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D E C I S I O N
of 14 June 2005

Case Number: T 1182/01 - 3.3.3

Application Number: 93113458.9

Publication Number: 0584771

IPC: C08F 20/04

Language of the proceedings: EN

Title of invention:

Easy to disperse polycarboxylic acid thickeners

Patentee:

Noveon IP Holdings Corp.

Opponent:

BASF Aktiengesellschaft, Ludwigshafen

Headword:

-

Relevant legal provisions:

EPC Art. 111(1), 114(2)

Keyword:

"Late-filed documents - admissibility"

"Abuse of procedure (no)"

"Apportionment of costs (no)"

Decisions cited:

T 0117/86, T 1019/92, T 0223/95

Catchword:

-



Case Number: T 1182/01 - 3.3.3

D E C I S I O N
of the Technical Board of Appeal 3.3.3
of 14 June 2005

Appellant: BASF Aktiengesellschaft, Ludwigshafen
(Opponent) -Patentabteilung - C6-
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Representative: -

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Decision under appeal: Decision of the Opposition Division of the
European Patent Office dated 16 May 2001 and
posted 23 August 2001 rejecting the opposition
filed against European patent No. 0584771
pursuant to Article 102(2) EPC.

Composition of the Board:

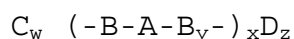
Chairman: R. Young
Members: C. Idez
H. Preglau

Summary of Facts and Submissions

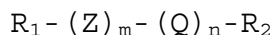
I. The grant of the European patent No. 0 584 771 in the name of The B.F. Goodrich Company (later Noveon IP Holdings Corp.) in respect of European patent application No. 93 113 458.9 filed on 24 August 1993 and claiming priority of the US patent application No. 935616 filed on 26 August 1992 was announced on 29 December 1997 (Bulletin 1997/52) on the basis of 35 claims.

Independent Claims 1 and 20 read, respectively, as follows:

"1. An interpolymer of
(1) at least one olefinically unsaturated carboxylic acid or anhydride containing at least one activated carbon-to-carbon olefinic double bond and at least one carboxyl group, in an amount of at least 15% by weight based upon the weight of the interpolymer, and
(2) 0.001 to 20% by weight based upon the weight of said carboxylic acid or said anhydride of at least one steric stabilizer having at least one hydrophilic moiety and at least one hydrophobic moiety, selected from the group consisting of
- linear block copolymeric steric stabilizers, having a hydrophobic moiety having a length of more than 5 nm (50 Angstroms) (as calculated by the Law of Cosines) and being defined by the following formula:



wherein A is a hydrophilic moiety having a solubility in water at 25°C of 1% or greater, a molecular weight of from 200 to 50,000, and selected to be covalently bonded to B;
B is a hydrophobic moiety having a molecular weight of from 300 to 60,000, a solubility of less than 1% in water at 25°C, capable of being covalently bonded to A;
C and D are terminating groups which can be A or B, can be the same or different groups,
w is 0 or 1;
x is an integer of 1 or more,
y is 0 or 1, and
z is 0 or 1,
- random copolymeric comb steric stabilizers, being defined by the following formula:

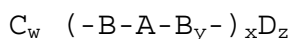


where R_1 and R_2 are terminating groups and may be the same or different and will be different from Z and Q,
Z is a hydrophobic moiety having a solubility of less than 1% in water at 25°C,
Q is a hydrophilic moiety, having a solubility of more than 1% in water at 25°C, and
m and n are integers of 1 or more, and are selected such that the molecular weight is from 100 to 250,000, and
- mixtures thereof.

