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

Case Number: T 0211/06 - 3.3.07

Application Number: 01982798.9

Publication Number: 1350567

IPC: B01J 37/02

Language of the proceedings: EN

Title of invention:

Processing method utilizing display information and cell structure processed by the processing method

Applicant:

NGK INSULATORS, LTD.

Headword:

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Relevant legal provisions:

EPC Art. 54(2), 56, 111(1)

EPC R. 27

PCT R. 5

Keyword:

"Internal art and subjective "laboratory practice" - not prior art under Article 54(2) EPC, and not a possible correct starting point for assessing inventive step"

Decisions cited:

T 0248/85, T 0654/92, T 0691/94

Catchword:

Disclosure in the application as filed which turns out on the available evidence not to be prior art under Article 54(2) EPC cannot be used as starting point for assessing inventive step nor can subjective "laboratory practice" put forward by the examining division without any objective evidence that this was knowledge available to the public be used as a starting point for assessing inventive step.



Case Number: T 0211/06 - 3.3.07

D E C I S I O N
of the Technical Board of Appeal 3.3.07
of 25 April 2007

Appellant:

NGK INSULATORS, LTD.
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Aichi 467-8530 (JP)

Representative:

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Decision under appeal:

Decision of the Examining Division of the
European Patent Office posted 8 November 2005
refusing European application No. 01982798.9
pursuant to Article 97(1) EPC.

Composition of the Board:

Chairman: S. Perryman
Members: B. Struif
F. Rousseau

Summary of Facts and Submissions

I. The appeal lies from the decision of the examining division refusing European patent application 01 982 798.9 originating from international application PCT/JP01/09999 (published as WO 02/040157) and having a filing date of 16 November 2001. The application as filed comprised 15 claims. Independents Claims 1 and 10 read as follows.

"1. A processing method for carrying a cell structure with a catalytic component, characterized by displaying information about a mass of said cell structure is displayed on the surface thereof prior to the initiation of a carrying process, reading said information and carrying said cell structure with an appropriate amount of the catalytic component on the basis of the information, in the carrying process."

"10. A cell structure processed by a processing method according to any one of claims 1 to 9."

II. By a decision dated 8 November 2005 the examining division refused the application. That decision was based on a set of claims 1 to 11 as the main request, claims 1 to 4 being filed with letter dated 8 September 2005 and claims 5 to 11 filed with letter dated 7 January 2005 and on an auxiliary request. The decision *inter alia* referred to the following prepublished prior art:

D1: US-A-5 755 025

D2: EP-A-0 681 095

D3: JP-A-8 001 280

Furthermore, the examining division made reference to the following:

"Background art" as described in the application as filed, page 1, line 14 to page 3, line 6: hereafter indicated as A1

Common industrial practice (laboratory practice); hereafter indicated as A3

Claim 1 of the main request read as follows:

"1. A method of processing a cell structure (1) to load it with a catalytic component, comprising the steps of:

- (i) measuring the mass of the cell structure (1);
- (ii) displaying information about the measured mass of the cell structure on the surface of said cell structure or on the outer surface of a metallic container in which the cell structure is held before the catalytic component is loaded on the cell structure;
- (iii) reading said information prior to loading of the catalytic component;
- (iv) determining the amount of the catalytic component to be loaded on the basis of said read information; and
- (v) loading said cell structure with the determined amount of the catalytic component determined in step (iv).

Claim 1 of the auxiliary request read as follows:

"1. An industrial method of processing cell structures (1) to load them with a catalytic component, comprising the steps of:

- (i) measuring the mass of each cell structure (1), the masses of the cell structures being distributed;
- (ii) displaying information about the measured mass of each cell structure on the surface of each respective said cell structure, or on the outer surface of a metallic container in which the cell structure is held before the catalytic component is loaded on the cell structure;
- (iii) reading said information prior to loading of the catalytic component on each respective cell structure;
- (iv) determining the amount of the catalytic component to be loaded on the basis of said read information; and
- (v) loading said cell structure with the determined amount of the catalytic component determined in step (iv).

III. The examining division held that:

- (a) The amendments of the main and auxiliary request complied with the requirements of Article 123(2) EPC.
- (b) As regards inventive step, the claimed method started from a prior art as presented in the application as filed, page 2, lines 15 to 25

according to Rule 27(1)(b) EPC (herein referred to as A1). Although the appellant argued that this passage concerned internal state of the art, there was no evidence on file in that respect. The appellant's arguments were first presented in response to the summons and the examining division could not see any reason for providing at that stage additional written documents reflecting the prior art as presented by the applicant.

