

BESCHWERDEKAMMERN
DES EUROPÄISCHEN
PATENTAMTS

BOARDS OF APPEAL OF
THE EUROPEAN PATENT
OFFICE

CHAMBRES DE RECOURS
DE L'OFFICE EUROPEEN
DES BREVETS

Internal distribution code:

- (A) [] Publication in OJ
(B) [] To Chairmen and Members
(C) [X] To Chairmen
(D) [] No distribution

D E C I S I O N
of 9 July 2003

Case Number: T 0724/01 - 3.3.3

Application Number: 92306664.1

Publication Number: 0524802

IPC: C08L 65/00

Language of the proceedings: EN

Title of invention:

A container for a sanitary article

Patentee:

DAIKYO GOMU SEIKO LTD.

Opponent:

SCHOTT GLASWERKE

Headword:

-

Relevant legal provisions:

EPC Art. 123(2)

Keyword:

"Amendments - added subject-matter (no)"

Decisions cited:

-

Catchword:

-



Case Number: T 0724/01 - 3.3.3

D E C I S I O N
of the Technical Board of Appeal 3.3.3
of 9 July 2003

Appellant: DAIKYO GUMO SEIKO LTD.
(Proprietor of the patent) No. 38-2, Sumida 3-chome
Sumida-ku
Tokyo (JP)

Representative: Hayes, Adrian Chetwynd
Boult Wade Tennant
Verulam Gardens
70 Gray's Inn Road
London WC1X 8BT (GB)

Respondent: SCHOTT GLASWERKE
(Opponent) Hattenbergstrasse 10
D-55122 Mainz (DE)

Representative: Luderschmidt, Schüler & Partner GbR
Patentanwälte
Postfach 3929
D-65029 Wiesbaden (DE)

Decision under appeal: Decision of the Opposition Division of the
European Patent Office posted 28 March 2001
revoking European patent No. 0524802 pursuant
to Article 102(1) EPC.

Composition of the Board:

Chairman: R. Young
Members: P. Kitzmantel
R. Moufang

Summary of Facts and Submissions

I. Mention of the grant of European patent No. 0 524 802 in respect of European patent application No. 92 306 664.1 in the name of DAIKYO GOMU SEIKO LTD., which had been filed on 21 July 1992 claiming two JP priorities of 22 July 1991 and 8 July 1992, was announced on 27 November 1996 on the basis of 11 claims, Claim 1 reading as follows:

"A container for a sanitary article consisting of a material containing a resin formed of a cyclic olefin compound or a bridged polycyclic hydrocarbon compound, as a polymeric component."

Claims 2 to 11 were dependent on Claim 1.

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

Hoechst AG (later Ticona GmbH) (Opponent I) on 15 August 1997 (opposition withdrawn with submission dated 21 December 2000),

and

Schott Glaswerke (Opponent II) on 21 August 1997.

The oppositions were *inter alia* based on documents

D6: EP-A-0 291 208,

D7: EP-B-0 384 694,

D10: EP-B-0 430 585, and

D12: DE-A-3 937 865.

III. By its decision announced orally on 7 March 2001 and issued in writing on 28 March 2001, the Opposition Division revoked the patent.

That decision was based on an amended set of three claims, Claim 1 reading as follows:

"A container for a sanitary article consisting of a material containing a shaped or laminated resin formed of a homopolymer of a tetracyclo [4,4,0,1^{2.5},1^{7.10}]-3-dodecene compound wherein:

the resin may be a mixture with at least one member selected from the group consisting of olefinic resins and synthetic rubbers, the resin being present in a proportion of at least 30 weight %; and the resin has a bromine number of at most 1 and a softening point of at least 130°C."

Claims 2 and 3 were dependent on Claim 1.

It was held in that decision that Claim 1 contravened the requirements of Article 123(2) EPC because the definition "homopolymer of a tetracyclo [4,4,0,1^{2.5},1^{7.10}]-3-dodecene compound" was an unsupported generalisation on the basis of the structure of five specifically exemplified tetracyclododecene structures; the missing justification for this generalisation was apparent from the fact that the gas barrier properties of the resin were strongly influenced by the nature of the

substituents as evidenced by Examples 3 and 4 in Table 3 of the patent in suit.

The decision also stated that, even in the event that the Article 123(2) EPC objection could be overcome, Claim 1 would not be allowable because its subject-matter was anticipated by D10, a document disclosing a hydrogenated polycyclic polymer prepared by ring-opening polymerisation of a tetracyclododecene composition which could be utilised for sanitary articles including injectors and pipettes. Since the polymer had a Tg of at least 130°C and, because of the hydrogenation reaction, must have a bromine value close to zero, it met all requirements of present Claim 1.

