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D E C I S I O N
of 26 June 2001

Case Number: T 0279/01 - 3.4.2

Application Number: 94901416.1

Publication Number: 0667982

IPC: H01M 4/00

Language of the proceedings: EN

Title of invention:

Optimized positive electrode for alkaline cells

Patentee:

OVONIC BATTERY COMPANY, INC.

Opponent:

H.C. STARCK GmbH & Co. KG

Headword:

-

Relevant legal provisions:

EPC Art. 111(1)

Keyword:

"Amended claims filed by the appellant (patentee) with its
statement of the grounds of appeal"

"Remittal to the first instance"

Decisions cited:

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Catchword:

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Case Number: T 0279/01 - 3.4.2

D E C I S I O N
of the Technical Board of Appeal 3.4.2
of 26 June 2001

Appellant: OVONIC BATTERY COMPANY, INC.
(Proprietor of the patent) 1707 Northwood
Troy, MI 48084 (US)

Representative: Kügele, Bernhard
NOVAPAT-CABINET CHEREAU
9, Rue du Valais
CH-1202 Genève (CH)

Respondent: H.C. STARCK GmbH & Co. KG
(Opponent) Im Schleeke 78-91
D-38642 GOSLAR (DE)

Representative: Drope, Rüdiger, Dr.
c/o Bayer AG
Konzernbereich RP
Patente und Lizenzen
D-51368 Leverkusen (DE)

Decision under appeal: Decision of the Opposition Division of the
European Patent Office posted 10 January 2001
revoking European patent No. 0 667 982 pursuant
to Article 102(1) EPC.

Composition of the Board:

Chairman: E. Turrini
Members: A. G. Klein
G. E. Weiss

Summary of Facts and Submissions

I. European patent No. EP-A-0 667 982 (Application No. 94 901 416.1, International Publication No. WO 94/11910) was granted with a set of claims of which claim 1, the only independent claim, after correction of an obvious clerical error ("Hi" was changed to "Bi") reads as follows:

"1. A positive electrode for use in alkaline rechargeable electrochemical cells comprising: an active material comprising a compositionally and structurally disordered multiphase nickel hydroxide host matrix which includes at least 6% Co as modifier and optionally additional modifiers chosen from the group consisting of F, Li, Na, K, Mg, Ba, Ln, Se, Nd, Pr, Y, Co, Zn, Al, Cr, Mn, Fe, Cu, Zn, Sc, Sn, Sb, Te, Bi, Ru and Pb."

II. The patent was opposed on the grounds that its subject-matter lacked novelty and inventive step, and that it was not disclosed in a manner sufficiently clear and complete for it to be carried out by a skilled person.

The patentee did not present any submissions in defence of the patent in the course of the opposition procedure.

The patent was revoked by the opposition division for lack of novelty of its subject-matter.

III. The appellant (patentee) filed an appeal against the revocation of the patent.

In its statement of the grounds of appeal of 18 May

2001 the appellant did not contest the correctness of the opposition division's decision, but requested the maintenance of the patent with an amended set of claims of which claim 1, the only independent claim, after correction of the same clerical error as for the granted claim 1 (Hi was changed to Bi), reads as follows:

"1. A positive electrode for use in alkaline rechargeable electrochemical cells comprising: an active material comprising a compositionally and structurally disordered multiphase nickel hydroxide host matrix which includes at least three modifiers chosen from the group consisting of F, Li, Na, K, Mg, Ba, Ln, Se, Nd, Pr, Y, Co, Zn, Al, Cr, Mn, Fe, Cu, Zn, Sc, Sn, Sb, Te, Bi, Ru and Pb; wherein one of said at least three modifiers is Co in an amount of at least 6%."

IV. The appellant's statement of the grounds of appeal was notified to the respondent (opponent) on 25 May 2001 with a delay of four months for any submissions in answer.

In a communication dated 11 June 2001 the board informed the parties that in consideration of the changes brought to claim 1 it intended to remit the case right away to the opposition division for further prosecution on the basis of the amended set of claims, and that the submission of substantial arguments on the merits of the amended claims did not appear to be necessary at this stage. In order to avoid further delaying of the procedure the board also invited the respondent not to await the expiry of the four months

delay given in the communication of 25 May 2001 for filing any submissions, or for confirming that it did not in the circumstances intend to file any submission at this stage.

The respondent confirmed by a letter dated 18 June 2001 that it would not present any submissions with concern to whether the case should be remitted to the opposition division. He expressly reserved the right to present substantial arguments as to the merits and that it expected that a new due date for doing so will be set by time.

Reasons for the Decision

1. The appeal is admissible.
2. The active material of the positive electrode set out in claim 1 as granted, on which the opposition division's revocation was based, comprised at least 6% Co, and **only optionally** additional modifiers chosen from the group set out in the claim, in an **unspecified number**.

Present claim 1 as amended now comprises the additional limitation that the active material of the positive electrode in addition to the at least 6% Co **necessarily** also comprises **at least two** further modifiers chosen from the group set out in the claim.

3. The questions of whether the new combination of features as now defined in claim 1, which apparently

was not recited in any of the claims as originally filed or as granted, has been adequately disclosed in the application documents as originally filed and of whether it is patentable have not yet been examined by the opposition division.

Should these issues be resolved in favour of the appellant, the relevance of the ground of opposition based on an alleged insufficiency of the disclosure, which was also raised in the notice of opposition but not considered by the opposition division so far, would still have to be examined.

Thus, in order not to deprive the parties of their right to having the case considered by two instances, the board at present deems it appropriate to make use of the possibility given to it under Article 111(1) EPC to remit the case right away to the opposition division for further prosecution on the basis of the newly filed version of the claims.

Order

For these reasons it is decided that:

1. The decision under appeal is set aside.
2. The case is remitted to the first instance for further prosecution.

The Registrar:

The Chairman:

P. Martorana

E. Turrini