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D E C I S I O N
of 24 June 2003

Case Number: T 0657/01 - 3.3.3

Application Number: 93200971.5

Publication Number: 0565184

IPC: C08J 3/22

Language of the proceedings: EN

Title of invention:

Process for obtaining granular forms of additives for organic polymers

Patentee:

Great Lakes Chemical (Europe) GmbH

Opponent:

Ciba Speciality Chemicals Holding Inc.
GENERAL ELECTRIC COMPANY
Akzo Nobel N.V.
W.R. Grace & Co.

Headword:

-

Relevant legal provisions:

EPC Art. 123(2), (3)

Keyword:

"Amendments - added subject-matter (yes)
- inescapable Article 123(2), (3) trap (yes)"

Decisions cited:

G 0001/93, T 0553/99

Catchword:

-



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Boards of Appeal

Chambres de recours

Case Number: T 0657/01 - 3.3.3

D E C I S I O N
of the Technical Board of Appeal 3.3.3
of 24 June 2003

Appellant:
(Proprietor of the patent) Great Lakes Chemical (Europe) GmbH
Juchstrasse 45
CH-8500 Frauenfeld (CH)

Representative:
Akers, Noel James
Howrey Simon Arnold & White
City Point,
One Ropemaker Street
London EC2V 9AW (GB)

Respondents:
(Opponent 01) Ciba Speciality Chemicals Holding Inc.
Klybeckstrasse 141
P.O. Box/Postfach
CH-4002 Basel (CH)

Representative: -

(Opponent 02) GENERAL ELECTRIC COMPANY
1 River Road
Schenectady
New York 12345 (US)

Representative:
Grever, Frederik
General Electric Plastics B.V.
P.O. Box 117
NL-4600 AC Bergen op Zoom (NL)

(Opponent 03) Akzo Nobel N.V.
Patent Department
Velperweg 76
P.O. Box 9300
NL-6800 SB Arnhem (NL)

Representative: -

(Opponent 04)

W.R. Grace & Co.
Grace Plaza, 1114 Avenue of the Americas
New York, New York 10036 (US)

Representative:

Duckworth, Timothy John
J.A. Kemp & Co.,
14 South Square,
Gray's Inn
London WC1R 5JJ (GB)

Decision under appeal:

Decision of the Opposition Division of the
European Patent Office posted 20 April 2001
revoking European patent No. 0 565 184 pursuant
to Article 102(1) EPC.

Composition of the Board:

Chairman: R. J. Young
Members: P. Kitzmantel
J. H. Van Moer

Summary of Facts and Submissions

I. Mention of the grant of European patent No. 0 565 184 in respect of European patent application No. 93 200 971.3 in the name of Great Lakes Chemical Italia S.r.l. (now Great Lakes Chemical (Europe) GmbH), which had been filed on 1 April 1993 claiming an IT priority of 6 April 1992, was announced on 17 June 1998 on the basis of four claims, independent Claims 1 and 4 reading as follows:

"1. Process for obtaining granular forms from powder mixtures of two or more additives for organic polymers in the absence of waxes, paraffins and stearamides, which includes extruding the mixture at a temperature of between about the melting point of the component with the lowest melting point and 140 °C, cooling the extrudate at room temperature and cutting or granulating it into pellets, with the condition that, when the mixture consists of two additives, these are not tetrakis[3-(3,5-di-t-butyl-4-hydroxyphenyl)propionyloxymethyl]methane, either in an amorphous or crystalline form, and an antiacid."

"4. Use of the pellets obtained with the process relating to any of the previous claims, combined with organic polymers."

Claims 2 and 3 were dependent on Claim 1.

II. Notice of Opposition requesting revocation of the patent in its entirety on the grounds of Article 100(a), (b) and (c) EPC was filed by

CIBA Specialty Chemicals Holding (Opponent I) on
15 March 1999,

General Electric Company (Opponent II) on 17 March
1999,

Akzo Nobel N.V. (Opponent III) on 17 March 1999, and

W.R. Grace & Co (Opponent IV) on 17 March 1999.