- IV. On 25 May 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 comprising Claims 1 to 3 of a main request was submitted on 3 August 2001; further written submissions of the Appellant date from 22 May 2002, 9 June 2003 (comprising sets of claims of five auxiliary requests) and 7 July 2003 (comprising a set of claims of a further auxiliary request).

Claim 1 of the main request reads:

"A container for a sanitary article consisting of a material containing a shaped or laminated resin formed of a homopolymer of dimethyl-tetracyclo [4,4,0,1^{2.5},1^{7.10}]-3-dodecene, methyloxycarbonyltetracyclo [4,4,0,1^{2.5},1^{7.10}]-3-dodecene or ethylidene-tetracyclo [4,4,0,1^{2.5},1^{7.10}]-3-dodecene* wherein the resin may be a mixture with at least one member selected from the

group consisting of olefinic resins and synthetic rubbers, the resin being present in a proportion of at least 30 weight %; and the resin has a bromine number of at most 1 and a softening point of at least 130°C." (* correction from ethylidene-tetracyclo ...)

As compared to Claim 1 of the main request the subject-matter of Claims 1 of the auxiliary requests 1, 2, 4, 5 and 6 is restricted in scope; Claim 1 of auxiliary request 3 relates to a specific use of the subject-matter of Claim 1 of the main request.

V. The arguments of the Appellant which are relevant to this decision presented in the written submissions and at the oral proceedings held on 9 July 2003 may be summarized as follows

(a) Claim 1 complied with the requirements of Article 123(2) EPC because it was now restricted to homopolymers from three specific tetracyclododecene compounds which were clearly supported by the original disclosure (EP-A document), namely *inter alia* by the statements on, respectively, page 8, lines 43 to 50, page 9, lines 1 to 8 and page 10, lines 33 to 40 in conjunction with the statement on page 10, lines 53 to 56 according to which these compounds were used as polymeric component of a cyclic resin which could, as a copolymeric component, contain certain further monomeric species. The latter statement provided support for the term "homopolymer" because, in the absence of such copolymeric component, the polymers derived from these compounds must necessarily be homopolymers.

- (b) In addition, Synthetic Examples 4 and 6 disclosed the preparation of homopolymers from dimethyl-tetracyclo [4,4,0,1^{2.5},1^{7.10}]-3-dodecene and from methyloxycarbonyltetracyclo[4,4,0,1^{2.5},1^{7.10}]-3-dodecene which resulted in Resins (d) and (f), respectively, whose properties and technical feasibility were elaborated in the experimental section of the patent in suit (Examples 3, 4, 9 to 12, 13, 15 to 20, 23 and 24). Evidence of a homopolymer derived from the third compound ethylidene-tetracyclo [4,4,0,1^{2.5},1^{7.10}]-3-dodecene which was not exemplified in the patent in suit itself was comprised by the Appellant's submission dated 22 May 2002.
- (c) Concerning the absence of the indication of a bromine number for Resin (d), the Appellant stated that, given the presence of hydrogen during the polymerisation reaction and taking into account the bromine numbers reported in Synthetic Examples 2 and 5, it was reasonable to assume that the bromine number of Resin (d) met the requirement of Claim 1.
- (d) With regard to the question whether Resin (f), because of the presence in the polymerisation mixture of 1-hexene, was to be considered as a homopolymer, the Appellant contended that the small amounts of 1-hexene used according to Synthetic Example 6 indicated its function as a molecular weight modifier for the methyloxycarbonyltetracyclododecene homopolymer. This was confirmed, in the Appellant's view, by

the statement in the EP-A-0 436 372 (page 5, lines 14 to 18) which distinguished between compounds, like 1-hexene, used as molecular weight modifiers and comonomers.

- (e) The Appellant also submitted arguments contesting the lack of novelty objections based on D10 contained in the decision under appeal and maintained by the Respondent and furthermore stated that the claimed subject-matter was also inventive.

VI. The arguments of the Respondent which are relevant to this decision presented in the written submissions dated 18 February 2002 and 28 May 2003 and at the oral proceedings may be summarized as follows:

- (a) In its first written submission the Respondent held that Claim 1 of the main request contravened the requirements of Article 123(2) EPC because in the absence of a specific worked example the general description of the patent in suit did not provide a clear support for a homopolymer made from ethylidene-tetracyclo [4,4,0,1^{2.5},1^{7.10}]-3-dodecene. At the oral proceedings the Respondent refrained from any further comment on that issue and requested that the Board decide on the basis of the written submissions.
- (b) It was not clear, in the Respondent's view, that the bromine number of Resin (d) was within the range of "at most 1" specified in Claim 1 of the patent in suit.

