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D E C I S I O N
of 11 October 2005

Case Number: T 0706/02 - 3.4.02

Application Number: 97121641.1

Publication Number: 0849378

IPC: C25B 11/06

Language of the proceedings: EN

Title of invention:

Low hydrogen overvoltage cathode and process for production thereof

Applicant:

Tosoh Corporation

Opponent:

-

Headword:

-

Relevant legal provisions:

EPC Art. 111(1), 123(2)

Keyword:

"Amendments - added subject-matter (yes)"

"Allowability of disclaimer - accidental anticipation (no)"

"Request of remittal (not allowed)"

Decisions cited:

G 0010/93, G 0001/97, G 0001/03, T 0219/93, T 0740/98,
T 0500/00

Catchword:

-



Case Number: T 0706/02 - 3.4.02

D E C I S I O N
of the Technical Board of Appeal 3.4.02
of 11 October 2005

Appellant: Tosoh Corporation
4560, Kaisei-cho Shinnanyo-shi
Yamaguchi-ken, 746-8501 (JP)

Representative: Kügele, Bernhard, et al
Novagraaf SA
25, Avenue du Pailly
1220 Les Avanchets
CH-Geneva (CH)

Decision under appeal: Decision of the Examining Division of the
European Patent Office posted 6 February 2002
refusing European application No. 97121641.1
pursuant to Article 97(1) EPC.

Composition of the Board:

Chairman: A. G. Klein
Members: F. J. Narganes-Quijano
J. H. P. Willems

Summary of Facts and Submissions

- I. The appellants (applicants) lodged an appeal against the decision of the examining division refusing European patent application No. 97121641.1 (publication No. 0849378).

In its decision the examining division held that the subject-matter of claim 1 of the request then on file did not involve an inventive step over the prior art (Articles 52(1) and 56 EPC). Claim 1 was directed to a low hydrogen overvoltage cathode comprising a coating layer, and the claim specified, among other negative features, that "the coating layer [...] does not contain phosphorous".

- II. In their statement setting out the grounds of appeal the appellants submitted an amended set of claims, and requested that the decision under appeal be set aside and that the case be remitted to the examining division for further prosecution. The amended claim 1 included the same negative features as the claim 1 upon which the contested decision was based.

- III. By a summons dated 13 April 2005, and in accordance with an auxiliary request of the appellants, oral proceedings were appointed on 11 October 2005. In a communication pursuant to Article 11(1) of the Rules of Procedure of the Boards of Appeal (RPBA) annexed to the summons to attend oral proceedings, the Board referred, *inter alia*, to the English translation of document

D3: JP-A-57-60086

considered by the examining division during the first-instance proceedings, and to the requirements for the admissibility of disclaimers set out in decision G 1/03 (OJ EPO 2004, 403) of the Enlarged Board of Appeal. In its communication the Board gave a preliminary, non-binding assessment of the case and noted in particular that:

- (a) The Board would consider the remittal of the case for further prosecution (Article 111(1) EPC) only if there are special reasons for doing so.
- (b) The negative feature of claim 1 according to which the coating layer "does not contain phosphorous" does not appear to be supported by the application as originally filed (Article 123(2) EPC).
- (c) Disregarding the negative features of claim 1 that do not appear to be supported by the application as filed, examples 6 to 9 of document D3 would appear to result inevitably in a low hydrogen overvoltage cathode as that defined in claim 1. In addition, document D3 (abstract) addresses the same problem considered in the application, i.e. lowering the hydrogen overvoltage of cathodes for electrolysis of water or aqueous solutions of alkali metal chlorides (first paragraph of the description and the two last paragraphs on page 3 of the application), and, in addition, the document proposes - as the application does - forming the cathodes by electro-deposition of a coating layer on an electro-conductive base material by means of a plating bath containing nickel ions and organic compounds. Consequently,

document D3 cannot be considered to represent an accidental anticipation within the meaning of decision G 1/03 (point 2.2.2 of the reasons). It follows that the negative feature of claim 1 according to which "the coating layer does not contain phosphorous", interpreted as a disclaimer based on the disclosure of document D3, does not appear to be admissible (Article 123(2) EPC, and G 1/03, points 2.3.4 and 2.6.5 of the reasons together with point 2.1, second subparagraph of the order).

- IV. In reply to the summons to oral proceedings, the appellants filed by letter dated 1 September 2005 an amended set of claims including a claim 1 containing the negative feature that the "coating layer does not contain phosphorous". The appellants requested that the oral proceedings be cancelled, and that the case be remitted to the examining division for further prosecution or, on an auxiliary basis, that the proceedings be continued in writing.

