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Bezeichnung der Erfindung: Radiation Processing of Polymeric Products
Title of invention:
Titre de l'invention :

Klassifikation / Classification / Classement : C 08 J 7/10

ENTSCHEIDUNG / DECISION

vom / of / du 21 January 1986

Anmelder / Applicant / Demandeur : BICC

~~Patentinhaber / Proprietor of the patent /
Titulaire du brevet~~

~~Einsprechender / Opponent / Opposant~~

Stichwort / Headword / Référence : Radiation Processing/BICC

EPÜ / EPC / CBE Articles 52(1), 64(2) and 84
"Product-by-process" claims
"Identification of the closest prior art"

Leitsatz / Headnote / Sommaire

1. The provisions of the EPC governing the requirements for patentability and those relating to the extent of protection fulfil different functions. A claim directed to subject-matter which, though coming within the extent of protection provided by the EPC, does not meet the requirements for patentability laid down in Articles 52 to 57, is not allowable. A known product is not rendered novel merely by means of further definition (as a "product of process").
2. An objective assessment of inventive step starting from the closest prior art implies that the latter has been positively identified and considered.

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Patentamt

Beschwerdekammern

European Patent
Office

Boards of Appeal

Office européen
des brevets

Chambres de recours



Case Number: T 248/ 85

DECISION
of the Technical Board of Appeal
of
21 January 1986
3.3.1

Appellant:
BICC Public Limited Company
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Decision under appeal: Decision of Examining Division 013 of the European Patent
Office dated 18 July 1985 refusing European patent
application No 82 305 334.3 pursuant to Article 97(1)
EPC

Composition of the Board:

Chairman: K. Jahn
Member: P. Lançon
Member: G. Paterson

Summary of Facts and Submissions

- I. European patent application 82 305 334.3 filed on 7 October 1982 and published with publication number 77620 claiming priority of the prior application of 15 October 1981 (GB 8 131 144), was refused by the decision of the Examining Division 013 of the European Patent Office dated 18 July 1985. The decision was based on Claims 4 and 5 received on 13 March 1985. Independent Claims 1, 4 and 5 were worded as follows:
1. A method of radiation processing a product made at least in part from an oxygen sensitive cross-linkable polymeric material comprising sealing the product in a flexible container and subjecting it to gamma irradiation therein, the volume and permeability of the flexible container being such that the ratio of the sum of the volume of oxygen contained in it and the volume of oxygen that would diffuse into it during the irradiation period to the exposed surface area of the polymeric material is less than a critical value determined empirically for the particular polymeric material.
 4. Cross-linked PVC coated wire characterised in that it was actually made by and is the direct product of the process claimed in any one of Claim 2 or Claim 3.
 5. An irradiated product characterised in that it was actually made by and is the direct product of the process claimed in Claim 1.

II. The reason given for the refusal was that the product claimed in Claims 4 and 5 is not novel and that, consequently, these claims are not allowable under Article 52 together with Article 54 EPC. The decision also stated that the subject-matter of Claims 1 to 3 of the application is novel (Art. 54 EPC) and that an inventive step for the subject-matter of Claims 1 to 3 could be appreciated (Art. 56 EPC). Nevertheless, Claims 4 and 5 constituted an obstacle to granting the patent.

III. The Applicant lodged an appeal against the decision received on 16 August 1985, paid the fee within the time limit and filed a statement setting out the grounds of appeal dated 12 September 1985 (received on 16 September 1985):

According to the Appellant:

The technical substance of the application does not enter into the issues in the Appeal. The claims at issue are Claims 4 and 5 as correctly set out in the Decision under Appeal.

The products claimed in Claims 4 and 5 are not per se distinguishable from the products of the prior art (points 2 and 5 of the Statement of Grounds). The appellant submits that he does not claim any protection beyond that already given by Article 64(2) EPC to the method Claims 1 to 3. He takes the position that novelty is conferred on the products as claimed by the process of the relevant method claim.

Consequently, he seeks to secure the grant of a patent in which the protection given by Article 64(2) EPC is expressly stated (point 4 of the Statement of Grounds).

- IV. Oral proceedings were arranged at the request of the Appellants on 21 January 1986. In its summons, the Board referred to its earlier decision T 150/82 "claim categories/IFF", OJ EPO 7/1984, 309 also concerning product-by-process claim.
- V. The arguments submitted to the Board by the Appellants can be summarized as follows:

1. The products claimed in Claims 4 and 5 are not per se distinguishable from the products of the prior art (point 2 and 3 of the Statement of Grounds).

The Appellants submit that they do not claim any protection beyond that already given by Article 64(2) EPC to the method Claims 1 to 3.

2. The main reason why the Appellants submit that Claims 4 and 5 should be allowed are as follows:

According to them, the effect of the minor amendments proposed to Claims 4 and 5 is to make it abundantly clear that the protection which the Appellants seek by these claims is only that to which they are expressly entitled by Article 64(2) EPC, in view of the agreed allowability of method Claims 1 to 3.

