

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

Aktenzeichen / Case Number / N^o du recours : T 122/90 - 3.4.1

Anmeldenummer / Filing No / N^o de la demande : 84 201 357.5

Veröffentlichungs-Nr. / Publication No / N^o de la publication : 138 258

Bezeichnung der Erfindung: Heat recoverable articles

Title of invention:

Titre de l'invention :

Klassifikation / Classification / Classement : G09F 3/02

ENTSCHEIDUNG / DECISION

vom / of / du 29 November 1990

Anmelder / Applicant / Demandeur : RAYCHEM LIMITED (GB)

Patentinhaber / Proprietor of the patent /

Titulaire du brevet :

Einsprechender / Opponent / Opposant :

Stichwort / Headword / Référence :

EPO / EPC / CBE Article 76(1)

Schlagwort / Keyword / Mot clé : Extension of the subject-matter of a divisional application beyond the content of the earlier application - No, after amendments.

Leitsatz / Headnote / Sommaire

**Europäisches
Patentamt**
Beschwerdekammern

**European Patent
Office**
Boards of Appeal

**Office européen
des brevets**
Chambres de recours



Case Number : T 122/90 - 3.4.1

D E C I S I O N
of the Technical Board of Appeal 3.4.1
of 29 November 1990

Appellant : RAYCHEM LIMITED
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Representative : Dlugosz, Anthony Charles
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Decision under appeal : Decision of Examining Division 063 of the European Patent Office dated 30 May 1989 refusing European patent application No. 84 201 357.5 pursuant to Article 97(1) EPC

Composition of the Board :

Chairman : K. Lederer
Members : R. Shukla
G. Paterson

Summary of Facts and Submissions

I. European patent application No. 84 201 357.5 under dispute is a divisional application filed on 24 September 1984 under the provisions of Rule 25(1)(a) EPC and was divided from an earlier European patent application No. 81 303 441.0 filed on 27 July 1981 and published on 3 February 1982.

II. The above divisional application was refused by decision of the Examining Division. The reason given for the refusal was that the subject-matter of the application extended beyond the content of the earlier application as filed and, therefore, the divisional application did not comply with the requirements of Article 76(1) EPC.

In particular, it was considered that in the earlier application as filed the final process step of cross-linking bond forming parts of the polymeric material or the feature that the bond forming parts are cross-linked is obligatory. According to the subject-matter of Claim 1 of the application in suit, on the other hand, the bond forming parts may not be cross-linked so that the requirements of Article 76(1) EPC are not met.

III. The Applicant lodged an appeal against the decision and, along with the Statement of Grounds of Appeal, he submitted a new main claim as an auxiliary request.

IV. In response to a communication from the Board raising objections under Article 76(1) EPC to claims according to main and auxiliary requests, the Appellant, following a suggestion from the Board, filed a new Claim 1 and new pages of the description. He now requests that the

appealed decision be set aside and a patent be granted on the basis of the following documents:

Claims : 1 to 5 filed on 8 November 1990;
6 to 9 filed on 24 September 1984;

Description : pages 1 to 2 and 5 to 14 filed on
24 September 1984;
pages 3 and 4 filed on 8 November 1990;

Drawings : sheets 1/3 to 3/3 filed on
24 September 1984.

V. The valid Claim 1 reads as follows:

"A sleeve assembly comprising a web (1a, 5, 8a) of heat-recoverable polymeric material that is bonded to itself or to at least one other polymeric web (1b, 8b-8d) along a plurality of longitudinally spaced-apart transversely extending seams (2, 6, 10a, 10b) to define a plurality of open-ended radially inwardly head-recoverable sleeves (4, 7, 12) disposed in side-by-side relationship, the seams (2, 6, 10a, 10b) providing lines of weakness to facilitate detachment of individual sleeves, the polymeric material forming the or each web being cross-linkable so that the bonded parts of the web(s) can be cross-linked, and the assembly including a retaining spine extending along an edge of the assembly."

Claims 2 to 9 are dependent claims.

