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D E C I S I O N
of 12 January 1999

Case Number: T 0503/96 - 3.5.2
Application Number: 88400267.6
Publication Number: 0281444
IPC: H01B 12/00
Language of the proceedings: EN

Title of invention:
Process for manufacturing a superconducting wire of compound
oxide-type ceramic

Patentee:
Sumitomo Electric Industries Limited

Opponent:
Vacuumschmelze GmbH, Hanau
Siemens AG

Headword:
-

Relevant legal provisions:
EPC Art. 114(2), 111(1), 104(1)

Keyword:
"Evidence of common general knowledge in the art introduced on
appeal too relevant to be disregarded"
"Remittal to opposition division"

Decisions cited:
T 0258/84, T 0273/84, T 0223/95, G 0010/91, T 0017/91,
T 0534/89, T 0198/88

Catchword:
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Boards of Appeal

Chambres de recours

Case Number: T 0503/96 - 3.5.2

D E C I S I O N
of the Technical Board of Appeal 3.5.2
of 12 January 1999

Appellant:
(Opponent)

Siemens AG
Postfach 22 16 34
80506 München (DE)

Other party:
(Opponent)

Vacuumschmelze GmbH, Hanau
-Bereich Verträge und Patente-
Grüner Weg 37
Postfach 2253
63412 Hanau (DE)

Representative:

Epping, Wilhelm, Dr.-Ing.
Patentanwalt
Postfach 22 13 17
80503 München (DE)

Respondent:
(Proprietor of the patent)

Sumitomo Electric Industries Limited
No. 15, Kitahama 5-chome
Higashi-ku
Osaka-shi
Osaka 541 (JP)

Representative:

Hirsch, Marc-Roger
Cabinet Hirsch
34 rue de Bassano
75008 Paris (FR)

Decision under appeal:

Interlocutory decision of the Opposition Division
of the European Patent Office posted 29 April
1996 concerning maintenance of the European
patent No. 0 281 444 in amended form.

Composition of the Board:

Chairman: W. J. L. Wheeler
Members: R. G. O'Connell
A. C. G. Lindqvist

Summary of Facts and Submissions

I. This is an appeal by opponent II (Siemens AG) as sole (remaining) appellant from the decision of the opposition division concerning the maintenance of European patent No. 0 281 444 in amended form.

The proprietor had also filed an appeal, but withdrew it by the letter dated 4 April 1997 following a communication from the board pointing out that this appeal appeared not to be admissible since the proprietor appeared not to have been adversely affected by the decision under appeal, given that the latter had effectively granted the proprietor's main request in the first instance proceedings.

The patent as approved by the opposition division has 23 claims; it has not been amended further on appeal. Claim 1 is worded as follows:

"1. A process for manufacturing a superconducting elongated article characterised in that it comprises the following steps: filling a metal pipe with a ceramic material powder consisting of a copper containing compound oxide having superconductivity, the metal of said pipe being Ag, Au, platinum metals comprising Pt, Pd, Rh, Ir, Ru and Os, and alloys containing them as the base metal, and another metal such as Cu, Cu alloys or stainless steel being arranged around said metal pipe, carrying out plastic deformation of said composite metal pipe filled with said ceramic material powder to reduce the cross section of said composite metal pipe, subjecting the deformed composite metal pipe to heat-treatment to

sinter said ceramic material powder filing (sic) said composite metal pipe, and then after this step of heat treatment, cooling said composite metal pipe containing the sintered ceramic material powder slowly at a rate of less than 50° C/min."

Claims 2 to 23 are dependent on Claim 1.

II. The following documents cited in support of the opposition remain relevant to the present appeal:

D1: IEEE Transactions on Magnetism, Vol. MAG-13, No. 1, January 1977, pages 836 to 839

D6: IEEE Transactions on Magnetism, Vol. MAG-19, No. 3, May 1983, pages 402 to 405

D7: "Superconductor Materials Science, Metallurgy, Fabrication and Applications", ISBN 0-306-40750-7, pages 431 to 442

D9: Physical Review Letters, Vol. 58, No. 9, 2 March 1987, pages 908 to 910.

With the statement of the grounds of appeal, the appellant filed the following additional documents:

D16: US-A-4 594 218

D17: US-A-3 623 221

D18: DE-B-1 640 573.

III. The appellant's original request was that the decision under appeal be set aside and that the patent be revoked (main request); auxiliarily that an additional search be ordered in respect of the subject-matter now claimed and that oral proceedings be held.

