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D E C I S I O N
of 1 February 2005

Case Number: T 0064/03 - 3.3.3

Application Number: 96906946.7

Publication Number: 0818506

IPC: C08L 27/18

Language of the proceedings: EN

Title of invention:

Aqueous polytetrafluoroethylene dispersion composition and use thereof

Patentee:

DAIKIN INDUSTRIES, LIMITED

Opponent:

AUSIMONT S.p.A.
Dyneon LLC

Headword:

Polytetrafluoroethylene dispersions/DAIKIN

Relevant legal provisions:

EPC Art. 69(1), 83, 84, 100(b), 113(1), 114((2), 123(2), 123(3)

Keyword:

"New ground raised for first time during oral proceedings - opportunity to comment - (no)"
"Distinction between relevance and merit of new ground"
"'Telescoped' - no separate decision announced"
"Claims - clarity (no)"
"Request that Opposition Division be ordered to restrict considerations to facts and evidence already on file - inadmissible"

Decisions cited:

G 0009/91, G 0010/91, T 0156/84, T 0326/87, T 0383/88,
T 0484/89, T 1002/92, T 0433/93, T 0817/93, T 1129/97,
T 1164/00, T 1075/01

Catchword:

-



Case Number: T 0064/03 - 3.3.3

D E C I S I O N
of the Technical Board of Appeal 3.3.3
of 1 February 2005

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Decision under appeal: Decision of the Opposition Division of the
European Patent Office posted 14 November 2002
revoking European patent No. 0818506 pursuant
to Article 102(1) EPC.

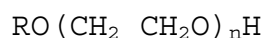
Composition of the Board:

Chairman: R. J. Young
Members: M. C. Gordon
H. Preglau

Summary of Facts and Submissions

- I. Mention of the grant of European patent No. 0 818 506 in respect of European patent application No. 96906946.7 in the name of Daikin Industries, Limited, was announced on 31 May 2005 on the basis of 5 claims. Claim 1 read as follows:

"An aqueous polytetrafluoroethylene dispersion composition characterized in that the composition comprises 30 to 65 wt. % of polytetrafluoroethylene and a polyoxyethylene alkyl ether in an amount of 2 to 10 wt. % based on the polytetrafluoroethylene, the polyoxyethylene alkyl ether being represented by the formula



wherein R is a saturated or unsaturated hydrocarbon group having 8 to 18 carbon atoms, and n is 5 to 18, having a cloud point of over 45 °C to not higher than 85 °C and containing 65 to 70 wt. % of ethylene oxide in the molecule."

The granted claims further contained an independent claim 3 directed to an article prepared by coating a base material with the composition of claim 1, an independent claim 4 directed to a binder for batteries containing the composition of claim 1 and an independent claim 5 directed to a coating composition comprising a dispersion as defined in claim 1 and a pigment. Claim 2 was dependent on claim 1.

II. Notices of Opposition, requesting revocation of the patent in its entirety on the grounds of Article 100(a) EPC were filed on 23 February 2001 by Ausimont S.p.A (Opponent I) and on 27 February 2001 by Dyneon LLC (Opponent II).

III. The oppositions cited *inter alia* the documents

D1: US-A-3 704 272 (corresponding to JP-B-21532/1977);

D8: "Nonionic Surfactants", M.J. Schick (Ed.);
Dekker, New York, 1967, pp. 72-85, 102-125,
138-141, 570-583;

D14 consisting of:

D14a: Parant, B., "Index- the Non-Ionic
Surfactants", page 86 (date given by OI as
October 1988);

D14b: Hoechst Datasheet E-HOE 5027 D/E, August
1992 "Genapol X Grades", pages 1-5; and

D14c: Genapol X-080 datasheet (March 1991);

D1 being cited by both Opponents in their notices of Opposition; D8 being cited by OI in the Notice of Opposition and D14a-c being cited by OI in the submission of 28 August 2002.

IV. By its decision announced orally on 29 October 2002 and issued in writing on 14 November 2002 the Opposition Division revoked the patent.

The decision of the Opposition Division was based on a main and an auxiliary set of claims submitted in writing on 28 August 2002 and 25 October 2002 respectively.

Claim 1 of the main request differed from claim 1 as granted by replacement of the term "polyoxyethylene alkyl ether" with "ethoxylated aliphatic alcohol".

Claim 1 of the auxiliary request was further amended by raising the lower limit of ethylene oxide (EO) content to 65.5 wt%.

Claims 2-5 of both requests corresponded to claims 2-5 as granted.

