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D E C I S I O N
of 21 January 1994

Case Number: T 0176/92 - 3.2.5

Application Number: 86117544.6

Publication Number: 0232524

IPC: B23H 7/08

Language of the proceedings: EN

Title of invention:
Cut wire for electrical discharge machining

Applicant:
Sumitomo Electric Industries Limited

Opponent:
-

Headword:
-

Relevant legal norms:
EPC Art. 111(1)

Keyword:
"Remittal for further prosecution"

Decisions cited:
T 0063/86 (OJ EPO 1988, 224)

Headnote/Catchword:
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Case Number: T 0176/92 - 3.2.5

D E C I S I O N
of the Technical Board of Appeal 3.2.5
of 21 January 1994

Appellant: Sumitomo Electric Industries Limited
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Decision under appeal: Decision of the Examining Division of the European
Patent Office dated 27 September 1991 refusing
European patent application No. 86 117 544.6
pursuant to Article 97(1) EPC.

Composition of the Board:

Chairman: C.V. Payraudeau
Members: A. Burkhart
H.P. Ostertag

Summary of Facts and Submissions

- I. The Appellant (applicant) Alodged an appeal against the decision of the Examining Division to refuse the application No. 86 117 544.6.

The Examining Division had found that the cut wire which was the subject-matter of the single claim did not involve an inventive step in the light of the teaching of document DE-A-3 105 988 (D1).

- II. The Appellant requested that the decision of the Examining Division be set aside and a patent be granted on the basis of a new claim defining a method for manufacturing a cutting wire.

- III. In response to a communication of the Board of Appeal, in which an objection under Article 123(2) EPC had been raised against the new claim, the Appellant filed on 1 October 1993 an amended claim which reads as follows:

"A method for manufacturing a cutting wire, comprising the steps of forming a covering layer of copper on the outer periphery of a stainless steel core (such a type SUS-304) and drawing the covered stainless steel core so that the diameter of the cutting wire is from 0,1 mm to 0,3 mm, the percentage of the sectional area of said core to the total sectional area of the cutting wire is in the range of 50 % to 75 % and the tensile strength of said cutting wire is in the range of 118 kg/mm² to 171 kg/mm² at the temperature of 200°C."

- IV. In support of the patentability of the method according to the new claim, the Appellant essentially argued as follows:

The cutting wire known from document D1 was drawn **before** being covered with copper, whereas according to the method of the new Claim 1 the cutting wire was drawn **subsequent** to being covered with copper. As a result of this differentiating manufacturing step, a high tensile strength of the cutting wire could be obtained.

Reasons for the Decision

1. The examination and the refusal of the Examining Division was based on a product claim referring to a "cut wire", which was defined by various product features specifying the nature and the composition of the wire materials, the dimensions and the tensile strength.
2. The Appellant has made it plain in his Statement of Grounds of appeal that he no longer wishes to apply for a patent based on a product claim referring to a cut wire, but instead he wishes now to apply for a patent based on a process claim referring to a "method for manufacturing a cutting wire".
3. The new claim defining such method contains now for the first time the features "comprising the steps of forming a covering layer of copper on the outer periphery of a stainless steel core and drawing the covered stainless steel core".

As can be learnt from the Statement of Grounds of appeal, the Appellant considers these process features as being essential for the invention and as involving an inventive step with respect to the prior art.

4. The examination file shows, however, that these process features were not considered during the examining proceedings. It also appears that the search report was established without consideration of these process features.

5. In these circumstances, the Board arrives at the following conclusion:

The new process claim constitutes a substantial amendment which requires substantial further examination in relation to both the formal and substantive requirements of the EPC.

In line with the decision T 63/86 (see OJ EPO 1988, 224, point 2), the Board considers that such examination should be carried out by the Examining Division as the first instance.

Therefore, the Board has decided to exercise its power under Article 111(1) EPC to remit this case to the Examination Division, in order that it should examine and decide:

- (i) whether consent can be given to the amended claim filed on 1 October 1993 under Rule 86(3) EPC, final sentence,
- (ii) if consent can be given to such amended claim, whether such claim is allowable under the provisions of the EPC.

Order

For these reasons, it is decided that:

1. The decision under appeal is set aside.
2. The case is remitted to the first instance for further prosecution.

The Registrar:



A. Townend

The Chairman:



C. Payraudeau