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Please find enclosed an amended copy of the decision T0255/91-3.4.2.

dated 12.09.91 due to computer errors.

Publication in the Official Journal Yes /

File Number: T 255/91 - 3.4.2
Application No.: 86 103 489.0
Publication No.: 0 195 388
Title of invention: Production of oxygen enriched air

Classification: B01D 53/04, C01B 13/02

DECISION
of 12 September 1991

Applicant: AIR PRODUCTS AND CHEMICALS, INC.

Headword: Priority/AIR PRODUCTS AND CHEMICALS

EPC Article 87(1) and (3), 54

Keyword: claimed priority (no); prior application by legal predecessors of applicant, disclosing same features with large range of values; limitation (e.g. "disclaimer") limits the scope, but does not change the nature of the invention; novelty (no).

Headnote

A patent application cannot serve as a basis for claiming a right of priority for a European application under Article 87(1) EPC where an application has been filed prior to the said application and this subsequent application is distinguished from the previous application only by a limitation of the scope of protection (e.g. a disclaimer) which does not change the nature of the invention (cf. T 73/88 "Snackfood/HOWARD", headnote published in OJ EPO 1990, No. 5). This, of course, does not apply where Article 87(4) EPC is applicable, i.e. the previous first application has left no rights outstanding.

Case Number : T 255/91 - 3.4.2

D E C I S I O N of 10 December 1991 correcting
errors in the Decision of the Technical Board of Appeal 3.4.2
of 12 September 1991

Appellant : AIR PRODUCTS AND CHEMICALS, INC.
P.O. BOX 538
Allentown
Pennsylvania 18105 (US)

Representative : Kador & Partner
Corneliusstrasse 15
W - 8000 München 5 (DE)

Decision under appeal : Decision of Examining Division of the European
Patent Office dated 31 May 1990 posted on
14 November 1990 refusing European patent
application No. 86 103 489.0 pursuant to
Article 97(1) EPC.

Composition of the Board :

Chairman : E. Turrini
Members : M. Chomentowski
C.V. Payraudeau



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of the Technical Board of Appeal 3.4.2
of 12 September 1991

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Chairman : E. Turrini
Members : M. Chomentowski
C.V. Payraudeau

Summary of Facts and Submissions

- I. European patent application No. 86 103 489.0 (publication No. 0 195 388) was refused by the Examining Division on the grounds that, since the priority claimed in respect of this application was not valid due to the existence of a prior application No. 537309 (here designated P1), the priority of which had been claimed in respect of EP-A-0 135 936 (here designated D1), filed in the USA on 29 September 1983 by the legal predecessors of the Applicant more than twelve months before the filing of the present application and, since D1, which disclosed the subject-matter of Claim 1 of the present application had been published before the filing date of the present application, the subject-matter of Claim 1 lacked novelty.
- II. The Appellant (Applicant) lodged an appeal against this decision.
- III. The Board expressed in a written communication to the Appellant the provisional opinion that the claim for priority was not valid and that, accordingly, Claim 1 of the application as filed was not novel having regard to D1.
- IV. With letters of 12 August 1991 and of 11 September 1991, the appellant filed new sets of claims and arguments.
- V. During the oral proceedings which were held at his request, the Appellant requested that the decision under appeal be set aside and that the case be sent back to the Examining Division with the order to continue the prosecution of the examination

- (1) on the basis of Claims 1 and 12 filed on the 12 August 1991 and of Claims 2 to 11 of the application as filed with a correspondingly amended description (main request),
- (2) on the basis of Claims 1 and 12 filed on the 11 September 1991 and of Claims 2 to 11 of the application as filed with a correspondingly amended description (auxiliary request).

Main request:

Claim 1 reads as follows.

