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**Datasheet for the decision
of 20 April 2007**

Case Number: T 1088/06 - 3.2.05
Application Number: 02001200.1
Publication Number: 1209399
IPC: F16L 9/12
Language of the proceedings: EN

Title of invention:

Corrugated polymeric tubing having at least three layers with at least two respective layers composed of polymeric materials dissimilar to one another

Applicant:

ITT MANUFACTURING ENTERPRISES, INC.

Opponent:

-

Headword:

-

Relevant legal provisions:

EPC Art. 76(1), 111(1)
EPC R. 88

Keyword:

"Extension beyond the earlier application as filed - no"

Decisions cited:

G 0003/89

Catchword:

If information in the earlier application is objectively recognisable by the person skilled in the art as information that is incorrect, and if the person skilled in the art would derive the correct information directly and unambiguously, using common general knowledge, and seen objectively and relative to the date of filing, from the whole of the documents of the earlier application as filed, then the correct information belongs to the content of the earlier application and may be used to decide whether a divisional application extends beyond the content of the earlier application as filed, Article 76(1) EPC.



Case Number: T 1088/06 - 3.2.05

D E C I S I O N
of the Technical Board of Appeal 3.2.05
of 20 April 2007

Appellant: ITT MANUFACTURING ENTERPRISES, INC.
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Decision under appeal: Decision of the Examining Division of the
European Patent Office posted 18 April 2006
refusing European application No. 02001200.1
pursuant to Article 97(1) EPC.

Composition of the Board:

Chairman: W. Zellhuber
Members: H. Schram
M. Vogel

Summary of Facts and Submissions

I. The appeal is against the decision of the Examining Division dated 18 April 2006 refusing European patent application No. 02 001 200.1 (publication No. 1 209 399), which was filed as a divisional application to European patent application No. 95 915-639.9 (publication No. 0 755 493 / WO 95/27866, henceforth referred to as the earlier or parent application) on the ground that the application extended beyond the content of the earlier application as filed, Article 76(1) EPC.

II. The appellant (applicant) requested that the decision under appeal be set aside and, as a sole request, that a patent be granted on the basis of claims 1 to 19, filed on 22 September 2005, which were refused by the Examining Division.

Claims 5, 6 and 15 of the sole request read as follows:

"5. The tubing of claim 1 wherein the thermoplastic material employed in the interior layer contains conductive media in a quantity sufficient to provide an electrostatic dissipation capacity between about 10^4 to 10^9 Ohm/cm²".

"6. The tubing of claim 1 wherein the interior layer further contains a conductive material selected from the group consisting of elemental carbon, copper, silver, gold, nickel, silicon, and mixtures thereof, the conductive material being present in an amount sufficient to provide the interior layer with an

ability to dissipate electrostatic energy in a range between about 10^4 to 10^9 Ohm/cm²".

"15. The tubing suitable of one of the preceding claims wherein the thermoplastic material of the bonding layer contains quantities of a conductive material sufficient to provide electrostatic dissipation capacity in a range between about 10^4 to 10^9 Ohm/cm²".

III. In support of his request, the appellant submitted that the decision under appeal had denied the allowance under Article 76(1) EPC to correct the range of " 10^{-4} to 10^{-9} Ohm/cm²" for electrostatic dissipation given in the earlier application to " 10^4 to 10^9 Ohm/cm²" in the divisional application. In several decisions of the Boards of Appeal the allowance of corrections under Rule 88, second sentence, EPC were ruled. Hereto, the obviousness of the error and the correction had to be considered. The appellant argued that in the present case the obviousness of the error and the correction was given. The invention related to multi-layer tubing suitable for use on motor vehicles, in particular fuel lines, comprising layers of thermoplastic material. The person skilled in the art would immediately recognize the negative exponents -4 and -9 as a mistake, since the lower end of the range would mean that the material was superconductive, and that the mistake was in the sign and not in the absolute values of the exponents, i.e. 4 and 9.

Reasons for the Decision

1. The expression " 10^{-4} to 10^{-9} " occurs six times in the earlier application as filed: on page 13, line 28, on page 16, line 11, on page 18, line 17, and in claims 8, 9 and 17 (see WO 95/27866).

The expression " 10^4 to 10^9 ", which differs from the above expression by a reversal of the sign of the exponents, occurs also six times in the divisional application as filed: in column 9, line 11, in column 10, line 48, in column 12, lines 11 and 12, and in claims 8, 9 and 17 (see EP-A 1 209 399).

Claims 5, 6 and 15 of the sole request correspond to claims 8, 9 and 17 of the divisional application as filed, which in turn substantially correspond to claims 8, 9 and 17 of the earlier application as filed, i.e. apart from the signs in the exponents.