III. The oppositions were *inter alia* based on documents

E1: EP-A-0 514 784,

E3: EP-A-0 392 392,

E4: Transcript of lecture "Pressagglomeration" held by
Dipl.Ing. R. Friedrich on 20 September 1989, and

E5: US-A-4 446 086.

IV. By its decision orally announced on 27 March 2001 and
issued in writing on 20 April 2001, the Opposition
Division revoked the patent.

The decision was based on a main and two auxiliary
requests whose Claims 1 differed from the granted
version by the addition of a disclaimer (all requests)
and by further amendments (auxiliary requests).

It held that

- all requests met the requirements of
Article 123(2) and (3) EPC,

- the disclosure of the patent was sufficient within the terms of Article 83 EPC,
- the main request, although novel by introduction of the disclaimer over E1, was anticipated by E5,
- the first and the second auxiliary requests, although novel over E5, were obvious over E3 in combination with E4.

V. On 13 June 2001 the Patentee (Appellant) lodged an appeal against the decision of the Opposition Division and paid the appeal fee on the same day. The Statement of Grounds of Appeal was submitted on 29 August 2001. A further written submission was filed by the Appellant on 21 May 2003, partly in response to the provisional comments of the Rapporteur attached to the summons to attend oral proceedings dated 12 February 2003.

With the latter submission the Appellant filed four versions of Claim 1 (one main and three auxiliary requests), all these versions essentially corresponding to Claim 1 of the main request underlying the decision under appeal (i.e. being different from the granted version only by the disclaimer introduced to establish novelty over E1), but for the following amendments:

Main request: the words "or granulating" are deleted after the word "cutting"; the relevant passage therefore reading: "... cooling the extrudate at room temperature and cutting it into pellets ...".

First auxiliary request: the word "then" is inserted ahead of the word "cutting"; the relevant passage therefore reading: "... and then cutting it into pellets ..."

Second auxiliary request: the passage "to room temperature" is inserted after the words "at room temperature"; the relevant passage therefore reading: "... cooling the extrudate at room temperature to room temperature and cutting it into pellets ...".

Third auxiliary request: in addition to the same amendment as according to the second auxiliary request, the following new feature is added after "and cutting it into pellets": "... the mixture comprising at least one additive having a melting point above the extrusion temperature of the mixture ...".

VI. The Appellant's arguments as far as they are relevant for this decision and as presented in their written submissions and during the oral proceedings held on 24 June 2003 may be summarized as follows:

(i) The passage in Claim 1 of all requests "cooling the extrudate at room temperature" met the requirements of Article 123(2) EPC in that it was fully supported by the disclosure of Example 1 of the application as filed. The reasons being as follows:

(1) To the skilled person there was no factual difference between the meaning of "cooled to room temperature", i.e. the term used in

Example 1 for the treatment of the extruded "spaghetti", and "cooling at room temperature".

Evidence therefor was

- that the latter term was not objected to by the Examining Division, the Opposition Division and by three of the four opposition statements,
- the identity of these two terms when translated into French or Italian, and
- that the word "at" comprised the meaning "indicate the goal of an indirect or implied action" and could therefore be read to mean "cooled until they reach room temperature" (according to Webster's New Collegiate Dictionary, 1981, page 69).

(2) The information "cooling at room temperature" was implicit to the disclosure of the Examples because in the absence of a reference in the application as filed to forced cooling, the skilled person would take it for granted that the cooling was carried out at ordinary conditions, i.e. at room temperature; this was the automatic "default" position.

(ii) Alternatively, in application of the principles set out in G 1/93 (OJ EPO 1994, 541) the passage "cooling at room temperature" did not contravene

the requirements of Article 123(2) EPC because this feature provided no technical contribution, but merely excluded something from protection and did not therefore give an unwarranted advantage to the Patentee.

(iii) This conclusion was particularly valid with regard to Claim 1 of the second and third auxiliary requests because by supplementing the passage "cooling at room temperature" by the words "to room temperature" it became even more conspicuous that what really mattered was the latter feature; the consequence being that the passage objected to was clearly rendered technically inessential and could remain in Claim 1 without contravention of Article 123(2) EPC as was held in the wholly analogous situation according to T 553/99 of 21 February 2001 (not published in the OJ EPO).

