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15

Aktenzeichen / Case Number / N° du recours : T 421/86

Anmeldenummer / Filing No / N° de la demande : 82 305 312.9

Veröffentlichungs-Nr. / Publication No / N° de la publication : 0 077 174

Bezeichnung der Erfindung: Compositions for forming poly(oxazolidone/urethane)
Title of invention: thermosets and products therefrom

Titre de l'invention :

Klassifikation / Classification / Classement : C08G 59/02

ENTSCHEIDUNG / DECISION

vom / of / du 25 January 1988

Anmelder / Applicant / Demandeur : Stauffer Chemical Company

Patentinhaber / Proprietor of the patent /
Titulaire du brevet :

Einsprechender / Opponent / Opposant :

Stichwort / Headword / Référence :

EPÜ / EPC / CBE Article 54(1)

Kennwort / Keyword / Mot clé : "Novelty"

Leitsatz / Headnote / Sommaire

Europäisches
Patentamt

European Patent
Office

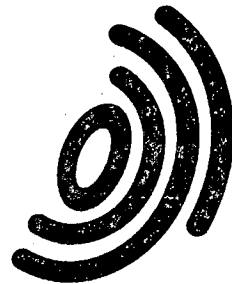
Office européen
des brevets

Beschwerdekammern

Boards of Appeal

Chambres de recours

Case Number : T 421/86



D E C I S I O N
of the Technical Board of Appeal 3.3.1
of 25 January 1988

Appellant : Stauffer Chemical Company
Westport
Connecticut 06880 (USA)

Representative : Froud, Clive et al.
Elkington and Fife
High Holborn House
52/54 High Holborn
London WC1V 6SH (GB)

Decision under appeal : Decision of Examining Division 012
of the European Patent Office
dated 11 July 1986 refusing European
patent application No. 82 305 312.9
pursuant to Article 97(1) EPC

Composition of the Board :

Chairman : K.J.A. Jahn
Members : R.W. Andrews
C. Payraudeau

Summary of Facts and Submissions

- I. European patent application No. 82 305 312.9, filed on 6 October 1982 and published on 20 April 1983 (publication No. 0 077 174) claiming priority of 8 October 1981 from a prior application filed in the United States of America, was refused by a decision of the Examining Division 012 of the European Patent Office dated 11 July 1986. The decision was based on Claims 1 to 14 filed on 31 January 1986.

Claim 9 reads as follows:-

"9. A process for the production of an essentially acid group free prepolymer containing two terminal epoxy groups and two non-terminal, secondary hydroxy groups characterised in that it comprises reacting, in a single step, a polyol, a dicarboxylic acid anhydride and a diepoxide; the reactants being present in their entirety at the outset of the reaction."

- II. The stated ground for the refusal was that the subject-matter of Claim 9 lacked novelty in the light of the disclosure in US-A-3 507 820. This document describes the preparation of polymers with ester linkages by reacting epoxy resins with polyvalent carboxy compounds with optional concurrent use of polyhydric alcohols.
- III. An appeal was lodged against this decision on 3 September 1986 with payment of the appropriate fee. In the statement setting out the grounds of appeal filed on 5 November 1986 the Appellant argued that the subject-matter of Claim 9 was not derivable directly and unambiguously from the cited document and that a skilled person following this prior teaching would not inevitably arrive at a result falling within the terms of the present Claim 9.

- IV. In a communication the Board informed the Appellant that it also considered that the subject-matter of Claim 9 lacked novelty in the light of the teaching in the cited document and, furthermore, that Claim 9 did not appear to satisfy the requirements of Article 84 EPC taken in conjunction with Rules 29(1) and (3) EPC.
- V. In his reply to this communication the Appellant agreed to forgo protection for Claim 9 and the dependent Claims 10 to 14.
- VI. The Appellant requests that the decision under appeal be set aside and that the case be remitted to the Examining Division for further prosecution on the basis of Claims 1 to 8 filed on 31 January 1986.

Reasons for the Decision

1. The appeal complies with Articles 106 to 108 and Rule 64 EPC and is, therefore, allowable.
2. With the deletion of Claims 9 to 14 the Appellant has overcome the only ground for the refusal of the application. Therefore, the decision under appeal must be set aside.

However, the patent sought cannot be granted since the substantive examination of the present Claims 1 to 8 has not yet been completed. Under those circumstances the Board makes use of its power under Article 111(1) EPC to remit the case to the Examining Division for further prosecution.

Order

For the above reasons, it is decided:

1. The decision under appeal is set aside.
2. The case is remitted to the Examining Division for further prosecution on the basis of Claims 1 to 8 filed on 31 January 1986, amended pages 2, 3, 5, 12, 15, 16, 23, 25, 27, 29, 30 and 32 to 34 filed on 30 May 1985 and pages 1, 4, 6 to 11, 13, 14, 17 to 22, 24, 26, 28 and 31 of the description as originally filed.

The Registrar:



The Chairman:

