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D E C I S I O N
of 9 August 1995

Case Number: T 0789/92 - 3.3.3

Application Number: 88901688.7

Publication Number: 0303647

IPC: C08G 69/00

Language of the proceedings: EN

Title of invention:

Macrocyclic oligomers containing spiro(bis)indane moieties

Applicant:

GENERAL ELECTRIC COMPANY

Opponent:

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Headword:

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Relevant legal provisions:

EPC Art. 82, 123(2)

Keyword:

"Unity - (yes) after amendment"

"Extension of the content of the application - (no) after amendment"

Decisions cited:

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Catchword:

-

Case Number: T 0789/92 - 3.3.3

D E C I S I O N
of the Technical Board of Appeal 3.3.3
of 9 August 1995

Appellant: GENERAL ELECTRIC COMPANY
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Decision under appeal: Decision of the Examining Division of the European Patent Office dated 25 February 1992 refusing European patent application No. 88 901 688.7 pursuant to Article 97(1) EPC.

Composition of the Board:

Chairman: C. R. J. Gérardin
Members: H. H. R. Fessel
J. A. Stephens-Ofner

Summary of Facts and Submissions

- I. European patent application No. 88 901 688.7, filed on 20 January 1988, claiming the priorities of 27 February 1987 and 22 June 1987 from two earlier applications in the United States of America and published under the Patent Cooperation Treaty on 7 September 1988 with international publication No. WO88/06605, was refused by a decision of the Examining Division 2.1.15.012 of the European Patent Office dated 25 February 1992.

That decision was based on a set of 19 claims filed on 21 November 1988, which had been amended in response to an observation of lack of unity made in the International Search Report dated 25 July 1988.

- II. The reason for the decision was that the subject-matter as defined in Claim 1 extended beyond the content of the application as filed (Article 123(2) EPC), related to a group of inventions not linked by a single inventive concept and therefore offended the provisions of Article 82 EPC.

The following documents were cited in support of these objections:

- (1) FR-A-2 137 599, and
- (2) EP-A-198 338.

More specifically, it was stated that since spiro(bis)indane moiety and cyclic structure were already known from Claim 1 of document (1) and Claim 11 of document (2), every alternative specified in the

claims belonged to a different technical field and became a separate invention. The following groups of inventions were considered to be based on an single inventive concept:

1. A composition comprising cyclic polyamide oligomers of formula I of Claim 1 wherein Z^1 = radicals of formulae III and IV;
2. A composition comprising cyclic polyimide oligomers of formula I of Claim 1 wherein Z^1 = radicals of formulae V and VI;
3. A composition comprising cyclic poly(aryl ether ketone) or poly(aryl ether sulphone) oligomers of formula I of Claim 1 wherein Z^1 = radicals of formulae VII.

III. On 24 April 1992 a Notice of Appeal was lodged against that decision together with payment of the prescribed fee. The Statement of Grounds of Appeal was submitted together with that Notice of Appeal.

Together with the Statement of Grounds of Appeal the Appellants filed a set of 9 claims. Claim 1 was now specifically directed to the macrocyclic monomers and oligomers containing spiro(bis)indane moieties and imide moieties. Furthermore, the requirement that "b is from 0 to 90% of a plus b" was replaced by "b is from 0 to 11 and $a+b=12$ ".

They argued that the claimed subject-matter met the requirements of Article 123(2) and Article 82 EPC, since it was made clear that "a is from 1 to 12, b is

from 0 to 11 and $a+b=12$ " and the definition of the linking group Z^1 was restricted to the radicals of formulae V and VI of Claim 1.

- IV. The Appellants requested 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 9 filed on 24 April 1992.

Reasons for the Decision

1. The appeal is admissible.
2. The wording of the claims overcomes the objection under Article 123(2) EPC.
 - 2.1 With regard to the subject-matter originally claimed the scope of Claim 1 has been restricted to polyimides and polyamideimides having recurrent units of formulae III and IV respectively. Formulae III together with the meaning of Z^2 , R^4 and p derives from formulae (IX) in original Claim 13, when the polymer forms a macrocyclic structure together with the spiro(bis)indane moiety of formula (II); the same applies to formula IV together with the meaning of Z^3 , which is supported by original Claim 16. As to the new parameter b, it corresponds in substance to the parameter (12-a) in the application as originally filed.
 - 2.2 Dependent Claims 2 to 9 correspond, after appropriate adjustment, where necessary, of their appendancy, to original Claims 2 to 4 and to 13 to 17.

3. The definition of Z¹ also overcomes the objection under Article 82 EPC, which was the second ground of refusal of the application.

That definition, which now limits the scope of the linking group to polyimides and polyamideimides only, corresponds in fact to one of the compositions encompassed in the subject-matter as claimed before the Examining Division, thus to a composition forming an invention based on one single general inventive concept (cf. decision under appeal, page 4, second composition).

4. In view of the above the Board remits the case to the Examining Division 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 Examining Division for further prosecution.

The Registrar:

The Chairman:

E. Görgmaier

C. Gérardin