(iv) The Appellant submitted furthermore arguments with regard to other objections under Article 123(2) EPC, including the admissibility of the disclaimer which had been introduced during the first stage opposition proceedings, as well as with regard to the issues of novelty and inventive step.

VII. The Respondents presented their counterstatements in the following written submissions

Opponent I: 13 September 2002 and 10 April 2003,

Opponent II: 5 March 2002 and 5 June 2003,

Opponent IV: 7 May 2002,

and at the oral proceedings.

Opponent III refrained from making any written comments and did not attend the oral proceedings.

The arguments of the Respondents as far as they are relevant for this decision can be summarized as follows:

- (i) The feature "cooling at room temperature" in Claim 1 of all requests went beyond the content of the application as filed.
- (ii) However, this feature could not be deleted because it was already comprised by the granted version of Claim 1 with the consequence that its removal would result in an extension of the granted scope, contrary to Article 123(3) EPC.
- (iii) By specifying the cooling conditions with the term "cooling at room temperature" instead of "cooling to room temperature", as according to the disclosure of the application as filed, the final temperature of the cooled extrudate was no longer restricted to room temperature but could be higher, thus giving the Patentee an unwarranted advantage over third parties which was contrary to the purpose of Article 123(2) EPC as set out in G 1/93 (Reasons 16).
- (iv) As regards the consent to the passage "cooling at room temperature" of the previous instances of the EPO, reference was made to Section 13 of

the Reasons of G 1/93 which held that it did not, in principle, matter that such amendment had been approved by the Examining Division because the ultimate responsibility for an amendment lay with the Applicant or Patentee.

- (v) Since the language of the proceedings was English, it was the version in this language that determined the scope of Claim 1 and any possible alteration of the scope in another language was irrelevant.
- (vi) The Appellant's position that, in the present case, "cooling at" and "cooling to" had the same meaning was at variance with the understanding of these terms by the competent skilled person, i.e. the expert in chemical engineering, because in this field the terms "cooling at" and "cooling to" had clearly a different meaning: the former relating to the thermal cooling environment and the latter to the final temperature of the cooled matter.
- (vii) Any diverging interpretation, including those resulting from other meanings of the preposition "at" contained in Webster's New Collegiate Dictionary, required an explicit pointer in the patent specification which is missing.
- (viii) The passage "cooling at room temperature" therefore clearly provided a technical contribution to the claimed subject-matter; this was even implicitly acknowledged by the Patentee at the granting stage by introducing this passage in order to establish novelty over E3.

- (ix) Nor would the skilled person, in the absence of any information in the application as filed with respect to the thermal cooling conditions, regard "cooling at room temperature" as an inevitable "default" measure that was implicit to the disclosure of the application because the art comprised several cooling methods involving cooling temperatures different from room temperature, including cold air and water.

- (x) Furthermore, for an added feature to be admissible under Article 123(2) EPC its clear and unambiguous disclosure was required; a merely possible interpretation from a host of other alternative interpretations was anyway insufficient.

- (xi) In these circumstances, the conditions set out in Headnote 2 of G 1/93 for concluding that an added feature did not contravene Article 123(2) EPC because it did not provide a technical contribution to the subject-matter of the claimed invention was not met.

- (xii) By supplementing the passage "cooling at room temperature" with the words "to room temperature", as proposed by the Appellant according to the second and third auxiliary requests, the technical contribution of the former passage was not affected and this passage not made redundant because the thermal cooling conditions and the final temperature of the cooled extrudate related to two **separate** technical measures.

For that reason the present situation was different from that underlying T 533/99 in which case the added feature relating to the position of the display surface of the claimed reflection minimizing apparatus **covered** the unsupported feature relating to the position of the display unit.

- (xiii) In addition to the afore-mentioned arguments, the Respondents submitted further objections under Article 123(2) EPC, *inter alia* alleging the inadmissibility of the disclaimer which had been introduced in order to establish novelty over E1, as well as arguments relating to the issues of sufficiency, novelty and inventive step.

VIII. The Appellant requested that the decision under appeal be set aside and that the patent be maintained on the basis of the main request or the first to third auxiliary requests, submitted on 21 May 2003.

