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**Datasheet for the decision
of 02 April 2009**

Case Number: T 1910/08 - 3.2.07

Application Number: 05250871.0

Publication Number: 1568664

IPC: C03B 37/016

Language of the proceedings: EN

Title of invention:

Carbon particle fiber assembly technique

Applicant:

LUCENT TECHNOLOGIES INC.

Opponent:

-

Headword:

-

Relevant legal provisions:

EPC Art. 111(1), 123(2)

EPC R. 137(4)

Relevant legal provisions (EPC 1973):

-

Keyword:

"Added subject-matter - No after amendment"

"Remittal - yes"

Decisions cited:

-

Catchword:

-



Case Number: T 1910/08 - 3.2.07

D E C I S I O N
of the Technical Board of Appeal 3.2.07
of 02 April 2009

Appellant: LUCENT TECHNOLOGIES INC.
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Representative: Schulz, Dirk
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Decision under appeal: Decision of the Examining Division of the
European Patent Office posted 09 April 2008
refusing European application No. 05250871.0
pursuant to Article 97(1) EPC.

Composition of the Board:

Chairman: H. Meinders
Members: P. O'Reilly
E. Dufrasne

Summary of Facts and Submissions

- I. European application No. 05 250 871 was refused by the examining division.

The examining division considered that the amendment to claim 18 of each of the main and the first auxiliary requests added subject-matter contrary to Article 123(2) EPC. The examining division refused to admit the second auxiliary request on the basis that the amended claim 8 contained in the request gave rise to new objections under Article 84 EPC and Article 123(2) EPC.

- II. The appellant (applicant) filed an appeal against that decision.

- III. The appellant requested that the decision under appeal be set aside and that the case be remitted to the department of first instance for further prosecution on the basis of the primary request or, in the alternative, on the basis of the first or the second auxiliary request, all filed with letter dated 18 August 2008, or the third, fourth or fifth auxiliary request, filed during the oral proceedings before the Board on 2 April 2009.

- IV. The independent claims of the **main** request (filed as "primary request") read as follows:

"1. A method for assembling carbon particles into at least one aligned carbon fiber, the method comprising the step of drawing glass containing said carbon particles so as to form at least one carbon fiber from said carbon particles."

"18. A carbon particle fiber comprising aligned carbon particles that were aligned by having been drawn while intermixed within a glass-based carrier substance."

The independent claims of the **first** auxiliary request read as follows (amendments when compared to corresponding claims of the main request are depicted in bold or struck through):

"1. A method for assembling carbon particles into at least one aligned carbon fiber, the method comprising the step of drawing glass containing said carbon particles so as to form at least one carbon fiber from said carbon particles."

"18. A carbon particle fiber comprising aligned carbon particles that were aligned by having been drawn while intermixed within ~~a glass-based carrier substance~~ **glass.**"

The independent claims of the **second** auxiliary request read as follows (amendments when compared to the corresponding claims of the first auxiliary request are depicted in bold):

"1. A method for assembling carbon particles into at least one aligned carbon **particle** fiber, the method comprising the step of drawing glass containing said carbon particles so as to form at least one carbon **particle** fiber from said carbon particles."

"18. A carbon particle fiber comprising aligned carbon particles that were aligned by having been drawn while intermixed within glass."

The independent claims of the **third** auxiliary request read as follows (amendments when compared to the corresponding claims of the second auxiliary request are depicted in bold or struck through):

"1. A method for assembling carbon particles into at least one aligned carbon particle fiber, the method comprising the step of drawing glass containing said carbon particles so as to form at least one carbon fiber from said carbon particles."

"18. A carbon particle fiber comprising aligned carbon particles that were aligned by having been drawn while ~~intermixed~~ **dispersed** within glass."

In addition claim 6 of this request was amended compared to claim 6 of the main request to amend the expression "carbon fibers" to "carbon particle fibers" on its three occurrences in the claim.

It is not necessary to indicate the wording of the claims of the **fourth** and **fifth** auxiliary requests since they are not the subject of this decision.

V. The arguments of the appellant may be summarised as follows:

- (i) The amendments made to claim 18 of the main request do not contravene Article 123(2) EPC.

The expression "glass-based carrier substance" has a basis in the description as originally filed on page 1, lines 26 to 28 wherein it is indicated that the glass may be imbued with optional components. This means that the carbon particles are not in pure glass but rather in a glass-based substance due the possible presence of the optional components, which can even be present in a substantial amount. Also the fact that on page 1, lines 20 to 21 reference is made to the carbon particles being embedded in glass means that the glass acts as a carrier substance as specified in the claim. This part of the description as well as page 4, lines 14 to 17 support also the expression "intermixed within" as used in the claim. If the particles are embedded and dispersed within the glass then they must be intermixed within the glass since these three expressions all have the same meaning.

- (ii) The claim 18 of each of the first and the second auxiliary requests are identical and do not contain the expression "glass-based carrier substance" but merely refer to "glass" so that the objections to the former expression should be overcome in the amended claim 18 of these requests.
- (iii) Claim 1 of the second auxiliary request has the expression "carbon fiber" replaced by "carbon particle fiber". A basis for this amendment can be found on page 6, lines 3 and 4 of the application as originally filed.

(iv) In claim 18 of the third auxiliary request the expression "intermixed within" has been replaced by "dispersed within". Since there is a clear basis for the latter expression in the description on page 4, lines 14 to 16 the amendment conforms to Article 123(2) EPC.

IX. In a communication accompanying the summons to oral proceedings the Board set out its provisional opinion. It indicated that claim 18 of each of the requests filed with the appeal grounds dated 18 August 2008 might not comply with Article 123(2) EPC. Furthermore, the Board noted that the amendments made to this claim might not be in accordance with Rule 137(4) EPC.

