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**D E C I S I O N**  
**of 11 September 2003**

**Case Number:** T 1156/98 - 3.3.7

**Application Number:** 93105944.8

**Publication Number:** 0567835

**IPC:** H01B 1/20

**Language of the proceedings:** EN

**Title of invention:**

Electrically conductive abrasion resistant polymeric materials,  
their fabrication and uses thereof

**Applicant:**

International Business Machines Corporation

**Opponent:**

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**Headword:**

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**Relevant legal provisions:**

EPC Art. 84, 108

**Keyword:**

"Statement of grounds of appeal - sufficient grounds (yes)"

"Claims - clarity (no)"

**Decisions cited:**

-

**Catchword:**

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Case Number: T 1156/98 - 3.3.7

**D E C I S I O N**  
**of the Technical Board of Appeal 3.3.7**  
**of 11 September 2003**

**Appellant:** International Business Machines Corporation  
New Orchard Road  
Armonk, N.Y. 10504 (US)

**Representative:** Teufel, Fritz, Dipl.-Phys.  
IBM Deutschland Informationssysteme GmbH  
Patentwesen und Urheberrecht  
D-70548 Stuttgart (DE)

**Decision under appeal:** Decision of the Examining Division of the  
European Patent Office posted 22 September 1998  
refusing European application No. 93105944.8  
pursuant to Article 97(1) EPC.

**Composition of the Board:**

**Chairman:** R. E. Teschemacher  
**Members:** B. L. ter Laan  
G. Santavicca

## Summary of Facts and Submissions

I. European patent application No. 93 105 944.8, filed on 13 April 1993, claiming priority of 28 April 1992 from an earlier application in the USA (US 875171) and published on 3 November 1993 under No. 0 567 835, was refused in a decision of the Examining Division of the European Patent Office dated 22 September 1998. That decision was based on a set of twelve claims filed by letter of 12 March 1997, claim 1 reading:

"A method comprising:

forming an admixture of a solvent, an abrasion and scratch resistant material and an electrically conductive polymer

disposing said admixture onto a surface; and eliminating said solvent to form an electrically conductive abrasion/scratch resistant coating on said surface."

Claims 2 and 6 refer to preferred embodiments of the method according to Claim 1.

Claim 3 reads:

"A method according to claim 1 or 2 comprising:

disposing on a light transmitting surface a first layer of a light transmitting electrically conductive polymer according to claims 3, 4 or 6 to 8, disposing on said layer of light transmitting conductive polymer a second light transmitting layer of a material according to

claims 2 or 9, wherein said second layer is sufficiently thin to permit an electrical contact thereto to provide electrical contact to said first layer, said second layer preferably being from about 5% to about 30% of the thickness of said first layer."

Claims 4 and 5 are directed to preferred embodiments of the method of claim 3.

Claims 7 and 8 are both directed to methods, referring to "the method of any of the preceding claims".

Claim 9 also is a preferred embodiment of the method of claim 3, specifying the electrically conductive polymeric material as being a doped polyaniline.

Claim 10 reads:

"The composition of matter of claim 9, wherein said polyaniline is an emeraldine base form of polyaniline."

Claims 11 and 12 are both directed to compositions and refer to "the composition of matter of claim 7".

II. The Examining Division held that the claimed subject-matter did not satisfy the requirements of Articles 84, 54, 56 and 82 EPC. In particular, objections pursuant to Article 84 EPC were raised against claims 1, 3 and 10 to 12, regarding the way reference was made to other claims as well as the unclarity of some terms used.

- III. On 19 November 1998, a Notice of Appeal was lodged against that decision, together with payment of the prescribed fee. In the Statement of Grounds of Appeal filed on 11 December 1998, the Appellant (Applicant), agreed that the present set of claims did not comply with the requirements of Article 84 EPC and correction was offered in case allowable claims could be agreed. Also, the Appellant referred to a possible introduction of additional claims.
- IV. After a communication from the Board in preparation of oral proceedings, in which several objections, amongst others under Article 84 EPC, were raised, the Appellant informed the Board that they would not attend and that a decision according to the state of the file was requested. Oral proceedings were held on 11 September 2003 in the absence of the Appellant, who had been duly summoned (Rule 71(2) EPC).
- V. The Appellant had requested in writing that the decision of the first instance be cancelled and a patent "on the above application" be granted.

## Reasons for the Decision

### *Admissibility of the appeal*

1. The decision under appeal mentioned objections pursuant to Articles 54, 56 and 82 as well as the following four objections pursuant to Article 84 EPC as reasons for the refusal of the patent application:

- the reference in claim 3 to claims 3, 4 or 6 to 8 and to claims 2 or 9,
- claim 3, which is directed to a process for forming a two-layer system, contains a reference to claims 1 and 2, which are directed to processes for forming admixtures,
- the reference in claims 10 to 12 to "the composition of matter" of claims 7 and 9, respectively, whereas those claims are directed to processes,
- the unclarity of some expressions used in claims 1 and 3.

1.1 In the Statement of Grounds of Appeal, only the objection that claims 1 and 3 contained unclear terms, as well as the objections made under Articles 54, 56 and 82 were contested by the appellant. The first three objections pursuant to Article 84 EPC were expressly accepted. Nevertheless, no new claims were filed in order to remedy the objections made. Therefore, the Appellant agrees that the present set of claims does not comply with the requirements of Article 84 EPC, so

that the question arises whether the statement of grounds of appeal specifies the reasons on which the case for setting aside the contested decision is based (Article 108, 3d sentence, EPC; Case Law of the Boards of Appeal of the EPO, 4th edition, 2001, VII.D.7.5).

- 1.2 In the grounds of the appeal, page 5, second paragraph, "correction is offered in case an agreement concerning allowable claims can be reached". Although this statement demonstrates a false perception of the course of a procedure before the Boards of Appeal, expecting the Board to assess claims that contain uncontested unclarities or that have not even been filed, a false perception is not sufficient reason to refuse the admissibility of the appeal. The statement shows that the Appellant is prepared to amend the claims in such a way as to overcome any objections pursuant to Article 84 EPC, even if that has not (yet) been specifically done. Therefore, the Board decides to admit the appeal.

*Basis for this decision*

2. The Appellant had requested in writing that the decision of the first instance be cancelled and a patent "on the above application" be granted. Although the Appellant agreed that the claims upon which the first instance based its decision do not comply with the requirements of the EPC, no new claims were filed. Therefore, only the claims upon which the first instance based its decision, which are the only claims actually on file, can be the basis for the Board's decision.

*Clarity*

3. As apparent from the communication accompanying the summons for oral proceedings, the Board agrees with the view of the Examining Division, accepted by the Appellant, that the present claims do not comply with Article 84 EPC as regards the first three features mentioned in point 1 above, so that the application already has to be refused for this reason.

Therefore, it is not necessary to decide on the grounds for refusal that had been contested by the Appellant.

**Order**

**For these reasons it is decided that:**

The appeal is dismissed.

The Registrar:

The Chairman:

C. Eickhoff

R. Teschemacher