Europäisches Patentamt
Beschwerdekammern

European Patent Office
Boards of Appeal

Office européen des brevets
Chambres de recours

Veröffentlichung im Amtsblatt	Ja/Nein
Publication in the Official Journal	Yes/No
Publication au Journal Officiel	Oui/Non

Aktenzeichen / Case Number / N° du recours : T 13/83

Anmeldenummer / Filing No / N° de la demande : 79 301 445.7

Publikations-Nr. / Publication No / N° de la publication : 0 008 170

Bezeichnung der Erfindung:
Title of invention:
Titre de l'invention : "Polyisocyanurate containing moulding compositions

ENTSCHEIDUNG / DECISION

vom / of / du 13 April 1984

Anmelder/Patentinhaber:
Applicant/Proprietor of the patent:
Demandeur/Titulaire du brevet : ICI AMERICAS

Stichwort / Headword / Référence :

EPÜ / EPC / CBE Article 123(2), Rule 88, Article 84

"Erroneous technical calculation"

Leitsatz / Headnote / Sommaire

Rule 88 EPC does not apply to a non-obvious correction of an error in the description or claims which results from an erroneous technical calculation. A correction of such an error is allowable under Article 123(2) EPC if the amendment would be regarded by the skilled reader as clearly implied by the disclosure of the application as filed. If more than one arithmetical possibility of correction can be envisaged the correction chosen must be the one which the application as a whole clearly implies.

Europäisches Patentamt
Beschwerdekammern

European Patent Office
Boards of Appeal

Office européen des brevets
Chambres de recours

Case Number: T 13 / 83

DECISION

of the Technical Board of Appeal 3.3.1

of 13 April 1984

Appellant: ICI AMERICAS INC.
Concord Pike and New Murphy Road
Wilmington
Delaware 19899
U S A

Representative: Cooke, Edward Graham
Imperial Chemical Industries Limited Legal Dept.
Patents Thames House North Millbank
London SW1P 4QG
Great Britain

Decision under appeal: **Decision of Examining Division** Oll **of the European Patent Office dated** 26 July 1982 **refusing European patent application No** 79 301 445.7 **pursuant to Article 97(1) EPC**

Composition of the Board:

Chairman: D. Cadman
Member: H. Robbers
Member: O. Bossung

Summary of Facts and Submissions

I. European patent application No. 79 301 445.7, filed on 26.07.1979, published on 20.02.1980 (publication No. 0 008 170), claiming a priority of 27.07.1978, based upon the United States application Serial No. 928 690, was refused by decision of the Examining Division 011 of the European Patent Office, dated 26.07.1982. The subject of the decision was the amended claim 1, filed on 22.04.1982.

The ground for refusal was that this claim did not meet the requirements of Rule 88. The decision did not consider the question of whether or not the amended claim 1 contravened Article 84 EPC.

II. On 22.09.182 the applicant lodged an appeal against the decision, followed by a Statement of Grounds on 23.10.1982. The appeal fee was duly paid.

III. The appellant requests the cancellation of the decision and the acceptance of the revised claim 1 filed on 25.01.1982. This claim reads as follows:

1. A resin blend, useful in preparing non-sticky moulding compositions by the reaction therewith of polyisocyanate, which comprises:

5-93.5% by weight of a polyethylenically unsaturated polyisocyanurate resin obtained by the reaction of a vinylidene hydroxyl compound and a trimerisable aromatic polyisocyanate having at least two isocyanate groups, the mol ratio of NCO/OH being from 0.75 to 1.6
5-93.5% by weight of an ethylenically unsaturated monomer, and 1.5-30% by weight of relatively non-polar

polyol free of ethylenic unsaturation having a molecular weight in the range of 300-2,000 selected from the group consisting of polyols of polyethylene glycol, polypropylene glycol, polytetramethylene glycol, aromatic ethers which are condensation products of propylene oxide and aromatic polyols, and dihydroxy terminated polyesters derived from glycols or polyether glycols and dicarboxylic acids.

Alternatively, it is requested that a revised claim be allowed with the modification that the first and second component (hereinafter components A and B) are defined as "at least 5% by weight of ... . In its modified form this claim reads as follows:

A resin blend, useful in preparing non-sticky moulding compositions by the reaction therewith of polyisocyanate, which comprises:

A. At least 5% by weight of a polyethylenically unsaturated polyisocyanurate resin obtained by the reaction of a vinylidene hydroxyl compound and a trimerisable aromatic polyisocyanate having at least two isocyanate groups, the mol ratio of NCO/OH being from 0,75 to 1,6.

B. At least 5% by weight of an ethylenically unsaturated monomer, and

C. 1.5-30% by weight of relatively non-polar polyol free of ethylenic unsaturation having a molecular weight in the range of 300-2,000 selected from the group consisting of polyols of polyethylene glycol, polypropylene

glycol, polytetramethylene glycol, aromatic ethers which are condensation products of propylene oxide and aromatic polyols, and dihydroxy terminated polyesters derived from glycols or polyether glycols and dicarboxylic acids, the total of A, B and C adding up to 100%.

The appellant also requests that the appeal fee be refunded under Rule 67 EPC.

IV. In the Statement of Grounds the appellant argues that the amendment is an obvious one to make since it is arithmetically determined and therefore is consistent with Rule 88 EPC.

