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D E C I S I O N
of 25 February 2006

Case Number: T 0449/04 - 3.2.02

Application Number: 00127544.5

Publication Number: 1111080

IPC: C22C 38/08

Language of the proceedings: EN

Title of invention:
Maraging steel having high fatigue strength and maraging steel strip made of same

Applicant:
HITACHI METALS, LTD.

Headword:
-

Relevant legal provisions:
EPC Art. 54(2), (3), 87

Keyword:
"Priority right (yes)"
"First application - same invention"

Decisions cited:
G 0002/98, T 0693/97

Headnote:
The "same invention" considered in Article 87(1) EPC (the same requirement as for "the same subject matter" in the first application) does not encompass the comparative examples which are clearly and definitely excluded from the scope of the invention in the earlier application D1.

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Beschwerdekammern | Boards of Appeal | Chambres de recours

Case Number: T 0449/04 - 3.2.02

D E C I S I O N
of the Technical Board of Appeal 3.2.02
of 25 February 2006

Appellant: HITACHI METALS, LTD.
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Decision under appeal: **Decision of the Examining Division of the European Patent Office posted 11 November 2003 refusing European application No. 00127544.5 pursuant to Article 97(1) EPC.**

Composition of the Board:

Chairman: T. K. H. Kriner
Members: R. Ries
E. Dufrasne

Summary of Facts and Submissions

I. This appeal is against the decision of the Examining Division posted on 11 November 2003 to refuse European patent application No. 00 127 544.5.

The application was filed on 15 December 2000 and claims a priority date of 24 December 1999, on the basis of the Japanese patent application 36799799.

It was refused by the Examining Division on the grounds that the independent claims 1 and 8 did not meet the novelty requirement of Article 54(1) EPC.

As the only document of interest, the Examining Division cited the earlier Japanese patent application

D1 Patent Abstracts of Japan, volume 2000, No. 15, 6 April 2001, & JP 11160486, i.e. JP-A-2000-345302

D1a: translation of document D1 into English language submitted by the applicant

that was published on 12 December 2000, after the claimed priority date of 24 December 1999 and before the filing date of 15 December 2000 of the present application. The Examining Division specifically referred to comparative example 24 disclosed in Table 1. Although being outside the scope of the invention of D1, the composition of example 24 was found to fall completely within the elemental ranges of the maraging steel stipulated in claim 1 of the present application. Having regard to the fact that document D1 was submitted by the same applicant (HITACHI METALS Ltd.),

the priority right for this exemplifying composition was not recognised. Indeed, the application whose priority is claimed was not considered as being the "first application" within the meaning of Article 4 of the Paris Convention (Article 87(4) EPC). Hence, comparative example 24 of document D1 was held as being comprised in the state of the art pursuant to Article 54(2) EPC and anticipated the steel composition set out in claim 1 of the present application.

II. On 9 January 2004 the appellant (applicant) lodged an appeal against the decision and paid the prescribed fee on 20 January 2004. On 16 March 2004 a statement of grounds of appeal was filed.

III. The appellant's arguments can be summarised as follows:

The Examining Division used the wrong approach in its decision. It simply looked for a steel alloy composition which fell within the compositional ranges called for in claim 1 of the present application instead of asking whether D1 and the present application actually related to the same invention. Specifically, document D1 advocated the provision of a maraging steel composition which included a cobalt content of not less than 7 to less than 11 wt%.

Contrary to the technical teaching given in document D1, it was found in the present application that a high-strength maraging steel at a much lower price could likewise be obtained even when the cobalt content was reduced to less than 7%. The objects addressed in document D1 and the present application were, therefore, totally different, and the solutions excluded each

other at least with respect to the cobalt content. In view of this, document D1 could not be regarded as an earlier or the first application which related to the same invention. Consequently, document D1 which was published after the validly claimed priority date of the present application did not belong to the state of the art and could not anticipate the subject matter claimed in the present application.

The appellant therefore requested in his letter of 22 February 2006 that the decision of the Examining Division to refuse the present application be set aside and that the case be remitted to the first instance.

