



Case Number: T0664/90-322

DECISION

of the Technical Board of Appeal 322
of
9 July 1991

Appellant: NATIONAL RESEARCH DEVELOPMENT CORPORATION
101 Newington Causeway
London SE1 6BU
GRANDE BRETAGNE

Representative: Cullis, Roger
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Decision under appeal: Decision of Examining Division of the European Patent
Office dated 26.03.90 refusing European patent
application No 86904883.5 pursuant to Article 97(1) EPC

Composition of the Board:

Chairman: SZABO G. S. A.
Members: DU POUGET DE NADAILL
BENUSSI F

Publication in the Official Journal ~~Yes~~ / No

File Number: T 664/90 - 3.2.2
Application No.: 86 904 883.5
Publication No.: WO 87/01110
Title of invention: Fabrication of optical fibres

Classification: C 03B 37/018

D E C I S I O N
of 9 July 1991

Applicant: NATIONAL RESEARCH DEVELOPMENT CORPORATION

Headword:

EPC Art. 54, 123(2)

Keyword: "Product-by-process" claims

Headnote

Summary of Facts and Submissions

I. European patent application No. 86 904 883.5, filed as International application PCT/GB86/00484 and published under No. WO 87/01110 was refused by a decision of the Examining Division dated 26 March 1990. The decision is based on the new claims and description filed on 16 August 1989.

II. The reasons given for the refusal were that the subject-matters of claims 9 and 10, both worded in the way of "product-by-process", are not new and, further, that the amendment "of the order of 30-100 mB" brought in the description during the examination procedure has no support in the application as originally filed. The application does not meet, therefore, the requirements of Articles 52 and 123(2) EPC.

The above-mentioned amendment in the description was made by the Appellant to meet a previous objection of the Examining Division, according to which the expression "a few millimetres of mercury" on page 4 of the specification did not meet the requirements of Rules 35(12) and 36(1) EPC.

III. Current claims 1, 9 and 10 read as follows:

"1. A method of fabricating a preform for the manufacture of optical fibres incorporating a doped glass in which a dopant material is deposited in a dopant chamber and is subsequently vaporised from said chamber and deposited on the inner surface of a tubular glass member characterised in that said method includes the sequential steps of heating the dopant chamber (1) to fuse said dopant to the chamber wall (3), subsequently heating said chamber to cause said dopant to vaporise at a predetermined rate,

passing a gaseous source material ($\text{SiCl}_4, \text{GeCl}_4, \text{O}_2$) through said carrier chamber to mix said dopant material with said source material, depositing from the mixture of said source material and said dopant material a mixture (8) of solid components, and fusing said solid components to form a doped glass preform.

9. A preform for the drawing of optical fibres made by the method of any one of claims 1 to 8.

10. An optical fibre drawn from a preform according to claim 9."

IV. The Appellant lodged an appeal against this decision. In his Statement of Grounds of appeal, after giving a full account of the letters exchanged during the examination procedure, he indicated that the Examining Division had issued the decision without giving him any warning and that he would be prepared to withdraw claims 9 and 10, if the objection made to these claims were still maintained. Moreover, he also tentatively proposed to replace the expression "a few millimetres of mercury" by the words "a few hundred pascals".

The Appellant requests that the refusal be withdrawn so that the examination may be brought to a positive conclusion on the basis of his above proposals. Alternatively, this is requested on the basis of claims wherein claims 9 and 10 have been deleted and "a few hundred pascals" inserted, as suggested above.

Reasons for the Decision

1. The appeal is admissible.

2. The main question in this appeal is whether or not the claims 9 and 10, which both concern products made by a process, are allowable under Article 54(2). Despite the Examining Division's request to indicate the differences between the preform of claim 9 and the optical fibres of claim 10 vis-à-vis the prior art disclosed in the introductory part of the description, the Appellant has never answered this request and the Statement of Grounds of appeal does not tackle this point either. There was only the argument that it was not apparent how the contested claims could be regarded as independent claims, since they were limited to products made by the method of claims 1 to 8.

