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D E C I S I O N
of 20 August 1998

Case Number: T 0570/96 - 3.3.3

Application Number: 89301185.8

Publication Number: 0329324

IPC: C08L 33/26

Language of the proceedings: EN

Title of invention:

Polymeric compositions and their production

Patentee:

Allied Colloids Limited

Opponent:

S.N.F. S.A.

Headword:

-

Relevant legal provisions:

EPC Art. 56, 64, 114(2), 123(3)

Keyword:

"Main request - change of category - refused"

"First, second and third auxiliary requests - filed late - not clearly allowable"

Decisions cited:

G 0002/88, T 0153/85, T 0402/89, T 0005/90

Headnote:

The admissibility of late-filed requests depends upon the general principle applied in case T 0153/85, that it is for the public good that legal conflicts be brought to an early close. Decision T 0153/85 was merely a specific application of that

principle, by providing for a stricter scrutiny for allowability of all late filed requests: the later they are filed the more clearly allowable they must be. At such a late stage all the accumulated objections under the EPC must be taken into account.



Case Number: T 0570/96 - 3.3.3

D E C I S I O N
of the Technical Board of Appeal 3.3.3
of 20 August 1998

Appellant: Allied Colloids Limited
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Representative: Maiwald, Walter, Dr. Dipl.-Chem.
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Decision under appeal: Decision of the Opposition Division of the
European Patent Office dated 26 March 1996,
issued in writing on 25 April 1996 revoking
European patent No. 0 329 324 pursuant to
Article 102(1) EPC.

Composition of the Board:

Chairman: C. Gérardin
Members: R. Young
J. A. Stephens-Ofner

Summary of Facts and Submissions

I. The mention of the grant of European patent No. 0 329 324, on the basis of seven claims, in respect of European patent application No. 89 301 185.8, filed on 8 February 1989 and claiming GB priorities of 10 February 1988 (GB 8803064 and GB 8803066) was announced on 20 April 1994 (Bulletin 94/16). Claim 1 read as follows:

"A dispersion in non-aqueous liquid of acrylamide polymer particles which include acrylamide monomer and of which at least 50% by weight of the particles are below 30µm in size, wherein the water content of the dispersion is below 15% by weight based on the total weight of the dispersion, and the dispersion also contains amidase that is effective when the dispersion is dispersed into water for 2 hours at 25°C to reduce the content of acrylamide monomer."

Claims 2 to 7 were dependent claims directed to elaborations of the dispersion according to Claim 1.

II. Notice of Opposition was filed on 20 January 1995, on the ground of lack of inventive step. The opposition was supported *inter alia* by the document:

D1: US-A-4 687 807.

III. With a decision dated 26 March 1996, issued in writing on 25 April 1996, the Opposition Division revoked the patent.

The decision held that, compared with the closest state of the art, which was document D1, disclosing a water-

in-oil emulsion of polyacrylamide differing from that claimed in the patent in suit only in the amount of water present, which was not below 15 wt%, the technical problem was simply to provide an alternative way to reduce the monomer content in polyacrylamide dispersions at a later (user) stage. If it were desired to transfer the digestion of the acrylamide from the producer to the customer, it would have been obvious to reduce the amount of water in the dispersions of D1, so that the digestion of the monomer was not triggered until water was added at a later stage.

- IV. On 24 June 1996, a Notice of Appeal against the above decision was filed, together with payment of the prescribed fee.

In the Statement of Grounds of Appeal, filed on 22 August 1996, the Appellant (Patentee) relegated the defence of the patent in the form as granted to an auxiliary request and submitted, as main request, a new set of Claims 1 to 4 directed to a process for the production of a dispersion of acrylamide polymer particles. The Appellant's arguments, which concentrated on these process claims, defended the change of category as permissible under Article 123(3) EPC, in view of the ruling of the Enlarged Board in G 0002/88 (OJ EPO 1990, 093).

- V. In the reply of the Respondent (Opponent), dated 18 December 1996, it was argued that the change of category to a process claim was not allowable under Article 123(3) EPC, since the scope must necessarily have been changed; furthermore, the fact of the patent as granted forming an auxiliary request indicated that the main request must be broader in scope.

