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D E C I S I O N
of 13 September 1999

Case Number: T 1049/98 - 3.4.2

Application Number: 92915309.6

Publication Number: 0583426

IPC: C25D 5/02, C25D 5/54, H0K5 3/42

Language of the proceedings: EN

Title of invention:
Improved process for preparing a nonconductive substrate for electroplating

Patentee:
Macdermid Incorporated

Opponent:
Electrochemicals Inc.

Headword:
-

Relevant legal provisions:
EPC Art. 101, 102
EPC R. 55(c)

Keyword:
"Attacked claim deleted - no power to examine the remaining claims"

Decisions cited:
G 0009/91, G 0010/91

Catchword:

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Boards of Appeal

Chambres de recours

Case Number: T 1049/98 - 3.4.2

D E C I S I O N
of the Technical Board of Appeal 3.4.2
of 13 September 1999

Appellant: Macdermid Incorporated
(Proprietor of the patent) 245 Freight Street
Waterbury
Connecticut 06702 (US)

Representative: Harrison, Ivor Stanley
Withers & Rogers
Goldings House, 2 Hays Lane
London SE1 2HW (GB)

Respondent: Electrochemicals Inc.
(Opponent) 5630 Pioneer Creek Drive
Maple Plain
Minneapolis 55359 (US)

Representative: Weatherald, Keith Baynes
Castles
17 Landsdowne Road
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Surrey CRO 2BX (GB)

Decision under appeal: Decision of the Opposition Division of the
European Patent Office posted 24 August 1998
revoking European patent No. 0 583 426 pursuant
to Article 102(1) EPC.

Composition of the Board:

Chairman: E. Turrini
Members: R. Zottmann
M. Lewenton

Summary of Facts and Submissions

- I. The Appellant (Patentee) lodged an appeal against the decision of the Opposition Division revoking the European patent No. 0 583 426 with the application No. 92 915 309.6.

The opposition was based on the grounds of Article 100(a) EPC that claim 11 lacks novelty and inventive step and on the ground laid down in Article 100(b) EPC.

- II. In the grounds of appeal the Appellant requested that the patent be maintained on the basis of claims 1 to 10 as granted (the claim set as granted contains eleven claims).

In a communication the Board of Appeal informed the parties that the description had not been adapted to the new claim set.

The Appellant submitted an amended description to meet this objection.

- III. The Appellant requested in spirit that the decision under appeal be set aside and that the patent be maintained in the following version:

Description: pages 2 and 4 as filed with the letter dated 25 March 1999;
page 3 and page 5 to page 14 line 22 of EP-B-0 583 426;

Claims: Nos. 1 to 10 as granted.

Furthermore, he requested that, if the Respondent indicated in writing by no later than 26 November 1998 that he would not be opposing the appeal, the appeal would be treated by rectification of the decision by the Opposition Division and reimbursement of the appeal fee.

III. The Respondent (Opponent), by letter of 2 March 1999, merely stated that he has no objection to claims 1 to 10 of the patent being reinstated.

Reasons for the Decision

1. The appeal is admissible.
2. *Amendments*

It is evident that deletion of independent claim 11 as granted, which does not contain any reference to a preceding claim, and the corresponding adaptation of the description are conform to Article 123(2) and (3) EPC.

3. *Sufficiency of the Patent*

The Board sees no reason to call in question the conclusion of the Opposition Division that the ground of opposition laid down in Article 100(b) EPC does not prejudice the maintenance of the patent. Since none of the parties presented arguments relating to this ground

of opposition, it is unnecessary to give details for this opinion of the Board.

4. *Novelty and Inventive Step*

The grounds of opposition of Article 100(a) EPC were limited to only a part of the patent, namely to the subject-matter of independent claim 11. Claim 11 does not contain a reference back to another claim. Therefore, the examination of the case with respect to said grounds of opposition is limited to said subject-matter. Neither the Opposition Division nor the Board of Appeal has the obligation or power to examine and decide on the maintenance of the other subject-matters of the patent, namely the subject-matters of claims 1 to 10 (see decisions G 0009/91 and G 0010/91). Since the Appellant does not maintain independent claim 11, the Board is not obliged or empowered to examine novelty and inventive step of the patent in its present form.

5. *Rectification and Reimbursement of the Appeal Fee*

The condition imposed by the Appellant for the corresponding request (see section III. last paragraph) is not fulfilled, since the letter of the Respondent was filed after the date set by the Appellant. Moreover, rectification of a decision and consequential reimbursal of the appeal fee is only possible in *ex parte* proceedings where the appellant is not opposed by another party to the proceedings, see Article 109(1) EPC.

Order

For these reasons it is decided that:

1. The decision under appeal is set aside.
2. The case is remitted to the Opposition Division with the order to maintain the patent in the following version:

Description: pages 2 and 4 as filed with the letter dated 25 March 1999;
page 3 and page 5 to page 14 line 22 of EP-B-0 583 426;

Claims: Nos. 1 to 10 as granted.

3. The request for reimbursement of the appeal fee is rejected.

The Registrar:

The Chairman:

M. Beer

E. Turrini