20. A method of interpolymerizing at least one olefinically unsaturated carboxylic acid or anhydride monomer containing at least one

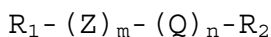
activated carbon-to-carbon olefinic double bond and at least one carboxyl group, and 0.001 to 20 weight percent, based upon the weight of said carboxylic acid or said anhydride, of at least steric stabilizer having at least one hydrophilic moiety and at least one hydrophobic moiety and selected from the group consisting of:

- linear block copolymeric steric stabilizers having a hydrophobic moiety having a length of more than 5 nm (50 Angstroms) (as calculated by the Law of Cosines) and being defined by the following formula:



wherein A is a hydrophilic moiety having a solubility in water at 25°C of 1% or greater, a molecular weight of from 200 to 50,000, and selected to be covalently bonded to B; B is a hydrophobic moiety having a molecular weight of from 300 to 60,000, a solubility of less than 1% in water at 25°C, capable of being covalently bonded to A; C and D are terminating groups which can be A or B, can be the same or different groups, w is 0 or 1; x is an integer of 1 or more, y is 0 or 1, and z is 0 or 1,

- random copolymeric comb steric stabilizers being defined by the following formula:



where R_1 and R_2 are terminating groups and may be the same or different and will be different from Z and Q,

Z is a hydrophobic moiety having a solubility of less than 1% in water at 25°C,

Q is a hydrophilic moiety, having a solubility of more than 1% in water at 25°C, and

m and n are integers of 1 or more, and are selected such that the molecular weight is from 100 to 250,000 and mixtures thereof,

in an organic media consisting essentially of organic liquids, in the presence of free radical forming catalysts, wherein said carboxylic acid or anhydride is present in an amount of at least 15% by weight based upon the weight of the interpolymer."

- II. On 24 September 1998 a Notice of Opposition was filed by BASF AG in which revocation of the patent in its entirety was requested on the grounds of lack of novelty and lack of inventive step (Article 100(a) EPC) and insufficiency of disclosure (Article 100(b) EPC).

These objections were supported, *inter alia*, by the following documents:

D1: EP-A-0 297 184;

D2: EP-B-0 178 127; and

D3: EP-A-0 126 528.

- III. By a decision announced orally on 16 May 2001 and issued in writing on 23 August 2001, the Opposition Division rejected the opposition.

IV. In its decision, the Opposition Division held that the requirements of Article 83 EPC were met, since the skilled person following the information given in the examples of the patent in suit patent in suit, and perhaps making a few routine experiments should have found the appropriate amounts of starting monomers in order to carry out the process of Claim 20.

Before dealing with the further objections of lack of novelty and lack of inventive step, the Opposition Division held that the term "interpolymer" used in the claims should be interpreted as referring to any association of a carboxylic acid polymer and a steric stabilizing surfactant. It further held that it was clear from the wording of Claim 1 that the interpolymer must contain at least 15% by weight of a carboxylic acid or anhydride, and that a polymer comprising only the salt of a carboxylic acid would not meet the former requirement and would not be within the scope of Claim 1 of the patent in suit.

Concerning novelty, the Opposition Division stated that none of the documents D1, D2 (even taking the reference in D2 to Example 3 of document EP-A-0 077 618 (referred to below as D12) into consideration) and D3 disclosed an interpolymer containing at least 15% by weight of a carboxylic acid or anhydride and an amount of steric stabilizer of 0.001 to 20% by weight based on the weight of said carboxylic acid or said anhydride.

Concerning inventive step, the Opposition Division stated that, as disclosed in the patent in suit, thickeners on the basis of olefinically unsaturated carboxylic acid or anhydrides obtained via

solution/precipitation were known in the art. Starting from this prior art, the technical problem was seen as to provide a polymer which was easy to disperse and yielded lower dispersion viscosities combined with increased thickening properties.

According to the decision of the Opposition Division, documents D1 to D3 were concerned with a technical problem unrelated with the one underlying the opposed patent, so that they could neither serve as a valid starting point nor render obvious the subject-matter of the patent.

- V. A Notice of Appeal was filed on 31 October 2001 by the Appellant (Opponent). The prescribed fee was paid on the same day.

With the Statement of Grounds of Appeal filed on 21 December 2001, the Appellant submitted the following documents:

- D4: EP-A-0 333 499;
- D5: US-A-4 419 502;
- D6: EP-A-0 412 388;
- D7: US-A-4 529 773;
- D8: EP-A-0 522 467;
- D9: EP-A-0 151 467;
- D10: EP-A-0 172 025;
- D11: US-A-4 892 916, and
- D12: EP-A-0 077 618.

It also argued essentially as follows

(i) Concerning novelty:

(i.1) The term "carboxylic acid" used in the patent in suit should be interpreted as encompassing free carboxylic acid and salts thereof.

