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**Datasheet for the decision
of 10 November 2011**

Case Number: T 0425/08 - 3.3.10

Application Number: 01932125.6

Publication Number: 1293216

IPC: A61L 9/22, F24F 7/00,
F24F 3/16, H01T 23/00

Language of the proceedings: EN

Title of invention:
Sterilization Method

Applicant:
Sharp Kabushiki Kaisha

Headword:
-

Relevant legal provisions:
EPC Art. 111(1)

Keyword:
"Main request: remittal to first instance - fresh case"

Decisions cited:
G 0010/93, T 0063/86, T 0047/90

Catchword:
-



Case Number: T 0425/08 - 3.3.10

D E C I S I O N
of the Technical Board of Appeal 3.3.10
of 10 November 2011

Appellant: Sharp Kabushiki Kaisha
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Abeno-ku
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Osaka-fu 545-0013 (JP)

Representative: Jones, Nicolas Guy
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Decision under appeal: Decision of the Examining Division of the
European Patent Office posted 14 September 2007
refusing European patent application
No. 01932125.6 pursuant to Article 97(1) EPC
1973.

Composition of the Board:

Chairman: P. Gryczka
Members: C. Komenda
D. S. Rogers

Summary of Facts and Submissions

- I. The Appellant (Applicant) lodged an appeal against the decision of the Examining Division rejecting the European patent application No. 01932125.6.
- II. The decision under appeal found that the subject-matter of the method claims 1 of the then pending main, first and second auxiliary requests was not novel. The subject-matter of the method claims 1 according to the then pending third, fourth and fifth auxiliary requests also did not involve an inventive step. As a further remark not forming part of the decision it was indicated that the subject-matter of the further independent claims, which were directed to an ion generating device, were not necessarily novel and inventive, if they merely refer back to the independent method claims 1.
- III. At the oral proceedings held on 10 November 2011 before the Board the Appellant filed *inter alia*, a main request, which was the same main request as filed with a letter dated 7 October 2011. Claim 1 thereof reads as follows:
- "1. An ion generating device configured to kill airborne germs, said device comprising an AC source, a pair of electrodes and a dielectric positioned between said electrodes, said device configured to operate within the ranges of 1.1 to 3.0 kV rms and 60 Hz to 30 kHz to generate $O_2^-(H_2O)_n$ (n being a natural number) as negative ions in the form hydrated with water vapour molecules present in the atmosphere and $H^+(H_2O)_m$ (m being a natural number) as positive ions in the form

hydrated with water vapour molecules present in the atmosphere, said device further comprising means to discharge the ions into the air to kill said germs through an oxidation reaction by hydrogen peroxide (H_2O_2) or radical OH generated as an active species through chemical reaction between the negative and positive ions."

- IV. With its statement of the Grounds for appeal the Appellant argued that in a divisional application of the application in suit a patent was granted based on two method claims. Consequently, claims directed to a device for carrying out such a novel and inventive method would in any case be patentable.

- V. The Appellant requested that the decision under appeal be set aside and that a patent be granted on the basis of claims 1 to 5 according to the Main Request; or on the basis of one of the Auxiliary Requests 1 to 3, all the above being submitted at the oral proceedings held on 10 November 2011 before the Board.

- VI. At the end of the oral proceedings the decision of the Board was announced.

Reasons for the Decision

- 1. The appeal is admissible.

2. Scope of examination on appeal

Proceedings before the Boards of Appeal in ex-parte cases are primarily concerned with examining the contested decision (see decision G 10/93, OJ EPO 1995, 172, points 4 and 5 of the reasons), other issues not dealt with in the decision normally being left to the Examining Division to consider after a referral back, so that the Appellant has the opportunity for these to be considered without loss of an instance (Article 111(1) EPC second sentence).

Main request

3. The decision under appeal dealt with a then pending main request and five auxiliary requests. The decision on these requests was based exclusively on the independent claims 1, which were all directed to sterilization methods, which according to the decision under appeal were neither considered to be novel nor to involve an inventive step (see paragraph II *supra*). As an additional remark, which did not form part of the decision under appeal, the Examining Division stated that those independent claims, which were directed to ion generating devices characterized merely by reference to the independent method claim 1, would also not be patentable.

3.1 Before the Board for the first time a main request was presented, which contained substantial amendments, since the claims were exclusively directed to devices such as ion generating devices and air conditioning devices, all method claims having been deleted. In addition, these "device" claims were no longer

characterized by mere reference to the method claims, but defined the devices by a specific combination of technical features corresponding to the various structural components of the claimed devices. Therefore, the remark in the decision under appeal concerning the non-patentability of the then pending device claims no longer applies to the device claims submitted with the present main request. Further, as the decision under appeal dealt only with method claims, the Board concludes that by filing a main request, which no longer contains any method claims, the grounds for refusing the application were overcome, with the consequence that the appeal is well founded.

4. *Remittal*

Having so decided, the Board has not taken a decision on the substantive issues raised by the main request since the decision under appeal was solely based on claims of a different category. Thus, the claims according to the main request give rise to fresh issues not yet addressed in examination proceedings constituting a "fresh case" (see e.g. decisions T 63/86, OJ EPO 1988, 224; T 47/90, OJ EPO, 1991, 486). As the Examining Division has not yet ruled on the requirements for patentability of claims directed exclusively to devices such as ion generating devices and air conditioning devices, the Board considers it appropriate to exercise the power conferred on it by Article 111(1) EPC to remit the case to the Examining Division for further prosecution on the basis of claims 1 to 5 according to the Main Request filed during Oral proceedings held on 10 November 2011 before

the Board, in order to enable the first instance to decide on the outstanding issues.

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 upon the basis of claims 1 to 5 of the Main Request submitted at the oral proceedings before the Board.

The Registrar

The Chairman

C. Rodríguez Rodríguez

P. Gryczka