Oral proceedings were requested should the Board contemplate to dismiss the applicant's request.

IV. Independent Claims 1 and 8 submitted on 29 October 2003 read as follows:

"1. A maraging steel having high fatigue strength, consisting essentially, by mass, of

C	:	not more than 0.008%
Si	:	from O inclusive to not more than 2.0%
Mn	:	from O inclusive to not more than 3.0%
P	:	not more than 0.010%
S	:	not more than 0.005%
Ni	:	12 to 22%
Mo	:	3.0 to 7.0%
Co	:	less than 7.0%
Ti	:	not more than 0.1%
Al	:	not more than 2.0%
N	:	less than 0.005%
O	:	not more than 0.003%

Fe : substantially the balance,
wherein the total amount of (3Si + 1.8Mn + Co/3 + Mo + 2.6Ti + 4Al) is in a range of 8.0 to 13.0%."

"8. A maraging steel strip made by use of the steel of any one of claims 1 to 7, wherein said maraging steel strip is provided with a nitride layer formed on a surface portion of said maraging steel, and that said maraging steel strip is provided with compressive residual stress in said surface portion."

Reasons for the Decision

1. The appeal is admissible.

2. *Priority right - "first application"*

2.1 The first question the Board has to answer in order to assess the validity of the priority claimed is whether the application whose priority is claimed, JP 36799799 (hereafter (PR)), is the "first application" within the meaning of Article 87(1) EPC.

The Board has, therefore, to compare, pursuant to Article 87(4) EPC, the "subject-matter" of the application whose priority is claimed (PR) with the "subject-matter" of the earlier application filed by the same applicant in the same country, JP 11160486 (D1). Should the "subject-matter" of the application whose priority is claimed (PR) be the same as the "subject-matter" of the earlier application D1, then the application whose priority is claimed (PR) would

not be a "first application" and could not form the basis of a priority right.

In its assessment, the Board has to follow the interpretation of Article 87 EPC given in Opinion G 2/98 (OJ EPO 2001, 413) of the Enlarged Board of Appeal, which states firstly that the concept of the "same invention" in Article 87(1) EPC has to be narrowly or strictly interpreted, equating with the concept of "the same subject-matter" under Article 87(4) EPC, and, secondly, that the description of the invention according to the earlier application has to be considered as a whole.

2.2 The earlier application D1 aims at providing a maraging steel alloy having a high fatigue strength and exhibiting an interior hardness after the aging treatment of not less than 500 HV (cf. D1, Abstract; D1a, claim 1, page 9, second paragraph; the present application (A2 publication), paragraphs [0005], [0044]). As set out in D1a, paragraph [0014], cobalt is an important element which inter alia contributes to the age strengthening of the alloy. In order to achieve the desired effect, it is indispensable that cobalt is present in the range of **not less** than 7% to less than 11%.

In contrast to the disclosure of document D1, the application whose priority is claimed (PR) stipulates that the content of cobalt is restricted to **less** than 7% (claims 1 and 2, paragraphs [0008] and [0009]).

Lowering the cobalt-content of the steel contributes to a significant reduction in costs without adversely

affecting the other mechanical properties (cf. the A2 publication, [0025], similar and most probably analogous to paragraph [0014] of the application whose priority is claimed (PR)) and solves the problem of providing a maraging steel which is low in the production costs (cf. A2 publication of the present application, [0005]), having substituted increased amounts of other strengthening elements for a part of cobalt.

Given that the earlier application D1 dissuades from providing a maraging steel comprising less than 7% Co, it is beyond dispute that the invention disclosed in said earlier application D1 is not the "same invention" as the one disclosed in the application whose priority is claimed (PR).

