

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

File Number: T 1/91 - 3.4.2
Application No.: 83 903 728.0
Publication No.: 0 126 742
Title of invention: Inkind system for producing circuit patterns

Classification: G01D 15/16, B05C 5/02

D E C I S I O N
of 16 July 1992

Applicant: MICRO PEN RESEARCH ASSOCIATES

Headword:

EPC Art. 82, 84 und 123(2) EPC

Keyword: "Unity of invention (yes, after amendments)" - "Added subject-matter (no, after amendments)"



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Boards of Appeal

Chambres de recours

Case Number : T 1/91 - 3.4.2

D E C I S I O N
of the Technical Board of Appeal 3.4.2
of 16 July 1992

Appellant : MICRO PEN RESEARCH ASSOCIATES
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Decision under appeal : Decision of Examining Division of the European
Patent Office dated 27 July 1990 refusing
European patent application No. 83 903 728.0
pursuant to Article 97(1) EPC.

Composition of the Board :

Chairman : E. Turrini
Members : W.W.G. Hofmann
J.-C. Saisset

Summary of Facts and Submissions

- I. European patent application No. 83 903 728.0 (international publication number WO 84/01825) was refused by decision of the Examining Division.

- II. The reasons given for the refusal were

that the term "viscous material" contained in independent Claims 1, 18, 26, 27 and 34 and several dependent claims valid at that time went beyond the disclosure of the application as filed and thus infringed Article 123(2) EPC,

that Claims 1 and 27 lacked clarity (Article 84 EPC) since they did not comply with the description of the invention,

and that independent Claims 1 and 18 lacked unity of invention as required by Article 82 EPC since they were not so linked as to form a single general inventive concept.

- III. The Appellant lodged an appeal against the decision.

- IV. In a communication the Board expressed its provisional view that the claims were not allowable having regard to Articles 123(2), 84 and 82 EPC.

- V. Oral proceedings were held at the end of which the Appellant handed over a new set of claims restricted to Claims 1 to 17, and requested that the decision under appeal be set aside and a patent granted on the basis of these claims.

Claim 1, the only independent claim, reads as follows:

"1. A system for use in producing patterns on a substrate with ink material and with the aid of a flexurally (56) supported member (28) having an orifice, said system comprising means (24, 29, 26, 30, 40, 38, 168, 170) for moving said substrate with respect to said member, means (208, 30, 36, 38, 40, 168, 170) for controllably feeding said ink material through said orifice at a volume rate synchronous with the rate of relative movement of said member and substrate, and means (56, 152, 151, 144, 146, 40, 140, 142, 198, 180) coupled to said member and responsive to the viscous forces on the member from the ink material flowing from said orifice upon said substrate for allowing said viscous forces to determine the vertical displacement of said member to maintain a constant thickness of line of said ink material in said pattern for a given cross-sectional area of said line."

VI. With regard to this set of claims, the Appellant argued that all the objections of the Board of Appeal had been met and that these claims should therefore be allowable.

Reasons for the Decision

1. The appeal is admissible.
2. Unity of invention

The Appellant has now limited the set of claims to Claims 1 to 17; Claim 1 is the only independent claim, and Claims 2 to 17 depend directly or indirectly on Claim 1.

The point of objection regarding unity of invention mentioned in the decision of the Examining Division has thus been removed. The set of claims relates to the single invention set out in Claim 1.

The requirements of Article 82 EPC are therefore fulfilled.

3. Subject-matter going beyond the content of the application as filed

The Appellant has reestablished the term "ink" contained in the original claims. The Board cannot see any difference in meaning between the originally disclosed term "ink" alone and the term "ink material" now introduced into the claims. Thus, no objection remains regarding this point.

The former objection of the Board regarding the original disclosure of the feature of Claim 3 "separate from said supply" is dropped. The "means for supplying ink" mentioned in original Claim 4 point to "a supply" and it seems trivial that "means for supplying ink" mentioned separately from a "closed volume" (original Claim 3) are in fact separate from this volume.

