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D E C I S I O N
of 20 September 2000

Case Number: T 0599/98 - 3.4.2

Application Number: 90117951.5

Publication Number: 0418829

IPC: G02B 6/44

Language of the proceedings: EN

Title of invention:
Tape-like coated optical fiber

Patentee:
SUMITOMO ELECTRIC INDUSTRIES, LTD.

Opponents:
DSM N.V.
Alcatel Kabel Beteiligungs-AG

Headword:

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Relevant legal provisions:
EPC Art. 54, 111(1)

Keyword:
"Decision based on an incorrect assessment of the evidence on the file"
"Remittal to the first instance for further prosecution"

Decisions cited:

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Catchword:

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Case Number: T 0599/98 - 3.4.2

D E C I S I O N
of the Technical Board of Appeal 3.4.2
of 20 September 2000

Appellant: SUMITOMO ELECTRIC INDUSTRIES, LTD.
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Decision under appeal: Decision of the Opposition Division of the
European Patent Office posted 20 April 1998
revoking European patent No. 0 418 829 pursuant
to Article 102(1) EPC.

Composition of the Board:

Chairman: E. Turrini

Members: A. G. Klein

B. J. Schachenmann

Summary of Facts and Submissions

I. European patent No. 0 418 829 (application No. 90 117 951.5) was granted with the following single claim:

"1. An optical fiber ribbon, comprising:

a plurality of optical fiber strands arranged side by side in a plane, each of said plurality of optical fiber strands comprising a glass optical fiber, a coating layer of ultraviolet cured resin provided on an outer periphery of said glass optical fiber, and a layer of coloring material provided on said coating layer of ultraviolet cured resin, wherein said coloring material contains at least one volatile component; and

an overall coating of ultraviolet cured resin provided onto an outer periphery of said plurality of optical fiber strands so as to integrate said plurality of optical fiber strands with each other into a ribbon;

characterised in that the weight of said at least one volatile component contained in said coloring material of said colored layers at 60°C is selected so as to be not larger than 5% of the weight of said coloring material."

II. The patent was revoked by the Opposition Division on the ground that the subject-matter of granted claim 1 lacked novelty in view of the contents of document:

D1: JP-A-64 022 976, together with the Deweat abstract and the English translation of the Japanese patent document.

In its decision the Opposition Division acknowledged that document D1 did not explicitly specify the amount of volatile components present in the colouring material composition disclosed there (see point 3 of the reasons, first sentence). It however accepted that the results, presented in test reports produced by the opponent I, of measurements of the weight loss experienced by cured layers of a colouring material of the composition disclosed in document D1 when heated up to 60°C for two weeks actually provided a determination of the content in weight of the volatile components at 60°C present in the coloured layer, within the meaning of claim 1 (see point 3.2 of the reasons, last sentence). Since the so measured weight loss was between 1.9% and 2.6%, i.e. substantially below the upper value of 5% specified in claim 1 of the patent, document D1 was considered to anticipate the subject-matter of the claim (see point 3.3, last paragraph and point 3.4 of the reasons).

- III. The appellant (proprietor of the patent) filed an appeal against the decision revoking the patent.
- IV. Oral proceedings were held on 20 September 2000.

At the outset of the oral proceedings, the Board invited the parties to reconsider whether the weight loss measured after heating layers of colouring material at 60°C for two weeks actually represented the weight of the volatile component "contained in said colouring material at 60°C" within the meaning of the characterising portion of claim 1, as had apparently been assumed so far both by the parties and by the Opposition Division.

V. The appellant in this respect declared that the characterising portion of claim 1 indeed referred to the weight of the volatile component which was still contained in the colouring material at a temperature of 60°C. This weight could be determined from the difference between the known weight of the volatile component initially included into the curable ink material and the weight of such volatile component which left the material during its curing and heating up to 60°C, as was evident from the sentence bridging pages 3 and 4 of the patent specification.

The appealed decision was however based on the wrong assumption that the weight of the volatile component referred to in the characterising portion of claim 1 corresponded to the weight of the volatile component which had left the material, rather than to the weight of the volatile component which was still contained in it.

VI. The respondent I (opponent I) insisted that the weight of volatile component referred to in the characterising portion of claim 1 actually corresponded to the weight loss measured in his test reports. If his interpretation of the claim could not be accepted by the Board, the way of measuring the volatile component contained in the coloured layers at 60°C became an essential feature of the invention. Since the patent specification did not however disclose any method of measuring the claimed weight content, it was open to an objection under Article 100(b) EPC (insufficiency of the disclosure), and the case should be referred back to the first instance.

The respondent II (opponent II) accepted that the

characterising portion of claim 1 referred to the volatile component still present in the colouring material at 60°C, rather than the weight of the component which had left the material in the curing and heating processes. He however blamed the appellant for having suddenly departed from his own former interpretation of the claim. He also expressed doubts as to whether the claimed subject-matter met any industrial purpose, since the content of volatile components at 60°C was totally immaterial to the proper operation of an optical fibre ribbon which was not intended for being used at any higher temperature.

VII. At the end of the oral proceedings the appellant requested that the decision under appeal be set aside and that the patent be maintained on the basis of the claim as granted or on the basis of an amended claim in accordance with auxiliary requests 1 to 3 as specified in his letter dated 18 August 2000.

The respondents for their part requested that the appeal be dismissed.

Reasons for the Decision

1. The appeal is admissible.

2. The optical fibre ribbon defined in claim 1 of the patent in suit is "characterised in that the weight of said at least one volatile component **contained** in said colouring material of said coloured layers **at 60°C** is selected so as to be not larger than 5% of the weight of said coloring material" (emphasis added). In the Board's view, the upper limit of 5% referred to in the

claims thus applies to the weight of the volatile component which is still contained in the colouring material after it has been heated up to 60°C. This is confirmed by the specification which explicitly states that "the weight percentages of the volatile components were measured **after** the ultra violet curable ink was cured and heated up to 60°C" (emphasis added). The upper limit referred to in the claim does not however apply to the weight of any volatile component which has left the colouring material during its heating up to 60°C, and is thus no longer contained in it at 60°C.

Accordingly, the results of measurements of the weight loss experienced by colouring layers having the compositions disclosed in document D1 after two weeks at 60°C, as produced by the respondent I, are not representative of the weight of the volatile components contained in the colouring material within the meaning of claim 1. They cannot therefore be relied upon to demonstrate that the claimed subject-matter lacks novelty in view of the contents of document D1, as did the Opposition Division.

3. Thus, the appealed decision was based on a wrong understanding of the claimed subject-matter and/or an incorrect assessment of the evidence on the file, and it cannot be upheld by the Board, accordingly.
4. A number of issues still have to be considered before a final decision can be taken on the validity of the patent.

It shall in particular be considered whether the respondents should be given an opportunity to present more appropriate evidence in support of their

argumentation against the novelty of the claimed subject-matter in view of the contents of document D1.

The respondents also contested the inventive step involved by the claimed subject-matter and the sufficiency of the description. These objections might also still require proper consideration.

Accordingly, in order not to deprive the parties of their right to have the outstanding questions examined by two instances of jurisdiction, the Board deems it appropriate to make use of its discretion under Article 111(1) EPC to remit the case to the first instance for further prosecution.

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:

The Chairman:

P. Martorana

E. Turrini