The Opposition Division found that the amendments made met the requirements of Article 123(2) EPC. Contrary to the position taken by Opponent II, the Opposition Division did not consider that the amended term "ethoxylated aliphatic alcohol" was disclosed only in the context of a discussion of the prior art. Further it was not considered that there was any inconsistency between this term and the possibility - explicitly recited in claim 1 - that the substituent group R may contain unsaturation. On the contrary, it was considered that the original wording was open to such an objection. It was held, with reference to page 2 lines 34 and 56 of the patent in suit, that the skilled person knew that these terms were equivalent. It was also held that it became clear from page 3, line 1 of the patent in suit that it was not the intention to encompass surfactants containing aromatic groups. Further it was found that suitable groups R (saturated

and unsaturated) were disclosed at page 3, line 39 and in examples 1-4 of the patent in suit.

The patent in suit was revoked on the grounds that the it did not meet the requirements of Article 83 EPC.

Both Opponents had, independently and with different reasoning, raised this ground at a late stage of the proceedings: Opponent I with letter of 28 August 2002 and Opponent II during the Oral Proceedings before the Opposition Division.

The arguments of Opponent I were disregarded as being late filed and of no relevance.

The Opposition Division took account, however, of the arguments of Opponent II which it found convincing.

These can be summarised as follows:

- the cloud point was an essential feature of the claimed subject matter;
- the patent did not disclose the method or the measurement conditions (concentration, solvent) by which this was to be determined;
- in the case of mixtures of surfactants the patent did not disclose whether the cloud point was determined on the mixture or on the individual surfactants;
- it was known from the prior art, in particular D8 and D14 (especially D14b), that there were many

methods for determining the cloud point, employing different conditions of concentration of solvents, and that these measurements were "appreciably" influenced by the presence of additives; and

- the results could diverge by up to 30°C (based on D14c).

The counter arguments of the Patentee that:

- it was clear from paragraphs [0007] and [0019] of the patent in suit that the method of D1 was that to be employed;
- D1 represented the starting point of the present invention; and
- the method of D1 was the most common one

were not found convincing.

In particular the Opposition Division held that there was no hint or suggestion in the patent in suit that the cloud point should be measured in accordance with the disclosure of D1.

The Patentee requested rejection of the new ground pursuant to Article 114(2) EPC as late filed.

After a break in the Oral Proceedings, the Division asked the Patentee whether the method of D1 corresponded to a standard (ASTM, JIS, DIN), which the Patentee was not able to confirm. Thereupon the

decision revoking the patent on this new ground was announced.

V. On 10 January 2003, the Patentee (Appellant) lodged an appeal against the decision of the Opposition Division and paid the Appeal fee on the same day. Maintenance of the patent on the basis of the claims filed on 28 August 2002 (Section IV above) was requested. As an auxiliary measure, appointment of Oral Proceedings was requested.

VI. The Statement of Grounds of Appeal was submitted on 24 March 2003 together with a copy of European Standard EN 1890 and an experimental report.

The arguments presented by the Appellant in the Statement of Grounds of Appeal which are relevant for this decision may be summarised as follows:

- (i) The ground on which the patent had been revoked had not been raised in the opposition statements of either opponent.
- (ii) The objection of Opponent I under this "fresh" ground, submitted with letter of 28 August 2002 had been deemed belated and irrelevant and hence not admitted.
- (iii) The objection of Opponent II under this "fresh" ground was based on entirely different facts and submitted at an even later stage (one hour into the Oral Proceedings). It had been admitted despite the request of the Appellant to reject it.

The Patentee had been accorded around 25 minutes to consider this.

- (iv) Instead of revoking the patent, the Division should have rejected the fresh ground, or accorded the Appellant sufficient time to explain the technical background.

This was a blatant violation of the principle of due process and justified setting aside the decision.

- (v) The Appellant had explained in the Oral Proceedings before the Opposition Division that the most common method for determining the cloud point of polyoxyethylene alkyl ether surfactants was in a 1% aqueous solution. Opponent I had confirmed this at the Oral Proceedings, however this statement was absent from the minutes.

VII. The arguments presented by Respondent I (Opponent I) in the letter dated 15 October 2003 and Respondent II (Opponent II) in the letter dated 10 September 2003, as far as they are relevant for this decision, may be summarised as follows:

- (a) Respondent I:

- (i) The objection under Article 83 EPC was based on the fact that while the cloud point was stated by the Appellant to be an essential feature, and was necessary to ascertain which components were suitable, no method to determine this was disclosed in the patent

in suit. The evidence of the Appellant showed that there was no reliable way to find out which method needed to be used, so the skilled person would not know how to determine this. It was considered that in such a situation, it was inappropriate to consider that there had been a "blatant violation" of the principle of due process.