"1. The method of obtaining from ambient air a product stream having a moderately enriched oxygen concentration, which comprises the steps of:

- (1) introducing the feed air into a bed of adsorbent selective in retention of nitrogen to increase the pressure in that bed from atmospheric to a higher level first pressure not in excess of about 10 atmospheres,
- (2) then reducing the bed pressure to an intermediate level second pressure which is above atmospheric but less than 0,75 times the first pressure, excluding the ratios of 0,56 and 0,67 times, by withdrawing from the bed and recovering as product a gas which is enriched in oxygen, said withdrawal being carried out in a flow direction concurrent with that of initial introduction of feed air into the bed,
- (3) and thereafter venting the bed to restore atmospheric pressure therein, said venting being carried out in a flow direction counter to that of said withdrawal of oxygen enriched product gas."

Claims 2 to 11 are dependent claims. Claim 12 is a further independent claim.

Auxiliary request:

Claim 1 reads as follows.

"1. The method of obtaining from ambient air a product stream having a moderately enriched oxygen concentration, which comprises the steps of:

- (1) introducing the feed air into a bed of adsorbent selective in retention of nitrogen to increase the pressure in that bed from atmospheric to a higher level first pressure not in excess of about 10 atmospheres,
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Claims 2 to 11 are dependent claims. Claim 12 is a further independent claim.

VI. The Appellant submitted in substance the following arguments in support of his requests.

In the present application, the feature that the reduction from the first to the second pressure is done according to a ratio of said pressures is stressed as being essential to the performance of the invention; this feature is a first novel feature as compared to P1, which discloses a process including features of the invention of the present application, but from which it is directly derivable that the reduction of pressure is effected according to the difference between the first and second pressures. Even if it could be considered that the person skilled in the art, taking into account the teaching of P1, would have the choice between a difference of pressures and a ratio thereof, the selection of a ratio, as in the present application, would in itself mean that the present subject-matter is novel as compared to that of P1. Moreover, the present application includes a second feature, i.e. the upper limit of the allowable ratios, which is not derivable from P1 and is thus also the result of a selection within the range of allowed pressure ratios derivable from P1. In connection with this second feature, the Appellant presented also a new example corresponding to an experimental run wherein, with a ratio of pressures of 0.45, i.e. less than 0.56 and thus also less than 0.75 and different from 0.67 and 0.56, in accordance with the application, the obtained enriched air purity is 32.6%; this is to be compared with respective results of D1, page 9, lines 6 to 20 and the corresponding text location of P1, wherein, with a ratio of pressures of 0.67, the obtained enriched air purity is 28.0%. According to the Appellant, this surprising result demonstrates that the present application relates to a proper selection. Therefore, since the process of the present application includes two distinguishing features which are not derivable from P1, said process is novel and P1 is not a first application for claiming priority.

In relation thereto, the Appellant referred to the opinion expressed in the literature on patent law, according to which a "priority application" which adds features to a previous "priority application" can form the basis of a second, different patent application (see in particular Schulte, "Patentgesetz", paragraph 41, Rdn. 4, Carl Heymanns Verlag KG, Köln, Berlin, Bonn, Munich, 4th edition, 1987; see also Benkard, "Patentgesetz", "Einleitung" Rdn. 13, 16 and 18, C.H.Beck'sche Verlagsbuchhandlung, Munich 1981).

Reasons for the Decision

1. The appeal is admissible.

2. Main request:

2.1 Priority

2.1.1 The present European patent application claims the priority of the patent application No. 713503 filed in the USA on the 19 March 1985, i.e. less than 12 months before the date of filing the present European patent application, i.e. 14 March 1986. However, the legal predecessors of the appellant, i.e. the inventors, have also filed in the USA the patent application P1 on the 29 September 1983, i.e. more than 12 months before the date of filing the present European patent application. It is to be noted that the priority of the former US patent application P1 has been claimed in D1 and that, thus, it cannot be considered as having left no rights outstanding (Article 87(4) EPC).

