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**Datasheet for the decision  
of 22 February 2019**

**Case Number:** T 1252/16 - 3.3.05

**Application Number:** 10013131.7

**Publication Number:** 2284133

**IPC:** C03C10/04, A61K6/06

**Language of the proceedings:** EN

**Title of invention:**

Lithium silicate materials

**Applicant:**

Ivoclar Vivadent AG

**Headword:**

Lithium silicate/IVOCLAR

**Relevant legal provisions:**

EPC Art. 52(2)(d), 84, 111(1), 123(2)

Guidelines for examination Part G - Chapter IV, 5.4

**Keyword:**

Amendments - allowable (yes)

Claims - clarity (yes)

Double patenting - same subject-matter (no)

Remittal to the department of first instance - (yes)

**Decisions cited:**

T 0553/02, T 0307/03, T 0307/06, T 2461/10, T 0318/14

**Catchword:**



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Case Number: T 1252/16 - 3.3.05

**D E C I S I O N**  
**of Technical Board of Appeal 3.3.05**  
**of 22 February 2019**

**Appellant:** Ivoclar Vivadent AG  
(Applicant) Bendererstrasse 2  
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**Representative:** Uexküll & Stolberg  
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**Decision under appeal:** **Decision of the Examining Division of the  
European Patent Office posted on 3 November 2015  
refusing European patent application No.  
10013131.7 pursuant to Article 97(2) EPC.**

**Composition of the Board:**

**Chairman** E. Bendl  
**Members:** A. Haderlein  
P. Guntz

## Summary of Facts and Submissions

- I. The applicant (appellant) has filed an appeal against the examining division's decision to refuse the patent application. The present application is a divisional application derived from an earlier application No. 04 018 339 (parent application). When the decision under appeal was taken, an intention to grant based on application No. 10 013 142 had been issued. The latter is also a divisional application derived from the above parent application and will be referred to herein after as the "second divisional application".
- II. In the decision under appeal, the examining division held that none of the requests complied with the prohibition of double patenting in view of the patent granted based on the parent application and the intention for grant issued in the proceedings of the second divisional application. The claims of the requests underlying the impugned decision related to subject-matter overlapping the subject-matter of the granted claims of the patent based on the parent application and those intended for grant in the proceedings of the second divisional application. Moreover, it was decided, *inter alia*, that the main request did not comply with the requirement of clarity because dependent claim 14 contained the expression "about".
- III. In the opposition proceedings for the patent based on the aforementioned second divisional application No. 10 013 142, the following document was cited:
- D8: Borom, M.P., et al., Strength and Microstructure in Lithium Disilicate Glass-Ceramics, J. American Ceramic Soc., Vol. 58, No. 9-10, pp. 385 to 391,

referred to as D4 in the above opposition proceedings.

- IV. With its statement of grounds of appeal, the appellant filed a main request and an auxiliary request.
- V. Third-party observations were received. The objections raised therein against the appellant's main request, as far as considered relevant, may be summarised as follows:

In addition to objections with regard to double patenting, the expression "main crystalline phase" in claims 1 and 10 was not clear. Moreover, claims 1 and 10 did not define a measuring method for determining this feature. Claims 7 and 8 infringed the provisions of Article 52(2) (d) EPC, and claim 9 did not comply with the requirement of clarity because it did not define the measuring method for determining the biaxial strength.

- VI. The wording of independent claims 1 and 10 of the main request reads as follows:

"1. Use of a lithium silicate blank with lithium metasilicate as the main crystalline phase for the manufacture of a dental restoration.

10. Process for preparing a dental restoration, which process comprises shaping a lithium silicate blank with lithium metasilicate as the main crystalline phase to a desired geometry by machining or by hot pressing to form a shaped lithium silicate product."

Claims 2 to 6 refer directly or indirectly back to claim 1 and dependent claims 7 and 8 read as follows:

"7. The use according to any one of claims 2 to 6, wherein the blank is labelled with information.

8. The use according to claim 7, wherein the information on the blank comprises the material, the size and the type of the shape, which is to be machined from the blank."

Claims 9 and 11 to 14 refer to preferred embodiments of the two independent claims.

VII. The appellant's arguments, as far as relevant for the present decision, may be summarised as follows:

The claims of the main request complied with Article 123(2) EPC. The requirement of clarity of the claims was also met because the expression "main crystalline phase" was clear, and the expression "about" objected to in the decision under appeal was deleted from the claims. The claims also did not infringe the prohibition of double patenting.

VIII. The appellant requested that the decision under appeal be set aside and that a patent be granted based on the main request or auxiliary request filed with the grounds of appeal.

### **Reasons for the Decision**

1. Main request - amendments

The claims of the main request correspond to the claims as originally filed wherein originally filed claim 10 and the term "about" in renumbered claim 13 have been deleted. The requirements of Article 123(2) EPC are

thus complied with.

2. Main request - clarity

2.1 The expression "main crystalline phase" is not objected to in the decision under appeal. It is the third party that raised an objection for lack of clarity of this expression.

2.2 This expression is not objectionable under Article 84 EPC for the following reasons.

2.2.1 Firstly, this expression would have been sufficiently clear to the skilled person because in the prior art this expression had been used many years before the effective date of the application and is referred to in it as the "main" or "predominant" or "principal" crystalline phase quantitatively determined using X-ray diffraction (XRD) (see D8, page 386, left-hand column, first full paragraph, and page 387, section "Results and Discussion", paragraphs (1)(A) and (1)(B)). Likewise, whether a crystalline phase is such a "main phase" is determined in the present application by XRD (see for instance page 32, lines 29 to 31, and Fig. 4 as originally filed) and is also referred to in the application as the "predominant" crystalline phase (page 11, lines 8 and 9).