In reply to a fax by the Board informing the appellants that the oral proceedings were maintained, the appellants informed the Board that they would not attend the oral proceedings.

- V. Oral proceedings were held before the Board in the absence of the appellants.

At the end of the oral proceedings the Board gave its decision.

VI. Claim 1 according to the present request of the appellants reads as follows:

"A low hydrogen overvoltage cathode comprising an electroconductive base material and a coating layer; wherein said coating layer contains:

at least one organic compound selected from the group consisting of amino acids, monocarboxylic acids, dicarboxylic acids, monoamines, diamines, triamines, and tetramines, and derivatives thereof at a carbon content of from 0.5 % to 18 % by weight, and

a metal component selected from the group consisting of nickel, nickel-iron, nickel-cobalt irons, or nickel-indium at an indium content ranging from 1 % to 90 %; and

wherein said coating layer does not contain phosphorous."

VII. The arguments of the appellants in support of their requests are essentially the following:

During the first-instance proceedings the admissibility of the disclaimers introduced in the claims had never been discussed or questioned by the examining division. Thus, while all the discussions, arguments and strategies of the appellants until the Board issued the summons to oral proceedings were developed in good faith on the assumption that the disclaimers contained in the claims were admissible, they were surprised by the application by the Board of decision G 1/03 to the present case and by the Board's negative preliminary opinion on the admissibility of the disclaimers. For this reason, in order to preserve all the rights of the appellants and taking into account that they should

have the right to two instances (T 219/93), the case should be remitted to the examining division for further prosecution, in particular for the assessment of the admissibility of the disclaimers under G 1/03.

The feature of claim 1 excluding phosphorous is based on the application as originally filed since the application does not mention phosphorous or the use of phosphorous. Therefore, the man skilled in the art knows from the description that no phosphorous is used. Consequently, the feature excluding phosphorous is not to be considered as a disclaimer in the sense of decision G 1/03, but as a further feature based on the description.

Reasons for the Decision

1. The appeal is admissible.

2. *Request for cancellation of the oral proceedings and remittal of the case, and for continuation of the proceedings in writing on an auxiliary basis*
 - 2.1 In reply to the summons to oral proceedings, the appellants requested the cancellation of the oral proceedings. The appellants, however, did not advance any reason in support of their request, nor did they allege any special circumstance preventing them from attending the oral proceedings. Nor was the Board aware of any change of facts that would have rendered the oral proceedings unnecessary or superfluous, or of any impediment for holding the oral proceedings on the date fixed by the summons.

Thus, in the absence of any good reason or special circumstance for cancelling the oral proceedings as requested by the appellants, the Board maintained the oral proceedings which were held on the date fixed by the summons and in the absence of the appellants pursuant to Rule 71(2) EPC and Article 11(3) RPBA.

- 2.2 The appellants also requested that the case be remitted to the examining division for further prosecution, and in particular for the assessment of the admissibility under Article 123(2) EPC of the negative feature of claim 1 according to which "the coating layer does not contain phosphorous". In support of their request, the appellants have submitted that the admissibility of the disclaimers has not been previously discussed or questioned by the examining division, and that they were surprised by the application by the Board in the present case of decision G 1/03 and by the Board's preliminary opinion on the allowability under Article 123(2) EPC of the amendments to the claims.

The aforementioned negative feature, however, was already present in claim 1 upon which the contested decision was based, and the examining division already took into consideration the negative feature in the assessment of the patentability of the claimed subject-matter. Thus, although - as submitted by the appellants - the admissibility of the negative feature was neither discussed nor questioned by the examining division during the first-instance proceedings, the examining division had already assessed - if not explicitly, at least implicitly - the admissibility of the amendment to claim 1 by way of introduction of the negative

feature referred to above. In these circumstances, the Board sees no reason for remitting the case for reconsideration by the examining division of the admissibility of the amendment.

The appellants have also regarded the issuance of decision G 1/03 (OJ EPO 2004, 403) during the present appeal as an additional reason for remittal. However, the issuance of a decision of the Enlarged Board of Appeal during the appeal proceedings of an appeal case pending before the Boards of Appeal, and having a potential impact on the appeal case, does not constitute *per se* a reason for the remittal of the case. This is the more so as in decision G 1/03 the Enlarged Board of Appeal has only clarified and confirmed - at least as far as the issues that are pertinent for the present case are concerned, i.e. the admissibility of disclaimers based on a non-accidental anticipation - previous case-law of the Boards of Appeal and has raised no particular issue that would have required a re-assessment of the case on a new legal basis.