2.1.2 For assessing whether the present priority application is actually the first application in the sense of

Article 87(1) and (3) EPC, or not, it is thus necessary to determine whether the former US patent application P1 discloses the same invention as the present application, i.e. whether it destroys its novelty (see for instance the unpublished decision T 116/84 of 28 November 1984).

2.1.3 For assessing whether the subject-matter of a patent application is novel with respect to a prior document, it is necessary in accordance with the decision of the Board of appeal T 26/85, OJ EPO 1990, 22, to determine whether or not the information given to the person skilled in the art by this prior document is sufficient to enable him to practise the technical teaching which is the subject-matter of this application; therefore, in assessing the novelty of the invention over the prior disclosure in a case where overlapping ranges of a certain parameter exist, it has to be considered whether the person skilled in the art would in the light of the technical information seriously contemplate applying the technical teaching of the prior disclosure in the range of overlap; if it can be fairly assumed that he would do so it must be concluded that no novelty exists.

2.1.4 The method of present Claim 1 includes the three steps disclosed in P1 (see page 4, line 20 to page 8, line 19; Figures 1 and 2 of the corresponding D1). However, present Claim 1 further specifies that, in method step (2), the intermediate level second pressure is comprised in the range between atmospheric pressure and less than 0.75 times the first pressure, excluding the ratios of 0,56 and 0,67 times, whereas P1 does not include such an upper limit and does not exclude the said two particular ratios either. Thus, the pressure range of P1 covers the whole pressure range of present Claim 1.

2.1.5 The Appellant has submitted that, in the present application, the reduction from the first to the second pressure is done according to a ratio of said pressures; this is stressed as being essential to the performance of the invention; according to him, this feature is not directly derivable from P1. Moreover, even if the skilled person could derive from the teaching of P1 that either a difference of pressure or a ratio thereof could be used for such a reduction, then the teaching of P1 would consist of a set of two items (difference, ratio) which would differ from the teaching of the present application (only a ratio); starting from P1, a selection between the two possibilities would be necessary to arrive at said claimed object, which would therefore be novel as compared to P1. However, this argument is not relevant. The first pressure and the second "reduced" pressure are related to each other, and the relation can be expressed either as a "difference of pressures" or as a "ratio of pressures". It is possible that one of said relations, for instance the "ratio of pressures", may be expressed mathematically in a simpler, more convenient way. However, no technical effect due to the use of one of these expressions could be detected. In other words, the person skilled in the art, carrying into practice the process of P1, will reduce the pressure from a first pressure to a second pressure by, for instance, controlling the appropriate apparatus and it is irrelevant for the technical result whether the scale of this apparatus is expressed as a difference, i.e. linear, or as a ratio, i.e. logarithmic. In both cases, ranges of allowable values, either of the differences of pressures or of the ratios thereof, can be calculated by said person and designed on said scales. Therefore, the Board does not consider that this first feature is a distinguishing feature.

2.1.6 Concerning the limit of 0.75, the Appellant has also argued that the indication in the description of the present application and of its priority document that "it was an essential part of this invention that the second pressure be at a level no greater than 0.75 times the first pressure" disclosed a new feature of a novel invention with respect to P1 where such limitation had not been disclosed. However, P1 discloses unambiguously that the pressure is lowered from a first pressure (between 10 and 4 atmospheres) to an intermediate pressure (0.67% and 0.57% of the first pressure according to the examples) then to the atmospheric pressure. Therefore, the theoretical range "first pressure > intermediate pressure > atmospheric pressure" is covered by P1 and the present application appears to disclose and claim the same invention except for the arbitrary exclusion of the upper part of this range and of two particular values of said ratio. This exclusion may limit the scope of the claims of the present European patent application but it does not change the nature of the invention.

2.1.7 The Appellant has submitted that the particular pressure values of Claims 6 and 11 of P1 which are excluded by a disclaimer from the scope of Claim 1 should not deprive of novelty the subject-matter of present Claim 1, which concerns a range of pressure. However, as mentioned here above, the teaching of P1 is not limited to said two particular values and, thus, the other values of the pressure ratios covered by the disclosure of P1 have also to be taken into consideration when assessing the novelty of said subject-matter.

