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**Datasheet for the decision
of 24 April 2014**

Case Number: T 1765/13 - 3.3.05
Application Number: 11175939.5
Publication Number: 2398097
IPC: H01M4/58, C01G45/00, C01G49/00,
C01G51/00, C01G53/00
Language of the proceedings: EN

Title of invention:

Lithium secondary battery with high power

Applicant:

LG Chem, Ltd.

Headword:

Lithium battery use/LG CHEM LTD

Relevant legal provisions:

EPC Art. 76(1), 122(2), 109, 111(1)
EPC R. 103
RPBA Art. 11
Guidelines for examination C-IX 1.6, G-IV 5.4

Keyword:

Divisional application - double patenting (not allowed) (see Reasons 2.)
Interlocutory revision - department of first instance should have rectified decision (yes)
Substantial procedural violation (yes) - reimbursement of the appeal fee (no)
Remittal to the department of first instance (yes) - fundamental deficiency in first instance proceedings (yes)

Decisions cited:

G 0001/05, G 0001/06, T 0647/93, T 0794/95

Catchword:



**Beschwerdekammern
Boards of Appeal
Chambres de recours**

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Case Number: T 1765/13 - 3.3.05

D E C I S I O N
of Technical Board of Appeal 3.3.05
of 24 April 2014

Appellant: LG Chem, Ltd.
(Applicant) 20, Yoido-dong
Youngdungpo-gu, Seoul 150-721 (KR)

Representative: HOFFMANN EITLE
Patent- und Rechtsanwälte
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81925 München (DE)

Decision under appeal: **Decision of the Examining Division of the European Patent Office posted on 2 May 2013 refusing European patent application No. 11175939.5 pursuant to Article 97(2) EPC.**

Composition of the Board:

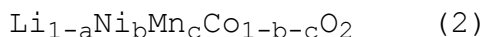
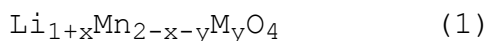
Chairman: G. Raths
Members: H. Engl
P. Guntz

Summary of Facts and Submissions

I. European patent application EP 11175939.5 is a divisional application of EP 05789669.8, published as EP-A-1 730 830 (the "parent application"), now granted as EP-B-1 730 802 (the "parent patent"). A further divisional application EP 11175941.1 is pending (see T 1766/13 of 17 April 2014). All applications were filed in the name of LG Chem, Ltd., KR. They claim the same priority date of 29 March 2004 and designate the same contracting states DE, FR and GB.

II. Granted claim 1 of the parent patent EP-B-1 730 802 reads as follows:

"1. A cathode active material for a secondary battery, comprising a lithium manganese-metal composite oxide (A) having a spinel structure and represented by the following general formula 1, and a lithium nickel-manganese-cobalt composite oxide (B) having a layered structure and represented by the following general formula 2:



wherein,

$$0 < x < 0.2;$$

$$0 < y < 0.1;$$

M is at least one element selected from the group consisting of Al, Mg, Ni, Co, Fe, Ti, V, Zr and Zn;

$$-0.1 \leq a \leq 0.1;$$

$$0.3 < b < 0.5; \text{ and}$$

$$0.3 < c < 0.5,$$

wherein the content of the lithium manganese-metal composite oxide (A) is greater than 50%, based on the total weight of the mixture."

EP-B-1 730 802 also contains an independent claim 5 relating to a lithium secondary battery comprising a cathode according to claim 1.

EP-B-1 730 802 has no process or use claims.

III. The present divisional application EP 11175939.5 was refused by the examining division on the ground that the parent and the divisional application may not claim the same subject-matter (no "double patenting"). In the decision to refuse, the examining division relied in particular on G 1/05 and G 1/06 and the Guidelines C-IX, 1.6, and G-IV, 5.4.

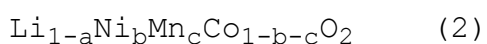
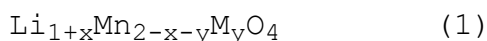
IV. The instant appeal, which lies from this decision, was filed with letter dated 2 July 2013. With the statement of grounds of appeal, dated 16 July 2013, the applicant (appellant) also filed a fresh set of claims 1 to 4, replacement pages 1, 3 to 5, 7 to 9, 15, 17, 20, 21 and 26 of the description, and the document:

Ingwer Koch, *"The same invention or not the same invention"*, Presentation held at the FICPI 12th Open Forum, Munich, 8 to 10 September 2010, pages 1 to 25.

