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File No.: T 0737/90 - 3.3.1
Application No.: 87 104 405.3
Publication No.: 0 239 923
Classification: C09K 11/76
Title of invention: Fluorescent lamp using multi-layer phosphor coating

D E C I S I O N
of 9 September 1993

Applicant: General Electric Company

Headword: Missing publication number/General Electric

EPC: Art. 123(2), Rule 88

Keyword: "Supplementation of a cross reference to a patent application by its publication number (allowed)"

Headnote
Catchwords

The answer to the question whether or not a document incorporated in the text of a European patent application by reference can be unambiguously identified and easily retrieved depends solely on the facts of the case. Neither Article 123(2) EPC nor the Guidelines for the Examination within the EPO require or imply that a patent application referred to must be identified by a number, in order to be taken into account for the purpose of Article 83 EPC.

Case Number: T 0737/90 - 3.3.1

D E C I S I O N
of the Technical Board of Appeal 3.3.1
of 9 September 1993

Appellant:

General Electric Company
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Representative:

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Decision under appeal:

Decision of the Examining Division of the
European Patent Office dated 21 March 1990
refusing European patent application
No. 87 104 405.3 pursuant to Article 97(1) EPC.

Composition of the Board:

Chairman: R.K. Spangenberg
Members: P.K.H. Krasa
J.A. Stephens-Ofner

Summary of Facts and Submissions

I. European patent application No. 87 104 405.3 filed on 25 March 1987, published under No. 0 239 923, was refused by the Examining Division on 21 March 1990. This decision was based on the application documents as filed and published. The application contained 16 claims. Claim 1 related to an improved fluorescent lamp comprising a phosphor coating comprising a dual layer of a first phosphor layer deposited on the inner glass surface and a second phosphor deposited on the first phosphor layer, said second phosphor layer comprising a blend of narrow bandwidth light emitting phosphors, the particles of which had a specified particle size range and a specified general formula.

The ground of refusal was that the application did not meet the requirement of Article 83 EPC, since in the description reference was made to another patent application, filed concurrently with the present application and assigned to the assignee of the present invention, which contained the necessary information as to how to obtain the phosphor of the above general formula. The application documents as filed, however, did not contain the application number or equivalent information which would have enabled the person skilled in the art to retrieve the document referred to, as prescribed by the Guidelines for Examination in the EPO, Chapter C-II, 4.18. Thus, since the phosphor of the above general formula could not be made by methods belonging to the common general knowledge of the relevant art, it was held that the content of the application as filed did not enable a person skilled in the art to carry out the claimed invention. The possibility of amending the description to include the missing application number was suggested by the

Applicant and considered by the Examining Division, but was found to contravene the requirements of Article 123(2) EPC.

- II. On 15 May 1990 a notice of appeal was filed, accompanied by the payment of the appropriate fee, and a statement of grounds of appeal was received on 21 July 1990, comprising a fresh set of 14 claims, wherein Claim 1 has been amended to include the features of Claims 15 and 16 as filed.

The Appellant (the applicant) submitted that the reference to "a concurrently filed application assigned to the assignee of the present invention", which was concerned with "a modified calcium halophosphate phosphor" was sufficient to allow an easy retrieval of this application, since it was only necessary to take the EP-Bulletin of 7 October 1997, in which the publication of the present application was mentioned, and to take notice of the very few (only four) applications of the same applicant mentioned therein. Since only one of them related to the modified phosphor of the above general formula and was classified accordingly, the application referred to could be identified without difficulty. Thus the amendment of the description, even if it would not be justified pursuant to Rule 88 EPC, would not contravene the provisions of Article 123(2) EPC.

- III. Two questions of law, which could well have been relevant to the issue of this appeal were pending before the Enlarged Board of Appeal under reference No. G 3/89 (see OJ EPO 1991, 20), namely the questions whether in a case where a correction was requested under Rule 88, sentence 2, EPC, documents submitted after the date of filing were admissible as evidence that nothing else would have been intended than what was offered as the

correction, and whether such corrections were allowable even where the amendment would extend the subject-matter disclosed in the unamended document and therefore contravene Article 123(2) EPC. Accordingly, the appeal proceedings were suspended pending the decision of the Enlarged Board of Appeal on the above questions.

- IV. These questions of law were duly answered, see OJ EPO 1993, 117. Oral proceedings took place on 9 September 1993 during which the Appellant submitted as his main request that the decision under appeal be set aside, the cross-reference on page 1, line 2 of the description as filed (page 2, line 4 of the published application) be supplemented by reference to EP-A-0 239 924 and the application be remitted to the Examining Division for further prosecution on the basis of Claims 1 to 14 submitted on 21 July 1990.
- V. At the end of the oral proceedings the decision to allow the appeal on the basis of this main request was announced.

