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

Case Number: T 1863/07 - 3.2.02

Application Number: 04813036.3

Publication Number: 1692320

IPC: C22C 33/02

Language of the proceedings: EN

Title of invention:

Methods of preparing high density powder metallurgy parts by
iron based infiltration

Applicant:

HOEGANAES CORPORATION

Opponent:

-

Headword:

-

Relevant legal provisions:

EPC R. 103(1)a)

Relevant legal provisions (EPC 1973):

EPC Art. 21, 51(4), 54, 84, 96(2), 109(1), 113, 123(2)

Keyword:

"Interlocutory revision - rectification (yes)"

"Basis of decision - right to be heard (no)"

Decisions cited:

-

Catchword:

Request for refund of the appeal fee after the granting of
interlocutory revision.



Case Number: T 1863/07 - 3.2.02

D E C I S I O N
of the Technical Board of Appeal 3.2.02
of 11 January 2008

Appellant:

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Decision under appeal:

Decision of the Examining Division of the
European Patent Office posted 8 May 2007
refusing European application No. 04813036.3
pursuant to Article 97(1) EPC 1973.

Composition of the Board:

Chairman: T. Kriner
Members: R. Ries
A. Pignatelli

Summary of Facts and Submissions

I. This appeal, which was filed on 4 July 2007, lies against the decision of the examining division dated 8 May 2007, refusing European patent application No. 04 813 036.3 filed on 3 December 2004 in the name of Hoeganaes Corporation, and published under the International Publication Number WO 2005/056855 A1. The appeal fee was paid together with the notice of appeal and the statement of grounds of appeal was filed on 7 September 2007.

II. The decision under appeal was based on a set of 27 claims filed with the applicant's submission dated 5 February 2007. The independent claims 1, 26 and 27 read as follows:

- "1. A method of making powder metallurgy parts using iron-based infiltration comprising the steps of:
- (a) providing an iron-based infiltrant comprising a near eutectic liquidus composition, e.g. a near hypo eutectic liquidus composition, of a first based ally system;
 - (b) providing an iron-based base compact comprising a near eutectic solidus powder composition, e.g. near hypo eutectic solidus powder composition, of a second iron-based alloy system;
 - (c) contacting the base compact with the infiltrant;
 - (d) heating the infiltrant and base compact to a process temperature above the melting point of the infiltrant, thereby forming a liquid component of the infiltrant; and
 - (e) infiltrating the base compact with the liquid component of the infiltrant."

"26. A method of making powder metallurgy parts using iron-based infiltration comprising the steps of:

- (a) providing an iron-based infiltrant comprising an eutectic liquidus composition of a first iron-based alloy system;
- (b) providing an iron-based compact having a network of interconnected porosities comprising an eutectic solidus powder composition of a second iron-based system;
- (c) contacting the base compact with the infiltrant;
- (d) heating the infiltrant and base compact to a process temperature above the melting point of the infiltrant, thereby forming a liquid component of the infiltrant."

"27. A powder metallurgy part prepared by the method of claims 1 or 21."

III. In that decision the examining division held that, although the requirements of Article 123(2) EPC (1973) were found to be met, the revised set of claims failed to satisfy the requirement of conciseness pursuant to Article 84 EPC (1973). So two independent method claims rather than one were still comprised and the applicant had not given any plausible reason for doing so. The examining division further held that the terms "near eutectic liquidus" and "near eutectic solidus" featuring in claim 1 were unclear, contrary to the position of the applicant who pointed in this context to document D1 using the same technical language as in the application. Moreover, the examining division objected to the novelty of the subject matter of newly filed product-by-process claim 27 having regard to the

technical disclosure of document D1, Article 54 EPC (1973). Given that the composition of the base compact was not an inherent feature, the subject matter of product-by-process claim 27 could not be distinguished from the infiltrated products known from D1 which disclosed the infiltration of an iron compact by an alloy having a near eutectic composition. The application was, therefore, refused having regard to the fact that the reasons for the refusal had been duly communicated to the appellant in the first communication by referring to the written opinion of the International Search Authority (ISA).

- IV. Enclosed with the statement of the grounds of appeal the appellant submitted a revised set of claims. He requested inter alia that the decision under appeal be set aside and the appeal fee be reimbursed because, in his view, the examining division in issuing its decision had committed a substantial procedural violation.

In support of this allegation the appellant argued that neither the appealed decision nor the first official communication of the examining division under Article 51(4) EPC (1973) were well reasoned with respect to Rule 29(2)c EPC (1973) allowing for more than one independent claim of the same category if, as in the present case, alternative processes for manufacturing powder metallurgy parts by infiltration were to be claimed. Moreover, the right to be heard pursuant to Article 113 EPC (1973) was violated given that the redrafted set of claims enclosed with the applicant's reply dated 5 February 2007 to the first official communication included the revised independent

method claims 1 and 26 on which the examining division had not yet commented.

- V. In view of the amended set of claims enclosed with the grounds of appeal, the examining division, by its decision dated 10 November 2007, rectified the appealed decision under Article 109(1) EPC (1973) but did not allow the appellant's request for reimbursement of the appeal fee. In that respect the examining division referred the case to the boards of appeal.