2.1.8 The Appellant has submitted that the invention of the present application differs from the invention of P1 in such a way that an objection concerning additional

subject-matter (Article 123(2) EPC) would have been made by the European Patent Office if the applicant of D1 had tried to add to the application as filed the features contained in page 4, line 6 to page 5, line 3 of the present application, and that the same criteria should apply for assessing additional subject-matter according to Article 123(2) EPC on the one hand, and the novelty of the invention as compared with a possible first application in the sense of Article 87(1) EPC, on the other hand. The Board cannot follow this hypothetical argumentation. It is to be noted in this respect that according to the established case law of the Boards of Appeal, it is permissible not only to exclude a specific state of the art from the claimed invention by a disclaimer even if the original documents give no basis for such an exclusion (cf. decision T 04/80, OJ EPO 1982, 149), but also when a smaller partial area of the generally defined subject-matter of the invention is to be excluded not in view of the state of the art but because it does not solve the technical problem (cf. the unpublished decision T 313/86 dated 12 January 1988, point 3.5 of the reasons). Therefore, according to this case law, the disclaimer of the upper range of given ratios would be possible, if justified.

- 2.1.9 Concerning the two excluded ratios of 0,56 and 0,67, the present application, which specifically discloses said values in its examples, does not give any technical reason why these two particular values should be excluded. A range is not rendered novel by the fact that the values from the example of a prior art document are excepted by a disclaimer, at least not if these values cannot be regarded as individual (cf. decision T 188/83, OJ EPO 1984, 555).

2.1.10 It is to be noted that the text of page 4, line 6 to page 5, line 3, of the present application, in addition to mentioning the importance of the presently claimed limit of 0.75 times the first pressure, only contains the supplementary information (a) that the range of pressure should be between atmospheric pressure and 10 atmospheres, this being already disclosed in P1 in connection with the two embodiments mentioned above and (b) that some lower values within said range are preferred. It contains also considerations about the method steps (intermediate purging) which are neither claimed nor explained.

2.1.11 Thus, no matter is derivable from P1, which could be interpreted as being of a nature such that the person skilled in the art would not, in the light of the technical facts, seriously contemplate applying the technical teaching of the prior disclosure in the range of overlap, i.e. the range between atmospheric pressure and less than 0.75 times the first pressure, excluding the ratios of 0,56 and 0,67 times. On the contrary, concerning the first limit (0.75), two embodiments of P1 (see paragraph 1.3.1) are specifically concerned with values of the pressure ratios which are less than 0.75.

2.1.12 Therefore, the Board is of the opinion that the feature that the intermediate level second pressure is above atmospheric but less than 0.75 times the first pressure, excluding the ratios of 0,56 and 0,67 times, in step (2) of the method, was disclosed in P1.

2.1.13 It is not contested that a "priority application" which adds features to a previous "priority application" can form the basis of a second, different patent application. However, it is to be noted that, in the present case, the

invention of the later, second "priority application" (corresponding to the present European patent application) is the same as the invention of the former, first "priority application", for the reasons given here above.

2.1.14 Thus, since the subsequent patent application is only distinguished over the previous application by a limitation of the scope of protection by exclusion of a part of a range (in particular by a disclaimer) which does not change the nature of the invention, and since the conditions of Article 87(4) EPC are not met, said subsequent patent application is not a first application in the sense of Article 87(1) EPC and cannot serve as a basis for claiming a right of priority (cf. the decision T 73/88, headnote published in OJ 1990, N05).

2.1.15 Therefore, the patent application No. 713503 filed in the USA on 19 March 1985, mentioned in the present application for claiming priority, is not a first application in the sense of Article 87(1) EPC and, thus, the persons who have duly filed it cannot enjoy, for the purpose of filing a European patent application, a right of priority with respect to said European application.

