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**Datasheet for the decision
of 28 June 2019**

Case Number: T 1946/16 - 3.3.05

Application Number: 08782231.8

Publication Number: 2173684

IPC: C04B35/488, C04B35/624,
C04B35/632, C09K3/14,
C04B35/626

Language of the proceedings: EN

Title of invention:

GRINDING BEADS AND METHOD OF PRODUCING THE SAME

Patent Proprietor:

ZIRCOA INC.

Opponent:

SAINT-GOBAIN CENTRE DE RECHERCHES ET
D'ETUDES EUROPEEN

Headword:

Grinding beads/Zircoa

Relevant legal provisions:

EPC Art. 123(2), 123(3)
EPC R. 139

Keyword:

Correction of error - (no)

Amendments - broadening of claim (yes)

Decisions cited:

G 0003/89, G 0011/91, G 0001/93, G 0001/10, T 0371/88,
T 0108/91, T 0031/93, T 0190/99, T 0314/03, T 0369/03,
T 2230/08, T 0195/09, T 1702/12, T 1993/12

Catchword:



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Case Number: T 1946/16 - 3.3.05

D E C I S I O N
of Technical Board of Appeal 3.3.05
of 28 June 2019

Appellant: ZIRCOA INC.
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Respondent: SAINT-GOBAIN CENTRE DE RECHERCHES ET
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Decision under appeal: **Decision of the Opposition Division of the
European Patent Office posted on 24 June 2016
revoking European patent No. 2173684 pursuant to
Article 101(3) (b) EPC.**

Composition of the Board:

Chairman E. Bendl
Members: T. Burkhardt
O. Loizou

Summary of Facts and Submissions

- I. The appeal of the patent proprietor (appellant) lies from the opposition division's decision to revoke the European patent EP 2 173 684 B.
- II. In the appealed decision the opposition division held, *inter alia*, inadmissible a request for correction under Rule 139 EPC of claim 1 of the granted patent and the correspondingly corrected text of claim 1 of the main request, as submitted on 15 May 2014, to infringe the requirements of Article 123(3) EPC.
- III. In this decision, the following document was among those discussed:

A2 Declaration by Emmanuel Nonnet, dated 27 January 2014

- IV. Claim 1 of the main request reads as follows (the additions in comparison to claim 1 as granted are indicated in bold and underlined and the deletions in bold and strikethrough):

"1. A method of forming alumina-zirconia beads, comprising the steps of:
(a) forming a slip comprised of 50% to 70% by weight water and 30% to 50% by weight of a mixture of metal oxides, said mixture comprised of:
20% to 40% by weight of alumina (Al₂O₃),
9% to 12% by weight ceria, and
51 % to 68% of monoclinic zirconia;
(b) milling said slip;
(c) adding manganese oxide (MnO) to said slip in a concentration of 0.1% to 1% by weight, based upon the final weight of said mixture of metal oxides;

(d) adding an ammonia-containing binding agent to said slip at a concentration of 1.1% by weight;
(e) forming beads by dropping said slip into a calcium chloride (CaCl_2) solution wherein drops of said slip gel into beads containing calcium oxide (CaO);
(f) washing said beads, until the CaO content of said beads is between 0.01% and 0.8% ~~0.08%~~ by weight to said weight of said mixture of said metal oxides;
(g) drying said beads; and
(h) firing said beads at a temperature between 1,320°C and 1,400°C for 2 hours to 8 hours."

V. The appellant essentially argued as follows:

The replacement of the upper CaO limit in claim 1 of the main request corresponded to a correction that was allowable under Rule 139 EPC since the skilled person would have had recourse to the description. Affidavit A2 corresponded to the common general knowledge and proved that a CaO content of up to 0.08 wt.% could not be reached in practice.

The requirements of Article 123(3) EPC were also met since the removal of the discrepancy between the claims and the description of the contested patent as granted did not extend the protection conferred.

VI. The opponent (respondent) essentially argued as follows:

The replacement of the upper CaO limit in claim 1 neither fulfilled the criteria set out in G 3/89 for a correction under Rule 139 EPC nor was it allowable under Article 123(3) EPC.

VII. The appellant requested that the decision be set aside and that the patent be maintained in amended form on the basis of the claims of the main (sole) request as filed on 15 May 2014.

The respondent requested that the appeal be dismissed.

Reasons for the Decision

For the reasons set out under point 1 below, the main request does not fulfil the requirements of Rule 139 EPC.

According to G 11/91 (reasons 1), a correction under Rule 139 EPC is a special case involving an amendment within the meaning of Article 123 EPC. This means that the alleged correction in the main request would have to meet the requirements of Article 123(3) EPC. However, as explained under point 2, this is not the case here.

1. Rule 139 EPC

Pursuant to Rule 139 EPC, linguistic errors, errors of transcription and mistakes in any document filed with the European Patent Office may be corrected on request, provided that the correction is obvious in the sense that it is immediately evident that nothing else would have been intended than what is offered as the correction.

1.1 In claim 1 as granted, the upper limit of the calcium oxide range after washing was 0.08 wt.%, whereas in claim 1 of the main request the appellant returns to the upper CaO limit of 0.8 wt.% of claim 1 as originally filed.

According to G 3/89 (reasons 5), it is a requirement for a correction under Rule 139 EPC "that the parts of a European patent application or of a European patent relating to the disclosure must ... contain such an obvious error that a skilled person is in no doubt that this information is not correct and - considered objectively - cannot be meant to read as such. If, on the other hand, it is doubtful whether any information at all is incorrect, then a correction is ruled out".