Reasons for the Decision

1. The appeal is admissible.
2. The Board draws the attention of the party to the fact that this decision is issued after the entry into force of the EPC 2000. When Articles or Rules of the old version of the EPC (1973) are cited, the year is indicated. The transitional provisions according to Article 7 of the Act revising the EPC of 29 November 2000 and the Decisions of the Administrative Council of 28 June 2001 and of 7 December 2006, Article 2, have been applied.
3. As to the competence of the examining division on the request for reimbursement of the appeal fee, the decision of the examining division is in line with decision G 3/03. Therein the Enlarged Board of Appeal ruled that in the event of interlocutory revision under Article 109(1) EPC (1973), the department of the first instance (i.e. the examining division) whose decision has been appealed is not competent to refuse a request

from the appellant for reimbursement. Rather, the board of appeal which would have been competent under Article 21 EPC (1973) to deal with the substantive issues of the appeal if no interlocutory revision had been granted is competent to decide on that request.

4. The appellant's request for reimbursement of the appeal fee can only be granted if, arriving at their decision of refusal, the examining division had committed a substantial procedural violation (Rule 103(1)a EPC). It therefore has to be examined whether a substantial procedural violation actually has taken place, in respect of the provisions applicable to the proceedings at that time, as alleged by the appellant.

4.1 As previously noted, the first official communication simply referred back to the written opinion of the ISA. In order to overcome the objections raised in the written opinion point 1.1 with respect to conciseness and arising under Article 84 EPC (1973), the applicant reduced the total number of claims from 45 to 27 and the number of the independent claims from 4 to 3 (cf. the appellant's response dated 5 February 2007, point 1). Moreover, clerical errors in the claims were corrected.

4.2 Turning to the clarity objections addressed in paragraphs 1.2 and 1.3 of the written opinion and objecting to the terms "near eutectic liquidus" and "near hypo-eutectic liquidus", the examining division was referred to the only relevant and closest prior art document D1. The applicant argued that D1 used the same terminology as in the application (cf. e.g. title, abstract). Therefore, the technical disclosure of D1

supported the applicant's view that the skilled metallurgist was fully aware of the meaning of the objected technical terms which could only be interpreted as a composition very similar or close to the binary or ternary eutectic composition. Hence, the contested terms were adhered to since they were considered well defined and clear in the metallurgist's understanding and, therefore, satisfied the requirements of Article 84 EPC (1973).

4.3 In the ISA's written opinion, box No. V, the subject matter of former claims 1 to 43 was rated novel and inventive over the technical disclosure of document D1 which was corroborated in paragraphs 2.1 and 2.2. Hence, there was no need for the applicant to amend the method claims 1 to 43 in substance.

4.4 In paragraph 2.3 of the written opinion, the novelty of the PM parts prepared by the claimed process (former claims 44, 45) was objected to vis-à-vis the products known from D1.

In his response the applicant disputed the point of view of the examining division and argued that D1 was only concerned with the infiltration of a compact made from commercial atomised powders rather than from the claimed iron-based compact having a near eutectic solidus powder composition. Since the examining division's contention with respect to D1 was considered unjustified, product claim 27 resulting from the combination of former claims 44, 45 was maintained (cf. paragraph 3 of the applicant's response dated 5 February 2007).

5. In the Board's view, this all goes to show that the applicant seriously tried to overcome the objections raised by the examining division and, if the objection was considered unfounded, defended his position by giving detailed explanations as to why the wording of the claim(s) was maintained. The Board therefore concludes that the applicant has made a *bona fide* attempt to deal with all the objections raised by the examining division by its reference to the ISA's written opinion.

5.1 According to Article 96(2) EPC (1973) the examining division shall invite the applicant as often as necessary to file observations to its official communications. The provisions of Article 96(2) EPC (1973) form the basis for the principles laid down in the Guidelines for substantive examination Part C VI 4.3.: If re-examination of an application shows that the applicant has not dealt with all the main objections, it is appropriate for the examining division to draw the applicant's attention to the deficiencies, e.g. by telephone or by a further written action to warn him that the application will be refused unless he can produce more convincing arguments or makes appropriate amendments within a specific time limit. Only when the applicant has not made any real effort to deal with the objections raised in the first official communication and no positive reaction is to be expected, should the examining division consider the immediate refusal of the application, this however being an exceptional case.

5.2 Thus before refusing an application after a single official communication, the applicant should have been

given a further opportunity to present comments or amendments if, as in the present case, a bona fide attempt has been made. In the Board's view, the applicant was taken by surprise by the refusal, all more so since (i) the positive statements given in the ISA's written opinion created the overall impression for the applicant that the claimed method of making PM part actually was patentable and (ii) because by the revised set of claims he had met (or at least had seriously tried to meet) the outstanding objections raised under Article 84 EPC (1973). As to the novelty objection with respect to claim 27, he considered the arguments supporting his point of view well founded, arguments that have been commented on by the examining division for the first time in the appealed decision.

6. The considerations made above lead to the conclusion that in the present case the immediate refusal of the application without any prior warning to the applicant constituted a substantial procedural violation within the meaning of Rule 103(1)a EPC which justified that the appellant's request for reimbursement of the appeal fee be allowed.

Order

For these reasons it is decided that:

Reimbursement of the appeal fee is ordered.

The Registrar:

The Chairman:

V. Commare

T. Kriner