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**Datasheet for the decision  
of 25 April 2007**

**Case Number:** T 0683/05 - 3.2.03

**Application Number:** 95928629.5

**Publication Number:** 0777089

**IPC:** F25B 9/00

**Language of the proceedings:** EN

**Title of invention:**

Cold heat accumulating material for extremely low temperatures  
and cold heat accumulator for extremely low temperatures using  
the same

**Applicant:**

KABUSHIKI KAISHA TOSHIBA

**Opponent:**

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**Headword:**

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**Relevant legal provisions:**

EPC Art. 123(2)

EPC R. 86(4)

**Keyword:**

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**Decisions cited:**

-

**Catchword:**

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Case Number: T 0683/05 - 3.2.03

**D E C I S I O N**  
of the Technical Board of Appeal 3.2.03  
of 25 April 2007

**Appellant:**

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**Representative:**

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**Decision under appeal:**

Decision of the Examining Division of the  
European Patent Office posted 21 December 2004  
refusing European application No. 95928629.5  
pursuant to Article 97(1) EPC.

**Composition of the Board:**

**Chairman:** U. Krause  
**Members:** C. Donnelly  
K. Garnett

## Summary of Facts and Submissions

- I. European Patent application 95928629.5 was filed as international application number PCT/JP95/01653 on 22 August 1995. The application was rejected by the examining division with a decision posted on 21 December 2004 on the grounds that it had been amended in such a way that it contained subject-matter which extended beyond that originally filed (Article 123(2) EPC).

Essentially, the examining division argued that there was no support in the application as filed for the selection of a sample according to a defined rate of particles with a form factor within a certain range. In particular, it was argued during the oral proceedings that, according to the passage at page 15, lines 10 to 15 referred to by the applicant, the evaluation of the form factor R is only carried out after the particles have been selected (by the mechanical crushing test) and, hence, could not have contributed to the selection of the batch.

- II. The appellant (patentee) filed a notice of appeal by letter of 16 February 2005. With the grounds of appeal filed by letter of 21 April 2005 the appellant filed a new main request and further auxiliary requests 1 to 3.
- III. In a communication pursuant to Article 11(1) RPBA dated 30 January 2007, annexed to the summons to oral proceedings, the Board indicated that the main request still did not appear to meet the requirements of Article 123(2) EPC. In particular the Board considered that the examining division appeared correct in

concluding that there was no basis for specifying a batch selection on the basis of the form factor of the particles.

In response, the appellant filed a new main request with its letter of 2 April 2007 and requested that, if it were deemed that the amended claims overcame the objection under Article 123(2) EPC, the case be remitted to the department of first instance for further examination without oral proceedings being held.

Following a telephone conversation with the rapporteur to the Board on 16 April 2007, during which, in particular, some discrepancies between the wording of the independent claim 1 and the dependent claims were highlighted, the appellant filed a new main request with letter of 17 April 2007.

IV. Claim 1 according to the main request reads as follows:

"A method of preparing a regenerator comprising the steps of:  
manufacturing particles of magnetic regenerator material;  
evaluating a form factor (R) of magnetic regenerator particles in a batch of magnetic regenerator particles using image analysis, where the form factor is defined by the expression:

$$R=L^{2/4\pi A}$$

and L represents the perimeter of a projected image of a magnetic regenerator particle, and

A represents a real area of the projected image of the magnetic regenerator particle and selecting regenerator material particles for use as the regenerator material such that the regenerator material has a rate of magnetic regenerator particles having a form factor  $R$  exceeding 1.5 which is not more than 5%.".

## **Reasons for the Decision**

### 1. Article 84 EPC

The Board considers that the claims meet the requirements of Article 84 EPC.

### 2. *Article 123(2) EPC*

The impugned decision is based entirely on the grounds that the subject-matter of the application has been amended such that its content extends beyond that originally filed. Thus, this matter will be the main issue addressed here.

#### 2.1 *Independent claim 1*

Taking each characteristic of independent claim 1 in turn:

(i) "A method of preparing a regenerator comprising the steps of"

The claims of the originally filed application are either directed at the regenerator material product itself (claims 1 to 9), a regenerator (claims 10 to 18)

or a refrigerator comprising a regenerator (claim 19). However, support for a method directed at preparing a regenerator can be found at page 13, lines 1 to 13 of the description as well as the detailed description of the embodiments.

(ii) "manufacturing particles of magnetic regenerator material"

Support for this step can be found in the description at page 12, lines 18 to 28 where details of the possible manufacturing techniques are given as well as for example, page 14, lines 19 to 23 and similar introductory paragraphs to each of the embodiments.

(iii) "evaluating a form factor (R) of magnetic regenerator particles in a batch of magnetic regenerator particles using image analysis, where the form factor is defined by the expression:

$$R=L^2/4\pi A$$

and L represents the perimeter of a projected image of a magnetic regenerator particle, and A represents a real area of the projected image of the magnetic regenerator particle"

The definition of the form factor itself is specified in claims 2, 6, 11 and 15. The specification of evaluating the form factor by image analysis is described inter alia at page 26, lines 4 to 8; page 27, lines 20 to 25 and page 31, lines 18 to 25.

(iv) "selecting regenerator material particles for use as the regenerator material such that the regenerator material has a rate of magnetic regenerator particles having a form factor R exceeding 1.5 which is not more than 5%."

The specified values for the form factor R and for the rate not to be exceeded in the regenerator material are given in claims 2, 6, 11 and 15 as well as the description page 11, lines 1 to 7, page 13, lines 6 to 9 as filed. Further support for the fact that these values are actually used as a basis for selecting regenerator material particles can be found for example at page 4, lines 25 to 28 and page 13, lines 6 to 9.

The passage at page 13, lines 1 to 13 of the description as filed, indicates that the regenerator particles can either satisfy the fracture rate criteria or the form factor criteria or both. This is also supported by original claims 1, 2, 6 and 7.

## 2.2 *Dependent claims*

The subject-matter of the dependent claims 2 to 6 find support in the application as filed as follows:

claim 2: page 12, lines 27 to 28

claim 3: page 14, line 24

claim 4: claim 7, page 12, lines 13 to 17 and page 6, lines 13 to 25

claim 5: claim 8, page 6, lines 13 to 25

claim 6: claims 5,9,14,18.

In conclusion the Board is satisfied that the claims of the main request fulfil the requirements of Article 123(2) EPC.

3. *Rule 86(4) EPC*

Since the basis for the subject-matter of the amended claims comes to some extent from the description of the application as filed, the Board feels it should take position on this point. Claim 1 of the main request is based essentially on the specification of a rate of particles for a particular value of the form factor R, and in this respect it reflects the essential nature of the specification of the originally filed claims 6 and 15 and combines with the originally claimed invention to form a single general inventive concept. It is therefore the Board's opinion that an examiner carrying out a search according to Article 92(1) EPC would have paid due regard to the parts of the description used as a basis for the amended claims and consequently should have consulted and cited any documents relevant to these claims. The requirements of Rule 86(4) EPC are thus considered to be met and no additional search is necessary.

4. *Novelty and inventive step*

The issues of novelty and inventive step have not been assessed by the examining division for any version of method claim. Thus, the Board sees no option but to remit the case to the first instance for further examination as requested in order to preserve the appellant's right to have recourse to a decision at two levels.



**Order**

**For these reasons it is decided that:**

1. The impugned decision is set aside.
2. The case is remitted to the examining division for further examination on the basis of the claims 1 to 6 according to the main request.

The Registrar:

The Chairman:

A. Counillon

U. Krause