- (ii) It was also considered that any attempt to make a comparison between a known method and the values given in the patent was pointless since it was not known which method was employed in the patent.
- (iii) The Appellant had used the time that he considered sufficient for his argumentation, and the time available to him was not limited by the Opposition Division.

(b) Respondent II:

- (iv) The raising of this new ground of opposition was a result of the experimental evidence filed by the Patentee with letter of 25 October 2002, 4 days before the oral proceedings. This evidence established that the correlation between cloud point and ethylene oxide (EO) content for the same compound varied between different manufacturers.
- (v) Prior to this evidence being submitted, the Opponents had assumed and argued that the

cloud point and EO content were directly linked such that one could be inevitably and directly derived from the other. It was the evidence of the Patentee that cast doubts on this assumption, in particular since this showed that there would be a substantial difference between the cloud point of the same compound provided by different suppliers.

VIII. The Board issued, on 16 November 2004, a communication accompanying a summons to attend Oral Proceedings.

- (i) According to the communication, it appeared that the amended claims of 28 August 2002 were not supported by the disclosure of the application as filed, contrary to Article 123(2) EPC. The occurrence of the term "ethoxylated aliphatic alcohol" in paragraph [0004] of the patent appeared to relate to a discussion of the prior art and not to the subject matter of the patent in suit. The original term appeared to be more precise than the amendment. As this was a substantive amendment, it had to be examined for compliance with Article 84 EPC. An inconsistency was seen between the use of the term "aliphatic alcohol" and the definition of R as being a saturated or unsaturated group of non-restricted nature, i.e. this definition included aromatic unsaturation whereas the term "aliphatic alcohol" excluded such species.

Due to this lack of clarity, it furthermore appeared unlikely that the amendment would fulfil

the intended purpose of overcoming an objection of lack of novelty with regard to prior art compositions containing aromatic compounds.

- (ii) With regard to the revocation on the ground of Article 100(b) EPC, it was observed that it was not apparent from the Minutes that any decision to admit the new ground and hence to refuse the request of the Patentee for its exclusion pursuant to Article 114(2) EPC had been separately announced, although it was derivable from the Minutes and the Decision of the Opposition Division that this ground had *de facto* been admitted into the proceedings.

The Parties were informed that the Board would examine whether the objection of the Appellant that the ground pursuant to Article 100(b) had been raised in such manner as to deprive it of a proper opportunity to present comments on this was justified, and that, if the Board concluded this was the case the case would in all likelihood be remitted to the Opposition Division for further prosecution without the Board taking position on the substantive merits of this ground of opposition. With regard to the appropriate procedure to be followed by an Opposition Division in such a situation, the Board cited decision T 433/93 (OJ EPO 1997, 509).

- IX. The Appellant responded in a letter dated 24 December 2004, arguing essentially as follows:

- (i) With regard to Article 123(2), 123(3) and 84 EPC it was submitted that the presentation of the terms "ethoxylated aliphatic alcohol/polyoxyethylene alkyl ether" in paragraph [0004] of the patent and on page 2, line 34 of the application indicated that the term was not a quotation from the prior art but showed that these terms were equivalent. It was acknowledged that according to the original wording the nature of the R group remained unclear. It was submitted that the amended wording "ethoxylated aliphatic alcohol" restricted the R group to an aliphatic group which could include ethylenic unsaturation, but not aromatic saturation. Hence the amended claim was more restricted than granted claim 1.

- (ii) With respect to Article 113(1) EPC, the Appellant requested remittal to the first instance for further prosecution. The arguments as set out in the Statement of Grounds of Appeal were essentially repeated.

- (iii) An auxiliary request for maintenance of the patent on the basis of 5 claims corresponding to those of the granted patent, however with the meaning of substituent R being unsaturated being deleted was proposed. The text of this request was not presented with the letter.

X. Oral proceedings were held before the Board on 1 February 2005.

During the Oral Proceedings the Appellant formally submitted the auxiliary request foreshadowed in the submission of 24 December 2004.

A. With regard to the alleged procedural violation:

(a) the Appellant submitted that he had been taken by surprise by the conduct of the Opposition Division and had not been prepared for a discussion on the issue of determination of the cloud point. In particular:

(i) The Appellant considered he had made only preliminary remarks on admissibility, with the aim of convincing the Division to disregard the new objection. He had consequently expected initially a decision on the relevancy/admissibility of the new ground, prior to any discussion on the merits thereof. The Opposition Division had, however, combined the debate on admissibility/relevancy and merit into one.

