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**Datasheet for the decision
of 11 November 2008**

Case Number: T 1842/07 - 3.3.06

Application Number: 96102977.4

Publication Number: 0718693

IPC: G03F 7/004

Language of the proceedings: EN

Title of invention:

Photoresist compositions and components

Patentee:

SHIPLEY COMPANY INC.

Opponent:

Tokyo Ohka Kogyo Co., Ltd.

Headword:

Photoresist compositions/SHIPLEY

Relevant legal provisions:

EPC Art. 123(2)
EPC R. 96

Relevant legal provisions (EPC 1973):

-

Keyword:

"Added subject-matter - yes"

Decisions cited:

-

Catchword:

-



Case Number: T 1842/07 - 3.3.06

DECISION
of the Technical Board of Appeal 3.3.06
of 11 November 2008

Appellant: SHIPLEY COMPANY INC.
(Patent Proprietor) 500 Nickerson Road
Marlborough, MA 01752 (US)

Representative: Bunke, Holger
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Respondent: Tokyo Ohka Kogyo Co., Ltd.
(Opponent) 150, Nakamaruko, Nakahara-ku, Kawasaki-shi
Kanagawa-ken (JP)

Representative: Hayes, Adrian Chetwynd
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Decision under appeal: Decision of the Opposition Division of the
European Patent Office posted 23 August 2007
revoking European patent No. 0718693 pursuant
to Article 102(1) EPC 1973.

Composition of the Board:

Chairman: P.-P. Bracke
Members: P. Ammendola
U. Tronser

Summary of Facts and Submissions

- I. This appeal is from the decision of the Opposition Division to revoke the European patent No. 0 718 693 concerning photoresist compositions and components.

Claim 1 as granted read:

"1. A composition responsive to activating radiation to form a latent image developable with an aqueous alkali solution comprising at least one alkali-soluble resin and at least one photoactive compound that is an ester or polyester derived from the reaction of an oxo-diazonaphthalene sulfonyl or carboxylic acid halide with a hydroxy or polyhydroxy ballast compound dissolved in a solvent, wherein said solvent is ethyl lactate distilled to a purity of greater than 99 percent."

- II. The patent had been granted on the basis of the divisional European patent application 96 102 977.4 (originating from the parent European patent application 87870199.4).

Claim 4 of this divisional application as originally filed read:

"4. The composition of any one of claims 1 to 3, wherein said solvent is ethyl lactate having a purity of greater than 99 %."

- III. Two Opponents had initially sought revocation of the patent in suit on the grounds of lack of novelty and inventive step and added subject-matter. One of the two

Opponents withdrew its opposition during the proceedings before the Opposition division.

- IV. In its decision the Opposition Division considered, *inter alia*, that the word "*distilled*" present in claim 1 as granted would not violate Article 123(2) EPC, despite the absence of support in the divisional application as originally filed, because such expression was a process feature which would not be limiting in the product claim. Therefore, the scope of the granted claim 1 would not change with the presence or the absence of the word "*distilled*" and, thus, this amendment would produce no addition of subject-matter to the claim. The Opposition Division considered however the subject-matter of claim 1 as granted not based on an inventive step.
- V. The Patent proprietor (hereinafter Appellant) lodged an appeal against this decision on 2 November 2007 and paid simultaneously the appeal fee. In its grounds of appeal filed on 28 December 2007 it only disputed the reasoning of the Opposition Division in respect of the lack of inventive step.
- VI. In its reply to the grounds of appeal, the Opponent (hereinafter Respondent) objected, *inter alia*, to the finding of the Opposition Division in respect of the issue of added subject-matter in relation to the presence of the word "*distilled*" in claim 1 as granted.
- VII. The Board summoned the parties to oral proceedings to be held on 11 November 2008.
- VIII. The Appellant provided no further submission in writing other than the letter of 30 September 2008 only

announcing that it was not going to take part to the forthcoming hearing.