VI. With a letter filed on 6 July 1998 in advance of the oral proceedings scheduled for 4 August 1998, the Appellant filed an amended set of Claims 1 to 4 forming a new main request ("Main Request July 1998"), and a new set of Claims 1 to 4 forming a first auxiliary request ("First Auxiliary Request July 1998"), and indicated that the claims of the patent as granted formed a second auxiliary request (page 2, first two lines, referring to the "previous first auxiliary request"). Claim 1 of the main request reads as follows:

"A process for the production of a dispersion of acrylamide polymer particles on to which particles amidase has been coated or adsorbed, comprising: producing a first substantially anhydrous dispersion in non-aqueous liquid of acrylamide polymer particles which include acrylamide monomer and of which at least 50% by weight of the particles are below 30µm in size, and blending into and distributing throughout the first dispersion an aqueous composition containing amidase, so that the water content of the resulting dispersion is below 15% by weight based on the total weight of the dispersion and so that the resulting dispersion contains amidase which is effective when the dispersion is dispersed into water for 2 hours at 25°C to reduce the content of acrylamide monomer."

Claims 2 to 4 are directed to elaborations of the process according to Claim 1.

Claim 1 of the first auxiliary request is worded as follows:

"A dispersion in non-aqueous liquid of acrylamide polymer particles which include acrylamide monomer and of which at least 50% by weight of the particles are below 30µm in size, which has been formed by providing a first substantially anhydrous dispersion of the polymer particles in the non-aqueous liquid and the amidase has been coated or absorbed onto the polymer particles as a result of blending into and distributing throughout the substantially anhydrous first dispersion an aqueous composition containing amidase, and the water content of the dispersion is below 15% by weight based on the total weight of the dispersion, and the dispersion also contains amidase that is effective when the dispersion is dispersed into water for two hours at 25°C to reduce the content of acrylamide monomer."

Claims 2 to 4 are directed to elaborations of the dispersion according to Claim 1.

VII. With a letter filed on 15 July 1998, the Respondent withdrew the opposition.

VIII. In the introductory remarks at the oral proceedings, objections were raised by the Board against the main request under Article 123(3) EPC and against the first auxiliary request under Article 84 EPC.

The Appellant then cancelled all but the main request (filed on 6 July 1998) and presented, instead, three further amended sets of claims forming new first, second and third auxiliary requests, respectively, two of them drafted as product-by-process claims directed

to a dispersion in non-aqueous liquid of acrylamide polymer particles, and one drafted as a process claim relating to the production of such dispersions.

After hearing the Appellant on the allowability of the main request, in particular under Article 123 EPC, and adjournment for deliberation, the decision was announced that the main request had been refused.

The Appellant then presented arguments on the allowability of the three auxiliary requests, after which the proceedings were again adjourned for deliberation. Following the adjournment, and without any decision being announced on the allowability of these requests, the representative of the Appellant was invited to present substantive arguments concerning all three requests, in particular with regard to inventive step. Following a further adjournment for final deliberation, the Board announced that it would reserve judgement. The final decision would be issued in writing.

- IX. The Appellant requested that the decision under appeal be set aside and the patent be maintained on the basis of the claims of the main request filed on 6 July 1998, or on the basis of the claims presented during the oral proceedings as first, second or third auxiliary request, respectively.

- X. On 20 August 1998 the Board announced its decision that the appeal was dismissed.

Reasons for the Decision

- 1. The appeal is admissible.

2. *Main request*

This request was filed on 6 July 1998, i.e. less than one month before the date set for oral proceedings, and thus fell within the scope of the principles applied for late filed claims in the decision T 0153/85 (OJ EPO 1988, 001), and in particular that the latter must be clearly allowable. The differences between the claims of this set and those of the main request filed with the Statement of Grounds of Appeal are relatively minor, however, being restricted to the dependent claims. Consequently, the Board did not decide to disregard the request, even though its claims were not, for the following reasons, clearly allowable.

2.1 The claims all involve a change of category, from a "product" type claim to a "process" type claim, the process being one for the production of the product previously claimed. In the written proceedings, the sole defence of this change of category, which had in any case been challenged under Article 123(3) EPC by the then Respondent (submission filed on 20 December 1996, pages 2 and 3), was that it was permitted under the ruling of the Enlarged Board in its decision G 0002/88.