Furthermore, it was, according to the examining division, common and compulsory industrial practice to first determine the characteristics of newly delivered base products and to assess the right amounts of catalytic component to be applied to the cell structure to determine the optimum amount of catalytic material to be added before starting the industrial processing. The technician had to identify the cell structure, to measure and record its mass, check the marking prior to loading, determining the amount of the catalytic component to be loaded and load them for control. That procedure was also cited as "laboratory practice" (herein referred to as A3).

The implementation of bar codes in the production of catalyst bodies was known from D1 and D2. Without reference to catalysts, the delivery of a given amount of material to a mould was known from D3.

Hence, the claimed subject-matter was found to lack an inventive step over the "prior art" disclosed in the application as filed (A1) or the

above "laboratory practice" (A3) when used as starting point in combination with D1 to D3.

IV. On 18 January 2006, the applicant (appellant) filed a notice of appeal against the above decision, the prescribed fee being paid on the same day. In the statement setting out the grounds of appeal filed on 3 February 2006, the appellant submitted a statement by the inventors dated 12 and 13 January 2006. The main request underlying the decision under appeal remained the same.

V. The arguments of the appellant can be summarized as follows:

(a) The examining division referred to the discussion in the application as filed entitled "Background prior art" as closest state of the art (A1). However, when assessing inventive step the closest prior art must be objectively identified, which might be different from the prior art at the disposal of the inventor. The passage on page 2, lines 9 to 25, in which also the term "conventionally" was used, was no state of the art in the meaning of Article 54(2) EPC, but an internal subjective starting point, from which the invention was made, as evidenced from the statement of the inventors. There was no evidence on file that any of the content of that "Background art" section was made available to the public before the priority date.

The arguments of the examining division, how the skilled person might carry out the "Background Art" (A1), namely by increasing the number of classes in order to reduce the variance in each weight class was speculative and impermissible, since technical details were added to an internal process which had not been evidenced as state of the art.

Furthermore, there was no evidence on file that the examining division's hypothetical "laboratory practice" (A3), as an option of the closest prior art, was comprised in the state of the art. Thus, such hypothetical approach could not be used as starting point for evaluating inventive step either. Hence, the treatment of an alleged prior use as closest state of the art without any evidence, which led, in part, to the application being refused, was a substantial procedural violation (Article 113(1) EPC). For that reason, a refund of the appeal fee was requested.

- VI. In a communication of 14 December 2006, the board provided a preliminary opinion of the case, announcing that the Board would be prepared to set aside the decision under appeal and remit the case for further prosecution by the examining division. The Board, however, indicated that it considered that the incorrect assessment of inventive step based on an incorrect assessment of the prior art did not amount to a procedural violation. Even if it were considered a procedural violation, the Board would not have considered it equitable to reimburse the appeal fee, since the situation had come about due to the

appellant's failure to comply with Rule 5 PCT requiring identification of publicly available prior art, since only this could be useful for understanding, searching and examining the invention.

VII. In reply to that communication, the appellant withdrew its request for reimbursement of the appeal fee in the conditional on the Board setting aside the decision under appeal and remitting the case for further prosecution.

VIII. The appellant requested that the decision under appeal be set aside and that the case be remitted to the first instance for further prosecution.

Reasons for the Decision

1. The appeal is admissible.

Amendments made to the main request

2. According to the decision under appeal the amended claims of the main request met the requirements of Article 123(2) EPC. The board sees no reason to take a different view.

Inventive step

State of the art

3. An invention is considered to involve an inventive step, if having regard to the state of the art, it is not obvious to a person skilled in the art (Article 56 EPC).

The state of the art for the purpose of considering inventive step is as defined in Article 54(2) EPC. According to the decision under appeal, the statement in the application as filed, on page 2, lines 15 to 25, was regarded as a presentation of the prior art according to Rule 27(1)(b) EPC (A1), and was treated as the closest prior art.

- 3.1 In the application as filed, there is a section headed "Background Art", in which a process for preparing a catalyst converter is described (page 2, line 11 to page 3, line 6). According to that Background Art section: "... in the case where a catalytic component is carried in the cell structure, an appropriate amount to be carried varies depending on the masses of the cell structures. Conventionally, the masses of the cell structures are measured beforehand and the cell structures are sorted into several classes based on the mass, and the amount of the carried catalytic component (the mass of the catalytic component) is adjusted so as to become the fixed value by controlling the masses after the catalytic component has been carried based on each class of the mass. However, since the masses of the cell structures have a certain variation even within the same class of the mass range, actually some variance exists in the carried amount of the catalytic component if it is examined at the individual cell structures.