As for the rest, the disclosure of Claim 2 is based on original Claims 2 and 4, that of Claim 3 is based on original Claims 3 and 4, that of Claims 4 to 16 is based on original Claims 4 to 16, and that of Claim 17 is based on original Claims 17 and 1.

Therefore, the claims (description and drawings have not been changed) are in accordance with the requirements of Article 123(2) EPC.

4. Clarity

The designation of the claimed subject-matter is now consistently formulated to be a system (for use in producing patterns on a substrate). Regarding this formal question concerning the nature of the claimed subject-matter, clarity has thus been established (Article 84 EPC).

However, this does not necessarily mean that the Board considers the present claims to be clear in every aspect.

The objection of the Examining Division in point 1.2 of its decision has certainly to be taken into account. Indeed, those features of Claim 1 which relate to the determination of the vertical displacement of the member by the viscous forces, if taken without any reference to the description or drawings, give little information; and even if they were read in conjunction with features from the description and drawings, they would show inconsistencies and not provide clear definitions.

Moreover, it remains to be seen whether, together with the other features of Claim 1, the indication "flexurally supported member" is sufficient to guarantee the possibility of a vertical displacement of the member having the orifice.

The Board is, however, of the opinion that now, after the set of claims have been amended and brought in order as to the formal aspects, the Examining Division should not be bound by the Board's acceptance or rejection of specific amendments which could cover only the isolated aspect of clarity and would have to stop where the scope of possible interpretations in their relationship to the prior art (touching the questions of novelty and inventive step) would be concerned. The aspects of novelty and inventive

step should - on the basis of the modified claims - be examined and decided upon by the Examining Division.

5. Similar considerations apply to the question of formulating Claim 1 in accordance with Rule 29(1) EPC which is connected to the assessment of the relationship between claimed subject-matter and prior art and should be left to the Examining Division.
6. Regarding the objections of the Examining Division under Rule 27(1) EPC, the Board is of the opinion that while it is certainly necessary to cite the relevant prior art and to disclose the invention so that the problem and its solution can be understood, the corresponding amendments of the description can be deferred until the claims have been found to be allowable.

The Board does not consider the negative response of the Appellant in his letter of 15 January 1989 to be an absolute and final refusal to make such amendments, in particular since meanwhile on page 3 of the letter of 6 December 1990 to the Board, the Appellant has stated his agreement to cite any prior art document in the introduction to the specification.

7. The Appellant expressed lack of understanding for the fact that whereas formal questions were extensively prosecuted by the Examining Division, the basic requirements of patentability, i.e. novelty and inventive step, were not thoroughly examined. In this respect, the Board wishes to point out that formal questions like unity of invention, unduly added subject-matter or clarity are generally by no means of secondary importance. Before it is known which of several claimed inventions the Applicant maintains, before the content of the claims is kept within the limits of the original disclosure of the application, and before the

claimed subject-matter is understandably defined, an examination regarding novelty and inventive step cannot normally be performed. The obligation to decide between different ways in which such formal objections of the Examining Division could be met, lies with the Applicant. In the present case, the Applicant (Appellant) could have certainly speeded up the examining procedure if he had reacted at an earlier stage to the objections raised against a set of claims which - as he should have known - were not compatible with the European Patent Convention.

8. Lack of novelty or inventive step was not among the reasons on which the decision of the Examining Division was based. Although in the communications of 20 July 1988 and 30 May 1989 the Examining Division already stated a provisional opinion regarding novelty and inventive step of the subject-matter of Claim 1 valid at that time, this cannot be regarded as a full examination by the first instance with respect to these points since the judgment was impeded by the formal deficiencies of the claims. The claims have meanwhile been changed.

The Board has therefore decided to remit the case to the Examining Division for further prosecution in accordance with Article 111 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 with the order to proceed further on the basis of the set of claims 1 to 17 filed during the oral proceedings.

The Registrar:

The Chairman:

E. Görgmaier

E. Turrini