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**Datasheet for the decision
of 19 October 2022**

Case Number: T 0303/20 - 3.3.05

Application Number: 15156338.4

Publication Number: 2913417

IPC: C22C19/05, C22F1/10

Language of the proceedings: EN

Title of invention:

Article and method for forming article

Patent Proprietor:

General Electric Company

Opponent:

Siemens Aktiengesellschaft

Headword:

Article and method for forming article/General Electric

Relevant legal provisions:

EPC Art. 123(2)
RPBA 2020 Art. 13(2)

Keyword:

Amendments - allowable (yes)

Decisions cited:

T 1563/10, T 0107/14

Catchword:



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Case Number: T 0303/20 - 3.3.05

D E C I S I O N
of Technical Board of Appeal 3.3.05
of 19 October 2022

Appellant: Siemens Aktiengesellschaft
(Opponent) Werner-von-Siemens-Straße 1
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Respondent: General Electric Company
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Representative: Openshaw & Co.
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Decision under appeal: **Decision of the Opposition Division of the
European Patent Office posted on 2 December 2019
rejecting the opposition filed against European
patent No. 2913417 pursuant to Article 101(2)
EPC.**

Composition of the Board:

Chairman E. Bendl
Members: J. Roider
O. Loizou

Summary of Facts and Submissions

- I. The opponent's (appellant's) appeal lies from the opposition division's decision to reject the opposition.
- II. The appellant's only objection in the appeal proceedings concerning the claims as granted (main claim request) was that the subject-matter of claim 1 went beyond the original disclosure.
- III. In the communication under Article 15(1) RPBA, the board expressed the opinion that the requirements of Article 123(2) EPC seemed to be fulfilled and that, since no other ground of opposition had been validly raised, the appeal should be dismissed.
- IV. Claim 1 of the main request reads as follows (bold: features from original claim 3; underlined: features from original claim 2; rest: original claim 1):

"An article comprising an equiaxed grain structure and a composition, wherein the composition comprises, by weight percent:

6.0% to 9.0% aluminum (Al);

up to 0.5% titanium (Ti);

*2.5% to 4.5% tantalum (Ta), **which is optionally replaced completely or partly by niobium (Nb) on a 1:1 molar basis;***

10.0% to 12.5% chromium (Cr);

5.0% to 10.0% cobalt (Co);

0.30% to 0.80% molybdenum (Mo);

2.0% to 5.0% tungsten (W);

up to 1.0% silicon (Si);

0.35% to 0.60% hafnium (Hf);

*0.005% to 0.010% boron (B);
0.06% to 0.10% carbon (C);
up to 0.02% zirconium (Zr);
up to 0.1% lanthanum (La);
up to 0.03% yttrium (Y); and
balance nickel (Ni) and incidental impurities, and
wherein rhenium (Re), if present, is a trace element in
an amount of less than 0.01%, by weight, of the
composition."*

V. Requests

The appellant (opponent) requested that the decision under appeal be set aside and the patent be revoked.

The respondent (patent proprietor) requested that the appeal be rejected as inadmissible or be dismissed (main request), or, in the alternative, that the patent be maintained as amended on the basis of one of the two auxiliary requests filed with the reply to the grounds of appeal.

Reasons for the Decision

1. Admissibility of the appeal

1.1 With the notice of appeal the appellant set out the grounds of appeal (pages 2 and 3) but did not refer to any articles of the EPC. In view of the context of the impugned decision, it is apparent to the board that the appellant is challenging some of the reasons relating to Article 100(c) EPC. In particular, the appellant establishes why, in its opinion, the opposition

division erred in deciding that the alloy composition as defined in the subject-matter of claim 1 as granted did not add subject-matter with respect to the application as originally filed.

It did not make any further objections, as was confirmed at the oral proceedings before the board (see the minutes).

- 1.2 Since at least one of the grounds mentioned in the impugned decision leading to the maintenance of the patent in unamended form has been objected to and discussed in the grounds of appeal, the appeal is considered to be admissible.
2. Main request, Article 123(2) EPC
 - 2.1 The subject-matter of claim 1 as granted is the combination of the features contained in claims 1, 2 and 3 as originally filed (see point IV. above).
 - 2.2 The appellant is of the opinion that this combination was not originally disclosed because original claim 1 related to a closed composition and did not allow for additional elements. According to original claim 3, part of the tantalum was to be replaced with niobium on a 1:1 molar basis, in contradiction with original claim 1 (see T 1563/10, reasons 2.1). A lack of clarity was incompatible with the requirements of Article 123(2) EPC, according to which the subject-matter must, *inter alia*, be directly and unambiguously disclosed.
 - 2.3 Claim 3 as originally filed refers back to, *inter alia*, claim 2 as originally filed and thus contains all its features. Claim 2 as originally filed refers back to

claim 1 as originally filed and thus contains all its features.

Claim 1 as originally filed specifies that the alloy "*comprises*" a certain list of elements and also that Ni represents "*the balance*" of the composition. This wording clearly and unambiguously discloses that the rest of the composition consists of Ni and that no further elements may be present. In other words, claim 1 as originally filed was directed to a closed composition.

However, dependent claim 3 as originally filed stipulates replacing tantalum with niobium on a 1:1 molar basis. This definition thus adds niobium - a further element - contrary to the wording of claim 1. Therefore, original claim 3 is to be seen as a "*false dependent claim*", relating to a further composition that consists of the elements listed in both claims 1 and 3 as originally filed (see also T 107/14, reasons 1.1).

Notwithstanding the question of whether a lack of clarity may arise if a set of claims contains false dependent claims (see T 1563/10) and whether this question is relevant in the context in hand, this potential contradiction was in any case overcome in this matter by the amendment combining original claims 1, 2 and 3, ultimately leading to the current claim 1.

3. The appellant argued that replacing tantalum with niobium on a 1:1 molar basis meant that the weight range according to claim 1 could not be achieved because niobium had only about half the specific weight of tantalum. The combination of original claims 1 and 3

thus infringed the requirements of Article 123(2) EPC.

4. The respondent requested that this argument not be taken into account pursuant to Article 13(2) RPBA 2020 because it was first raised in a letter submitted by the appellant after the notification of the summons to oral proceedings and there were no exceptional circumstances which could justify its admission.
5. Irrespective of whether or not this new line of reasoning is admissible, it is not successful. The disputed feature was contained verbatim in original claim 3. Therefore, this cannot infringe the requirements of Article 123(2) EPC.

Order

For these reasons it is decided that:

The appeal is dismissed.

The Registrar:

The Chairman:



C. Vodz

E. Bendl

Decision electronically authenticated