The present invention has been completed, in view of the above described problems in the prior art, and the object thereof is to provide a processing method for carrying a catalytic component on each cell with an appropriate amount thereof in accordance with the mass

of the cell structure, at the time when the processing for carrying a catalyst component on the cell structure is done, even if there is a variation in the mass of the cell structure...".

3.2 The original application was a PCT application. It is the view of the Board that where Rule 5 PCT refers to indicating the background art which can be regarded as useful for understanding, searching and examining the invention, and with reference to which the technical problem solved by the invention can be understood, "background art" in this rule means publicly available art at the priority date, and not some internal prior art known only within the company employing the inventors.

3.3 However, as appears from the statement of the inventors dated 12 and 13 January 2006, which statement was not on file when the decision was taken, the above cited passages, in particular the batch process described as "conventionally" on page 2, lines 15 to 25 comprised confidential information between the applicant (NGK) the catalyst manufacturer and the automotive manufacturer. Due to the savings in catalyst components and due to a competitive advantage in the market resulting therefrom, the applicant and the two manufacturers concerned were stated to have a strong interest that such information remain confidential until a corresponding application was filed.

There is no evidence before the board that this art (A1) was made available to the public before the priority date as required by Article 54(2) EPC. The practice starting out from art, which is known to the applicant

but which is not made available to the public at the priority date is inconsistent with the requirements of the EPC (T 654/92 of 3 May 1994 (points 4.2 and 4.3). Consequently, such a process described on page 2, lines 9 to 25 represents internal state of the art and is not comprised in the state of the art as required under Article 54(2) EPC (see also T 248/85, OJ EPO 1986, 261 (points 9.1 and 9.2) and T 691/94 of 13 May 1996 (point 2.1 and 2.2)).

- 3.4 Since the internal batch process (A1) has not been made available to the public, any modifications thereto cannot be made available *a fortiori*. Consequently, the board does not consider that the internal art cited in the application as filed or any modified version thereto is the correct starting point for evaluating inventive step in line with the established Case Law.
4. According to the impugned decision another starting point was based on a so called "laboratory practice" or "common industrial practice", how to apply the catalytic component on a carrier (A3). This approach concerned the determination of the characteristics of the product to assess the right amounts in order to determine optimum amount of catalytic component to be added before starting industrial processing. In preliminary tests in laboratory, the skilled person had to identify the cell structure, to measure the mass and record it, to determine the amount of the catalytic component to be loaded and to load them for control (see decision under appeal, point 3a, page 5, third paragraph).

4.1 There is however no evidence on file at all that this "laboratory practice" was made available to the public and concerns state of the art under Article 54(2) EPC. This would be using a subjective starting point, which cannot be objectively assessed, since it is not based on reliable technical information based on evidence as required by Article 54(2) EPC. Consequently, such subjective "laboratory practice" as indicated above (A3) cannot be used to identify the closest prior art and is not a correct starting point for assessing inventive step either.

4.2 From the above it follows that the starting points applied to in the decision under appeal for the purposes of Article 56 EPC are based either on internal art or on a practice argued by the examining division to be known to the skilled person, for which there is no evidence on file that it was available to the public before the priority date. Hence, the first instance finding for lack of an inventive step has been deprived of its essential basis.

Remittal to the first instance

5. Given that the Board accepts that on the evidence what was originally described in the application as prior art in fact is not prior art for the purpose of Article 54(2) EPC, then the applicant is not bound by his original statement as to what was prior art. But, it also follows that the problem to be solved and any benefits of the invention must be reformulated in respect of something which is indeed prior art (as preferably evidenced by some published document), without violation of the requirements of

Article 123(2) EPC. In that respect, the board notes that the preliminary international examining report started from JP-A-07-265 706 as closest document (see English translation of the report, box V). The examining division should examine whether or not that Japanese document comes closer to the claimed invention than documents D1 to D6 on file. The closest document should be indicated in the description (Rule 27(b) EPC).

- 5.1 No attempt has yet been made yet to adapt the description, nor to make a submission as to how the invention relates to the closest state of the art (at least as perceived by the applicant) which was public knowledge. It may be necessary to consider another problem which can be regarded as solved over the closest state of the art, which objectively existed, provided that the skilled person would recognise the same as implied or related to the problem initially suggested (Case Law of the Boards of Appeal of the European Patent Office, 4th edition 2001, I.D.4.5).

- 5.2 In order to avoid loss of instance, and in view of the points raised above, the case has to be remitted to the department of first instance for examination of inventive step (Article 111(1) EPC). The appellant is afforded an opportunity to submit a description in compliance with Rule 27 EPC.

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:

T. Buschek

S. Perryman