IV. In a communication accompanying a summons to oral proceedings the board informed the parties of its provisional views as follows:

- (i) the undisputedly new subject-matter of claim 1, as approved by the opposition division, appeared to involve an inventive step having regard to the prior art which was available to the opposition division;
- (ii) documents D16 to D18 appeared to be responsive, relevant and, having regard to the radical nature of the amendment to the claims, submitted in due time within the meaning of Article 114(2) and as such were not to be disregarded; the same applied to the new evidential aspect of D6;
- (iii) the case should be remitted to the opposition division for consideration of the new factual framework; cf "Case Law of the Boards of Appeal of the EPO", at section VI, A 6.9.1 and E 8);

and asked the parties to reconsider their requests for oral proceedings in the light of these observations.

V. Following receipt of this communication the appellant requested that the case be remitted directly to the opposition division without oral proceedings before the board, in particular for consideration of D16 to D18 (main request); auxiliarily that oral proceedings be held before the board.

VI. The respondent requests that the appeal be dismissed (main request). In the event that the board should decide not to disregard any of the new documents D16 to D18, or completely new arguments based on D6, the respondent auxiliarily requests that the board remit the case to the opposition division for consideration

of the issue of inventive step in the light of this new prior art, with an order for apportionment of the costs incurred by the respondent in considering these new documents. The respondent also requests oral proceedings on an auxiliary basis, in particular on the question of the admissibility of new arguments based on D6.

VII. The appellant argued essentially as follows:

Inventive step

- (i) The decision under appeal concluded that the subject-matter of claim 1 of the opposed patent as amended was new and involved an inventive step essentially because no prior art hinted at the features of - using the labelling in the decision under appeal - (iii) surrounding the metal pipe containing the superconductive powder with another metal such as Cu, Cu alloys and stainless steel and (iv) further processing the composite metal pipe; cf decision under appeal at point 8.

- (ii) The 'powder in pipe', or Kunzler technique had been used for exotic superconductive materials, long before the discovery of the high superconductive transition temperature cuprates, eg for the so-called Chevrel phase materials; cf D6, page 402, left column, penultimate paragraph, first three lines. (The latter document was mentioned in the opposed patent at page 4, lines 10 and 11, and referred to in the decision under appeal, albeit not completely

accurately.) This Kunzler technique had also been used for manufacturing high temperature superconductors of the Li-Ti-O system as mentioned in D1, page 836, left hand column, section I, first paragraph.

- (iii) In the case of the Chevrel phase materials it was also known not only to encase the powder in a single sheath but also to employ a double pipe comprising two different materials. Thus D6 taught the use of a Mo pipe encased in a stainless steel outer pipe; cf page 402, left hand column, last paragraph.
- (iv) Whereas it was true that the material of the inner pipe in D6 was not comprised of the materials specified in claim 1 as approved by the opposition division, newly cited D16 disclosed a Chevrel phase superconductive core encased in a Mo pipe lined with Ag; cf D16, column 2, lines 5 to 11 and claim 3 (sic; claim 2 was evidently meant).
- (v) In fact it was a completely standard technique in the art of fabricating commercially usable superconductors to provide a second pipe to encase a precursor conductive article comprising a single pipe enclosing a core of superconductive material; this was done either by way of additional cryogenic stabilisation (especially when the inner pipe was made of a very expensive material) or to increase mechanical strength. In this respect D17 and D18 were evidence of common general knowledge in the art which was so notorious that it should not, strictly speaking, require proof by the admission of these newly cited documents.

(vi) Additional search

The reasons given by the opposition division at point 3, second paragraph of the decision under appeal for not setting an additional search by the search division in train as provided for by the Guidelines D-VI 5 were not convincing. The appropriate criterion was not whether the 'composite pipe' feature was included in the classification units already searched, but whether the search division would have a specific reason for searching for this feature. In fact the manner in which this feature appeared in the application was not such as to enable the search division to recognise it as essential to the invention. It did not appear in the section headed " Summary of the invention"; it appeared in only one (example 10) of 18 examples and in the description it is only mentioned as a **possible** embodiment. The opposition division's reasoning was tantamount to excluding additional searches in principle and this impression was strengthened by the opposition division's implication that it was up to the opponent to carry out the additional search - and in a very short time (cf point 10 of the decision under appeal). In such circumstances subsequently filed relevant prior art documents should be admitted as a matter of course.