2.2 Novelty

2.2.1 Since the right of priority cannot be enjoyed, the effective date for the present European patent application is the date of filing at the European Patent Office, i.e. the 14 March 1986. However, since D1 was published on 3 April 1985, i.e. before the effective date of filing of the present application, and since the subject-matter of Claim 1 is known from D1 (see paragraphs above), therefore, the subject-matter of Claim 1 lacks novelty in the sense of Article 54 EPC.

2.2.2 Therefore, the main request is not allowable
(Article 54(1) and (2) and 97(1) EPC).

3. Auxiliary request:

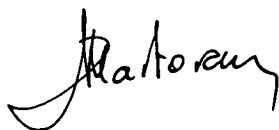
3.1 Claim 1 of the auxiliary request differs from Claim 1 of the main request in that the allowed range of pressure ratios is further limited and is less than 0.56. For the reasons mentioned here above, this new exclusion also constitutes a new limitation, which further limits the scope of the invention disclosed in D1 or in the main request, but which does not change the nature of this invention. Therefore, for the same reasons, this auxiliary request is not allowable either.

Order

For these reasons, it is decided that:

The appeal is dismissed.

The Registrar:




P. Martorana

The Chairman:



E. Turrini

MA
CP



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In der Anlage erhalten Sie eine Kopie des Berichtigungsbeschlusses zur Entscheidung

Please find enclosed a copy of the decision correcting errors in the decision

T 255/91 - 342

Veuillez trouver en annexe une copie de la décision rectifiant des erreurs dans la décision



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Boards of Appeal

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Case Number : T 255/91 - 3.4.2

D E C I S I O N of 10 December 1991 correcting
errors in the Decision of the Technical Board of Appeal 3.4.2
of 12 September 1991

Appellant : AIR PRODUCTS AND CHEMICALS, INC.
P.O. BOX 538
Allentown
Pennsylvania 18105 (US)

Representative : Kador & Partner
Corneliusstrasse 15
W - 8000 München 5 (DE)

Decision under appeal : Decision of Examining Division of the European
Patent Office dated 31 May 1990 posted on
14 November 1990 refusing European patent
application No. 86 103 489.0 pursuant to
Article 97(1) EPC.

Composition of the Board :

Chairman : E. Turrini
Members : M. Chomentowski
C.V. Payraudeau

In application of Rule 89 EPC the Decision given on 12 September 1991 is hereby ordered to be corrected as following:

On the front page in the Keyword the words "; novelty (no)" have been transferred to the end.

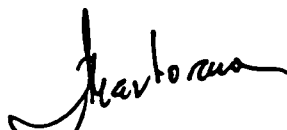
On page 8, before the last line, the following text has been inserted:

"permissible not only to exclude a specific state of the art from the claimed invention by a disclaimer even if the original documents give no basis for such an exclusion (cf. decision T 04/80, OJ EPO 1982, 149), but also when a smaller partial area of the generally defined subject-matter of the invention is to be excluded not in view of the state of the art but because it does not solve the technical problem (cf. the unpublished decision T 313/86 dated 12 January 1988, point 3.5 of the reasons). Therefore, according to this case law, the disclaimer of the upper range of given ratios would be possible, if justified.

2.1.9 Concerning the two excluded ratios of 0,56 and 0,67, the present"

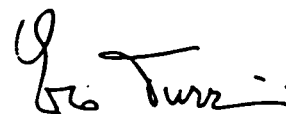
On page 10, paragraph 2.1.14, line 5, the word "protection" has been replaced by the word "invention".

