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**Datasheet for the decision
of 8 October 2013**

Case Number: T 0409/10 - 3.3.10

Application Number: 03000556.5

Publication Number: 1300456

IPC: C09K3/14, B24B31/116

Language of the proceedings: EN

Title of invention:
Abrasive liquid slurry

Patent Proprietor:
EXTRUDE HONE CORPORATION

Opponent:
Sonplas GmbH

Headword:

Relevant legal provisions:
EPC Art. 76(1), 84, 101(3)
EPC R. 43(1)

Keyword:
Divisional application - added subject-matter (yes)
- main request
Claims - clarity after amendment (no) - product defined by
trade mark - auxiliary requests 1 and 2

Decisions cited:
T 0762/90, T 0459/09

Catchword:



**Beschwerdekammern
Boards of Appeal
Chambres de recours**

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Case Number: T 0409/10 - 3.3.10

D E C I S I O N
of Technical Board of Appeal 3.3.10
of 8 October 2013

Appellant: EXTRUDE HONE CORPORATION
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Decision under appeal: **Decision of the Opposition Division of the
European Patent Office posted on 7 December 2009
revoking European patent No. 1300456 pursuant to
Article 101(3) (b) EPC.**

Composition of the Board:

Chairman: P. Gryczka
Members: R. Pérez Carlón
D. Rogers

Summary of Facts and Submissions

- I. The appellant (patent proprietor) lodged an appeal against the decision of the opposition division to revoke European patent No. 1 300 456, arising as a divisional application from parent application EP 96 928 033.8.
- II. An opposition was filed, on the grounds that the patent in suit contained subject-matter which extended beyond the content of the patent as originally filed and beyond the content of the earlier application EP 96 928 033.8 (Article 100(c) EPC), that the invention was not disclosed in a manner sufficiently clear and complete for it to be carried out by a person skilled in the art (Article 100(b) EPC), and that subject-matter of the patent as granted did not involve an inventive step (Article 100(a) EPC).
- III. The opposition division came to the conclusion that the then pending main request and auxiliary requests 1 to 4 contained added subject-matter, and that the subject-matter of the then pending auxiliary requests 10 and 11 was not sufficiently disclosed for it to be carried out by a person skilled in the art. The then pending auxiliary request 5 to 9 were not admitted into the proceedings.
- IV. Under cover of a letter dated 9 September 2013, the appellant filed a main request and auxiliary requests 1 and 2. Claim 1 of these requests reads as follows:

Main request:

"An abrasive liquid abrasive slurry for polishing and

radiusing microholes, said abrasive liquid slurry comprising:

a low viscosity naphthenic mineral oil,

finely divided abrasive particles of #400 to #1000 mesh, and selected from silicon carbide, boron carbide, garnet and diamond, and

low molecular weight polyethylene as a rheological additive for making the slurry thixotropic,

the slurry having sufficient viscosity at low shear rates to remain homogeneous and to maintain a uniform distribution of abrasive grain, and

the slurry having a viscosity of about 100,000 cps with a Brookfield spindle #3 rotating at less than 1 rpm and a viscosity of about 800 cps with the spindle #3 at 100 rpm."

In claim 1 of the first auxiliary request, the low molecular weight polyethylene component was further defined as:

"low molecular weight polyethylene Allied Signal AC-9 as a rheological additive for making the slurry thixotropic".

Whereas this feature was worded in the second auxiliary request as:

"low molecular weight polyethylene Allied Signal AC-9 as a rheological additive that creates a thixotropic slurry".

- V. The arguments of the appellant relevant for the present decision were the following:

The skilled reader would extract from the passage on page 8, line 14-16 of the parent application EP 96 928 033.8 the information that any low molecular weight polyethylene was a suitable rheological additive for the claimed invention, with the consequence that claim 1 of the main request did not contain subject-matter which went beyond the content of the earlier application.

Since clarity was not a ground of opposition, and the feature of claim 1 of the first and second auxiliary requests "Allied Signal AC-9" had already been present in granted claim 3, which was dependent from claim 1, its clarity was not open to examination by the board.

Claim 1 of the first and second auxiliary requests should be interpreted as comprising Allied Signal AC-9 as sold at the filing date, with the consequence that claim 1 was clear.

- VI. The arguments of the respondent (opponent) relevant for the present decision were the following:

On page 8, lines 14-16 of the parent application, the feature "low molecular weight polyethylene" was disclosed in combination with "Allied Signal AC-9". Since the later restriction was not a feature of claim 1, said claim contained subject-matter which went beyond the disclosure of the earlier application.

The composition of the blend commercialised as "Allied Signal AC-9" could have changed during the patent term, with the consequence that claim 1 of the first and

second auxiliary requests were not clear.

Although the feature "Allied Signal AC-9" had been already present in the claims as granted, claim 1 of the first and second auxiliary requests did not result from a mere combination of granted claims, so that the board must examine its clarity.

VII. Oral proceedings before the board took place on 8 October 2013.

VIII. The final requests of the parties were the following:

- The appellant requested that the decision under appeal be set aside and that the patent be maintained upon the basis of the claims of the main request, or alternatively, upon the basis of either auxiliary request 1 or 2, all requests having been filed under cover of a letter dated 9 September 2013.
- The respondent requested that the appeal be dismissed.