However, there is no reason why the skilled person, when reading claim 1 as granted, would have considered the upper CaO limit to be manifestly incorrect. On the contrary, this feature is clear and makes technical sense. Hence, the skilled person would have understood claim 1 as it stood (see also T 1702/12, reasons 3.3 to 3.6, T 195/09, reasons 1.1.2, or T 2230/08, reasons 4 and 5).

Consequently, this condition for a correction under Rule 139 EPC is not met.

1.2 The appellant holds that the skilled person would have recognised that there is a discrepancy between claim 1 as granted and the description.

It is true that only upper CaO limits of 0.8 wt.%, 0.69 wt.% or 0.64 wt.% are disclosed in the description of the contested patent (namely in paragraphs [5, 6, 16, 23, 27 and 31]), but not 0.08 wt.%.

However, the CaO range in claim 1 is clear and not contradictory to the other features of the claims. It is moreover common practice to restrict a claim during the examination proceedings. Consequently, the skilled person would not have been in a position to conclude that the upper limit of the CaO content in claim 1 was undoubtedly incorrect.

Even if (*arguendo*) the skilled person were to have doubts about the correctness of the value, it would only have detected a discrepancy between the claims and the description. Yet this discrepancy could have been the result of an incomplete adaptation of the description.

- 1.3 In the appellant's view, affidavit A2 proved that the skilled person would have considered it impossible to achieve a CaO content of up to 0.08 wt.% by washing (see A2, point 2 and the first sentence of point 3).

This argument is not convincing. The assertion is based on Figure 1 of A2, which indicates that two hours of washing is not sufficient to arrive at a CaO content of less than 1 wt.%.

Additionally, the theory presented in A2 to explain that a CaO content below 0.1 wt.% would inevitably result in unstable beads (e.g. the last sentence in the first paragraph on page 2) is not supported by further evidence and therefore cannot be considered to be sufficiently proven, let alone be considered common general knowledge at the time of filing of the application.

- 1.4 In the appellant's view, the CaO range of claim 1 as granted between 0.01 and 0.08 wt.% would be too small to make technical sense.

However, the range is a sub-range of the initially claimed range with the lower end point of 0.01 wt.% being identical. While the claimed range is indeed relatively small, there is no requirement for a minimum size of a range in a claim.

Consequently, this argument is not convincing either.

- 1.5 According to the appellant, the amendment could also be considered a "normal" amendment under Article 123 EPC, i.e. without invoking Rule 139 EPC.

However, the requirements of Article 123(3) EPC are not met as explained under point 2 below.

2. Article 123(3) EPC

- 2.1 Compared to claim 1 as granted, the scope of protection of claim 1 of the main request is *broadened* to also encompass methods of forming alumina-zirconia beads with a residual CaO content between 0.08 and 0.8 wt.%.

Consequently, the main request is not allowable because it contravenes the requirements of Article 123(3) EPC.

Since claim 1 of the main request violates Article 123(3) EPC and claim 1 as granted violates Article 123(2) EPC, the situation corresponds to that described in G 1/93. The upper CaO limit of 0.08 wt.% in claim 1 as granted has indeed no basis in the application as originally filed.

However, this decision confirms that an extension of the scope of protection conferred is not acceptable in such a situation (see headnote 1).

2.2 The appellant cited a number of decisions to support its case.

In T 108/91, an inaccurate technical statement in a granted claim, which was evidently inconsistent with the totality of the disclosure of the patent and ran against an implicit technical objective (reasons 2.2), was replaced, and it was concluded that this would not contravene the requirements of Article 123(3) EPC.

However, the situation in the present case differs since the CaO range in claim 1 as granted is not evidently inconsistent with the description but merely refers to a sub-range of the range disclosed in the description.

Moreover, in T 195/09 (reasons 2.1.5), the board noted that T 108/91 was overruled in this regard by G 1/93.

2.3 In addition, the appellant cites a number of decisions where an amendment was allegedly allowed to align the claims and the description without indicating, however, specific passages or reasons why this case law could be applied to the present case. In the board's view, this is not the case:

- In T 1993/12, an amendment of the claim was held allowable under Article 123(3) EPC, with reference to T 108/91, since the description was in contradiction with the claims. In that case, it was unclear whether the parameter "viscosity" in the claim referred to the

caoutchouc mass for cushioning or to the elastomers/
vulcanisation agent (reasons 5 and 14). By contrast, in
the present case, the claims are clear. Consequently,
the situation in the present case differs.

- In T 371/88, a broadening under Article 123(3) EPC on
the basis of the description was found allowable.
However, this decision is older than G 1/93. Moreover,
the claim was not clear (reasons 2.5), contrary to the
present case.

- According to G 1/10, an amendment has to satisfy the
requirements of Article 123 EPC (reasons 13).

- In T 369/03, an amendment was held allowable under
Article 123(3) (reasons 4.7) but the amendment removed
an inconsistency in the claims (reasons 4.5), contrary
to the present case, where the claims are clear.

- T 31/93 (reasons 2.2, 2.3 and 2.6), T 314/03 (reasons
2.8 and 2.11) and T 190/99 (reasons 2.3.4) follow the
approach of T 108/91, and this argument consequently
fails for the reasons indicated under 2.1 and 2.2
above.

3. For these reasons, the main (sole) request is neither
allowable under Rule 139 EPC nor under Article 123(3)
EPC.

Order

For these reasons it is decided that:

The appeal is dismissed.

The Registrar:

The Chairman:



C. Vodz

E. Bendl

Decision electronically authenticated