VI. In support of the allowability of his request, the Appellant argued essentially as follows:

In the earlier application, a heat-recoverable marker sleeve assembly and a process for manufacturing such a

marker sleeve assembly are described. The manufacturing process consists of a number of sequential steps whereby a product is formed at the end of each of the steps. The marker sleeve assembly forming the subject-matter of the claimed invention is the last intermediate product that arises before the step of cross-linking so that the description of the process leading up to the step of cross-linking in the earlier application constitutes a clear disclosure of the claimed intermediate product. The application in suit, therefore, meets the requirements of Article 76(1) EPC.

Reasons for the Decision

1. The appeal is admissible .
2. Claim 1 of the divisional application in suit relates to a sleeve assembly comprising heat-recoverable sleeves disposed in a side-by-side relationship and formed from at least one web of polymeric material and a retaining spine extending along an edge of the assembly. Bonded seams which define the sleeves provide lines of weakness to facilitate detachment of the individual sleeves. According to the claim, the polymeric web of which the sleeve assembly is formed is cross-linkable so that the bonded parts of the sleeve assembly can be cross-linked. The latter are, however, not cross-linked.
- 3.1 According to one preferred mode of manufacturing a marker sleeve assembly described in the earlier application (page 4, lines 1 to 12 in combination with page 11, lines 1 to 16, figures 1 to 3 and page 12, lines 2 to 6), a pair of sheets of a polymeric material are deformed at a temperature below the softening point of the polymeric material and are allowed to cool in the deformed state so

as to make them heat-recoverable. The sheets are then superimposed and bonded laterally along seams (2) to define marker sleeves (4) disposed side-by-side and the seams are provided with lines of weakness to facilitate separation of the sleeves. Finally the the resulting assembly is cross-linked so that the bonded parts are cross-linked to each other. Prior to cross-linking, a retaining spine may be attached to the assembly so that the individual sleeves can be removed out of sequence. In view of the above and the fact that the process is controllable and the uncross-linked assembly is not of transient nature, it is evident that prior to the final step of cross-linking, a sleeve assembly without cross-linked bonded parts is indeed produced and that the earlier application clearly describes such a sleeve assembly.

- 3.2 In view of the above, the Board agrees with the Appellant that the sleeve assembly as defined in Claim 1 of the divisional application was clearly disclosed in the earlier application. Also, according to the claim, the polymeric web of the sleeve assembly, and in particular the bonded parts of the sleeve assembly are required to be cross-linkable so that the sleeve assembly is evidently suitable for the manufacture of the marker sleeve assembly according to the earlier application requiring cross-linked bonded parts. Thus, the context in which the sleeve assembly of the divisional application was described in the earlier application, that is, as an intermediate sleeve assembly suitable for the manufacture of a final marker sleeve assembly, is also retained in the claimed subject-matter of the divisional application. The Examining Division had rightly objected to the subject-matter of the claim valid at the time which did not specify that the bonded parts could be cross-linked so that the sleeve assembly was presented out of its original context.

- 3.3 Characterising features of dependent Claims 2 to 5 are disclosed in Claims 15 to 17 and 14 respectively of the earlier application, whereas Claims 6 to 9 are supported by the original description of the earlier application. The description of the divisional application is substantially identical to that of the earlier application and has been modified merely with a view to render it consistent with the claimed invention.
- 3.4 For the foregoing reasons, the divisional application satisfies the requirements of Article 76(1) EPC.
- 3.5 During the examination pursuant to Article 96(2), the Examining Division had raised the objection of lack of inventive step to the subject-matter of Claim 1 having regard to the disclosure in the earlier application which was regarded as the prior art published before the filing date of 24 September 1984 of the divisional application. It is, however, not evident from the file whether novelty and inventive step were assessed in relation to the other documents cited in the European search report. In order that the Applicant is not deprived of examination of the issues of novelty and inventive step by the first instance, the Board, in accordance with its powers under Article 111(1) EPC, remits the case to the first instance for consideration of the above issues.

Order

For these reasons, it is decided that:

1. The decision under appeal is set aside.

2. The case is remitted to the Examining Division for further prosecution on the basis of the application documents mentioned under item IV. above.

The Registrar:

The Chairman:

P. Martorana

K. Lederer