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D E C I S I O N
of 10 March 1997

Case Number: T 0956/96 - 3.3.3

Application Number: 90118749.2

Publication Number: 0421306

IPC: D01F 11/12

Language of the proceedings: EN

Title of invention:

Fluorinated graphite fibers and method of manufacturing them

Applicant:

YAZAKI CORPORATION, et al

Opponent:

-

Headword:

Grounds of Appeal

Relevant legal provisions:

EPC Art. 108

EPC R. 65(1)

Keyword:

"Admissibility of the appeal (no) - inadequate substantiation"

Decisions cited:

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Catchword:

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Case Number: T 0956/96 - 3.3.3

D E C I S I O N
of the Technical Board of Appeal 3.3.3
of 10 March 1997

Appellant: YAZAKI CORPORATION
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Tokyo 108 (JP)

Representative: Grünecker, Kinkeldey
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Decision under appeal: Decision of the Examining Division of the
European Patent Office posted 4 June 1996
refusing European patent application
No. 90 118 749.2 pursuant to Article 97(1) EPC.

Composition of the Board:

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

Summary of Facts and Submissions

- I. European patent application 90 118 749.2, publication number 0 421 306, filed on 28 September 1990, relating to fluorinated graphite fibres and method of manufacturing them was refused on 4 June 1996 by the Examining Division 2.1.08.024.
- II. The decision was based on pages 1-25 as originally filed and a set of 4 claims of which Claim 1 had been filed on 16 October 1995 and Claims 2-4 on 28 February 1995.

That Claim 1 read as follows:

"Fluorinated graphite fibres comprising an intercalated compound of graphite fibres which have a diameter of 0.1 to 0.5 μm , a length of 10 to 1000 μm , and a three-dimensional crystal structure in which graphite hexagonal network faces are substantially in parallel with the axis of fibres and oriented in a coaxial manner, and fluorine, wherein the length of repeating periods in the direction of C-axis of the crystals coexist within a range of from 5 to 24 \AA ."

The reason for the refusal was that the amended Claim 1 contained subject-matter extending beyond the content of the application as filed (Article 123(2) EPC).

In that decision the Examining Division also expressed its views upon the novelty and inventive step of some hypothetical claims that would have met the requirements of Article 123(2) EPC.

III. On 13 August 1996 the Appellant (Applicant) filed a Notice of Appeal together with payment of the prescribed fee. It requested that a patent be granted on the basis of the papers on file. With the Statement of Grounds of Appeal filed on 10 October 1996 a new set of claims was filed replacing claims 1-4 as on file and used as the basis for the subject-matter of the appeal. New Claim 1 was said to be based upon originally filed claim 1 defining the graphite fibres by length and diameter according to the graphite fibres as disclosed in Example 2.

In addition thereto the Appellant explicitly said: "The new wording of claim 1 "fluorinated graphite fibres comprising an intercollated compound of graphite fibres having a diameter of ..." wherein it is now clarified that this feature relates to the raw material."

Further arguments related to novelty and inventive step.

IV. The Appellant requested that a patent be granted on the basis of Claims 1-4 and following description:

pp. 1, 3, 10, 12 and 14 as filed with the Statement of Grounds of Appeal;

pp. 2, 4 to 9, 11, 13 and 15 to 21 as originally filed.

Reasons for the Decision

1. The appeal complies with Articles 106 and 107 and also with the first two sentences of Article 108 EPC and with Rule 64 EPC. However, it remains to be considered whether the requirement of Article 108, last sentence, EPC for filing, within four months after the date of

notification of the decision by the first instance, a written statement setting out the grounds of appeal, had been observed in the present case.

2. As mentioned in paragraph II above, the ground of refusal of the application in suit was an amendment introduced into Claim 1 thereby extending it beyond the contents of the application as filed.

The new amended Claim 1 filed with the Statement of Grounds of Appeal differs from that refused by the Examining Division in that "...graphite fibres **which have** a diameter of...." was replaced by ".....graphite fibres **having** a diameter of....". This is not an amendment leading to a subject-matter being any different from that of the claim as rejected. From the amended claim alone it is impossible to derive the legal or factual reasons why the decision of the Examining Division should be set aside. The argument that this amendment clarified that this feature relates to the raw material is, in the light of the above wording , without any substance. The Appellant has thus left it entirely to the Board to conjecture in what respect the Appellant may consider the decision under appeal to be defective i.e. why the reasons given under A as to the non compliance with the requirements of Article 123(2) EPC do not apply. This is just what the requirement that grounds for appeal should be filed, is designed to prevent. This is particularly so in a case such as the present one, where a very detailed and complex analysis of the originally filed application was given.

3. It follows from the above considerations that the mere amendment of the wording of a claim the subject-matter of which was objected under Article 123(2) EPC does not comply with the requirements of Article 108, last sentence, EPC. Consequently, and in accordance with Rule 65(1) EPC, the appeal has to be rejected as inadmissible.

4. Since the appeal is not admissible, the auxiliary request for oral proceedings is of no effect.

Order

For these reasons it is decided that:

The appeal is rejected as inadmissible.

The Registrar:



E. Görgmeier

The Chairman:



C. Gérardin

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