V. The new claims 1 to 4 (dated 16 July 2013) of divisional application EP 11175939.5 read:

"1. Use of a lithium secondary battery as a high power, large capacity battery in an electric vehicle or a hybrid electric vehicle, wherein the lithium

secondary battery comprises a cathode which comprises a cathode active material which comprises a lithium manganese-metal composite oxide (A) having a spinel structure and represented by the following general formula 1, and a lithium nickel-manganese-cobalt composite oxide (B) having a layered structure and represented by the following general formula 2:



wherein,

$$0 < x < 0.2;$$

$$0 < y < 0.1;$$

M is at least one element selected from the group consisting of Al, Mg, Ni, Co, Fe, Ti, V, Zr and Zn;

$$-0.1 \leq a \leq 0.1;$$

$$0.3 < b < 0.5; \text{ and}$$

$$0.3 < c < 0.5,$$

wherein the content of the lithium manganese-metal composite oxide (A) is greater than 50%, based on the total weight of the mixture."

"2. Use according to Claim 1, wherein the content of the lithium manganese-metal composite oxide (A) is in the range of 80 to 95%, based on the total weight of the mixture."

"3. Use according to Claim 1, wherein the pH of the active material is in the range of 8.9 to 10.4."

"4. Use according to Claim 1, wherein the metal (M) is selected from the group consisting of Mg, Al, Co and Ni."

VI. The appellant essentially argued as follows:

The decision of refusal was exclusively based on the ground of double patenting having regard to granted claims 1 and 5 of the parent patent EP-B-1 730 802. Said granted claims were respectively directed to a cathode active material for a secondary battery and a lithium secondary battery comprising such a cathode active material.

In contrast, all claims now pending were directed to the use of a battery comprising the inventive cathode. Thus the present claims were directed to a different object, namely the use of a lithium secondary battery as a high-power, large-capacity battery in an electric vehicle or a hybrid electric vehicle, as compared to the claims of the granted parent patent. The appellant submitted that the present claims could not reasonably give rise to an objection of double patenting because they related to an aspect, namely the use for a specific purpose, fundamentally different from the objects (i.e. a cathode active material per se and a lithium secondary battery per se) of the previously granted claims. There was a self-evident difference between on the one hand a use of a battery and on the other hand a cathode active material for a secondary battery and a lithium secondary battery per se.

The appellant argued that the test for double patenting was not whether the disclosed subject-matters in the parent and divisional applications were the same, but whether the claims of the two cases were "for the same subject-matter".

These arguments were consistent with the case law of G 1/05 and G 1/06.

VII. Requests:

The appellant requested that the decision under appeal be set aside and that a patent be granted on the basis of claims 1 to 4, amended description pages 1, 3 to 5, 7 to 9, 15, 17, 20, 21 and 26, all filed with letter dated 16 July 2013, and drawing pages 1/3 to 3/3 as originally filed.

Reasons for the Decision

1. Amendments

1.1 Parent application EP 05789669.8, published as EP-A-1 730 830, and divisional application EP 11175939.5 have the same description.

1.2 Present new claim 1 is based on a combination of claims 1 and 15 and on the description, page 2, lines 18 to 20, and page 3, lines 15 to 18, of the parent and divisional applications as originally filed. The latter passages disclose the use of the claimed lithium battery as a high-power, large-capacity power source for electric vehicles (EVs) and hybrid electric vehicles (HEVs).

The claim feature according to which *"the content of lithium manganese-metal composite oxide (A) is greater than 50%, based on the total weight of the mixture,"* is based on page 28, lines 19 to 22, of the parent application and on page 12, lines 15 and 16, of the divisional application as filed.

Claims 2 to 4 are based on the disclosure of page 29,

lines 1 to 11, of the parent application and on page 12, lines 18 to 24, of the divisional application.

The requirements of Articles 76(1) and 123(2) EPC are thus met.

2. Double patenting

2.1 The decision of refusal was based solely on the ground that an unallowable "double patenting" existed having regard to claims 1 and 5 of the granted parent patent EP-B-1 730 802. Said claims were directed to a cathode active material for a secondary battery and a lithium secondary battery comprising such a cathode active material, respectively (see point II of this decision).