3. The EPC makes a firm distinction between two kinds of inventions, namely the methods and the products, see Article 52(2) and (4) and Rules 29(2) and 30. Rule 29(2) refers to different categories of claims relating either to a process (e.g. use) or to a product (e.g. apparatus) and states that the application may contain independent claims in each category. When Rule 29(4) defines a dependent claim which contains "all the features of any other claim", it means claims of the same category. It must be assumed that in spite of references to claims in another category to define certain features, such claims must be construed as independent from each other in other respects.

4. According to an established jurisprudence of the Boards of Appeal, "product-by-process" claims, that is to say claims defining a product solely by the fact that it is obtained by a certain process, are admissible only if the products themselves fulfill the requirements for patentability (see the decisions T 150/82, OJ EPO 1984, 309, and T 284/85, OJ EPO 1986, 261). In the present case the products of the method claim 1 seem, prima facie, to be identical with

those of the state of the art. The Appellant has not shown that the products claimed are different from the products of the prior art. Once the product itself is part of the state of the art and is thus not novel according to the criterion of novelty as set out in Article 54(1) EPC, the fact of defining this product by reference to a new process is irrelevant to the question of novelty. The use of a different parameter for defining a known product does not confer novelty to the product.

5. In view of Article 64(2) EPC product-by-process claims to known products are moreover quite superfluous and may create confusion since such claims are normally construed as claims to the article per se being obtainable by the method and not merely obtained. Such claims are therefore unclear in the sense of Article 84 EPC.
6. Since one millimetre of mercury corresponds to 1,33 pascal, the phrase "a few millimetres of mercury" cannot have the meaning of "about 30-100 mB". The Board agrees with the Examining Division that the introduction of such a range in the application infringes Article 123(2) EPC.
7. As regards the auxiliary request, the deletion of claims 9 and 10 removes the objection of lack of novelty and is therefore acceptable. The amendment of the description by replacing "in the order of 30-100 mB" in the text by "a few hundred pascals" is allowable. It is equivalent to the term originally filed ("few millimetres of mercury"). It is allowable.
8. Although the Appellant made no specific request in respect of the procedure followed by the Examining Division when rejecting the present application and seemed only to find this wrong in view of the principles expressed in the "Guidelines for Examination in the EPO", VI-4.3, the Board

has considered what actually happened and finds the reproach of the Appellant unjustified. The Appellant himself acknowledges in his statement that the Examining Division, in a second communication dated 3 October 1989, indicated that a rejection of the application would be considered, if the requirements of patentability already mentioned in the first communication were not fulfilled for the independent claims 9 and 10. Such advice is a clear warning, so that the Guidelines were properly followed. A direct rejection of an application is not excluded either when an applicant has not made any real effort to deal with the objections. This last condition also seems to apply in the present case, since the Appellant confined himself to stating that the products of claims 9 and 10 should be patentable, if the method claim 1 was acceptable in this respect.

9. Since the appealed decision was founded exclusively on objections under Articles 52, 54 and 123(2) EPC the Board considers it appropriate to make use of the powers conferred on it by Article 111 EPC to remit the case to the first instance for further prosecution.

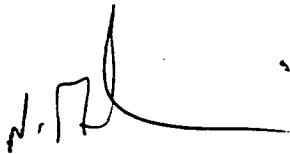
Order

For these reasons, it is decided that:

1. The decision under appeal is set aside.
2. The case is remitted to the first instance for further examination on the basis of the auxiliary request made by the Appellant in points 13 and 14 of the grounds of appeal, that is to say on the basis of the following documents:


- Description and claims, as filed on 16 August 1989, however amended in the following way: Deletion of claims 9 and 10 and replacement of the expression "in the order of 30-100 mB" on page 4 (numbered 3), line 28 of the description by the words "a few hundred pascals".
- Figures, as originally filed.

The Registrar:



N. Maslin

The Chairman:



G. Szabo