(ii) The absence of a separate decision on admissibility had deprived the Appellant of an opportunity to deal with the substance of the ground, and to discuss this with the experts of the Appellant who were present at the Oral Proceedings before the Opposition Division and, if necessary, to request that the procedure be continued in writing.

(iii) The Appellant emphasised the need legally to separate the discussions on relevancy and

merit. If the new ground had been found to be relevant, then it would have been necessary to allow a continuation of the procedure to consider the merit. In the context of the present Appeal proceedings, this would have meant remittal to the first instance due to the principle that parties are entitled to decisions at two levels (reference made to T 1075/01 (22 October 2004, not published in the OJ EPO) and T 326/87 (OJ EPO 1992, 522)).

- (iv) On the question of relevancy of the new ground, the patent in suit represented a selection from the disclosure of D1 and hence everything disclosed in D1 applied also to the patent in suit. In support of this reference was made to paragraphs [0004], [0007], [0019] and [0022].

- (b) The Respondents submitted that everything relevant to the question of Article 100(b) in relation to the cloud point determination had been discussed, and that the Appellant had been given every opportunity to comment on this. It was also apparent from the Appellant's submissions that he considered that the question of relevance of this new ground had been fully discussed. The Appellant could have requested an opportunity to make further submissions - even if not expressly invited to do so.

In particular:

- (i) It should have been clear to the Appellant that the Opposition Division considered the reasons serious and intended to take a decision on this.
- (ii) It was submitted with reference to T 484/89 (8 December 1992, not published in OJ EPO) that "opportunity" was not to be equated with "time", but "possibility". The Appellant had had the possibility to make submissions or request more time, e.g. continuation of the proceedings in writing, but did not. It was not considered that there was any need for separate decisions on admissibility/relevance and merit of the new ground as these issues were intimately linked, the arguments put forward in favour of admitting the new ground equally applying to its merits.
- (iii) In any case it was disputed that this was really a new ground. Rather, and by analogy with G 9/91 and G 10/91 (OJ EPO 1993 408 and 420) it was argued that a new line of argumentation by the Appellant resulting in a change in the interpretation of the claims meant it was justified to examine the claims for compliance with all provisions of the EPC.
- (iv) It was argued that T 433/93, cited in the Communication of the Board, was not relevant

as this decision dealt with the case in which a new ground which had never previously been in the proceedings was raised.

- (v) On the substance of the objection, it was argued that the evidence of 25 October 2002 showed that it was not possible to understand what was meant by the cloud point, essentially repeating the arguments put forward in the written procedure. The submission of the Appellant at the first instance Oral Proceedings and at the Proceedings before the Board of Appeal that the method of D1 was the applicable one was contradicted by the statements and evidence filed with the Statement of Grounds of Appeal, showing that the Appellant considered that other methods could be applicable.

B. With regard to the admissibility of the amended claims according to the main request under Article 123(2) and (3) EPC:

- (a) The Appellant repeated the argument that the patent in suit was derived from D1 (with reference to paragraphs [0004]-[0007] of the patent).

- (i) The terms employed were synonymous as would be clear to the skilled reader from the reference to D1. The amendment had been undertaken to overcome a lack of clarity which arose due to a peculiarity of the

manner in which claims were interpreted according to EPC practice, i.e. without employing the description to elucidate the scope.

- (ii) It was inherent in the disclosure of the patent in suit that aromatic substituents on the surfactant were undesired, and hence a reasonable reading of the claim would exclude this possibility. While it was acknowledged that there was a certain discrepancy between the definition of the surfactant and the possibility that the group R can be saturated or unsaturated, the skilled person would interpret this in the light of the description of the patent in suit to exclude aromatic groups. In any case the formula would be given precedence over the nomenclature. The Chairman observed that this meant that aromatic groups would mandatorily fall under the claim.

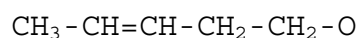
- (iii) With regard to the meaning of the term "alkyl" it was argued that the term as employed in the art did not necessarily require "alkyl" groups in the strict sense but covered R groups that could have both unsaturation and alkyl in part. The nature of the R group would be elucidated e.g. by reference to D1.