2.2 In contrast, new claim 1 and dependent claims 2 to 4 are use claims. Thus present claim 1 is directed to the use of a lithium secondary battery, comprising the specific cathode of the invention, as a high-power, large-capacity power source in an electric or hybrid vehicle, whereas the granted claims of the parent application relate to products, namely a cathode active material and a lithium secondary battery. Thus the use claims of the present divisional application relate to a subject-matter different from the subject-matters of the granted claims of EP-B-1 730 802.

The present use claims are also distinct from the claims directed to a method for fabricating a lithium manganese-metal composite cathode, claimed in co-pending application EP 11 175 941.1 and found allowable in appeal case T 1766/13 (of 17 April 2014).

- 2.3 The Enlarged Board of Appeal observed in G 1/05 (OJ EPO 2008, 271, Reasons 13.4) and G 1/06 (OJ EPO 2008, 307):
"The principle of prohibition of double patenting exists on the basis that an Applicant has no legitimate interest in proceedings leading to the grant of a second patent for the same subject-matter if he already possesses one granted patent therefor. Therefore, the Enlarged Board finds nothing objectionable in the established practice of the EPO that amendments to a divisional application are objected to and refused when the amended divisional application claims the same subject-matter as a pending parent application or a granted parent patent".

Evidently, with respect to the present case, a product and its use are not "the same subject-matter" in the sense of G 1/05 and G 1/06. The same is true for the use of a product and a method of fabricating it.

- 2.4 This is consistent with the Guidelines, C-IX 1.6, instructing as follows: *"The parent and divisional applications may not claim the same subject-matter (see G-IV, 5.4). ... The difference between the claimed subject-matter of the two applications must be clearly distinguishable."*

According to the Guidelines G-IV, 5.4, *"it is permissible to allow an applicant to proceed with two applications having the same description where the claims are quite distinct in scope and directed to different inventions."*

Both criteria are clearly fulfilled in the present case.

2.5 Therefore, applying the case law of the Enlarged Board of Appeal, the objection of double patenting cannot be upheld against the claims as amended. The decision under appeal therefore has to be set aside.

3. Interlocutory revision

3.1 Article 109(1) EPC stipulates that if a department whose decision is contested considers the appeal to be admissible and well-founded, it is to rectify its decision, provided that the appellant is not opposed by another party to the proceedings.

Article 109(2) EPC stipulates that if the appeal is not allowed within three months of receipt of the statement of grounds, it is to be remitted to the board of appeal without delay, and without comments as to its merits.

3.2 In view of the provision of Article 109(2) EPC, the examining division is prevented from commenting as to why it did not consider the appeal well-founded and rectify its decision. It is therefore not for the board to speculate. However, as the appellant explicitly drew attention to the possibility of granting interlocutory revision in view of the amended claims (see grounds of appeal, page 3), the examining division's failure to rectify constitutes a substantial procedural violation (see T 647/93; OJ EPO 1995, 132).

3.3 According to Rule 103(1) EPC, the appeal fee is to be reimbursed in full in the event of interlocutory revision or where the board of appeal deems an appeal to be allowable, if such reimbursement is equitable by reason of a substantial procedural violation.

While pointing to the substantial procedural violation

(see point 3.2), in the present case the board does not consider it equitable to reimburse the appeal fee, since neither the examination procedure leading to the contested decision nor the decision itself were tainted with procedural shortcomings. The necessity for the appellant to file an appeal arose from the decision of the examining division itself (refusal due to double patenting), not from the later incorrect handling by the examining division, i.e. not from the denial of interlocutory revision (see T 794/95 of 7 July 1997, Reasons, point 5).

4. Remittal

According to Article 11 RPBA, a board is to remit a case to the department of first instance if fundamental deficiencies are apparent in the first-instance proceedings, unless special reasons present themselves for doing otherwise.

In the present case, the occurrence of a substantial procedural violation was noted. Reasons not to remit are not apparent to the board.

As the claims have been substantially amended to the extent of creating a fresh case, which is a further argument for a remittal, and in order not to deprive the appellant of the possibility to have its case decided by two instances, the board exercises its power under Article 111(1) EPC to remit the case to the examining division for further prosecution.

5. Oral proceedings

The appellant requested oral proceedings should the application be refused. As the application is not

refused, the instant decision to remit may thus be taken without an oral hearing.

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:



C. Vodz

G. Rath

Decision electronically authenticated