(i.2) The amount of steric stabilizer should be calculated on the total amount of carboxylic acid in interpolymer, i.e. the amount of free and neutralized acid and was independent on the amount of free acid in the interpolymer.

(i.3) Thus, D1, D2 and D3 destroyed the novelty of the subject-matter of the patent in suit.

(i.4) Even if one would consider that the term "carboxylic acid" referred only to free carboxylic acid, documents D2 and D3 would also be a novelty destroying documents.

(i.5) Documents D4 to D11 were also novelty destroying for the subject-matter of the patent in suit, since they disclosed either a composition comprising a polymer of an unsaturated carboxylic acid with an emulsifier falling under the definition of the steric stabilizer according to the patent in suit (D4, D5, D6, D8, and D10) or a copolymer of an unsaturated carboxylic acid with a comonomer falling under the definition of the steric stabilizer (D7, D9 and D11).

(ii) Concerning inventive step:

(ii.1) Contrary to the submissions of the Opposition Division, D3 would represent the closest state of the art.

(ii.3) According to the decision of the Opposition Division, the technical problem to be solved by the patent in suit was to provide thickeners which were easy to disperse and which exhibited good thickening properties.

(ii.4) The solution proposed in the patent in suit was to prepare an interpolymer according to Claim 1 in non neutralized form. This polymer could be easily dispersed in water with the other components of the dispersion, and could, after addition of a base, thicken the mixture.

(ii.5) The technical problem solved by D3 was to provide polymers which were easy to disperse and which could be used as thickener.

(ii.6) The skilled person would determine which amount of free carboxylic groups would be necessary to obtain a good thickening effect after the addition of a base.

(ii.7) Furthermore, D10 clearly taught to add the base after the mixture of the thickener with the other components of the dispersion had been completed.

(ii.8) Thus, the subject-matter of the patent in suit would lack inventive in view of D3 alone or in view of the combination of D3 with D10.

(ii.9) D4 could also be taken as the closest state of the art, since it disclosed polymers exhibiting all the features set out in Claim 1 in terms of amount of unsaturated carboxylic acid in the interpolymer, type of steric stabilizer and amount thereof.

(ii.10) D4 alone or in combination with D10 would render the claimed subject-matter obvious.

VI. In its letter dated 11 September 2002, the Respondent (Patent Proprietor) argued essentially as follows:

(i) By submitting the new documents, the Appellant had filed a new opposition.

(ii) No reasons had been submitted by the Appellant for the late submission of these documents.

(iii) These documents could have been filed within the opposition time limit. Their unsubstantiated late filing 39 months after the time limit for filing the opposition amounted to a procedural abuse.

The Respondent thus requested remittal of the case back to the first instance, and apportionment of 100% of the costs involved on the side of the Respondent which occurred in conjunction with the late filing of these documents.

VII. In its letter dated 8 October 2002, the Appellant argued essentially as follows:

(i) Documents D4 to D10 were introduced as a reaction to the decision of the Opposition Division, to consider the subject matter of the patent in suit as novel and inventive over D1 to D3.

(ii) Documents D4 to D10 were *prima facie* relevant for the patentability of the patent in suit.

(iii) The Patentee had not taken position on the relevance of the new documents. He had not submitted further arguments why these documents should be considered as late.

(iv) Thus, the requests of the Patentee for remittal and apportionment of costs should be dismissed.

VIII. The submissions of the Respondent in its letter dated 10 June 2003 might be summarized as follows:

(i) There was no obligation to indicate reasons why the submissions of the numerous new prior art by the Appellant should be considered as late.

(ii) The opposition procedure had not been conducted by the Appellant with the necessary diligence.

(iii) These late submissions represented an abuse of the proceedings.

IX. With its letter dated 21 June 2004, the Respondent filed 6 auxiliary requests. It also submitted an experimental report and a document referred to as

D13: Morrison and Boyd, "Organic Chemistry", 3rd Edition, July 1976; page 579.

It also argued essentially as follows:

(i) As shown in D13, carboxylic acid were defined by the structural element -COOH. Thus, salts of carboxylic acids should be distinguished from carboxylic acids.