The question to be answered in the present appeal is whether the range of the electrostatic dissipation capacity (cf. claims 5 and 15) and the range of the ability to dissipate electrostatic energy (cf. claim 6) indicated as being "between about 10^4 to 10^9 Ohm/cm²" extend beyond the content of the earlier application as filed, Article 76(1) EPC.

The Examining Division held that the correct range could not be "directly and unambiguously derived from the parent application as originally disclosed", see decision under appeal, Reasons 1. The Examining Division applied the disclosure test for the purpose of Article 76(1) EPC to arrive at this result, although it

held that the person skilled in the art would realize that the range 10^{-4} to 10^{-9} Ohm/cm² was erroneous.

However, in a case where information in the earlier application is incorrect, in the judgment of the Board it must be investigated whether the person skilled in the art would derive the correct information directly and unambiguously, using common general knowledge, and seen objectively and relative to the date of filing, from the whole of the documents of the earlier application as filed, analogous to Opinion G 3/89 (OJ EPO 1993, 117; Correction under Rule 88, second sentence, EPC) of the Enlarged Board of Appeal (see Conclusion 1, first sentence).

2. *Obviousness of information that is incorrect in the earlier application*

The range for electrostatic dissipation given in the earlier application is objectively recognisable by the person skilled in the art as information that is incorrect. Since the arguments of the appellant can be accepted with respect to this point, there is no need for further substantiation of this matter.

3. *Obviousness of what is offered as the correction in the divisional application*

In the judgment of the Board, the person skilled in the art would not only realize that the range of 10^{-4} to 10^{-9} Ohm/cm² for electrostatic dissipation given in the earlier application was a mistake, he or she would also realize that the error resides in the magnitude of the lower and upper value (10^{-9} and 10^{-4} , respectively) of

the range, since dissipative composites suitable for multi-layer tubing for motor vehicles typically have electrostatic dissipation values many orders of magnitudes higher than said upper value. For example, document EP-A 0 470 606 cited in the Search Report discloses a multi-layer fuel line with a layer having a surface resistance of $< 10^9 \Omega$ (see claim 2), and document FR-A 2 689 956, which is also cited in the Search Report, discloses a multi-layer fuel line with a layer having a volume resistivity of not more than $10^{11} \Omega \cdot \text{cm}$ (see claim 3). It may be noted that the numerical values of surface resistance and surface resistivity are the same and that surface resistivity is independent of the size of the "square".

The Examining Division, although accepting that the minus signs of the exponents were erroneous and should be plus signs, argued in the decision under appeal that it was possible that the error did not only reside in the minus signs of the exponents: the numbers 4 and 9 could be wrong as well (Reasons 1, sixth paragraph).

However, in the present case there is no indication that the numbers 4 and 9 are wrong. Hence there is no need to offer a correction for these numbers. If the test for correcting a mistake in a composed number were to be extended to parts of that number that are not objectively recognisable by the person skilled in the art as information that is incorrect, it would be virtually impossible to correct a specific number, since it is always possible to propose more than one possibility to replace that number.

The person skilled in the art, having realized that the mistake resides in the magnitude of the numbers defining the numerical range, will appreciate in this particular case that the mistake is resolved by reversing the signs of the exponents.

4. *Extension beyond the content of the earlier application as filed, Article 76(1) EPC*

In the judgement of the Board, the person skilled in the art would thus derive the range of 10^4 to 10^9 Ohm/cm² directly and unambiguously, using common general knowledge, from the earlier application as filed. Consequently, this range implicitly belongs to the content of the earlier application.

In the Enlarged Board opinion G 3/89 (*loc. cit.*) it is stated (see Reasons 4): *Since a correction admissible under Rule 88, second sentence, EPC is thus of a declaratory nature only, it does not infringe the prohibition of extension under Article 123(2) EPC either.*

In the judgement of the Board, this principle applies *mutatis mutandis* to a divisional application, wherein with respect to the earlier application information, that was incorrect, has been "corrected": such a correction admissible under Rule 88, second sentence, EPC does not infringe the prohibition of extension under Article 76(1) EPC.

The range of 10^4 to 10^9 Ohm/cm² occurring *inter alia* in claims 5, 6 and 15 of the sole request therefore does

not introduce subject-matter extending beyond the earlier application as filed, Article 76(1) EPC.

5. The Examining Division has not yet had the opportunity of considering the question of whether the application meets all the requirements of the EPC, including possibly further objections under Article 76(1) EPC. It is thus considered appropriate to remit the case to the department of first instance for further prosecution, Article 111(1) 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:

D. Meyfarth

W. Zellhuber