(b) The Respondents argued that:

(i) the term "ethoxylated aliphatic alcohol" was broader than the original term "polyoxyethylene alkyl ether". The latter term meant that mandatorily a saturated alkyl residue must be present in the molecule, e.g. the terminus must be of the form C_nH_{2n+1} even if between this group and the polyoxyethylene functionality there were other types of aliphatic groups, e.g. ethylenically unsaturated units. In contrast, the wording of the suggested amendment did not place any such restriction on the molecule meaning e.g. that an ethoxylated unit containing terminal vinyl functionality would be encompassed, rendering the revised wording broader than the original term.

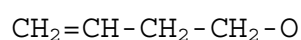
(ii) Respondent II illustrated this as follows:

The residue



would be considered as an "alkyl ether" due to the terminal methyl group.

However, the residue



would not be considered as an "alkyl ether" since there was no alkyl group in this.

C. With regard to the auxiliary request of the Appellant, neither Respondent raised any objection pursuant to Article 123(2) and (3) EPC. Respondent II considered that the amended claim potentially did not meet the requirements of Article 84 EPC since it was not clear whether the cloud point was solely due to this compound or to the presence of some other additive. It was also observed that it would be necessary to ensure that further statements in the description, e.g. paragraph [0016] would be limited to the formula in the claim.

XI. The final requests of the parties were:

Appellant (Patentee):

That the decision under appeal be set aside and that the case be remitted to the first instance for further prosecution on the basis of claims 1 to 5 filed with letter dated 28 August 2002 (main request), or in the alternative on the basis of claims 1 to 5 filed at the oral proceedings as auxiliary request.

Both Respondents (Opponents):

That the appeal be dismissed.

Respondent II further requested auxiliarily:

That, in case of remittal of the case to the first instance, that the Opposition Division should be obliged to base the further prosecution only on the facts and evidence already on file.

Reasons for the Decision

1. The Appeal is admissible.
2. *Article 113(1) EPC*

The patent was revoked on the grounds of Article 100(b) EPC it being held that the patent failed to disclose the method for determining the cloud point of the surfactants.

This ground was raised for the first time at the Oral Proceedings before the Opposition Division, being based on evidence submitted by the Patentee in an entirely different context.

- 2.1 The case law that has been developed on late filed grounds in Opposition and Opposition Appeal proceedings indicates that as a first step, a consideration of the admissibility of said new grounds is necessary.
 - 2.1.1 As the Enlarged Board ruled in case G 10/91, the purpose of the statement under Rule 55(c) EPC is to establish the legal and factual framework within which substantive examination of the Opposition shall be conducted (Reasons 6). Consideration of a new ground not covered by the statement pursuant to Rule 55(c) was possible in exception to this principle only in cases (before the Opposition Division) where prima facie "there are clear reasons to believe that such grounds are relevant and would in whole or in part prejudice maintenance of the European Patent" (Reasons 16).

2.1.2 Decision T 1002/92 (OJ EPO 1995, 605), referred under 3.1 of the Reasons to the "applicable principles" as set out in G 10/91 and to the earlier landmark decision T 156/84 (OJ EPO 1988, 372). In T 1002/92 it was clarified (Reasons 3.5) that late filed material was generally examined for relevance, and following such an examination the admissibility of this material to the proceedings was determined having regard to whether or not (in the opinion of the relevant instance) it was likely to affect the outcome of the decision to be taken.

2.1.3 The general considerations discussed under 2.1.1 and 2.1.2 were crystallised in the aforementioned decision T 433/93.

(a) T 433/93 concerns the situation where a new ground is introduced by the Opposition Division under Article 114(1) EPC and clarifies that the patentee must be informed - normally in writing even during Oral Proceedings - by the Division both of the introduction of the new ground and the essential legal and factual reasons which would substantiate such ground, and thereafter accorded a proper opportunity to present comments in reply (Headnote 1 and Reasons 3).

(b) Relevance of T 433/93 to the present case:

(i) Respondent II had argued at the Oral Proceedings before the Board that the findings of T 433/93 were not applicable to the present case since the ground of Articles 83/100(b) EPC was already in the

proceedings. This aspect will now be examined.