Reasons for the Decision

1. The appeal complies with Articles 106-108 and Rule 64 EPC. It is therefore admissible.

2. Claim 1 as initially filed reads as follows:

1. A resin blend useful in preparing non-sticky moulding compositions by the reaction therewith of polyisocyanate, which comprises:

5-95% by weight of polyethylenically unsaturated polyisocyanurate resin,

5-95% by weight of an ethylenically unsaturated monomer, and 1.5-30% by weight of relatively non-polar polyol free of ethylenic unsaturation having a molecular weight in the range of 300-2,000 selected from the group consisting of polyols of polyethylene glycol, polypropylene glycol, polytetramethylene glycol, aromatic ethers which

are condensation products of propylene oxide and aromatic polyols, and dihydroxy terminated polyesters derived from glycols or polyether glycols and dicarboxylic acids.

This claim is defective in two respects:

(a) the total of the minima of B and C and the maximum of A amounts to 101,5%;
(b) the total of the minima of A and C and the maximum of B again amounts to 101,5%.

Therefore, it offends against Article 84 EPC in the matter of clarity.

3. The decision of the Examining Division is based upon Rule 88 EPC. This rule says that a correction of an error which concerns the description, claims or drawings should be allowed only if the correction is obvious in the sense that it is immediately evident that nothing else would have been intended than what is offered as the correction (in the German text even: "...daß, nichts anderes beabsichtigt sein konnte...").

4. However in the present case the appropriate correction of the erroneous technical calculation is not obvious in the sense required by Rule 88. It is moreover observed that the applicant did not expressly request a correction on the basis of the said Rule.

4. A similar case has already occurred : case T 02/80 (Official Journal 10/81). This case concerned a mixture consisting of five components A, B, C, D and E, A being the major component with B, C, D and E as additives in specified proportions. The total of the minima of B, C, D and E amounted to more than 100%, and correction of this error by deleting the maximum percentage of A was allowed. In the decision it was also stated that this correction did not contravene Article 123(2) EPC.

6. The Board takes the position that in order for a correction of the said error to be allowable, it must remove the objection under Article 84 EPC, but without causing an amendment to be made which would add subject-matter to the application and thus contravene Article 123(2) EPC.

7. The Board also takes the position that where a drafting error in an application would be evident to a reader skilled in the art, the person to whom the application is addressed, it is reasonable to suppose that he would, in the light of the content of the application, attempt to formulate a notional correction which would enable him to make sense of what he reads, and to the extent that the correction might be said to leap to the mind of the reader, although perhaps only after close study of the document, it can be regarded as implicit in the application and would not contravene Article 123(2) EPC if effected in practice.

However, it is not to be supposed that where, as in the present case, several alternatives can be seen for the correction of an arithmetical error, that all can be treated as implied in the application. In particular, where the correction would extend a percentage range in-

to territory that the applicant had not sought to cover in his application as originally filed, then it may be said that such a correction could not be regarded as implied in the application, since it would, metaphorically, involve taking a step into the dark with unknown technical consequences, and would therefore be rejected by the skilled reader. In addition, such a correction, even if arithmetically straightforward, would introduce not only the new end point to the range, but also all points between it and the old end point, which effect could scarcely be said not to add to the subject-matter of the application.

8. Applying the above principles to the present case, there can be no real doubt that the defect in Claim 1 as originally filed was such that it would have been quickly picked up by the skilled reader. When, however, the reader proceeded to attempt to make sense of the claim, he would have encountered the difficulty that there existed more than one way in which matters could have been put right. However, as far as solutions which involved reduction of the minimum quantities of components A and B or C by 1.5% are concerned, such solutions would not be allowed, since they would involve extension rather than contraction of ranges, and in the case of component C, would even result in the possibility of its total absence from the claimed compositions, which could not have been implied in the application as filed, since Component C is the characterising component of the said compositions. It is understood that this component serves as a thickening agent which is applied in a minor amount and that the specific properties which distinguish the end product from the state of the art are mainly determined by this component and the proportion

thereof. Therefore, it is in the maxima of A and B that the solution to the difficulty should be sought.

9. The maxima of A and B in claim 1 as filed were both 95% and it can readily be seen that to reduce only one of them to 93.5% would not remove the defect in the case where the quantity of the other employed was 95%. Therefore both maxima must be reduced to 93.5% in order to remove the defect completely, and this is something which, the Board is satisfied would strike the skilled reader as the most straightforward correction to apply, in the sense that it is the one to which the application itself leads him. That is also precisely what the appellant proposes and what the Board accepts as clarifying the claim without contravening Article 123(2).

10. Another possible correction different from the one proposed by the appellant is the alternative proposal laid down in the statement of grounds (page 3, lines 14-19). Since the Board has adopted the appellant's preferred proposal, no further consideration of this alternative proposal is called for.

12. Reimbursement of an appeal fee may be ordered where a Board of Appeal deems an appeal to be allowable, if such reimbursement is equitable by reason of a substantial procedural violation (Rule 67 EPC). Such a violation cannot be said to exist in this case. It is true that the claim which is accepted now by the Board was proposed already by the appellant on 25.01.1982, although it was not accepted by the Examining Division. This does not constitute a procedural violation but only a contestable judgement. Moreover, the appellant himself did not contest this judgement but filed a new revised claim instead.

Order

For the foregoing reasons it is decided that:

1. The decision of the Examining Division 011 of 26.07.1982 is set aside.

2. The case is remitted to the first instance with the order to reconsider it on the basis of this decision.

3. The request for reimbursement of the appeal fee is rejected.

The Registrar
J. Rückerl

The Chairman
D.L.T. Cadman