Reasons for the Decision

Main request

1. *Added subject-matter*

1.1 The claims of the present main request are identical to the claims of the main request on which the examining division based its decision. It rejected the request on the basis that the amendments to claim 18 offended against Article 123(2) EPC, objecting to the addition of the expression "glass-based carrier substance". It considered that this expression had a broader meaning than just "glass" which is mentioned in the description as originally filed.

The appellant argued that there is a basis for the amendment in the description on page 1, lines 24 to 26

which refers to the glass body being imbued with one or more materials to influence the properties of the body. This part of the description, however, is imprecise as to the amount of material that is imbued. Even very small amounts of some materials can influence the properties of glass. The amendment to claim 18, however, introduces the concept of a "glass-based carrier substance". Such an expression clearly allows that the substance is only partly related to glass, even though the actual nature of the relationship was not disclosed in the application as originally filed, i.e. in which sense is the substance "based" on glass? The part of the description invoked by the appellant as a basis merely indicates that there may be optional additives. There is no indication in the application that these may be such as to change the nature of the glass sufficiently that it may merely be described as "glass-based".

The Board concludes that the decision of the examining division was correct in this respect.

- 1.2 Also the term "carrier" was not contained in the application as originally filed. The appellant considered that the skilled person would understand that this was the function of the glass since the carbon particles are embedded or dispersed in the glass which has no other disclosed function.

The Board cannot agree with the appellant. The description discloses the carbon particles as embedded in or dispersed within the glass. "Embedded" describes the way in which the particles are retained in the glass. "Dispersed" describes the spatial relationship of the particles both to each other and to the glass. The term

"carrier", however, describes a functional relationship, i.e. the particles are carried by the glass during a treatment irrespective of how they are retained in the glass and irrespective of their spatial distribution. There is therefore no basis in the application as originally filed for the introduction into the claim of the term "carrier".

- 1.3 As indicated in its provisional opinion the Board doubted that there was a basis in the application as originally filed for the carbon particles to be described as "intermixed within" the carrier. The appellant referred to page 1, line 20 which refers to the particles being "embedded in glass" and to page 4, lines 15 to 20 which refers to "the dispersion of carbon particles...within...glass." The appellant argued that there was no difference in the meaning of "intermixed within" and the expressions used in the description.

The Board cannot agree with the appellant in this respect. The expression "intermixed within" refers to the mixing of the particles themselves, i.e. their **inter**mixing. The expression "embedded in" refers to the manner in which the particles are retained in the glass. Finally, "dispersion" describes the spatial distribution of the particles in the glass. These are all clearly quite different properties. The parts of the description quoted by the appellant thus do not provide a basis for this amendment to claim 18.

- 1.4 Therefore, the amendments made to claim 18 of this request do not comply with Article 123(2) EPC.

First and second auxiliary requests

2. *Added subject-matter*

2.1 Claim 1 of the second auxiliary request has been amended to replace the expression "carbon fiber" by "carbon particle fiber". A basis for this amendment can be found for example on page 5, lines 11 to 13 and page 6, lines 3 and 4.

Therefore, the amendments made to claim 1 of the second auxiliary request comply with Article 123(2) EPC.

2.2 The claims 18 of each of these requests are identical with each other. Compared to claim 18 of the main request these claims no longer contain the expression "glass-based carrier substance" but do still contain the expression "intermixed within". As already explained above with respect to claim 18 of the main request (see point 1.3) the Board considered that the presence of this latter expression in the claim added subject-matter.

2.3 Therefore, the amendments made to claim 18 of each of these requests do not comply with Article 123(2) EPC.

Third auxiliary request

3. *Added subject-matter*

3.1 In this request the expression "intermixed within" has been replaced by "dispersed within" in claim 18 compared to claim 18 of the second auxiliary request. In the discussion of claim 18 of the main request the Board has noted that the description page 4, lines 15 to 20 refers

to "the dispersion of carbon particles...within...glass."
Thus there is a basis in the description for the expression "dispersed within glass". The Board concludes therefore that this amendment to claim 18 complies with Article 123(2) EPC.

Claim 1 of the third auxiliary request is identical to claim 1 of the second auxiliary request (see point 2.1 above). Claim 6 has been amended so as to be in conformity with claim 1, by referring where applicable to "carbon particle fibres".

3.2 The Board considers therefore that claims 1, 6 and 18 as amended according to this request comply with Article 123(2) EPC.

4. *Extent of the examination of the third auxiliary request by the Board*

4.1 The Board has examined only the claims of the third auxiliary request for compliance with Article 123(2) EPC.

4.2 The Board has thus not examined the amendments to the description for conformity with Article 123(2) EPC or any other requirement of the Convention, nor has the Board examined the claims for conformity with any other requirement of the Convention.

4.3 The Board has in particular not considered whether the amendments to claim 18 of the third auxiliary request comply with Rule 137(4) EPC since such an examination requires an assessment of what has been searched which can only be carried out by the examining division, as

well as an assessment of unity of invention which it has not (yet) performed.

5. *Remittal to the department of first instance*

5.1 The examining division has not yet carried out a complete examination of the application (as amended during the appeal proceedings). In accordance with Article 111(1) EPC the Board therefore considers it appropriate, in accordance with the request of the appellant, to remit the case to the department of first instance so as to give the appellant the possibility to argue its case before two instances.

Order

For these reasons it is decided that:

1. The decision under appeal is set aside.
2. The case is remitted to the department of first instance for further prosecution.

The Registrar:

The Chairman:

G. Nachtigall

H. Meinders