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File No.: T 0536/92 - 3.2.4
Application No.: 88 312 034.7
Publication No.: 0 322 179
Classification: A01G 9/10
Title of invention: Sheet material for use in cultivating plants

D E C I S I O N
of 29 November 1993

Applicant: Bussan G. & A. Co., Ltd.

Headword:

EPC: Art. 109(1), Art. 111, Rule 67

Keyword: "Amended claim filed on appeal" - "Remittal" - "Reimbursement of appeal fee - no"

Headnote
Catchwords



Europäisches
Patentamt

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Patent Office

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des brevets

Beschwerdekammern

Boards of Appeal

Chambres de recours

Case Number: T 0536/92 - 3.2.4

D E C I S I O N
of the Technical Board of Appeal 3.2.4
of 29 November 1993

Appellant:

Bussan G. & A. Co., Ltd.
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Representative:

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Decision under appeal:

Decision of the Examining Division of the European
Patent Office dispatched on 22 January 1992
refusing European patent application
No. 88 312 034.7 pursuant to Article 97(1) EPC.

Composition of the Board:

Chairman: C.A.J. Andries
Members: M.G. Hatherly
J.P.B. Seitz

Summary of Facts and Submissions

I. European patent application No. 88 312 034.7 was refused by a decision of the first instance dispatched on 22 January 1992.

II. The reason given for the refusal was lack of inventive step of the subject-matter of the independent product Claim 1, of some of the claims dependent thereon and of the independent method Claim 12, having regard to the prior art documents:

GB-A-2 014 024;

FR-A-2 344 216; and

EP-A-0 182 263.

An invitation to combine the originally filed Claims 1 and 3 had been made in a letter from the Examiner and this invitation was referred to in the decision.

III. An appeal against this decision was received on 18 March 1992, the appeal fee having been paid on 17 March 1992. The Statement of Grounds was received as a facsimile on 21 May 1992 and its confirmation on 25 May 1992.

IV. With the Statement of Grounds the Appellants submitted amended pages of the application including two independent Claims 1 and 10.

Claim 1 now reads as follows:

"A coilable sheet material for use in seedling or plant cultivation, which sheet material comprises a body of

fluid-permeable compressible material providing a pair of continuous opposite surfaces, the sheet material having a plurality of through holes extending from one said surface to the other and at least one said surface having projections and/or recess formed therein defining axially extending through passages between opposed surfaces of sheet material when the sheet material is coiled, **characterised in that** said surface comprises at least one first region coated with a ceramic powder which absorbs infra-red rays in the wavelength range of 5 to 15 micrometers."

Claim 10 now reads as follows:

"A method of cultivating a plant wherein water and nutrients are supplied to the stem and root system of a seedling within a ball formed by coiling a sheet material as claimed in any preceding claim."

- V. Among the requests in the Notice of Appeal was a request for refund of the appeal fee in the event of the appeal being successful.

In the later Statement of Grounds the Appellants made the "sole request" of remission to the Examining Division for interlocutory revision arguing that an amendment previously acknowledged by the Examiner to support the patentability of Claim 1 had been adopted in its entirety. Oral proceedings were requested if the Board was considering issuing a decision which did other than follow this request.

The Rapporteur telephoned the Representative of the Appellants on 15 October 1993 to inform him that it was likely that the Board would follow the sole request and remit to the Examining Division. The Board did not intend to refund the appeal fee since it could see no

substantial procedural violation. The Representative stated he did not wish an oral proceedings to be arranged for the purpose of contesting this intention not to refund the appeal fee.

VI. The request for the decision to be set aside and for remittal to the Examining Division is on the basis of the following documents:

Claims:

Claims 1 to 10 filed with the Statement of Grounds dated 21 May 1992;

Description:

pages 1, 1a, 2 and 5 filed with the Statement of Grounds dated 21 May 1992; and

pages 3, 4 and 6 as originally filed;

Drawings:

pages 1 to 9 as originally filed.

Reasons for the Decision

1. The appeal complies with Articles 106 to 108 and Rule 64 EPC; it is admissible.
2. *Independent product Claim 1: Combination of originally filed Claims 1 and 3*
- 2.1 The last paragraph of page 1 and the third paragraph of page 6 of the contested decision acknowledge novelty of the subject-matter of the originally filed Claim 3 and,

although they do not acknowledge that the subject-matter was patentable, at least they do not contain any negative arguments regarding inventive step. These paragraphs therefore imply that to combine the originally filed Claims 1 and 3 might lead to an allowable claim.

2.2 The present Claim 1 indeed includes the originally filed Claim 3 (and also the originally filed Claim 4) but the Appellants have in other respects gone backwards in the examination proceedings by omitting features which, presumably to avoid the prior art, had previously been introduced into the originally filed Claim 1 to arrive at the version of Claim 1 which was refused.

2.3 However an invitation to combine the **originally filed** Claims 1 and 3 was made in the Examiner's letter of 15 March 1991 and this invitation was referred to in the last paragraph on page 1 of the decision. Therefore it seems that also a combination of the originally filed Claims 1 and 3 would meet the objection against Claim 1 made in the decision.

3. *Independent method Claim 10*

3.1 Page 7 of the Examining Division's decision contains an objection that the subject-matter of the then ruling independent method Claim 12 lacks an inventive step, it being general practice to supply water and nutrients to the stem and root system of a seedling within a cultivating ball, and using a ball according to one of the previous claims adds nothing inventive.

3.2 The Board is unsure if this argument is that:

- i. the product is obvious, the method steps in the independent method claim add nothing inventive to this obvious product, therefore the independent method claim is unallowable; or that
- ii. even if the product were inventive, the method of using it would be conventional, so the independent method claim would still be unallowable.

