has been searched.

On the basis of the above, the Board can only conclude that the subject-matter of claims 1 and 2 has been searched, not, however, which subject-matter has **not** been searched, as done by the Examining Division. Even if the Search examiner would have been the examiner entrusted with the substantive examination of the case (which does not apply here) and thus the Examining Division would have had first-hand knowledge of what has and what has not been searched, or if the Search examiner has informed the Examining Division via internal means of the manner in which he has performed the search, the official file simply does not contain verifiable information in this respect.

Recourse must therefore be had to the Guidelines for Examination, Part C-VI, 5.2(ii), to establish the spectrum of possibilities within which the Examining Division is expected to operate when confronted with amendments based on subject-matter taken exclusively from the description, even **when** assuming that such subject-matter has not been searched.

On one end of the spectrum one finds subject-matter taken from the description and being made solely the subject-matter of an independent claim. In such a case the examiner should formulate an objection under Rule 86(4) EPC.

On the other end of the spectrum is the situation where a feature originally disclosed is added to an originally filed claim in order to meet an objection, e.g. lack of novelty, raised by the substantive examiner. In such a case no objection under Rule 86(4) EPC should be raised.

It is exactly the latter situation which applies in the present case:

The existing feature of the presintering composition, present in the originally filed and searched method claim is further restricted by incorporating in that method claim, the further limiting steps of the process with which the presintering composition is prepared.

The Examining Division, in its communication of 11 July 2005, indicated that claims 1 and 2 lacked novelty in respect of EP-A-0 863 108, precisely because the nature

of the presintering composition was not further defined in claims 1 and 2.

The Examining Division, in raising an objection under Rule 86(4) EPC in the impugned decision thus appears to have erred in how this requirement should be applied. In fact, it should have granted interlocutory revision as the objection on which the impugned decision was based (lack of novelty) had clearly been overcome in the manner suggested in that decision (see section II above) and should have requested an additional search as mentioned in the Guidelines for Examination, C-VI, 5.2(ii).

In view of the above, it is not necessary to examine whether the subject-matter of the claims as amended is non-unitary with that of the claims as originally filed (the further requirement to be fulfilled for application of Rule 86(4) EPC).

In exercising the Examining Division's competence pursuant to Article 111(1) EPC the Board considers that the requirements of Rule 86(4) EPC are met by present claims 1 and 2.

- 1.3 However, the two independent method claims 1 and 2 according to the main request are considered not to meet the requirements of Rule 29(2) EPC since they do not fall under one of the three alternative conditions specified in points (a) to (c) of Rule 29(2) EPC which entered into force on 2 January 2002 and is applicable to all applications for which the communication under Rule 51(4) EPC was not issued by that date, as is the case here.

Consequently, the main request is not admissible.

Auxiliary request

1.4 Claims 1 and 2 of the auxiliary request differ from those of the main request only in that claim 2 has been made dependent upon claim 1 by inserting the wording "**using the method according to claim 1**" in the sixth line between the terms "on optical devices" and ", in which a preform extending ...". Consequently, the conclusion of paragraph 1.1 above applies *mutatis mutandis* to claims 1 and 2 of the auxiliary request. Hence claims 1 and 2 of the auxiliary request meet the requirements of Article 123(2) EPC.

1.5 By making claim 2 dependent upon claim 1 the objection under Rule 29(2) EPC made in point 1.3 above against claims 1 and 2 of the main request is overcome.

Claims 1 and 2 of the auxiliary request are therefore considered to meet the requirements of Rule 29(2) EPC.

2. *Novelty (Article 54 EPC)*

2.1 D1 discloses a method for purifying natural or synthetic silica and its application for depositing the purified silica on a preform of an optical fibre. The method includes the use of a plasma torch apparatus 3 which includes a first feed duct 9 for feeding the plasma with granules of synthetic or natural silica 11 and a second feed duct 13 for feeding the plasma with a fluorine or chlorine compound in a carrier gas 15. The sodium or lithium contents (alkaline or alkaline-earth

contents) comprised in said silica granules react with the fluorine or chlorine in said plasma at 5000-10000°C whereby the optical quality of the subsequently deposited silica is improved by forming the fluorides NaF or LiF or the chlorides NaCl or LiCl which are given off in gaseous form so that the alkali or alkaline-earth content is reduced to a very low level (see abstract; page 2, lines 31 to 56; page 3, lines 6 to 33). The operating conditions of the plasma torch (power, flow rate of granules, carrier gas flow rate, and fluorine compound content in % carrier gas) according to D1 (see page 3 lines 34 to 42) are the same as in the present application (see page 6, lines 1 to 8 of the application as originally filed) and also figure 1 seems to be identical in both.

However, D1 is silent as to how the natural or synthetic silica starting material is made and it does likewise not mention further materials such as doped silica, aluminium oxide or titanium oxide. Consequently, there is no disclosure in D1 that the starting material "is granules of metaloxides or metalloïdioxides, which **are** prepared by dispersing the metaloxides or metalloïdioxides in water, spray drying it and heating the granules obtained at a temperature of from 150 to 1100°C for a period of 1 to 8 h" as required by claim 1 of the auxiliary request.

- 2.2 Claim 1 of the auxiliary request therefore meets the requirement of Article 54 EPC.

3. *Remittal to the first instance (Article 111(1)EPC)*

The impugned decision is silent with respect to the issue of inventive step.

Furthermore, since the Examining Division has not carried out an additional search as foreseen in the Guidelines for Examination, C-VI, points 5.2(ii) and 8.5, and since the claims are restricted to presintering compositions which are first obtained by a specific process sequence, a fresh case has been created so that it is not appropriate for the Board to further deal with it.

It further appears that clarification of the claims (Article 84 EPC) is necessary, as regards the feature of the grains (which should be "granules" so as to refer to the presintering composition used) and the phrase "a presintering composition" which should be "said presintering composition" (compare point IV above).

Therefore the Board considers it appropriate, in accordance with Article 111(1) EPC, to remit the case to the department of first instance for further prosecution. Thereby the appellant also has the opportunity to have the case examined with respect to inventive step without loss of an instance.

Order

For these reasons it is decided that:

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

The Registrar:

The Chairman:

G. Nachtigall

H. Meinders