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D E C I S I O N
of 5 May 2004

Case Number: T 0402/00 - 3.3.1

Application Number: 96203084.7

Publication Number: 0760356

IPC: C07C 17/20

Language of the proceedings: EN

Title of invention:

Process for the manufacture of pentafluoroethane

Applicant:

E.I. DU PONT DE NEMOURS AND COMPANY

Opponent:

-

Headword:

Pentafluoroethane/ DU PONT

Relevant legal provisions:

EPC Art. 76(1)

Keyword:

"Divisional application (not allowable) - extends beyond parent application - fresh combination of features"

Decisions cited:

T 0423/03

Catchword:

-



Case Number: T 0402/00 - 3.3.1

D E C I S I O N
of the Technical Board of Appeal 3.3.1
of 5 May 2004

Appellant:

E.I. DU PONT DE NEMOURS AND COMPANY
1007 Market Street
Wilmington,
Delaware 19898 (US)

Representative:

Woodcraft, David Charles
Brookes Batchellor
102-108 Clerkenwell Road
London EC1M 5SA (GB)

Decision under appeal:

Decision of the Examining Division of the
European Patent Office posted 11 November 1999
refusing European application No. 96203084.7
pursuant to Article 97(1) EPC.

Composition of the Board:

Chairman: A. J. Nuss
Members: R. Freimuth
S. U. Hoffmann

Summary of Facts and Submissions

- I. The appeal lodged on 6 January 2000 lies from the decision of the Examining Division posted on 11 November 1999 refusing European patent application No. 96 203 084.7 (European publication No. 760 356) which is a divisional application of European patent application No. 92 914 824.5 filed as international application having the publication No. WO 92/19576.
- II. The decision of the Examining Decision was based on the two sets of claims according to the then pending main and auxiliary request 1, both submitted on 28 November 1998, and on the set of claims according to the then pending auxiliary request 2 submitted at the oral proceedings before that Division.

The Examining Division refused the application on the ground of lack of support by the description and lack of clarity. It held in particular that the subject-matter claimed according to the then pending main and auxiliary request 1 did not satisfy the requirements of Article 84 EPC since the essential feature of the invention, namely that the Cr_2O_3 catalyst was prepared by pyrolysis of ammonium dichromate, was missing in claim 1. The product claims of the then pending auxiliary request 2 were found to be not clear, thus contravening the provisions of Article 84 EPC.

- III. In a communication pursuant to Article 110 EPC the Board addressed further possible deficiencies; thus, the Board pointed *inter alia* to the requirements of Article 84 EPC stipulating that the claims shall define the matter for which protection is sought, to those of

Article 123 (2) EPC stipulating that any amendment must not extend beyond the content of the application as filed and to those of Article 76 (1) EPC stipulating that any amendment must not extend beyond the content of the earlier parent application which was the basis for the present divisional application.

IV. At the oral proceedings before the Board held on 5 May 2004 the Appellant (Applicant) submitted a fresh set of seven claims as sole request superseding any previous request. Independent claim 1 read as follows:

"1. A process for the preparation of CF_3CHF_2 (125) comprising:

- (a) contacting HF with at least one reactant comprising a material selected from the group consisting of CF_3CHCl_2 (123); $\text{CClF}_2\text{CHClF}$ (123a), CF_3CHClF (124), and $\text{CHF}_2\text{CClF}_2$ (124a) in the gas phase in the presence of a Cr_2O_3 catalyst having an alkali metal content of not more than 100 ppm at a temperature of 300° to 370°C and an HF/reactant mole ratio of 2/1 to 10/1 for a time of 10 to 100 seconds to form a product stream comprising at least 50 mole % CF_3CHF_2 (125) and less than 2 mole % CF_3CClF_2 ; and thereafter,
- (b) separating and recovering CF_3CHF_2 from the product stream."

V. The Appellant submitted that this fresh set of claims satisfied the requirements of Article 76(1) EPC. Although there was no explicit counterpart for present claim 1 to be found in the earlier parent application, that application in general, specifically the description thereof, provided a proper basis for this

claim. The particular "HF/reactant mole ratio of 2/1 to 10/1" specified in present claim 1 was based on page 6, lines 3 and 4 of the earlier parent application. This part of the description referred to the range of the mole ratio of HF to a reactant, namely CF_3CHCl_2 ; however, the skilled person would read that disclosure using common sense and, hence, copy and apply that specific range also to any of the other reactants specified in claim 1.