IX. At the end of the oral proceedings, the decision was announced.

Reasons for the Decision

1. The appeal is admissible.

Main request:

2. Extension beyond the earlier application, Article 76(1) EPC:

Claim 1 of the main request contains the feature "low molecular weight polyethylene as a rheological additive for making the slurry thixotropic".

- 2.1 It has not been contested by the appellant that the only reference to the feature "low molecular weight polyethylene" in the parent application EP 96 928 033.8 (published as WO 97/05989) can be found on page 8, line 14-16, and reads:

"An additive which imparts the rheological properties to the slurry is low molecular weight polyethylene Allied Signal AC-9."

- 2.2 It has been, however, a point of dispute between the parties whether this passage provided a basis for the feature "low molecular weight polyethylene", without any further restriction, as in claim 1 of the main request.

The appellant argued that the skilled person, when reading the above quoted paragraph, would extract the information that any low molecular weight polyethylene was suitable for carrying out the invention. Furthermore, said paragraph mentioned "an additive", not "the additive", which clearly indicated that other possibilities apart from the one explicitly mentioned existed.

The board is, however, of the opinion that the passage on page 8 of the description of the parent application quoted above discloses one suitable additive, namely Allied Signal AC-9, but fails to disclose, in general, every low molecular weight polyethylene. Whether the skilled reader would contemplate, as alleged by the appellant, other low molecular weight polyethylene as

alternatives is a matter of obviousness, not of disclosure. The feature "low molecular weight polyethylene" in the main request represents an unallowable generalisation of the embodiment disclosed in the parent application (that is, "low molecular weight polyethylene Allied Signal AC-9"), for which no basis can be found in the parent application.

For this reason, it is concluded that the subject-matter of claim 1 of the main request extends beyond the content of the earlier application as filed, with the consequence that the main request is not allowable.

Auxiliary requests 1 and 2:

3. Clarity, Article 84 EPC:

3.1 The appellant argued that the feature "Allied Signal AC-9" was already present in dependent claim 3 as granted. According to the jurisprudence of the Boards of Appeal the board could not examine this feature with regards to Article 84 EPC, as clarity was not a ground for opposition.

According to the established jurisprudence of the Boards of Appeal, see for example in T 459/09 (not published in the Official Journal of the EPO, see headnote), any amendment that can be qualified as being of a substantial nature would in principle justify an unrestricted exercise of the examination power derivable from Article 101(3) EPC, including the examination of clarity, independently of whether the amendment arises from the incorporation of a feature from the description or from the combination of claims of the granted patent.

In addition, claim 1 does not result, as alleged by the appellant, from the mere combination of the subject-matter of granted claims. The feature "low molecular weight polyethylene Allied Signal AC-9" was present in claim 3 as granted. However, this claim indicated that the **slurry** was polyethylene Allied Signal AC-9, whereas claim 1 of the auxiliary requests 1 and 2 requires that this component is the rheological additive of the slurry, and not the slurry itself.

Since the feature "low molecular weight polyethylene Allied Signal AC-9" represents a substantial amendment of the subject-matter claimed the board is entitled to examine it with respect to its clarity in order to decide whether, taking into account the amendments made, the patent meets the requirements of the EPC as required by Article 101(3).

- 3.2 The appellant has argued that the meaning of Allied Signal AC-9 was clear at the date of filing of the patent in suit and any change of composition at a later point of time was irrelevant for the clarity of the claim.

In contrast to other articles of the EPC such as Article 54, Article 84 does not include any reference to any point of time. Hence, the board cannot find this request to satisfy the requirements of Article 84 EPC merely because it is asserted that there was a point in the past at which a term used in the claim would have been clear.

This argument of the appellant is, thus, dismissed.

- 3.3 Article 84 in connection with Rule 43(1) EPC requires that the claims shall be clear and define the matter

for which protection is sought in terms of the technical features of the invention. This requirement ensures that the public is not left in any doubt as to which subject-matter is covered by a particular patent and which is not. It follows from the requirement of legal certainty that a claim cannot be considered clear in the sense of Article 84 EPC if it comprises an unclear technical feature for which no unequivocal generally accepted meaning exists in the relevant art.

Claim 1 of the auxiliary requests 1 and 2 contains the feature "low molecular weight polyethylene Allied Signal AC-9". It is established jurisprudence of the Boards of Appeal that the use of a trade mark in a claim results in a lack of clarity of said claim since it is uncertain whether the meaning of such a trade mark would remain unaltered up to the end of the patent term (see for example T 762/90, point 4.1.1 of the reasons, not published in the OJ EPO). Since, in the present case, there is no evidence on file on the contrary, it is concluded that the blend marketed under the name Allied Signal AC-9 could have changed, or could change, in composition during the patent term, with the consequence that claim 1 of the first and second auxiliary requests are not clear.

Order

For these reasons it is decided that:

The appeal is dismissed.

The Registrar:

The Chairman:



C. Rodríguez Rodríguez

P. Gryczka

Decision electronically authenticated