The Registrar:



P. Martorana

The Chairman:



E. Turrini

**Beschwerdekammern des
Europäischen Patentamts**

**Boards of Appeal of the
European Patent Office**

**Chambres de recours de
l'Office européen des brevets**

Geschäftsstelle

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Als Anlage erhalten Sie den Leitsatz zur Entscheidung / -

Please find enclosed the headnote of the decision *T255, 91 - 342*

Veillez trouver en annexe une copie du sommaire de la décision / -

Publication in the Official Journal Yes / No

File Number: T 255/91 - 3.4.2
Application No.: 86 103 489.0
Publication No.: 0 195 388
Title of invention: Production of oxygen enriched air

Classification: B01D 53/04, C01B 13/02

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Publication in the Official Journal Yes /

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Headnote follows



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Claims 2 to 11 are dependent claims. Claim 12 is a further independent claim.

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VI. The Appellant submitted in substance the following arguments in support of his requests.

In the present application, the feature that the reduction from the first to the second pressure is done according to a ratio of said pressures is stressed as being essential to the performance of the invention; this feature is a first novel feature as compared to P1, which discloses a process including features of the invention of the present application, but from which it is directly derivable that the reduction of pressure is effected according to the difference between the first and second pressures. Even if it could be considered that the person skilled in the art, taking into account the teaching of P1, would have the choice between a difference of pressures and a ratio thereof, the selection of a ratio, as in the present application, would in itself mean that the present subject-matter is novel as compared to that of P1. Moreover, the present application includes a second feature, i.e. the upper limit of the allowable ratios, which is not derivable from P1 and is thus also the result of a selection within the range of allowed pressure ratios derivable from P1. In connection with this second feature, the Appellant presented also a new example corresponding to an experimental run wherein, with a ratio of pressures of 0.45, i.e. less than 0.56 and thus also less than 0.75 and different from 0.67 and 0.56, in accordance with the application, the obtained enriched air purity is 32.6%; this is to be compared with respective results of D1, page 9, lines 6 to 20 and the corresponding text location of P1, wherein, with a ratio of pressures of 0.67, the obtained enriched air purity is 28.0%. According to the Appellant, this surprising result demonstrates that the present application relates to a proper selection. Therefore, since the process of the present application includes two distinguishing features which are not derivable from P1, said process is novel and P1 is not a first application for claiming priority.

In relation thereto, the Appellant referred to the opinion expressed in the literature on patent law, according to which a "priority application" which adds features to a previous "priority application" can form the basis of a second, different patent application (see in particular Schulte, "Patentgesetz", paragraph 41, Rdn. 4, Carl Heymanns Verlag KG, Köln, Berlin, Bonn, Munich, 4th edition, 1987; see also Benkard, "Patentgesetz", "Einleitung" Rdn. 13, 16 and 18, C.H.Beck'sche Verlagsbuchhandlung, Munich 1981).

Reasons for the Decision

1. The appeal is admissible.

2. Main request:

2.1 Priority

2.1.1 The present European patent application claims the priority of the patent application No. 713503 filed in the USA on the 19 March 1985, i.e. less than 12 months before the date of filing the present European patent application, i.e. 14 March 1986. However, the legal predecessors of the appellant, i.e. the inventors, have also filed in the USA the patent application P1 on the 29 September 1983, i.e. more than 12 months before the date of filing the present European patent application. It is to be noted that the priority of the former US patent application P1 has been claimed in D1 and that, thus, it cannot be considered as having left no rights outstanding (Article 87(4) EPC).

2.1.2 For assessing whether the present priority application is actually the first application in the sense of

Article 87(1) and (3) EPC, or not, it is thus necessary to determine whether the former US patent application P1 discloses the same invention as the present application, i.e. whether it destroys its novelty (see for instance the unpublished decision T 116/84 of 28 November 1984).