- (ii) While the ground of Articles 83/100(b) EPC had indeed been invoked by Respondent I in the letter of 28 August 2002, and was discussed at the Oral Proceedings before the Opposition Division, it was not admitted to the proceedings (Reasons for the Decision 2.2 first two paragraphs).
 - (iii) Accordingly at the stage in the proceedings at which Respondent II invoked the ground of Article 100(b) EPC this ground was a new ground of opposition which was not part of the existing legal and factual framework of the opposition proceedings.
 - (iv) It is therefore concluded that the situation in the present case corresponds to that which formed the basis for Decision T 433/93 and that the conclusions reached in that case are relevant to the present Appeal.
- (c) In this context, reference may also be made to the General Instructions for the Opposition Divisions (c.f. Guidelines for Examination, "General Part" paragraph 3.1 and 3.2) set out in the Guidelines for Examination, Part E, chapter III, 8.6 and further (later) Case Law developed in this respect. In particular T 1164/00 (2 September 2003, not published in the OJ EPO) concerned a case in which an objection was raised (by the Opposition Division) for the first time during the Oral

Proceedings. In 1.1 of the reasons, and with reference to T 433/93, it was held that under these circumstances, with the Patentee not having been informed in advance of the admission of such new factual and legal reasons, he would have been taken by surprise, and hence, denied a fair opportunity during the Oral Proceedings to prepare a proper defence contrary to Article 113(1) EPC. The correct course of action would have been to adjourn the Oral Proceedings in order to accord the Patentee/Appellant sufficient time, pursuant to Article 113(1) EPC to prepare a suitable defence against the new objections (T 1164/00 Reasons 1.3, see also T 817/93 (30 November 1994, not published in OJ EPO) Reasons 5, T 433/93 Reasons 3).

2.2 Applying the considerations of the aforementioned Case Law to the present case:

- (a) it is apparent from the request of the Appellant reported in the minutes of the first instance Oral Proceedings not to admit this ground, and from the statements made in the written and Oral Proceedings before the Board, that the Appellant was under the impression that the Opposition Division was in the process of establishing the relevance of the late filed ground of Opposition in order to reach a decision on whether to admit it (cf. T 433/93 Reasons 3, final paragraph) and
- (b) from the minutes and decision it is apparent that the Division in effect "telescoped" the separate stages of discussion of relevance/admissibility

and the discussion of the substantive import of this new ground into one step to the point where a decision was taken on the substantive import without a decision on the relevance/admissibility being separately announced, or even announced at all. The Respondents have not disputed this.

2.3 Hence the Patentee was not informed in advance of the announcement of the decision revoking the patent on the ground of Articles 83/100(b) EPC that this ground had been admitted into the proceedings, i.e. of the changed legal framework of the proceedings.

2.4 As a result of the telescoping of the two steps, furthermore the Patentee was *de facto* denied an opportunity to present comments separately on the substantive merits of the new grounds, or even to indicate if he was in a position to do so.

2.5 As noted above, the Guidelines for Examination and Case Law, in particular T 433/93 and T 1164/00 establish that it is required by Article 113(1) EPC that at the point that an Opposition Division comes to the conclusion that the newly raised ground is sufficiently relevant to be admitted to the proceedings, the Patentee be informed - in writing - of the decision and invited to comment thereon, in particular to ensure that the Patentee is fully informed of the case which has to be met and has a proper opportunity to present comments. In the present case, had the Patentee/Appellant indicated (if necessary after a appropriate pause to allow for reflection and consultation with the technical experts present) that he was not in a position to deal with this changed

legal and factual framework within the context of the Oral Proceedings, the correct procedure would have been for the Opposition Division to terminate the Oral Proceedings, continue the procedure in writing, and possibly to arrange for a further Oral Proceedings.

- 2.6 Respondent II argued with respect to paragraph 2.13 of the reasons of T 484/89 that "opportunity" did not necessarily mean "time" but "possibility" and that the Patentee had had such a "possibility" to comment on this ground.

While, as may be derived from the foregoing the Patentee did have an opportunity to comment on the admissibility of this ground, no opportunity was accorded to comment on the substantive merit thereof, since the first time the Parties were aware that the Opposition Division had decided to admit this ground into the proceedings was simultaneous with the announcement of the decision revoking the patent on this ground. In contrast, T 484/89 concerned a case where an Opposition Division introduced into the opposition procedure, for the first time during the Oral Proceedings, a document cited both in the European Patent and in the Search Report. In that case it was held that the parties should be accorded, with reference to the above cited Part E of the Guidelines, an opportunity to comment, "if need be" (original: "allenfalls") after a break in the proceedings and "if need be" a new proceedings be appointed. In the case underlying that decision, the Patentee had entered into a discussion of the newly cited document which led the Board to conclude that the complaint of violation of the right to be heard was unfounded. The present case

is fundamentally different from that of T 484/89, since in that case the decision to introduce the new document was indeed announced separately at the oral proceedings before the Opposition Division. In contrast, in the present case no such announcement was separately made and the Appellant consequently did not enter into a discussion of the substantive merits of the newly filed ground. Far from it, the efforts and arguments of the Appellant were directed at having this ground not admitted to the proceedings. Accordingly the arguments of Respondent II based on T 484/89 do not support the position that the Patentee in the present case did not suffer an infringement of the right to be heard.