From Article 64(2) EPC which expressly states that protection shall be granted for the direct product of a patentable process, it necessary follows that, under the EPC, a product is rendered novel by the fact that it is produced by means of a new process and notwithstanding the fact that such product is not new per se, by virtue of its physical characteristics. Unless this is so, the Appellants submit, Articles 52(1) and 64(2) EPC are inconsistent with one another,

because "Article 64(2) EPC would give protection which Articles 52(1) forbids." The express claiming of the right given by Article 64(2) EPC is not forbidden by any Article of the Convention nor by any Rule of the Implementing Regulations.

Consequently, they seek to secure the grant of a patent in which the protection given by Article 64(2) EPC is expressly stated by virtue of the inclusion of Claims 4 and 5 (points 4 and 5 of the Statement of Grounds).

The absence of any product by process claim could mean that the matter for which the protection is sought according to Article 84 EPC has not been defined (point 18 of the Statement of Grounds).

Conversely, and in further support for the inclusion of Claims 4 and 5, the Appellants say that unless such claims are included, and having regard to the fact that Article 84 requires the claims to define the matter for which protection is sought, it is possible that a National Court would construe the absence of such claims as a waiver of the protection provided by Article 64(2).

3. Other subsidiary arguments raised by the Appellants are the following:

It cannot be expected that all prospective infringers will be aware of the existence and understand the effect of Article 64(2) EPC; indeed it can be expected that many if not most prospective infringers will be wholly unaware of it. An inexperienced prospective infringer would not realise that a European patent containing only claims to a method of manufacture would restrict

the importation of the direct product of the patented process (points 12 and 13 of the Statement of Grounds).

The allowance of the claims sought would reduce the risk of the Appellants having to go to the expense of a Court Action to establish the rights which the European patent will give (point 29 of the Statement of Grounds).

- VI. The Appellants request the cancellation of the Decision dated 18 July 1985 and the grant of a European patent containing Claims 1 to 5 in the form received by the European Patent Office in Munich on 13 March 1985.

If however, after all consideration, the Board of Appeal upholds the viewpoint of the Examining Division, then in those circumstances the Appellants would be prepared to cancel Claims 4 and 5 and would request the grant of a patent with Alternative Claims as filed on 13 March 1985; these comprise Claims 1, 2 and 3 in the same form in which they have existed without amendment from the filing of the application.

Reasons for the decision

1. The appeal complies with Articles 106 to 108 and Rule 64 EPC and is, therefore, admissible.
2. Claims 4 and 5 set out above are in issue in this Appeal. The Examining Division has indicated that it finds Claims 1 to 3 acceptable for the reasons set out in its Decision.

Although it is not restricted to the facts, evidence and arguments provided by the parties, the Board does not see any reason to examine these claims of its own motion at this stage of the proceedings.

Consequently the claims at issue are, as requested by the Appellants, "product-by-process" Claims 4 and 5.

3. In earlier case T 150/82, the Board has already decided that Claims for products defined in terms of processes for their preparation (known as "product-by-process" claims) are admissible only if the products themselves fulfil the requirements for patentability and there is no other information available in the application which could enable the Applicant to define the product satisfactorily by reference to its composition, structure or some other testable parameter.

That decision was based on a claim worded as follows:

"A product whenever produced by the process of Claim 1". In the reasons for the decision, this product-by-process claim was given as representing a definition of the products which are obtained by the use of the allegedly inventive process referred to .

4. In order to emphasize that the protection sought is only that conferred under Article 64(2), the Appellants have accordingly worded their product-by-process claims, partly using the wording of Article 64(2).

The claimed products are characterized in that they are "actually made by" and are "the direct product of the process" claimed in any one of the process claims.

5. Concerning the novelty of the product so defined, the Applicants admit that the products claimed are not per se distinguishable from the products of the prior art, but take the position that novelty is conferred on the products as claimed by the process of the relevant method claim.

The Board cannot accept this interpretation.

6. The submissions set out in V(2) above are wrong for the following reasons:

6.1 The function of the claims, according to Article 84 EPC, is to "define the matter for which protection is sought", - not to define the extent of protection. The function of the patent, when granted, is to confer protection upon the patentee by giving him rights within the designated States. The nature of such protection is determined in accordance with Article 69 EPC by reference to the terms of the claims. But the claims do not define the extent of protection: they define the matter for which protection is sought.

6.2 In accordance with Article 52(1) EPC, "European patents shall be granted for any inventions which are susceptible of industrial application, which are new and which involve an inventive step".

In other words, protection can only be conferred upon inventions. Thus the "matter" for which protection is sought, as defined by each claim, must satisfy the requirements of Article 52(1) EPC. In particular, the matter defined by each claim must be new and must therefore satisfy Article 54(1) EPC.