- IX. The oral proceedings before the Board took place as scheduled in the announced absence of the Appellant.
- X. The Appellant has provided no comment in writing during these appeal proceedings to the objection of added subject-matter already considered in the decision under appeal and raised again in the Respondent's reply to the grounds of appeal.
- XI. In respect of this issue the Respondent has argued in writing and orally substantially as follows.

The Opposition Division would have erred in considering relevant under Article 123(2) EPC whether or not the scope of claim 1 has been changed by specifying that the solvent is ethyl lactate "*distilled*" to a purity of greater than 99 percent. The only point relevant under such Article would rather be whether or not the wording used in this claim introduced matter not originally disclosed.

Moreover, the Opposition Division would have also erred in considering that the scope of this claim would not be altered by specifying that the high purity of the ethyl lactate must be achievable by distillation, since such definition has consequences as to the nature of the impurities possibly present therein.

Hence, the indication in granted claim 1 that the ethyl lactate is purified by distillation would amount to a limiting feature of the invention that was undisclosed

in the application as originally filed and, thus, would violate Article 123(2) EPC.

- XII. The Appellant requested in writing that the decision of the first instance be set aside and that the patent be maintained as granted, effective up to the expiry date of its maximum duration.

The Respondent has requested in writing and orally that the appeal be dismissed.

- XIII. At the end of the oral proceedings the Chairman has announced the decision of the Board.

Reasons for the decision

1. Even though the patent has already lapsed the disputed decision is subject to appeal according to Rule 98 EPC (former Article 106(2) EPC 1973).

Added subject-matter in claim 1 as granted (Article 123(2) EPC)

2. The Respondent has disputed the finding of the Opposition Division as to the compliance of claim 1 of the patent in suit with Article 123(2) EPC because of the word "*distilled*" as present in the definition of the claim feature reading "*wherein said solvent is ethyl lactate distilled to a purity of greater than 99 percent*" (see above section I of the Facts and Submissions).

- 2.1 Even though the Appellant has provided no comment on this issue in the appeal proceedings, it is apparent

from the decision under appeal that at least during the opposition proceedings the Appellant has maintained that the above-identified feature of claim 1 as granted would be supported by claim 4 and example 195 of the divisional patent application as originally filed.

- 2.2 However, as correctly acknowledged in the decision under appeal, the original claim 4 of the divisional application as filed (see above section II of the Facts and Submissions) supports only in part the wording used for defining such feature, because this claim only describes the use as solvent of ethyl lactate with a purity greater than 99 percent, i.e. without specifying whether or not such purity is achieved through a distillation or some other purification steps.

The Board finds also correct the further finding of the Opposition Division that original example 195 describes the use of ethyl lactate freshly distilled only in combination with two specific other solvents. Hence, also this example provides no direct and unambiguous disclosure of the possibility of using ethyl lactate purified by distillation as the sole solvent of the claimed composition or in combination with any other solvent different from the specific pair thereof mentioned therein.

- 2.3 The Opposition Division, despite having acknowledged the absence in the original divisional application of any basis for the word "*distilled*" of the above-identified feature of granted claim 1, has nevertheless reached the conclusion that such word produced no addition of subject-matter for the sole reason that it amounted to a process feature and, thus, would have no limiting effect

on the scope of claim 1, which is instead directed to a composition of matter.

The Board finds this argument not convincing for the following reason.

As correctly observed by the Respondent, the question as to whether an originally undisclosed wording introduced in a granted claim results in a limitation of the claimed subject-matter or only in a possibly redundant feature unsuitable for limiting the scope of the claim, is not relevant in view of Article 123(2) EPC.

Indeed, this Article requires any amendment to a European patent or patent application not to result in added subject-matter, i.e. it applies even to amendments of the claims that do not provide any additional limitation to the scope of these latter.

- 2.4 The Board can only conclude that the above-identified wording introduces in claim 1 as granted subject-matter that was not disclosed in the divisional application as originally filed. Hence, this claim does not comply with the requirements of Article 123(2) EPC and, therefore, the Appellant's sole request to maintain patent as granted is not allowable already for this reason.

Order

For these reasons it is decided that:

The appeal is dismissed.

The Registrar:

The Chairman:

C. Vodz

P.-P. Bracke