2.2.2 Secondly, there is no evidence on file that would suggest that not only different methods for determining whether a crystalline phase is the main crystalline phase would have been considered by the skilled person but that such methods would also have led to substantially different results, i.e. it would have depended on the measuring method whether a specific lithium silicate blank fell within the claimed scope.

Moreover, according to the case law of the boards of appeal, the necessity to include the measuring method into the independent claim arises, if at all, in the case of parameters (see the Case Law of the Boards of Appeal, 8th ed., II.A.3.5). Within the meaning of this case law, parameters relate to numerical values which are to be measured. However, in the case at hand, the feature "main crystalline phase" does not constitute such a parameter expressed as a numerical value because the claims do not refer to (ranges of) numerical values in the context of this feature.

2.3 The third party also raises an objection for lack of clarity with respect to the biaxial strength feature in claim 9. However, this objection is not supported by any evidence. In particular, there is nothing on file that would suggest that the skilled person would have considered methods other than the one disclosed in the application, i.e. ISO 6872 referred to on page 36, lines 20 to 27, and also that these other methods would not have yielded essentially the same values (cf. T 307/06, Reasons 3 to 3.3)

2.4 In claim 13 (corresponding to claim 14 of the main request underlying the impugned decision), the expression "about" objected to in the impugned decision has been deleted.

2.5 For these reasons, the requirement of clarity set forth in Article 84 EPC is complied with.

3. Main request - Article 52(2)(d) EPC

The third party objects to claims 7 and 8 for being merely directed to the presentation of information. This objection is obviously unfounded since both claims



are directed to the use of a lithium silicate blank, i.e. a physical object of a technical nature. The fact that the lithium silicate blank is labelled with information does not render it an invention which would be excluded from patentability pursuant to Article 52(2)(d) EPC (cf. T 553/02, Reasons 1.2.3).

4. Main request - double patenting

4.1 The examining division refused all requests underlying the impugned decision for lack of compliance with the prohibition of double patenting. The claims of the requests underlying the impugned decision related to subject-matter overlapping the subject-matter of the granted claims of the patent based on the parent application and those intended for grant in the proceedings relating to the second divisional application.

4.2 Decision T 307/03 is referred to in the decision under appeal. To the knowledge of the board, this is the only decision finding that the principle of prohibition of double patenting extends also to situations where the subject-matter of the granted claim is encompassed by the subject-matter of the claim later put forward and, thus, extends beyond situations of potentially conflicting claims relating to the same subject-matter (see Reasons 5.3; see also T 2461/10, Reasons 24). Contrary to the view adopted in T 307/03 (*supra*), according to established case law, any prohibition of double patenting only applies to the "same subject-matter" subject-matter and does not extend to claims not defining the same subject-matter but that confer a scope of protection overlapping each other only partially (see T 2461/10, *supra*, Reasons 21 to 25).

The board does not see any reason to depart from this established case law.

This established case law is reflected in the Guidelines for Examination at the EPO (see the November 2014 edition, Part G - Chapter IV, 5.4, in force at the time of the decision under appeal). As a rule, parties may expect the examiners to act in accordance with those Guidelines (*supra*, General Part, page 5, first paragraph).

- 4.3 In the case at hand, the claims of the present main request relate to the use of a lithium silicate blank and to a process for preparing a dental restoration comprising the shaping of a lithium silicate blank with lithium metasilicate as the main crystalline phase. In contrast, the claims of the patent based on the parent application are directed to a process for preparing a dental restoration comprising specific steps (a) to (d) and to the use of a lithium silicate glass ceramic blank having certain components in a certain wt.% range. None of the claims of the present main request contain the same features as those of the granted patent based on the parent application. Thus, the claims of the main request do not relate to the same subject-matter as those of the patent based on the parent application. Likewise, the claims of the present main request do not relate to the same subject-matter of the claims of the patent granted based on the second divisional application which are directed to a process for preparing a dental restoration comprising specific steps (a) to (d) and to the use of a lithium silicate blank prepared in accordance with these steps.

Thus, the claims of the present main request do not relate to the same subject-matter of either the granted

claims of the patent based on the parent application or the granted claims of the patent based on the second divisional application.

4.4 In conclusion, the claims of the main request are not objectionable under the principle of prohibition of double patenting, at least for the above reasons.

4.5 The board is aware that in recent case T 318/14 Board 3.3.01 decided to refer questions on the prohibition of double patenting to the Enlarge Board of Appeal (see the minutes of the oral proceedings of 7 February 2019). These questions, however, relate to potentially conflicting claims relating to the same subject-matter. As set out above, in the present case, the potentially conflicting claims do not relate to the same subject-matter. Thus, the outcome of the aforementioned referral has no bearing on the present case.

## 5. Remittal

The decision under appeal was based on objections for infringement of the prohibition of double patenting and for lack of clarity only. It deals neither with the requirement of novelty or inventive step. The board thus remits the case to the examining division for further prosecution (Article 111(1) EPC).

## Order

### For these reasons it is decided that:

1. The decision under appeal is set aside.
2. The case is remitted to the examining division for further prosecution based on the main request filed with the grounds of appeal.

The Registrar:

The Chairman:



A. Pinna

E. Bendl

Decision electronically authenticated