- 6.3 The subject-matter of a patent, that is, the matter defined in its claims, may in appropriate cases comprise both a process and the product(s) of such process. However, in such cases both the claims to the process and the claims to the product(s) of such process must satisfy the requirements of Article 52(1) EPC.
- 6.4 A product can in appropriate cases be defined by the use of various parameters, such as its structure, its composition, or its process of preparation. The use of a different parameter by which to define a particular product cannot by itself give the product novelty. In the present case, where as is admitted by the Appellants, the products defined by Claims 4 and 5 are physically the same as the products produced by prior art processes, such claims cannot satisfy the requirement as to novelty set out in Articles 52(1) EPC and 54(1) EPC. Each of Claims 4 and 5 defines the "matter for which protection is sought", i.e. a product, solely by reference to the process by which it is produced. Such method of definition of the product is not relevant to the question of novelty, once it is established, or in the present case admitted, that such a product is part of the state of the art for the purpose of Articles 54(1) EPC. There is only one criterion for novelty provided by the EPC, namely that set out in Article 54(1) EPC.
- 6.5 There is no inconsistency between Articles 52(1) EPC and 64(2) EPC as is alleged by the Appellants, when they are considered as set out above. The fact that Article 64(2) EPC provides protection as therein set out in respect of a patent whose subject-matter is a process is not relevant to the question whether the matter defined in the claims satisfies the requirements for patentability set out in Article 52(1) EPC.

In particular, Article 64(2) does not confer novelty upon a claim which is formulated as a "product-by-process", when no novelty exists in such product per se, and does not entitle or enable an Applicant for a European patent to include such claims in his patent which do not satisfy the requirements for patentability of Article 52(1) EPC.

- 6.6 Having regard to what is set out in 6.1 to 6.5 above, the subsidiary arguments of the Appellants are of minor importance. In particular, insofar as they are concerned with questions concerning interpretation and possible enforcement of European patents such questions are essentially matters of national law and not within the terms of reference of the EPC. Furthermore, it is clear from what has been set out above that the exact form of the "product-by-process" claims, i.e. the minor amendments proposed to Claims 4 and 5, is of no relevance to their allowability, which has to be determined in accordance with the substantive requirements of Article 52(1) EPC.
- 6.7 It may be mentioned that prior to the existence of the EPC it may well be that under national Patent Office practices applying national laws, "product-by-process" claims were commonly allowed. This has no bearing upon the proper interpretation of the law provided by the EPC as set out above.
7. Claims 4 and 5 being not allowed, the Board has to examine the alternative request and to decide on the basis of Claims 1 to 3 filed on 13 March 1985. These claims are identical to Claims 1 to 3 originally filed.
8. In its decision of 18 July 1985, the Examining Division stated that the subject-matter of Claims 1 to 3 was novel and that an inventive step could be appreciated.

9. Such statements are not necessarily to be excluded from decisions of this nature, but they should be the result of an objective examination of the subject-matter of the claims. Such was obviously not the case, here. Consequently, the Board is neither prepared to adopt the conclusions of the first instance nor to decide to grant a patent on the basis of Claims 1 to 3 at this stage of the proceedings.
- 9.1 Very early in its jurisprudence, the Board has emphasized the obligation of objectivity when assessing an inventive step (see T 01/80 "Carbonless copying paper" OJ. EPO 7/1981, 206 - see particularly headnote I). In the problem and solution method consistently recommended by the Board to assess the patentability of an invention, objectivity in the assessment of inventive step is, first of all, achieved by starting out from the objectively ruling state of the art, in the light of which the technical problem is determined which the invention addresses and solves (T 24/81 "Metal refining/BASF" OJ EPO 4/1983, 133).
- 9.2 In the present case, the Examining Division has correctly admitted that the closest prior art seems to be the one discussed in the description of the present application. However, the corresponding document has neither been cited, as recommended by Rule 27(1)(c) EPC, nor has it been at least identified. It must be concluded that this alleged closest prior art has not been checked and that the Examining Division has been satisfied with its description given by the Appellant. This assessment of the closest prior art cannot be qualified as objective. Consequently, starting from a non-objectively designated and even uncertain alleged closest state of the art, the determination of the technical problem cannot be certainly objective.

Therefore, the existence of an inventive step cannot have been reasonably assessed. The same applies for novelty.

10. In view of the above, it is observed that a full first instance examination on the basis of the principles developed by this Board i.e. on the basis of the problem and solution method has not yet taken place. This alone must have the consequence that the Decision under appeal is to be set aside and the case remitted to the first instance, without decision on the merits of the case.
11. In reconsidering the case, the Examining Division must:
 - (1) positively and objectively determine the most relevant piece of prior art, that is, it is necessary both to identify it and to check its teaching;
 - (2) objectively define the problem underlying the alleged invention in by comparison of the technical results achieved by the claimed invention with those achieved by the hereabove designated closest state of the art;
 - (3) satisfy itself that the so defined problem is solved by the claimed solution;
 - (4) assess the novelty of the subject-matter of the claims;
 - (5) assess whether such solution involves an inventive step, thereby taking into account the prior art.

Order

For these reasons, it is decided that:

1. The appeal concerning Claims 4 and 5 is rejected.
2. However, the Decision under appeal is set aside and the case is remitted to the Examining Division for further prosecution on the basis of Claims 1 to 3 filed on 13 March 1985.