(ii) It thus followed that the amount of stabilizer was dependent on the amount of olefinic unsaturated acid or anhydride.

(iii) Concerning documents D1 to D3:

(iii.1) D1, D2 and D3 disclosed polymers containing the carboxylic acid in neutralized form.

(iii.2) The polymers according to D1 to D3 had been obtained according to the reverse phase emulsion. This process required that the carboxylic groups were neutralized.

(iii.3) No evidence had been provided by the Appellant that producing a polymer according to D1, D2 and D3 directly and unavoidably led to a polymer having the amount of carboxylic acid groups as required in the patent in suit.

(iii.4) Thus, the claimed polymer was novel over D1 to D3.

(iii.5) Claim 1 of the first auxiliary request was drafted in a product-by-process form. This further underlined that the carboxylic acid was not in neutralized form and was polymerized in an organic medium. The subject-matter of Claim 1 was thus clearly distinguished from the cited prior art.

(iii.6) The person skilled in the art would have no motivation from D1 to D3 to solve the problem of providing an easy to disperse, easy to handle well thickening polymer as proposed by the patent in suit.

(iii.6.1) D1 was concerned by ionic polymers, in which the acid groups had been neutralized.

(iii.6.2) D2 was not directed to the provision of thickeners.

(iii.6.3) D3 related to dispersion of water swellable polymers in a water immiscible liquid with reduced amounts of emulsifiers. It did not belong to the same technical field as the patent in suit.

(iv) Concerning the auxiliary requests 2 to 6

(iv.1) In Claims 1 of the 2nd and 3rd auxiliary requests the definition of the block copolymer steric stabilizer had been limited to a BAB block copolymer and the interpolymer further comprised a polyether crosslinking agent.

(iv.2) Claims of the 4th auxiliary request corresponded to method claims 20 to 35 as granted. Claims of the 5th auxiliary request corresponded to method claims 18 to 32 of the 2nd auxiliary request. Claims of the 6th auxiliary request corresponded to method claims 17 to 30 of the 3rd auxiliary request.

(iv.3) Documents D1 to D4, and D6, D7, D9 to D12 did not disclose a polyether crosslinking agent.

(iv.4) D5 to D9 and D11 and D12 were silent on the presence of a BAB stabilizer.

(iv.5) D1 to D3 and D6 to D12 related to reversed phase polymerization. Thus, the carboxylic acid groups of the polymer would be neutralized.

(iv.6) Thus, the subject-matter of these auxiliary requests was novel over the cited prior art.

(iv.7) Concerning inventive step:

(iv.7.1) References D6 to D11 were not more relevant than D1 to D3.

(iv.7.2) It had been further shown by the examples of the patent in suit that the use of the specific BAB steric stabilizer led to an improved balance between unneutralized dispersion viscosity and neutralized dispersion viscosity.

(iv.7.3) The experimental report showed that the use of a polyether crosslinking agent instead of those disclosed in D4 led to better ability to build

viscosity, better salt sensitivity, and better dispersability. It also showed that the use of BAB block copolymers instead of AB polymers disclosed in D5 led to lower dispersion viscosity with comparable dispersion times.

- X. Oral proceedings before the board were held on 14 June 2005.

At the oral proceedings the discussion focussed on (i) the question as to whether there was a justification for the late filing of the documents D4 to D11, and (ii) on the question of the admission of documents D4 to D11 into the proceedings.

The arguments presented by the Parties concerning these points may be summarized as follows:

Concerning point (i):

(i.1) By the Appellant:

(i.1.1) In view of their high relevance, documents D4 to D11 should be not considered as late filed.

(i.1.2) In view of page 4, lines 45 to 46 of the patent in suit which stated that "the carboxylic monomers are the olefinically-unsaturated carboxylic acids containing at least one activated carbon-to-carbon olefinic double bond, and at least one carboxyl group; that is, an acid or function readily converted to an acid containing an olefinic double bond", it was the Opponent's view that the term "carboxylic acid" would also encompass the salts thereof.

(i.1.3) On that basis, there had been no reason for the Appellant to submit further documents in addition to D1 to D3, since, in the Appellant's view, these documents were clearly novelty destroying for the claimed subject-matter.