2.3 Not disputed is the Examining Division's argument that the earlier application D1 actually includes the comparative example 24 (cf. D1a, Table 1), the composition of which falls within the elemental ranges of the maraging steel claimed in the present application as well as in the application whose priority is claimed (PR). It is, however, noted that comparative example 24 is clearly outside the elemental ranges required for the maraging steel of the invention according to the earlier application D1. Moreover, comparative example 24 is explicitly presented in D1 in negative terms (cf. D1a, paragraph [0023]: "...the strength is somewhat insufficient.") and, in view of the global description of the invention in D1, could not even have been later inserted by amendment as part of the invention.

In a similar way, it was concluded in decision T 693/97 of 30 October 2001 (unpublished, reasons, 2.5), in evaluating the quality of the "same invention" between the priority document and the later filed European application (same requirement as for the "same subject-matter" in a first application, see 2.1 above) that when a sole invention is described in the priority document, the subject-matter of the comparative example cannot be considered as another invention included in that document upon which a priority right could be based.

Therefore, in the present case, the content of the comparative example 24 does not represent part of the "invention" taught in the earlier application D1. Having regard to the required strict or narrow interpretation of the term "the same invention" pursuant to Article 87(1) EPC, this term is focussed on what constitutes the elements of the invention, ie. the embodiments including the examples according to the invention. What has to be considered as a whole in the earlier application D1 is the description of the invention in that application. Elements of the earlier application D1 which do not relate to the invention defined in that application and which are only recognised later on as an essential part of another invention in the later application whose priority is claimed (PR) cannot be considered as part of the invention described in the earlier application D1 as a whole. In other terms, the "same invention" considered in Article 87(1) EPC does not encompass in the present case the comparative example(s) which are clearly and definitely excluded from the scope of the invention in the earlier application D1. To the contrary, the

comparative example 24 makes the skilled person to realize that the objects addressed in the earlier application D1 cannot be successfully achieved unless the composition of the maraging steel falls within the elemental ranges stipulated in the claims, i.e. comprises a cobalt content of **not** less than 7 to less than 11%.

The evaluation of the contents of the earlier application D1 and of the application whose priority is claimed (PR) shows that the technical teaching given in both documents is different and cannot be rated as concerning "the same invention" in the sense of Article 87(1) EPC or "the same subject-matter" according to Article 87(4) EPC, as interpreted by G 2/98, point 6.8, respectively. Consequently, the earlier application D1 cannot prevent the application whose priority is claimed (PR) from being a "first application" in the sense of Article 87(1) EPC for the purpose of establishing the priority right.

3. *Priority right - same invention*

The second question the Board has to answer in order to assess the validity of the priority claimed is whether the present application concerns the "same invention" as the application whose priority is claimed (PR).

Although the application whose priority is claimed (PR) is available only in Japanese language, it is nevertheless clearly apparent from claims 1 to 4 that the same maraging steel composition as in the present application is concerned. Moreover, the exemplifying compositions 1 to 8 given in paragraph [0022] of the

application whose priority is claimed (PR) comply with those given in Table 1 of the present application.

It therefore cannot be put in doubt that the Japanese application No. 36799799 can be relied on as a basis for claiming priority for the present European patent application.

4. *Status of D1 in the procedure*

In summary, with regard to the validity of the claimed priority, document D1 merely constitutes an intermediate national prior right. On the proper interpretation of Article 54(3) EPC, such national prior rights are not comprised in the state of the art and only European prior patent applications filed under the EPC could be considered as such under Article 54(3) EPC. As shown in the annex to the European Search Report, such a European patent application corresponding to D1 JP-A-2000345302 does, however, not exist.

Consequently, document D1 cannot be considered for the assessment of novelty in the present case.

5. Since, according to the appellant's letter dated 22 February 2006 in response to the telephone discussion between the Board and the appellant of the same date, the request for oral proceedings was conditional on a negative decision, which condition is not met, no oral proceedings are necessary.

Order

For these reasons it is decided that:

1. The decision under appeal is set aside.

2. The priority of the Japanese patent application 36799799 is validly claimed in the patent application in suit.

3. The case is remitted to the first instance for further prosecution.

The Registrar: The Chairman:

V. Commare T. K. H. Kriner