2.2 Whilst it is true that such amendments have been allowed in a number of cases in appeal, closer examination of the above decision of the Enlarged Board shows that the change of category considered was from a product claim, for instance a "compound" claim, to a "use" claim. The decision cited does not, therefore, provide a direct authority for the change of category involved in the present case.

2.3 Furthermore, the Board is aware of the decision T 0402/89 of 12 August 1991 (not published in OJ EPO), which stated, with reference to G 0002/88, in connection with the operation of Article 64 EPC, "Furthermore, the Board finds it difficult in this case (as the Enlarged Board did not in the above-cited case where a different type of amendment was at issue) to separate the twin linked concepts of "protection conferred" on the one hand and "rights conferred" on the other insofar as the latter involves the determination of what acts of third parties constitute infringement" (Reasons for the decision, point 2). It is considered that the objection raised in the written submission of the Respondent, which asserted that there had to be a difference in scope by virtue of the change of category, relates to this aspect.

2.4 The argument of the Appellant at the oral proceedings, that the scope of any additional such protection, provided by virtue of Article 64(2) EPC, for the product directly produced by the process belonging to the new category, could not be greater than that of the claim as granted to the product *per se*, ignores the different legal implications, referred to above, stemming from the separate protection afforded by Article 64 EPC, and applying, in particular, to Article 64(2) EPC.

2.5 The further argument of the Appellant at the oral proceedings, which was based on a quotation from a commentary concerning the decision T 0005/90 of 27 November 1992 (not published in OJ EPO), is not relevant, since in that case the process claim was narrower in scope than the corresponding product claim.

Thus the cited decision relates to different facts.

2.6 The onus was, however, on the Appellant to satisfy the Board that the subject-matter protected by the new claim was not extended, and, in view of the objections raised by the opposing party in particular, to show that the operation of Article 64(2) EPC could not lead to such an extension. Although the representative of the Appellant made considerable efforts in this direction during the oral proceedings, the doubts of the Board remained.

2.7 Consequently, the main request was refused.

3. *First, second and third auxiliary requests: legal considerations*

All these requests, which were formulated during the oral proceedings and were therefore filed at the latest possible date, were filed late. The admissibility of all late-filed requests depends, as was stated before in paragraph 2. *ibid.*, upon the general principle applied in case T 0153/85 to the facts of that case. That general principle, that it is for the public good that legal conflicts be brought to an early close (*expedit republicae ut sit finis litium*), is a legal maxim that is said to belong to the laws of **all** countries (Black's Law Dictionary; 6th Edition). It needs to be stressed again that decision T 0153/85 was merely a specific application, pursuant to Article 125 EPC, of the above maxim, by providing for a stricter scrutiny for allowability of all late filed requests: **the later they are filed the more clearly allowable they must be**. This is particularly so where they are filed during oral proceedings in the appeal, at the end

of which a final decision is normally given - thereby bringing the legal conflict (i.e. the opposition appeal) to a close. At such a late stage all the **accumulated** objections under the EPC must be taken into account, not just the very latest one that a new request may give rise to - always assuming that they had not been satisfactorily disposed of by earlier amendments. Were this not the case, the latest of several amendments may be found to be clearly allowable on a narrow ground, whilst leaving other, still live objections, out of consideration altogether.

Where, as in this case, a decision on the allowability of claims filed during the oral proceedings, themselves the successors of earlier late-filed ones, cannot be arrived at the end of oral proceedings, causing the decision itself to be reserved although the appeal is closed (cf. continuation of the appeal in writing), the claims cannot, by definition, be **clearly** allowable when the decision is rendered and the reasons given, or else they would have been when the oral proceedings were closed.

In particular, the Board was unable to come to the conclusion, even in the absence of any, possibly highly effective rebuttal by the Respondent, that the subject-matter of any of these requests clearly met all of the requirements of the EPC, including that of inventive step (Article 56 EPC). The requests were therefore disregarded in accordance with Article 114(2) EPC.

Consequently, there was no valid text before the Board, in the sense of Article 113(2) EPC, upon which a decision to maintain the patent could be based.

Order

For these reasons it is decided that:

The appeal is dismissed.

The Registrar: The Chairman:

E. Görgmaier C. Gérardin