VIII. The respondent's arguments can be summarised as follows:

New documents and arguments on appeal

- (i) The new documents D16, D17 and D18 had not been submitted in due time by the opponent; following decisions T 17/91 and T 534/89 the board should disregard them pursuant to Article 114(2) EPC irrespective of relevance. D6 should also not be considered further in the way in which the opponent now seeks to use it, viz in relation to the composite pipe feature; this document was a European search report document which had been cited by the opponent for the first time in the oral proceedings before the opposition division (cf decision T 198/88) and only in connection with the 'powder in pipe' feature. In the first instance proceedings the opponent had relied on D9 for the composite pipe feature, the fact that he had failed with that argument did not justify the new use of an old document nor the admission of new documents.

- (ii) The appellant's argument that an additional search was required in view of the limited notice of the inclusion of the composite pipe feature in the claim was not well founded. This feature was included, albeit in different words, in the amended claims filed with the patent proprietor's letter of 16 May 1994, almost two years before the first instance oral proceedings on 22 March 1996, and was explicitly commented on by the opponent (now appellant) in his letter of reply dated 6 December 1994.

Reasons for the Decision

1. The appeal is admissible.
2. *Inventive step*

The first issue to be considered in the present appeal is whether the undisputedly new subject-matter of claim 1, as approved by the opposition division, involves an inventive step having regard to the prior art which was available to the opposition division. On this point the board agrees with the conclusion expressed at points 8, 11 and 12 and of the decision under appeal that the feature "another metal such as Cu, Cu alloys or stainless steel being arranged around said metal pipe" was not derivable in an obvious manner from the prior art then on file, in particular not from D7 (erroneously referred to as D9 at point 11 of the decision under appeal).

3. *Newly cited documents*

- 3.1 As regards the issue of whether the documents D16 to D18, introduced on appeal, should be disregarded, the board notes that these new documents in combination with the document D6 are alleged to substantiate the appellant's contention made at the first instance oral proceedings (cf point 32 of the minutes of the oral proceedings) that the 'pipe in pipe' technique was part of the common general knowledge in the art in relation to the fabrication of elongate articles of brittle superconductive materials by the 'powder in pipe' (Kunzler) technique. On the basis of a *prima facie* consideration of these documents the board concludes that they are relevant in the sense that there is at least an arguable case that these documents substantiate the opponent's assertions. This board has

previously expressed the view in decision T 223/95 of 4 March 1997 (not published in OJ EPO) at point 7 that the need to substantiate an allegation of common general knowledge in the art can, in appropriate circumstances, justify the filing of new evidence on appeal. In the present case the circumstances which speak for the appellant are the radical amendments to the claims, in particular the restriction to the composite pipe (or 'pipe in pipe') feature which was taken from the description of one out of 18 examples and which had not appeared in any of the 90 claims of the originally filed application nor in any of the 25 claims of the patent as granted by the examining division. The wording of the present claim 1 was first communicated to the appellant as a fifth auxiliary request by letter dated 30 January 1996 some seven weeks prior to the oral proceedings on 22 March 1996. In the judgement of the board, failure to provide evidence substantiating an assertion of common general knowledge in the art within such a period is not necessarily to be regarded as culpable delay, since more is required than simply establishing that a particular technique was known or used; it is also a matter of the degree to which the technique was known or practised in the art concerned. Accordingly the board considers the evidence filed on appeal to be relevant, responsive and submitted in due time within the meaning of Article 114(2) EPC. In coming to this conclusion the board has given significant weight to the radical nature of the amendment to the claims.

- 3.2 The respondent has argued that in fact the opponent (now appellant) had notice of the amendment contemplated from the auxiliary request filed with the letter of 16 May 1994 - almost two years prior to the first instance oral proceedings - as was confirmed by the opponent's reply of 6 December 1994 in which he demanded an additional search of the feature concerned.

The board is not persuaded by this argument since the wording of the amendment at that time, as far as the disputed feature was concerned, was "said metal pipe comprising at least on its inside a layer inert to the superconducting ceramic materials under heated conditions". The permissibility of this amendment was contested by the opponent in the reply of 6 December 1994 and this position was supported by the opposition division - albeit on the ground of Article 123(2) rather than Article 123(3) - at the oral proceedings (cf minutes at point 12ff). Only with hindsight could this impermissible functional generalisation be seen as foreshadowing a restriction to the 'pipe in pipe' concept of example 10.