2.1.3 For assessing whether the subject-matter of a patent application is novel with respect to a prior document, it is necessary in accordance with the decision of the Board of appeal T 26/85, OJ EPO 1990, 22, to determine whether or not the information given to the person skilled in the art by this prior document is sufficient to enable him to practise the technical teaching which is the subject-matter of this application; therefore, in assessing the novelty of the invention over the prior disclosure in a case where overlapping ranges of a certain parameter exist, it has to be considered whether the person skilled in the art would in the light of the technical information seriously contemplate applying the technical teaching of the prior disclosure in the range of overlap; if it can be fairly assumed that he would do so it must be concluded that no novelty exists.

2.1.4 The method of present Claim 1 includes the three steps disclosed in P1 (see page 4, line 20 to page 8, line 19; Figures 1 and 2 of the corresponding D1). However, present Claim 1 further specifies that, in method step (2), the intermediate level second pressure is comprised in the range between atmospheric pressure and less than 0.75 times the first pressure, excluding the ratios of 0,56 and 0,67 times, whereas P1 does not include such an upper limit and does not exclude the said two particular ratios either. Thus, the pressure range of P1 covers the whole pressure range of present Claim 1.

2.1.5 The Appellant has submitted that, in the present application, the reduction from the first to the second pressure is done according to a ratio of said pressures; this is stressed as being essential to the performance of the invention; according to him, this feature is not directly derivable from P1. Moreover, even if the skilled person could derive from the teaching of P1 that either a difference of pressure or a ratio thereof could be used for such a reduction, then the teaching of P1 would consist of a set of two items (difference, ratio) which would differ from the teaching of the present application (only a ratio); starting from P1, a selection between the detected. In other words, the person skilled in the art, carrying into practice the process of P1, will reduce the pressure from a first pressure to a second pressure by, for instance, controlling the appropriate apparatus and it is irrelevant for the technical result whether the scale of this apparatus is expressed as a difference, i.e. linear, or as a ratio, i.e. logarithmic. In both cases, ranges of allowable values, either of the differences of pressures or of the ratios thereof, can be calculated by said person and designed on said scales. Therefore, the Board does not consider that this first feature is a distinguishing feature.

2.1.6 Concerning the limit of 0.75, the Appellant has also argued that the indication in the description of the present application and of its priority document that "it was an essential part of this invention that the second pressure be at a level no greater than 0.75 times the first pressure" disclosed a new feature of a novel invention with respect to P1 where such limitation had not been disclosed. However, P1 discloses unambiguously that the pressure is lowered from a first pressure (between 10 and 4 atmospheres) to an intermediate pressure (0.67% and 0.57% of the first pressure according to the examples)

then to the atmospheric pressure. Therefore, the theoretical range "first pressure > intermediate pressure > atmospheric pressure" is covered by P1 and the present application appears to disclose and claim the same invention except for the arbitrary exclusion of the upper part of this range and of two particular values of said ratio. This exclusion may limit the scope of the claims of the present European patent application but it does not change the nature of the invention.

2.1.7 The Appellant has submitted that the particular pressure values of Claims 6 and 11 of P1 which are excluded by a disclaimer from the scope of Claim 1 should not deprive of novelty the subject-matter of present Claim 1, which concerns a range of pressure. However, as mentioned here above, the teaching of P1 is not limited to said two particular values and, thus, the other values of the pressure ratios covered by the disclosure of P1 have also to be taken into consideration when assessing the novelty of said subject-matter.

2.1.8 The Appellant has submitted that the invention of the present application differs from the invention of P1 in such a way that an objection concerning additional subject-matter (Article 123(2) EPC) would have been made by the European Patent Office if the applicant of D1 had tried to add to the application as filed the features contained in page 4, line 6 to page 5, line 3 of the present application, and that the same criteria should apply for assessing additional subject-matter according to Article 123(2) EPC on the one hand, and the novelty of the invention as compared with a possible first application in the sense of Article 87(1) EPC, on the other hand. The Board cannot follow this hypothetical argumentation. It is to be noted in this respect that according to the established case law of the Boards of Appeal, it is application, which specifically discloses said values in

its examples, does not give any technical reason why these two particular values should be excluded. A range is not rendered novel by the fact that the values from the example of a prior art document are excepted by a disclaimer, at least not if these values cannot be regarded as individual (cf. decision T 188/83, OJ EPO 1984, 555).