VI. The Appellant requested that the decision under appeal be set aside and the case be remitted to the first instance for further prosecution on the basis of the sole request submitted at the oral proceedings before the Board.

VII. At the end of the oral proceedings the decision of the Board was announced.

Reasons for the Decision

1. The appeal is admissible.

2. *Amendments (Article 76(1) EPC)*

2.1 The filing of a divisional application is governed by Article 76 EPC which stipulates in paragraph 1, second sentence that a divisional application "may be filed only in respect of subject-matter which does not extend beyond the content of the earlier application as filed". Thus, in case of a divisional application, the requirement of Article 76(1) EPC is to be satisfied separately from and supplementary to that of

Article 123(2) EPC. While the former ensures that a divisional application does not extend beyond the content of the earlier parent application, the latter ensures that, once the provisions of Article 76(1) have been met, the divisional application may not be amended after its filing in such a way that it contains subject-matter extending beyond the content of the divisional application as filed (see e.g. decision T 423/03, point 3 of the reasons, not published in OJ EPO).

2.2 In order to determine whether or not the divisional application, in particular claim 1 thereof, offends against the provisions of Article 76(1) EPC, in accordance with the established jurisprudence it has to be examined whether technical information has been introduced into that divisional application which a skilled person would not have objectively and unambiguously derived from the earlier parent application as filed.

2.3 Claim 1 of the present divisional application specifies "an HF/reactant mole ratio of 2/1 to 10/1" while the reactants are selected in that claim from CF_3CHCl_2 , $\text{CClF}_2\text{CHClF}$, CF_3CHClF and $\text{CHF}_2\text{CClF}_2$. Thus, claim 1 specifies any of those reactants to satisfy this particular numerical range of the mole ratio to HF.

However, the earlier parent application as filed discloses on page 6, lines 3 and 4 only that "the HF/ CF_3CHCl_2 mole ratio" is within the range of 2/1 to 10/1. In the Board's judgement, the skilled person derives from that part of the earlier parent application as filed nothing more than the bare disclosure of that

particular combination, namely to apply the numerical range of 2/1 to 10/1 to the mole ratio of HF with the specific reactant CF_3CHCl_2 . Therefore the disclosure of that particular combination in the earlier parent application as filed cannot support the generalisation indicated in claim 1 of the present divisional application which results in applying the numerical range of 2/1 to 10/1 also to the mole ratio of HF with any of the other reactants specified in claim 1, i.e. with the reactants $\text{CClF}_2\text{CHClF}$, CF_3CHClF and $\text{CHF}_2\text{CClF}_2$. To dismantle the numerical range of 2/1 to 10/1 for the mole ratio from the one particular reactant CF_3CHCl_2 and to generalise that numerical range to any of the other reactants specified in claim 1, provides the skilled person with technical information which is not directly and unambiguously derivable from the earlier parent application as filed.

- 2.4 The Appellant argued that the skilled person would read that disclosure using common sense and, hence, apply that specific numerical range also to any of the other reactants specified in claim 1

However, the finding of whether or not a divisional application extends beyond the content of the earlier parent application as filed pursuant to Article 76(1) EPC is not a matter of common sense, but rather the matter which technical information a skilled person would have objectively and unambiguously derived from that earlier parent application (cf. point 2.2 *supra*). Therefore the Appellant's argument cannot challenge the above finding that claim 1 generates fresh technical information.

2.5 The Board concludes that the HF/reactant mole ratio in claim 1 objected to in point 2.3 *supra* extends the subject-matter claimed beyond the content of the earlier parent application as filed, thus, contravening the provisions of Article 76(1) EPC. Therefore there is no need for the Board to examine and to decide whether or not further features of claim 1 are in keeping with the requirements of Article 76(1) EPC.

3. In these circumstances, the Appellant's request is not allowable and must be rejected.

Order

For these reasons it is decided that:

The appeal is dismissed.

The Registrar:

The Chairman:

N. Maslin

A. Nuss