2.7 Accordingly it is concluded that the procedure adopted by the Opposition Division was flawed in that it failed to accord the Patentee a fair opportunity to present comments on the substantive aspects of the new ground introduced for the first time at the Oral Proceedings.

2.8 It is therefore concluded that the decision under Appeal does not fulfil the requirements of Article 113(1) EPC since in the procedure leading up to this, the Patentee was denied the opportunity to comment on the grounds on which it is based.

Thus the decision must be set aside.

3. *The admissibility of the amended claims*

In the decision under Appeal, the Opposition Division concluded that the amended claims of the sole request met the requirements of Article 123(2) and (3) EPC. This decision was taken in a procedurally

unexceptionable manner. However it is conspicuous to the Board, following examination of this Appeal, that these claims in fact do not meet the requirements of Article 123(2) and (3) EPC for the following reasons:

- 3.1 Claim 1 of the main request differs from claim 1 as originally filed and as granted by defining the surfactant component as an "ethoxylated aliphatic alcohol" whereas the original application and the granted patent employed "polyoxyethylene alkyl ether". All versions of claim 1 contain in addition to this verbal definition the chemical formula:



R being defined as a saturated or unsaturated

hydrocarbon group of 8 to 18 carbon atoms, n being 5 to 18, as well as the requirement that the molecule contain 65 to 70wt% ethylene oxide and that the cloud point be over 45°C to not higher than 85°C.

- 3.2 The argument of the Appellant that the terms "ethoxylated aliphatic alcohol" and "polyoxyethylene alkyl ether" would be seen as synonymous by the skilled reader due to the way in which they were presented in the description of the patent in suit, reference being made to paragraphs [0004]-[0007] of the latter is not convincing for the following reasons:

The critical passages, for example paragraph [0004], relate to a discussion of the prior art, not to the invention of the patent in suit. Paragraph [0004] refers to the compositions of the prior art (D1) "in

which an ethoxylated aliphatic alcohol (polyoxyethylene alkyl ether) is used". In the view of the Board, far from indicating beyond any doubt equivalence between these terms, this wording could equally be interpreted as indicating that the term "ethoxylated aliphatic alcohol" is a generic term for the class of compounds which are employed, and the term in brackets represents the specific sub-class employed.

The relevant Case Law on admissibility of amendments applies a very rigorous standard of proof, namely that of "beyond reasonable doubt" (T 383/88, not published in the OJ EPO, 1 December 1992, Reasons 2.2.2).

As set out above in the present case there is however a doubt as to the status of the statements in the patent in suit in regard to the prior art. Accordingly it is not proven "beyond reasonable doubt" that the questionable statements in the description of the patent in suit do in fact show unambiguously equivalence between the terms employed in the prior art and those employed in the original claims of the patent in suit.

- 3.3 A further consideration which speaks against the Appellant's interpretation of the scope of the amended claim arise from the relative breadth of the terms "ethoxylated **aliphatic** alcohol" and the wording of the granted claim "polyoxyethylene **alkyl** ether" (emphasis added).

3.3.1 Concerning the meaning of the term "alkyl" and hence the definition of the residue R, in the view of the Board the position of neither the Appellant nor Respondent II as set out in particular at the Oral Proceedings (Section X., B (a) and (b) above) is correct. According to the IUPAC rules for naming organic compounds, the term "alkyl" is restricted to an alkane from which a single hydrogen has been removed, thus providing a saturated monovalent radical.

This is the meaning the Board considers it appropriate to assign to the term "alkyl", rendering claim 1 as granted of the patent in suit more restrictive than either the Respondent or the Appellant argued.

3.3.2 The submissions of the Appellant concerning the interpretation of the term "alkyl" to the effect that the term as employed in the art does not necessarily require "alkyl groups" are not convincing. It is *prima facie* in contradiction with the wording of the claim, and secondly amounts to assigning a broad, extremely vague meaning to a term which on the contrary is clearly defined in the art, and precisely understood by the skilled practitioner as noted under 3.3.1.

3.3.3 The arguments of the Appellant would however be correct for the term "aliphatic".

The term "aliphatic" is generic to the term "alkyl" and does encompass groupings of the type set out by Respondent II.

Consequently, the passages at paragraphs [0004]-[0007] do not provide support for the amendment made.