- (c) The Respondent did not contest the Appellant's assertion that the function of 1-hexene in Synthetic Example 6 was that of a molecular weight modifier and that Resin (f) therefore was to be considered as a homopolymer.

- (d) The Respondent furthermore raised objections of lack of novelty and inventive step based on documents D6, D7, D10 and D12 as well as on the basis of the EP-A-0 436 372, a document which had already been submitted at the first instance oral proceedings without, however, having been considered by the Opposition Division.

- (e) At the oral proceedings the Respondent agreed to a remittal of the case to the first instance after a decision by the Board only on the issues of Article 123(2) and (3) EPC.

VII. The Appellant requested that the decision under appeal be set aside and that the case be remitted to the first instance for further prosecution.

The Respondent requested that the appeal be dismissed.

Reasons for the Decision

1. The appeal is admissible.

Main request

2. *Article 123(2) and (3) EPC*

- 2.1 In the Board's judgment, the requirements of Article 123(2) EPC are met for the following reasons (all citations refer to the original disclosure as contained in the EP-A-document):

- 2.1.1 The feature "container for a sanitary article" is supported by original Claim 1.

- 2.1.2 The feature "consisting of a material containing a shaped or laminated resin" is supported by page 13, lines 7 to 8.

- 2.1.3 The feature "homopolymer of dimethyl-tetracyclo [4,4,0,1^{2.5},1^{7.10}]-3-dodecene, methyloxycarbonyltetracyclo [4,4,0,1^{2.5},1^{7.10}]-3-dodecene or ethylidene-tetracyclo [4,4,0,1^{2.5},1^{7.10}]-3-dodecene" is supported by the statements in the description (page 5, lines 23 to 24; page 6, lines 35 to 40; page 8, last formula; page 9, first formula, page 10, fourth formula).

The statement on page 5, lines 23 to 24: "Examples of the compound to be the polymeric component of the cyclic resin used as a container material ..." (emphasis by the Board) unambiguously relates to a "polymeric component" comprising no other units than those of the compounds listed thereafter, i.e. to homopolymers.

Since the three tetracyclododecene compounds specified in Claim 1 are comprised by the list of compounds following this statement, these homopolymers are within the original disclosure of the patent in suit.

- 2.1.4 The optional feature "wherein the resin may be a mixture with at least one member selected from the group consisting of olefinic resins and synthetic rubbers, the resin being present in a proportion of at least 30 weight %" is based on original Claim 11 and page 12, lines 16 to 20.
- 2.1.5 The feature that "the resin has a bromine number of at most 1 and a softening point of at least 130°C" is based on Claims 6 and 7, page 5, lines 8 to 9 as well as on page 11, lines 24 to 27.
- 2.1.6 Dependent Claims 2 and 3 correspond to granted Claims 8 and 9.
- 2.2 Since the scope of Claim 1 of the main request is much narrower than that of its granted version, the requirement of Article 123(3) EPC is also met.
- 3. In view of differences between the subject-matter underlying the decision under appeal and that of present Claim 1, the novelty objection on the basis of D10 raised in the decision under appeal (Reasons 4) is not applicable to the present subject-matter.

Moreover, that objection was inconclusive even with regard to the subject-matter then claimed because D10 does not disclose homopolymers from tetracyclododecenes but polymers comprising recurring units of a different

ring structure (formulae [I] and [II] in Claim 1; page 3, line 56 to page 4, line 23, including formulae [A] and [B]) which optionally may comprise units derived from certain tetracyclododecenes (not comprising the specifically substituted tetracyclododecenes of present Claim 1: page 4, line 56 to page 5, line 15, formula [E]).

4. In its submission dated 28 May 2003 the Respondent contested the novelty of the claimed subject-matter on the basis of document D12, which has not been considered in the decision under appeal for that purpose, and on the basis of the newly submitted EP-A-0 436 372 (cf. section VI (d) above), both of which appear to be relevant for the issues of novelty and/or inventive step.
5. The issue of obviousness was not referred to in the decision under appeal.
6. In view of the situation summarized in sections 3 to 5 above, the examination of the substantive issues amounts to a case which is essentially different from that decided by the Opposition Division.
7. In this situation, in the application of its power under Article 111(1) EPC, the Board decides to remit the case to the first instance.

Order

For these reasons it is decided that:

1. The decision under appeal is set aside.
2. The main request meets the requirements of Article 123(2) and (3) EPC.
3. The case is remitted to the first instance for further prosecution.

The Registrar

The Chairman

E. Görgmaier

R. Young