(i.1.4) The Appellant was hence surprised by the restrictive interpretation given by the Opposition Division to the term "carboxylic acid", i.e. referring only to free acid.

(i.1.5) The Appellant was further surprised by the interpretation given by the Opposition Division to document D2, according to which the acrylic acid was neutralized before polymerization.

(i.1.6) For these reasons a new search had become necessary and documents D4 to D11 must be seen as a reaction to the interpretations made by the Opposition Division of the term "carboxylic acid" and of document D2.

(i.1.7) According to the decision under appeal, documents D1 to D3 referred to reverse phase emulsion polymerization while, according to the patent in suit, the polymers had been obtained by a solution/precipitation polymerization.

(i.1.8) Documents D4 to D11 had been cited to show that polymers according to the patent suit were known in the art and have been prepared by a process other than reverse phase emulsion polymerization. They further showed that monomers with free acid groups could be

used in that latter process and that interpolymers prepared by this process and falling under the scope of the patent in suit were known in the art.

(i.2) By the Respondent:

(i.2.1) From page 4, line 53 of the patent in suit it was evident that the term carboxylic acid referred to the free acid and anhydride thereof.

(i.2.2) In view of the teaching of the patent in suit, it was further clear that the salts of the carboxylic were not encompassed by the term "carboxylic acid", since the claimed polymers needed to be neutralized when used as thickeners, i.e. their thickening activity was linked to their possibility to be neutralized.

(i.2.3) Thus, there was no justification for the late filing of documents D4 to D11, which could indeed have been cited during the opposition period.

Concerning point (ii):

(ii.1) While relying essentially on its written submissions, the Appellant made the following additional statements:

(ii.1.1) Documents D4 and D5 disclosed the preparation of an interpolymer by a solution polymerization process.

(ii.1.2) It was clear that the pertinence of documents D4 and D5 had been recognized by the Patentee in view of its submissions made in its letter dated 21 June 2004.

(ii.1.3) Example 3 of D4 was particularly pertinent. It was contested that the process used in this example was a reverse phase emulsion polymerization. In any case, Claim 1 of the patent in suit was directed to a polymer *per se*.

(ii.1.4) Documents D7 and D11 disclosed the use of interpolymers of (meth)acrylic acid with a stabilizer of type AB as thickeners. The thickening effect was achieved by neutralization of the free acid groups.

(ii.1.5) D9 disclosed the manufacture of an interpolymer of unsaturated carboxylic acid with a stabilizer of type AB. They could be obtained by solution polymerization. The thickening activity of the interpolymers of D9 was achieved by the neutralization of the free acid groups of the interpolymer.

(ii.1.6) In Example 2 of D10, the acrylic acid was not completely neutralized. The amount of AB stabilizer in this example corresponded to the amount of stabilizer required by the patent in suit.

(ii.2) The Respondent indicated that it had no comments to make on documents D5, D7, D9, and D11 and made, in substance, the following submissions concerning the further documents:

(ii.2.1) In Example 3 of D4 the polymer was obtained by the reverse phase emulsion polymerization.

(ii.2.2) Reverse phase emulsion polymerization was also used in the preparation of the copolymers disclosed in

documents D6, D8 and D10. This process required the neutralization of the acid groups. This was also evident from the examples of D6, D8, and D10.

(ii.2.3) The amount of stabilizer in Example 2 of D10 was well above the amount required by the patent in suit.

XI. The Appellant requested that the decision under appeal be set aside and that the European patent No. 584 771 be revoked, that the request of the respondent for an apportionment of costs should be rejected and that the Board should decide on the outstanding issues without remittal to the first instance.

The Respondent requested that the appeal be dismissed or in the alternative that the patent be maintained on the basis of one of the six auxiliary requests, filed with the letter dated 21 June 2004 or that the case be remitted back to the first instance for further prosecution. Further the Respondent requested that 100% of the costs involved on the side of the patentee and his representative which occurred in conjunction with the late submissions of documents be apportioned.