In addition, contrary to the appellants' contention, in proceedings before the EPO there is no absolute right of a party to have every aspect of a case decided by two instances. As confirmed in decisions G 10/93 (OJ EPO 1995, 172, points 3 to 5 of the reasons) and G 1/97 (OJ EPO 2000, 322, point 2(a) of the reasons, second paragraph), it is within the discretion of the Board under Article 111(1) EPC to decide itself an issue raised during appeal or to refer the matter back to the first instance for decision, depending on the particular circumstances of the individual case (see "Case Law of the Boards of Appeal" EPO, 4th ed., 2001,

chapter VII, section D.9). In cases such as the present, where the examining division has assessed the patentability of a claim already containing the amendment at issue and consequently has considered - if not implicitly, at least tacitly - the amendment as admissible, the Board sees no reason for remitting the case for the only purpose of giving the examining division the opportunity to reconsider its view on the admissibility of the amendment.

The appellants have also referred to decision T 219/93 (not published in OJ EPO) in support of their request for remittal. This decision, however, concerns the circumstances giving rise to interlocutory revision under Article 109(1) EPC (point 4 of the reasons). In addition, the decision stresses the discretion conferred upon the Boards of Appeal by Article 111(1) EPC, second sentence in considering remittal of a case for further prosecution (point 2.1 of the reasons), and refers to the admissibility of amendments under Article 123(2) EPC as a precondition for considering setting aside of a decision of the examining division refusing an application (point 2.2). Thus, the Board cannot see in decision T 219/93 a support for the appellants' request for remittal.

- 2.3 The appellants have also requested on an auxiliary basis that the proceedings be continued in writing. Here again, however, the appellants did not allege any reason or special circumstance in support of their request. In addition, since the normal purpose of oral proceedings is to bring the case to a conclusion (Article 11(3) RPBA) and the appellants chose not to

attend the oral proceedings, the Board sees no reason for continuing the proceedings in writing.

2.4 In view of the foregoing, and since the appellants were given sufficient opportunity to present comments on the grounds on which the Board based the present decision (see point 3 below) and which, in essence, were already set out in the Board's communication annexed to the summons (point III above), the Board rejected the requests for cancellation of the oral proceedings and for remittal of the case as well as the auxiliary request for continuation of the proceedings in writing.

3. *Claim 1 - Article 123(2) EPC*

3.1 Claim 1 amended according to the present request of the appellants defines a low hydrogen overvoltage cathode comprising a coating layer that "does not contain phosphorous". As acknowledged by the appellants, there is no explicit support in the application as originally filed for the absence of phosphorous in the coating layer. In addition, in the Board's view there is no implicit support for such a feature either. The argument of the appellants according to which the application does not mention the use of phosphorous and consequently the skilled person would understand that no phosphorous is used is, in the absence of any explicit or implicit disclosure relating to phosphorous, not persuasive since the absence in the original application of any information relating to phosphorous is not a basis for supplementing the technical information content of the application as filed with an explicit reference to the absence of phosphorous.

Thus, the feature of claim 1 that the coating layer contains no phosphorous constitutes technical information that the skilled person would not have derived from the information content of the application as originally filed, and for this reason the subject-matter of present claim 1 goes beyond the content of the application as filed (Article 123(2) EPC).

- 3.2 The negative feature that the coating layer contains no phosphorous can - contrary to the later submissions of the appellants (point VII above) - be in principle considered to constitute a disclaimer, i.e. a feature which, although not based on the application as filed, is based on the disclosure of a prior art document - in this case document D3 - and which has been introduced in the claim to restore novelty of the claimed subject-matter over that disclosure. However, having regard to the standards laid down in the decision G 1/03 [*supra*] - and which standards are also to be applied in the present case, see decisions T 500/00 (point 1.8 of the reasons) and T 740/98 (point 2 of the reasons), none of them published in OJ EPO -, and as already noted by the Board in the communication accompanying the summons to oral proceedings (point III (c) above)) - and which view has not been contested in substance by the appellants in their subsequent letters of reply -, the disclosure of document D3 cannot be considered to constitute an accidental anticipation within the meaning of decision G 1/03. For this reason, the negative feature at issue, interpreted as a disclaimer, cannot be considered as an admissible disclaimer.

4. In view of the inadmissibility under Article 123(2) EPC of the amendments to claim 1 according to the present request of the appellants (point 3 above), and since the appellants have had due opportunity to comment on this issue, the appeal must be dismissed.

Order

For these reasons it is decided that:

The appeal is dismissed.

The Registrar:

The Chairman:

P. Martorana

A. G. Klein