4. *Additional search*

- 4.1 The board agrees with the appellant that the opposition division adopted the wrong criterion in considering the need for an additional search. The question to be answered in relation to a restrictive amendment is not primarily **where** the search division searched but **what** it can reasonably be assumed to have searched for. The pragmatic practice of the search division is set out at Guidelines B-III 3.6: "In principle, and in so far as possible and reasonable, the search should cover the entire subject-matter to which the claims are directed or to which they might reasonably be expected to be directed after they have been amended. ...Nevertheless, reasons of economy may make certain restrictions necessary, for example when there is a broad claim and many examples and it is not possible to foresee which will be the subject of amended claims."

- 4.2 Whether or not to commission an additional search in a particular case is a matter for the administrative discretion of the opposition division, but if an inappropriate criterion is invoked in exercising this discretion, doubt is inevitably raised as to whether the discretion was reasonably exercised. In line with its judgement that the opponent could not reasonably have anticipated the amendment in question, the board considers it unrealistic to impute to the search division that degree of foresight which is implied by the view taken by the opposition division.
- 4.3 It need hardly be said that the opposition procedure is not intended to provide a forum for an opponent to criticise the search; nevertheless since in case of amendment of the claims in the course of opposition or appeal proceedings, such amendments are to be fully examined as to their compatibility with the requirements of the EPC (opinion G 10/91, OJ EPO 1993, 420, at point 19) it is not inappropriate for an opponent to make observations on a possible need for an additional search to enable this full examination to be carried out (Guidelines D-VI 5). The judgement on whether an additional search is necessary and the obligation to perform this search if it is judged to be necessary are administrative matters for the EPO and should not be confused with or traded off against the opponent's procedural right to have due notice of this kind of radical amendment so as to allow time to prepare an appropriate response; it is a matter for the opponent whether he conducts a search for prior art relevant to the newly claimed subject-matter.

4.4 The board is reluctant to fetter the administrative discretion of the opposition division in relation to the need for an additional search and will, therefore, in the present case, not go further than suggesting that the opposition division should reconsider the matter on remittal (cf order below) in the light of the above comments and having regard to the documents D16 to D18 cited on appeal.

5. *Remittal*

5.1 In order not to deprive the parties of the opportunity to argue the new situation at two instances, and in conformity with the requests of both parties (cf points V and VI above), the board considers it appropriate to make use of its powers under Article 111(1) EPC to remit the case to the department of first instance for further prosecution, cf decisions T 258/84 (OJ EPO, 1987, 119) and T 273/84 (OJ EPO, 1986, 346).

5.2. The board has deliberately refrained from going into the merits of the parties' arguments relating to the interpretation of the newly cited documents D16 to D18 in order not to preempt the consideration of these matters by the department of first instance.

6. *Costs*

6.1 Regarding costs, Article 104(1) EPC specifies that:

"Each party to the proceedings shall meet the costs he has incurred unless a decision of an Opposition Division or a Board of Appeal, for reasons of equity,

orders, in accordance with the Implementing Regulations, a different apportionment of costs incurred during taking of evidence or in oral proceedings."

6.2 As regards equity, for the reasons given at points 3.1 and 3.2 above, the board is not persuaded by the respondent's argument that the opponent was culpable for not producing the documents D16 to D18 sooner. The same applies to the new evidential aspect of D6.

6.3 In the present case, the board's decision to remit the case immediately to the department of first instance means that the respondent has not incurred any undue cost burden in relation to the present appeal. Accordingly, the board does not see any reason of equity to order a different apportionment of costs in relation to these proceedings.

6.4 The question of costs in subsequent proceedings before the opposition division is left for consideration by the opposition division.

7. *Other matters*

Both parties request that, on remittal, oral proceedings be appointed before the opposition division. In the view of the board, an order to this effect would only be called for if the opposition division had failed to accord a party its right to oral proceedings under Article 116(1) EPC. The normal procedure is that a request for oral proceedings before the opposition division pursuant to Article 116(1)

should be directed to that department which is then responsible for applying the provisions of that article. Accordingly the parties are reminded that their requests for oral proceedings should be renewed in the resumed first instance proceedings.

Order

For these reasons it is decided that:

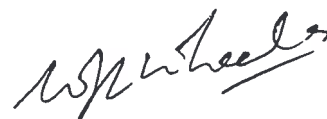
1. The decision under appeal is set aside.
2. The case is remitted to the department of first instance for further prosecution.
3. The respondent's request for an apportionment of costs is refused.

The Registrar:



M. Beer

The Chairman:



W. J. L. Wheeler