Reasons for the decision

1. The appeal is admissible.
2. Although the Appellant has submitted, together with the statement of grounds of appeal, an amended set of claims, the answer to the sole question to be decided in these appeal proceedings, namely whether or not the cross-reference to a co-pending application in the description is sufficient to allow an unambiguous identification and an easy retrieval of the document referred to, does not depend on any particular wording of the claims, so that the Board need not consider the formal allowability of the amended claims.

3. It is the consistent case law of the Boards of Appeal that the disclosure of a document may be supplemented by a reference to another document (see e.g. T 153/85, OJ EPO 1988, 1, point 4.2 of the reasons). In the Board's judgment, it is clear that such a reference can only be taken into account if it was available to the relevant addressees of the document containing the reference, here, where the document is a European patent application, the EPO before and the public after its publication. This means that the document referred to must be unambiguously identified and further, that the relevant addressees must have ready access to it, as is stated in the Guidelines for Examination in the EPO, Chapter C-II, 4.18, specifically relied upon by the Examining Division. However, this does not mean that the document referred to, if it is a patent application, must always be identified by a number, e.g. the application or publication number.

In the Board's judgment, the question whether or not the information provided is sufficient must be answered on the basis of the facts and evidence in each particular case. Moreover, the Board holds that, in the absence of any pointer to another country, a reference in a European patent application to another patent application "filed concurrently herewith" has *prima facie* to be understood as a reference to another **European** patent application.

4. On the basis of these general considerations, the Board is satisfied that in the present case the available information, i.e. the date of filing, the Applicant, and the technical field of the application, did enable the EPO, by using its database, to identify the application referred to unambiguously and without undue difficulty, since only two applications were filed on the relevant date in the relevant technical field by the

present Appellant, one of them being the application here in dispute, so that the other one must have been the one referred to. It is noted that this fact has not been disputed by the Examining Division.

5. Accordingly the sole remaining question is whether the relevant patent application was also easily, i.e. without undue effort, retrievable by the public on the publication date of the present application. To answer this question the only fact which has to be established is whether or not **in the particular situation of this case** the available information was sufficient for an unambiguous and quick retrieval of the patent application referred to.

In the Board's judgment the retrievability of a document cannot, as a matter of principle, be unduly difficult in the present context for the sole reason that it is necessary to consult a catalogue or index for this purpose. Thus, in the Board's judgment the requirement of easy retrieval of a cited document is met if a skilled person availing himself, if necessary, of the professional skills of a librarian, is able to find the document.

A library providing a complete collection of European patent documents will also normally provide the EPO bulletin. The Board is satisfied that a skilled person would have consulted this bulletin in the same way as an index or catalogue for retrieving a patent document whose publication number was not known. This person would thus have chosen the same approach as that offered by the Appellant in order to retrieve the European patent application referred to in the application in dispute on the basis of the informations provided therein, namely to consult the part of the EPO bulletin grouping the applications published on the same

date as the disputed one according to the name of the applicant. By this process he would have found, as stated by the Appellant in the statement of grounds of appeal, only two applications by the present Appellant in the relevant technical field (identifiable by the classification symbol), one of these being the application in dispute. A quick check of the filing date and the relevant content of the remaining one would unambiguously have revealed that it was the one referred to. In the Board's judgment, in the above circumstances the skill required to retrieve the patent application referred to therefore did not exceed the normal ability of the notional "person skilled in the art".

Since the Board is satisfied that the public was able without undue effort to take account of the entire content of the document incorporated by reference in the disputed application at its publication date, the relevant information contained in it, including its publication number, must be deemed to have formed part of the disclosure of the application as filed. For this reason, the requested supplementing of the cross-reference by the publication number of the application referred to does not contravene Article 123(2) EPC.

6. In this context the Board wishes to observe that the present situation is not comparable with that underlying the decision T 206/83 (see OJ EPO 1987, 5). In this decision it was held that information regarding the availability of certain starting compounds of a chemical process, which could only be retrieved by a search in a database, such as e.g. Chemical Abstracts, and which did not belong to the common general knowledge, did not form part of the content of a European patent application for the purpose of Article 83 EPC. In this case the disputed patent did not contain any reference to another document describing the preparation of the required starting

material. The question which had been decided therefore was not whether or not a specified document containing the missing information was retrievable but whether or not any missing technical information which had to be retrieved by a search in technical databases without the knowledge of the existence of a document containing it, formed part of the content of a patent specification. Thus the negative answer to this quite different question in decision T 206/83 is not in contradiction to the Board's above finding in the present case.

7. The examination of the present application should therefore proceed on the basis of the text as amended according to the Appellant's main request. Since the Examining Division has not yet given a final opinion on the patentability of the subject-matter of the present claims the Board uses its power under Article 111(1) EPC to remit the case to the Examining Division for further prosecution. It follows from what has been stated in point 2 of the reasons, that the Board has made a final decision only on the question of supplementing the cross-reference, so that this further prosecution should include the examination of the formal allowability of the amended claims, as well as the examination of the question whether or not the application as amended meets the requirements of Article 83 EPC.

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 main request.

The Registrar:


E. Görgmaier

The Chairman:


R. Spangenberg