Reasons for the Decision

1. The appeal is admissible.
2. *Admissibility of documents D4 to D11 into the proceedings*

- 2.1 As stated in decision T 117/86 (OJ EPO 1989, 401) facts and evidence in support of an opposition which are presented after the nine-month period has expired are out of time and late, and may or may not be admitted into the proceedings as a matter of discretion under Article 114(2) EPC.
- 2.2 Since the grant of the European Patent EP 0 584 771 was announced on the 29 December 1997, the nine-month period ended on the 29 September 1998.
- 2.3 As indicated above in paragraph V, documents D4 to D11 were submitted by the Appellant with the Statement of Grounds of Appeal, i.e. on the 21 December 2001.
- 2.4 It thus follows that documents D4 to D11 must be regarded as late filed.
- 2.5 Although it is the established case law of the boards of appeal, that the main criterion for deciding on the admissibility of a late-filed document is its relevance, i.e. its evidential weight in relation to other documents already in the case, further considerations which can play a decisive role in the question of admittance of late filed evidence are the degree of lateness and whether the late filing can be seen as representing an abuse of the proceedings (cf. T 1019/92 of 9 June 1994; not published in OJ EPO, Reasons, point 2.2).
- 2.6 In the present case, the issue of admissibility of documents D4 to D11 into the proceedings, hence, boils down to the following questions:

(i) as to whether their late filing of documents D4 to D11 by the Appellant is to be seen, as argued by the Respondent, as representing an abuse of proceedings,

and, if question (i) is negatively answered,

(ii) as to whether the relevance of documents D4 to D11 is *prima facie* such to justify their introduction into the proceedings.

- 2.6.1 In the present case, the Opposition Division has, in substance, considered in its decision that none of the documents D1 to D3 could challenge the novelty of the claimed subject-matter of the patent in suit, since the Appellant had produced no evidence that the interpolymers disclosed in D1 to D3 contained at least 15% by weight of an unsaturated carboxylic acid or anhydride and an amount of 0.001 to 20% by weight of steric stabilizer based upon the weight said unsaturated carboxylic acid or anhydride.
- 2.6.2 This statement of the Opposition Division was based on the assumption that the amount of unsaturated carboxylic acid in the interpolymer and the amount of steric stabilizer were to be calculated on the basis of the amount of unsaturated carboxylic acid in the free acid form.
- 2.6.3 When trying to justify the late filing of documents D4 to D11, the Appellant has submitted (Section X. (i.1.4), and (i.1.5) above) that it had been surprised not only by this restrictive interpretation of the term "unsaturated carboxylic acid" made by the Opposition

Division but also by the interpretation of document D2 by the Opposition Division.

2.6.4 According to the Appellant, it was clear in view of the disclosure of the patent in suit at page 4, lines 45 to 47, that salts of the unsaturated carboxylic acids fell under the definition of "unsaturated carboxylic acid" according to the patent in suit. As a consequence of this interpretation, it was of the opinion that documents D1 to D3 were clearly novelty destroying, so that no need was seen to file further documents in addition to documents D1 to D3 in order to destroy the novelty of the claimed subject-matter of the patent in suit.

2.6.5 According to the Appellant the filing of the documents D4 to D11 should hence be seen as a reaction to the decision of the Opposition Division based on the restrictive interpretation of the term "unsaturated carboxylic acid" and as a reaction to the interpretation by the Opposition Division of document D2 in order to improve its position with respect to the issue of novelty. It further pointed out that the filing of these documents had taken place at the earliest possible moment, namely with the filing of the Statement of Grounds of Appeal.

2.6.6 Consequently, in the Appellant's view, the filing of these documents in the appeal proceedings could not be considered as amounting to an abuse of procedure.

2.6.7 In this connection, it is evident, in the Board's view, that the main argument of the Appellant for justifying the late filing of the documents D4 to D11 is based on

the, in the Appellant's view, restrictive interpretation of the wording "carboxylic acid" by the Opposition Division.

2.6.8 In that respect, it is, in the Board's view, not unthinkable that the statement on page 4, lines 45 to 47 of the patent in suit according to which "the carboxylic monomers are the olefinically-unsaturated carboxylic acids containing at least one activated carbon-to-carbon olefinic double bond, and at least one carboxyl group; **that is, an acid or function readily converted to an acid** containing an olefinic double bond" (emphasis by the Board), might have led the Appellant to consider that salts of the unsaturated acid could be encompassed by the term "unsaturated carboxylic acid".