The Respondents requested that the appeal be dismissed.

Reasons for the Decision

1. The appeal is admissible.

Article 123(2) and (3) EPC

2. Claim 1 of the granted patent as well as all its operative versions (main request and first to third

auxiliary requests) comprise the statement "cooling the extrudate at room temperature" (emphasis by the Board).

3. This passage was introduced into Claim 1 during the examination phase in order to establish novelty over E3, allegedly on the basis of the information in Example 1 (page 7, line 25 to page 8, line 11 of the application as filed). However, the relevant disclosure of Example 1 reads: "A "spaghetti" is obtained which, when it has been cooled to room temperature, is then cut into pieces ..." (emphasis by the Board). Indeed, the Examining Division in its communication of 9 December 1996 suggested the wording "cooling the extrudate to room temperature ..." which was then changed by the Applicant's submission of 2 January 1997 to "cooling the extrudate at room temperature ...".

4. The Opposition Division in the decision under appeal *inter alia* acknowledged that the passage "cooling the extrudate at room temperature" was based on the original disclosure as comprised by the Examples and found the objection of Opponent 1 unconvincing that the original statement "cooled to room temperature" could not support the feature "cooling at room temperature" (cf. Minutes of the oral proceedings held on 27 March 2001, page 1, last two lines of paragraph 4).

5. However, in the Board's judgment, the passage "cooling the extrudate at room temperature" in Claim 1 of all requests which limits the scope of protection conferred by these claims is not supported by the disclosure of the application as filed; this applies especially to the information in its Example 1 "cooled to room temperature".

5.1 Since the passage provides a technical contribution to the claimed subject-matter it cannot, in application of the conclusions drawn in G 1/93 (Reasons 16), be considered **not** to extend beyond the content of the application as filed.

5.2 Nor can this scope-limiting passage be deleted or replaced by another feature disclosed in the application without contravention of Article 123(3) EPC (G 1/93, Reasons 13).

These conclusions are based on the following considerations:

Main request and first auxiliary request

6. Since Claim 1 of both these requests comprises the same passage "cooling at room temperature" and since both cover the same order of process steps: extruding - cooling - cutting, the compliance of both requests with the requirements of Article 123(2) EPC is subject to the same considerations. Furthermore, the conclusiveness of the arguments regarding the fulfilment of these requirements also extends to the different order: extruding - cutting - cooling, claimed by the Appellant to be covered by the wording of Claim 1 of the main request, because the order of these process steps involves no different appreciation of the technical contribution of the passage "cooling at room temperature" to the claimed subject-matter.

7. The Appellant's assertion that to the skilled person the terms "cooling at room temperature" and "cooling to room temperature" meant the same and that for this reason the term "cooling at room temperature" was not

objectionable under Article 123(2) EPC is at variance with the ordinary meaning of the two prepositions "at" and "to" in the present context. "Cooling at room temperature" clearly and unambiguously relates to the thermal conditions under which the extrudate is cooled, whereas "cooling to room temperature" describes the final temperature of the cooled extrudate, i.e. after its exposure to the cooling environment.

8. This conclusion cannot be invalidated by the Appellant's argument that the preposition "at" according to Webster's New Collegiate Dictionary could be interpreted to mean "to" because the skilled reader will normally understand a word in accordance with the ordinary meaning attributed to it in the context it is used: in the present case this is undoubtedly the meaning 6a in the cited dictionary, i.e. "used as a function word to indicate the rate, degree, or position in a scale or series <the temperature at 90>". Deviating from this meaning required a suggestion to do so in the relevant text which is absent. Even then such alternative meaning could only be considered to be disclosed within the meaning of Article 123(2) EPC if this was clearly and unambiguously the intention of the application as filed. The existence of such alternative meaning among other possible choices would not be sufficient.

9. The fact that, arguably, on the basis of a translation of this passage into a language other than English, e.g. French or Italian, a different conclusion might be arrived at has no bearing on the conclusion drawn in the preceding Section because, according to Article 70(1) EPC the language of the proceedings, here English, shall be the authentic text in any proceedings

before the EPO and in any Contracting State, the only possible exception thereto relating to translations into an official language of a State having a **narrower** scope than that conferred by the language of the proceedings (Article 70(3) EPC).