3.3 However, while a reference to a patentable claim of a first category in a claim of a second category does not necessarily imply the patentability of the independent claim containing the reference, the method of the present Claim 10 is essentially **a method involving the use of the sheet material** of one of the preceding claims. As such, providing the claims to the sheet material are inventive, then Claim 10 does not need a separate examination for obviousness, see Guidelines for Examination in the EPO, C-III, 3.7a and C-IV, 9.5a and decision T 16/87, section 8. d.

4. *Interlocutory revision*

4.1 If the objections on which a contested decision relies are met, then the Examining Division concerned must rectify its decision under Article 109 EPC (see decision T 139/87, OJ 1990, 69).

4.2 In the present case it seems that the Appellants have met the lack of inventive step objections made against the independent product and method claims (see sections 2.3 and 3.3 above).

4.3 However the Board is unsure whether the Examining Division was of the opinion that the lack of inventive step objection made against the independent method Claim 12 had been met (see point 3.2 ii above). If the Examining Division considered that this objection had not been met by the newly filed independent method Claim 10 referring to the newly filed product claims, then the Examining Division was correct in not rectifying its decision under Article 109 EPC.

4.4 In that case there would be no reason for the Board to state that the Examining Division had to rectify its decision in the framework of Article 109 EPC.

5. *Remittal*

As already stated, Claim 1 - including the originally filed Claim 3 - could have been considered by the Examining Division as being patentable, although it is not clear to the Board which problem is solved by the features of the present Claim 1, particularly by the presence of the ceramic powder.

Claim 1 however includes an alleged error correction, namely the feature in the originally filed application of the ceramic powder being "a source of infra-red rays" has been modified in the present Claim 1 and the present description to a ceramic powder which "absorbs infra-red rays".

The Appellants have requested remittal to the Examining Division, albeit in the framework of Article 109 EPC, and also the Board, in order not to deprive the Appellants of one instance of jurisdiction, considers it appropriate in the present case to exercise its power under Article 111(1) EPC to remit the case to the Examining Division for further prosecution on the basis

of the substantially amended product Claim 1 and Claim 10 directed to a method involving the use of the sheet material of one of the preceding product claims.

6. *Further prosecution of the case*

The attention of the Examining Division is drawn to the following points for the further prosecution of the case.

6.1 In order to assess inventive step, the technical problem underlying the invention as presently claimed will need to be considered (Rule 27(1)(c) EPC), see the first paragraph of section 5 above.

6.2 Correction of error or extension of subject-matter

6.2.1 The originally filed Claim 4 stated that "the ceramic powder **is made up** of infra-red rays in the wavelength range of 5 to 15 micrometers".

After a clarity objection from the Examining Division, the Appellants filed with the letter of 11 July 1991 an amended Claim 4 stating that "the ceramic powder is a **source** of infra-red rays in the wavelength range of 5 to 15 micrometers".

The current Claim 1 and line 14 of page 5 of the new description, both filed with the Statement of Grounds, include the feature of "ceramic powder which **absorbs** infra-red rays in the wavelength range of 5 to 15 micrometers".

The Appellants allege that this amendment "corrects an error in the English language text supplied to us at the time of filing".

6.2.2 It is clear that the originally filed Claim 4 contained an error. The reader would have read on page 5, lines 14 and 15 of the originally filed description of "a ceramic powder which is a **source** of infra-red rays. Typical wavelengths of the **discharged** infra-red rays range from 5 micrometers to about 15 micrometers". It would seem that this passage would have resolved the reader's difficulties and that this is the immediately evident correction to the originally filed Claim 4, which indeed the Appellants made in the amended Claim 4 with the letter of 11 July 1991.

The skilled person knows that sunlight (visible light) is absorbed by the earth and that, because the average temperature of the earth's surface is only 15°C, the surface emits principally infra-red radiation. So, it would appear that when the skilled person considered Figures 8 and 9 of the patent application, the amendment of 11 July 1991 would have fully satisfied him - sunlight is absorbed by the earth and by the exposed upper end of the coil and emitted as infra-red radiation. It does not seem that it would have occurred to him that the amendment of 11 July 1991 needed further amendment. As the Appellants admit in the Statement of Grounds, before infra-red radiation can be emitted by a ceramic substance, it can have been heated up in some other way than by infra-red radiation. It must also be borne in mind that substances often absorb and emit at different frequencies so that emission at 5 to 15 micrometers need not be the result of absorption at 5 to 15 micrometers.

6.2.3 The Examining Division's attention is drawn to the decisions G 3/89 (OJ 1993, 117) and G 11/91 (OJ 1993, 125).

6.3 The originally filed Claim 1 referred to "recesses" whereas the present Claim 1 refers only to "recess".

6.4 Claim 4 is appended to itself.

6.5 The application will need to be adapted to the amended claims that will lead to grant of a patent.

6.6 Reference numeral 5 is used for different components and many of the drawings reference numerals 122 and above do not appear in the description.

7. *Refund of the appeal fee*

7.1 According to Rule 67 EPC the appeal fee shall be reimbursed in the event of interlocutory revision (Article 109 EPC) or where the Board deems the appeal allowable, if reimbursement is equitable by reason of a substantial procedural violation.

7.2 The Appellants have not alleged that, and the Board cannot see that, a substantial procedural violation had taken place in the proceedings up to refusal. Even if the Examining Division had given interlocutory revision there would have been no obligation on it to reimburse the appeal fee (see decision T 79/91, point 4.2, unpublished).

7.3 Thus the appeal fee is not being reimbursed.

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 with the order that the further prosecution be based on the application text as set out in section VI above.
3. The appeal fee is not to be reimbursed.

The Registrar:



N. Maslin

The Chairman:



C. Andries