2.6.9 Nevertheless, the Board notes that in the communication of the Opposition Division dated 18 April 2000 annexed to the summons to the oral proceedings scheduled to take place on 16 May 2001 before the Opposition Division, (cf. paragraph 7.2 thereof), the Opposition Division, when assessing the novelty of Claim 1 of the patent in suit over Examples 1 to 3 of D1 made an unambiguous distinction between acrylic acid in free acid form and acrylic acid in neutralized (i.e. salt) form in that respect.

2.6.10 Thus, in the Board's view, the Appellant was made aware of the "restrictive" interpretation of the term "carboxylic acid" by the Opposition Division more than one year before the date of the oral proceedings.

2.6.11 The same is also true for the interpretation of document D2 by the Opposition Division, since the Opposition Division, in the above mentioned communication, clearly presented the reasons why, in its provisional view, document D2 could not be considered as novelty destroying for the subject-matter of Claim 1 of the patent in suit (cf. paragraph 7.3, thereof).

2.6.12 It thus follows, that under these circumstances, the Appellant could, as a precautionary measure, have carried out a further search in order to take the respective statements of the Opposition Division into account. In that respect, the Board further observes that enough time was at the disposal of the Appellant for doing so (i.e. more than 10 months), since the final date for filing written submissions before the oral proceedings was set to be 16 March 2001 by the Opposition Division.

2.6.13 However, there is, in the Board's view, no suggestion, even if documents D6 and D8 originate from the Appellant itself and even if document D5 was cited in the description of the prior art in the patent in suit (page 2, line 28 thereof), that there was a deliberate decision of the Appellant for tactical reasons not to cite documents D4 to D11 at that time (cf. T 1019/92; Catchword II).

2.6.14 Thus, the Board can only consider that the Appellant, through inadvertence, did not realize at that time the possible consequences of not taking into consideration the statements made by the Opposition Division in its communication annexed to the summons to oral

proceedings on the issue of the opposition procedure before the Opposition Division, and consequently did not carry out an additional search at that time.

2.6.15 It thus follows that the filing of the documents D4 to D11 by the Appellant with its Statements of Grounds of Appeal, is to be seen, in the Board's view, as an attempt to smooth out, as quickly as possible, its previous inadvertence, but in no case as representing an abuse of proceedings.

2.6.16 Consequently, question (i) above must be answered negatively. It remains to be decided whether a positive answer can be given to question (ii).

2.6.17 A positive answer to question (ii) presupposes at least that documents D4 to D11 are *prima facie* more relevant than the documents D1 to D3 filed during the nine-month opposition period.

2.6.18 As indicated in paragraph 2.6.2 above, the amount of carboxylic acid in the interpolymer and the amount of steric stabilizer were considered as based upon the weight of carboxylic acid in free acid form in the decision under appeal. This implies that the acknowledgment of novelty of the claimed subject over D1 to D3 resulted, in the view of the Opposition Division, from the fact that these documents failed to disclose interpolymers containing carboxylic acid in the free acid form and a steric stabilizer. In that respect, it was, in particular, pointed out in the decision under appeal, that D1 to D3 all related to reverse phase emulsion polymerization, and that in D1 (Examples 1 to 3), in D2 (page 5, lines 36 to 38) and

in D3 (Examples 2 to 6) the unsaturated carboxylic acid monomer used (i.e. acrylic acid) was neutralized.

2.6.19 It can thus be derived from the decision under appeal that, according to the Opposition Division, the weakness of documents D1 to D3 resided in their lack of disclosure of the combination of an interpolymer of carboxylic acid monomer in free acid form with the steric stabilizer according to the patent in suit.

2.6.20 It thus follows from these considerations, that, in the Board's view, the question of a greater relevance of documents D4 to D11 is to be dealt with in the context, which led to their late filing. This logically implies that the Board leaves deliberately open the question as to whether the term "unsaturated carboxylic acid" used in the patent in suit is to be interpreted as including or not salts thereof, and the question of the interpretation of document D2.