2.1.10 It is to be noted that the text of page 4, line 6 to page 5, line 3, of the present application, in addition to mentioning the importance of the presently claimed limit of 0.75 times the first pressure, only contains the supplementary information (a) that the range of pressure should be between atmospheric pressure and 10 atmospheres, this being already disclosed in P1 in connection with the two embodiments mentioned above and (b) that some lower values within said range are preferred. It contains also considerations about the method steps (intermediate purging) which are neither claimed nor explained.

2.1.11 Thus, no matter is derivable from P1, which could be interpreted as being of a nature such that the person skilled in the art would not, in the light of the technical facts, seriously contemplate applying the technical teaching of the prior disclosure in the range of overlap, i.e. the range between atmospheric pressure and less than 0.75 times the first pressure, excluding the ratios of 0,56 and 0,67 times. On the contrary, concerning the first limit (0.75), two embodiments of P1 (see paragraph 1.3.1) are specifically concerned with values of the pressure ratios which are less than 0.75.

2.1.12 Therefore, the Board is of the opinion that the feature that the intermediate level second pressure is above atmospheric but less than 0.75 times the first pressure,

excluding the ratios of 0,56 and 0,67 times, in step (2) of the method, was disclosed in P1.

2.1.13 It is not contested that a "priority application" which adds features to a previous "priority application" can form the basis of a second, different patent application. However, it is to be noted that, in the present case, the invention of the later, second "priority application" (corresponding to the present European patent application) is the same as the invention of the former, first "priority application", for the reasons given here above.

2.1.14 Thus, since the subsequent patent application is only distinguished over the previous application by a limitation of the scope of protection by exclusion of a part of a range (in particular by a disclaimer) which does not change the nature of the ~~protection~~^{invention}, and since the conditions of Article 87(4) EPC are not met, said subsequent patent application is not a first application in the sense of Article 87(1) EPC and cannot serve as a basis for claiming a right of priority (cf. the decision T 73/88, headnote published in OJ 1990, N05).

2.1.15 Therefore, the patent application No. 713503 filed in the USA on 19 March 1985, mentioned in the present application for claiming priority, is not a first application in the sense of Article 87(1) EPC and, thus, the persons who have duly filed it cannot enjoy, for the purpose of filing a European patent application, a right of priority with respect to said European application.

2.2 Novelty

2.2.1 Since the right of priority cannot be enjoyed, the effective date for the present European patent application is the date of filing at the European Patent Office, i.e.

the 14 March 1986. However, since D1 was published on 3 April 1985, i.e. before the effective date of filing of the present application, and since the subject-matter of Claim 1 is known from D1 (see paragraphs above), therefore, the subject-matter of Claim 1 lacks novelty in the sense of Article 54 EPC.

2.2.2 Therefore, the main request is not allowable (Article 54(1) and (2) and 97(1) EPC).

3. Auxiliary request:

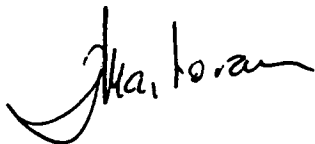
3.1 Claim 1 of the auxiliary request differs from Claim 1 of the main request in that the allowed range of pressure ratios is further limited and is less than 0.56. For the reasons mentioned here above, this new exclusion also constitutes a new limitation, which further limits the scope of the invention disclosed in D1 or in the main request, but which does not change the nature of this invention. Therefore, for the same reasons, this auxiliary request is not allowable either.

Order

For these reasons, it is decided that:

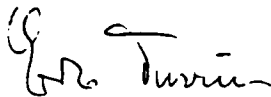
The appeal is dismissed.

The Registrar:



P. Martorana

The Chairman:



E. Turrini

MCH CP