Hence the amended claim 1 does not meet the requirements of Article 123(2) EPC.

Furthermore, and for the reasons given in section 3.3.1 above, the amended claim is broader than claim 1 as originally filed and as granted in this respect, contrary to Article 123(3) EPC.

3.4 In any case, it is apparent that claim 1 of the main request does not meet the requirements of Article 84 EPC since it contains a *prima facie* contradiction. On the one hand the molecule specified by the text to be "aliphatic", on the other hand unsaturation - without any limitation, i.e. also aromatic - is permitted by the definition of R in the structural formula as a "saturated or unsaturated hydrocarbon group".

3.5 The argument of the Appellant in respect to this ambiguity in the wording of the claim, i.e. the fact that while the term "ethoxylated aliphatic alcohol" would appear to exclude aromatic substituents that the formula would allow these, namely:

- that it is inherent from the discussion in the patent that aromatic groups were undesired;
- that a reasonable reading of the claim would exclude this possibility, and;
- that in any case the formula would be given precedence over the wording employed

cannot lead to success.

While the terminology employed is indeed ambiguous, the formula is unambiguous and encompasses the possibility of aromatic substituents through the use of the term "unsaturated".

This analysis of the claims also establishes that the proposed amendment would in any case not serve the purpose for which it was proposed, namely to exclude polyoxyethyleneethers bearing aromatic groupings.

- 3.6 The further argument of the Patentee in respect of interpretation of the claims, namely that under certain other Patent jurisdictions, the description would be employed to elucidate, interpret and clarify what it was intended to claim such considerations cannot play any role here. The applicable law is that of the EPC, in particular Article 84 EPC which specifies that the invention shall be defined by the claims. Of relevance here is the Case Law set out in T 1129/97 (OJ EPO 2001 273, in particular Reasons 2.1.3) which held that reference to the description to elucidate the scope of a claim (Article 69(1) EPC) concerned the extent of protection only, e.g. with regard to third parties, but not the definition of the matter to be protected. This latter function was exclusively that of Article 84 EPC and hence of the claims alone. Accordingly, it is not permissible to rely on the description to elucidate what is intended to be covered by the claim for the purposes of defining the matter for which protection is sought and hence the compliance or not of the claim with Article 84 EPC.

3.7 The foregoing leads to the conclusion that claim 1 of the main request is unclear in scope, contrary to Article 84 EPC, is not supported by the content of the application as filed contrary to Article 123(2) EPC and is broader in scope than claim 1 of the granted patent, contrary to Article 123(3) EPC.

Accordingly, the main request of the Appellant is not allowable.

3.8 As regards the claims of the Auxiliary request, they correspond to the wording of claim 1 as originally filed and granted, and are further restricted by deletion of the alternative that the R group is an unsaturated radical. Thus this request meets the requirements of Article 123(2) and (3). This has not been challenged by either of the Opponents.

4. *Article 84 EPC*

4.1 The objection of Respondent II to the amended claim of the auxiliary request under Article 84 EPC (Section X.C above), is not admissible since the considerations underlying it apply equally to the original unamended claim and did not arise as a result of an amendment made during Opposition Proceedings.

4.2 Regarding the observations that some amendments would be necessary to paragraph [0016] of the description, it is not apparent to the Board which amendments would be necessary since the terminology in paragraph [0016], particularly with regard to the reference to the polyoxyethylene alkyl ether is entirely consistent with

that of claim 1. Hence it is not clear under which article of the EPC this objection was raised.

4.3 It is thus concluded that the claims of the auxiliary request meet the requirements of Article 84 EPC.

5. *Auxiliary Procedural request of Opponent II*

The request of Opponent II that on remittal of the case the Opposition Division be restricted to a consideration of the evidence so far submitted and only permitted to consider new arguments amounts to requesting the Board to order the Division to modify or ignore Article 19 EPC, which specifies that Opposition Divisions are responsible for examination of oppositions against any European Patent.

According to Article 23(3) EPC the Boards shall comply with the provisions of the Convention, with the consequence that the Board is not empowered to deviate from, or order a different instance to deviate from, the EPC.

This request is inconsistent with the EPC and for this reason inadmissible.

Order

For these reasons it is decided that:

1. The decision under Appeal is set aside.
2. The main request of the Appellant is refused.

3. The auxiliary request of Respondent II is declared inadmissible.
4. The case is remitted to the first instance for further prosecution on the basis claims 1 to 5 of the auxiliary request filed at the oral proceedings.

The Registrar:

The Chairman:

E. Görgmaier

R. J. Young