10. The Board's decision whether or not an amendment conforms with the requirements of Article 123(2) EPC is independent of possibly contrary conclusions of other instances of the EPO and/or the parties. As set out in G 1/93 (Reasons 13, last sentence) the ultimate responsibility for any amendment always lies with the Appellant/Patentee. The positive attitude of an Examining and/or Opposition Division is therefore no guarantee for the eventual decision of a board on the question of the admissibility of an amendment although these bodies consist of people who are highly qualified for decisions on that issue.

11. Nor is the Appellant's contention convincing that, for interpreting the passage "cooling at room temperature", the skilled person will turn to the examples and thus discover that the "true" meaning of this passage was "cooling to room temperature". Firstly, the patent itself does not suggest an inconsistency between these two passages (because "cooling at room temperature" could easily result in "cooling to room temperature") and secondly, even if there was a suspicion about an inconsistency the "true" meaning could not be determined on the basis of the patent's disclosure. Even if recourse was had to the granting history, the intention behind the choice of the term "cooling at room temperature" could not be elucidated.

12. Also the Appellant's alternative argument that the added term "cooling at room temperature" in accordance with G 1/93 could remain in Claim 1 because it did not provide a technical contribution to the Claims subject-matter fails because the temperature at which the extrudate is cooled is clearly a technical feature of the claimed process, albeit not necessarily essential for its overall technical feasibility. It follows that the condition of a missing technical contribution set out in G 1/93 on whose basis added matter can be considered as not extending beyond the application as filed is not met here (Reasons 16; Headnote 2). This theoretical possibility to escape from the Article 123(2) / (3) trap is thus ruled out even if the Appellant's conclusion was right that the passage "cooling at room temperature" merely excluded protection for part of the subject-matter of the claimed invention as covered by the application.
13. Claim 1 of the main and the first auxiliary request thus do not comply with the requirements of Article 123(2) EPC.

Second and third auxiliary requests

14. No different conclusion is arrived at with regard to Claim 1 of the second and third auxiliary request because the insertion of the words "to room temperature" after the passage "cooling at room temperature" has no impact on the technical character of this passage. The temperature of the cooling environment is a technical feature quite distinct from the ultimate temperature of the cooled extrudate and limiting the latter to room temperature has no bearing on the temperature of the cooling environment. Rather

these two features relate to technical parameters which are separate from each other.

15. The situation is thus different from the one according to T 553/99 where it was decided that the addition of the feature "that the display surface (10) is downwardly angled with respect to the vertical by a small acute angle β " to the statement "said display unit being arranged for use in a substantially vertical position" rendered the latter feature completely inessential, and thus no longer providing a technical contribution, with the consequence that it could be maintained in the respective claim in spite of its lacking disclosure in the application as filed. This decision was arrived at because the position of the display unit was considered to be devoid of any technical significance for the claimed subject-matter once the position of the display surface was defined which was indeed the active part of the claimed reflection minimizing apparatus while the display unit provided merely a housing therefor.

However, as set out in the preceding Section in the present case the technical relevance for the claimed subject-matter of the unsupported feature "cooling at room temperature" remains unchanged after addition of the words "to room temperature". The conclusion of T 553/99 is therefore not applicable to the present situation.

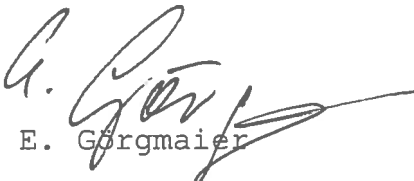
16. The further feature inserted into Claim 1 of the third auxiliary request in addition to the amended passage "cooling at room temperature to room temperature" which is common to the second and third auxiliary requests has no impact on the considerations concerning Article 123(2) EPC made above.
17. Claim 1 of the second and third auxiliary request thus fail to meet the requirements of Article 123(2) EPC.
18. None of the Appellant's requests is therefore allowable.

Order

For these reasons, it is decided that:

The appeal is dismissed.

The Registrar:


E. Gorgmaier

The Chairman:


R. Young