2.6.21 This has for its consequence, in the Board's view, that the late filed documents could only be regarded *prima facie* as more relevant than the documents considered by the Opposition Division, if it were immediately apparent that they contained an indication of interpolymers containing carboxylic acid in the free acid form and a steric stabilizer. This, however, implies, in view of the contradictory submissions of the Parties concerning the necessity of a neutralization step when interpolymers of unsaturated carboxylic acids are made by a reverse phase emulsion polymerization, that documents generally referring to the use of unsaturated carboxylic acid monomers as starting components in a process using a reverse phase

emulsion polymerization for the preparation of an interpolymer with a steric stabilizer but not containing an immediately apparent indication of a final interpolymer having free carboxylic acid groups, cannot, in the Board's view, be considered *prima facie* as more relevant than the documents which have been cited during the nine-month opposition period.

2.6.22 In this connection, it is immediately apparent that documents D4 (cf. in particular Examples 1, 3; column 3, line 22 to column 5, line 31), D5 (cf. in particular Claims 1 to 4; Examples I and II), D7 (cf. in particular column 2, lines 5 to 67; Example 1), D9 (cf. in particular Claims 1 to 2; Table II, tests 26, 32, and 33), and D11 (cf. in particular Claims 1 to 3; Table 1a, Polymer K) contain an indication of an interpolymer containing free acid groups and a steric stabilizer, so that they appear as being *prima facie* more relevant than the documents considered by the Opposition Division.

2.6.23 The same conclusion applies to document D10, since although relating like documents D6 and D8 to the manufacture of interpolymers by reverse phase emulsion polymerization, D10, in contrast to D6 and D8, contains an immediately apparent indication (cf. Example 2 thereof) of an interpolymer of acrylic acid having free acid groups.

2.6.24 The Board, however, refrains from going into the merits of the Parties's arguments relating to the interpretation of the documents D4, D5, D7 and D9 to D11 (cf. points VI, IX and X above), since this might

risk prejudicing the first instance consideration which is ordered below.

2.6.25 Nevertheless, for the reasons indicated above in paragraphs 2.6.22 and 2.6.23, the Board comes to the conclusion that documents D4, D5, D7, D9, D10 and D11 are *prima facie* sufficiently relevant to be introduced into the proceedings.

3. *Remittal*

Taking into consideration that the introduction of documents D4, D5, D7, D9, D0 and D11 amounts to a fresh case against the patent in suit, and having regard to the request of the Respondent for remittal to the first instance, the Board considers it appropriate to make use of its discretionary powers under Article 111(1) EPC and to remit the case to first instance for further prosecution (see T 223/95 of 4 March 1997, not published in the OJ EPO, Reasons point 5).

4. *Apportionment of costs*

4.1 According to the board of appeal case law, if a party introduces important facts or evidence at a late stage of proceedings, without cogent reasons for the delay, this might be taken into account in the apportionment of costs (cf. Case Law of the Boards of Appeal of the European Patent Office, 4th Edition, 2001, point VI.F.8; pages 336 to 337).

- 4.2 In this connection it is evident that the Appellant's conduct (cf. points 2.6.9 to 2.6.14) which led to the delayed filing of the documents D4 to D11 might be taken into account in the apportionment of costs.
- 4.3 In the present case the Board's decision to remit the case immediately to the department of first instance means that the Respondent has not incurred any undue cost burden in relation to the present appeal. Accordingly the Board does not see any reason of equity to order a different apportionment of costs in relation to these proceedings. The question of costs in subsequent proceedings before the Opposition Division and possible further appeal proceedings is left for consideration by the Opposition Division and Board of Appeal concerned (cf. also T 223/95; Reasons point 7).
- 4.4 Consequently, the Board refuses the request of the Respondent for apportionment of costs so that all issues of costs can be dealt with at the most appropriate time, i.e. when the Opposition Division has heard and decided the remitted case.

Order

For these reasons it is decided that:

1. The decision under appeal is set aside.
2. The case is remitted to the first instance for further prosecution on the basis of the main request of the Respondent.
3. The request for apportionment of costs is refused.

The Registrar:

The Chairman:

E. Görgmaier

R. Young