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**D E C I S I O N**  
**of 23 May 2006**

**Case Number:** T 0662/03 - 3.3.03

**Application Number:** 93921214.8

**Publication Number:** 0626980

**IPC:** C08K 3/04

**Language of the proceedings:** EN

**Title of invention:**

Carbon black containing EPDM compositions having either a high gloss or a textured matte finish

**Patentee:**

CABOT CORPORATION

**Opponent:**

Degussa AG

**Headword:**

-

**Relevant legal provisions:**

EPC Art. 54, 84

**Keyword:**

"Novelty (no) - main request"

"Claims - clarity (no) - auxiliary requests I and II"

**Decisions cited:**

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**Catchword:**

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Case Number: T 0662/03 - 3.3.03

**D E C I S I O N**  
of the Technical Board of Appeal 3.3.03  
of 23 May 2006

**Appellant:**  
(Patent Proprietor)

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**Respondent:**  
(Opponent)

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**Representative:**

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**Decision under appeal:**

Decision of the Opposition Division of the  
European Patent Office dated 14 March 2003 and  
posted 4 April 2003 revoking European patent  
No. 0626980 pursuant to Article 102(1) EPC.

**Composition of the Board:**

**Chairman:** R. Young  
**Members:** W. Sieber  
E. Dufrasne

## Summary of Facts and Submissions

I. The mention of the grant of European patent No. 0 626 980, in respect of European patent application no. 93 921 214.8, based on International application PCT/US93/08070, in the name of Cabot Corporation, filed on 27 August 1993 and claiming priorities of 27 August 1992 (US 936818) and 2 July 1993 (US 86793), was published on 11 April 2001 (Bulletin 2001/15). The granted patent contained 8 claims, whereby Claims 1 and 4 read as follows:

- "1. Process for preparing a EPDM composition in a manner known per se wherein EPDM and a carbon black having a CTAB of  $10 \text{ m}^2/\text{g}$  to  $30 \text{ m}^2/\text{g}$  and a ratio of DBP/CTAB greater than 4, wherein the carbon black is present in an amount of 100 to 300 parts by weight carbon black per 100 parts by weight EPDM are used.
  
4. Process for preparing a EPDM composition in a manner known per se wherein EPDM and a carbon [sic] black having a CTAB of  $30 \text{ m}^2/\text{g}$  to  $70 \text{ m}^2/\text{g}$  and a DBP greater than  $125 \text{ cm}^3/100 \text{ g}$ , wherein the carbon black is present in an amount of 100 to 300 parts by weight carbon black per 100 parts by weight EPDM are used."

The remaining claims are not of importance for this decision and consequently they will not be considered in further detail.

II. A notice of opposition was filed on 10 January 2002 by Degussa AG requesting revocation of the patent in its entirety on the grounds of Article 100(a) (lack of novelty and lack of inventive step) and Article 100(c) EPC.

The opposition was *inter alia* supported by the following documents:

D1: WO-A-94/05732;

D2: WO-A-93/21270; and

D9: Formulations Buna<sup>®</sup> Hüls AP, Edition 1992.

III. By a decision which was announced orally on 14 March 2003 and issued in writing on 4 April 2003, the opposition division revoked the patent. The decision was based on two sets of claims, namely a main request and an auxiliary request I.

(a) The main request was directed to maintenance of the patent as granted, ie Claims 1-8 as granted.

(b) The claims of auxiliary request I corresponded to the claims as granted, except that the introductory part of Claims 1 and 4 read as follows (amendments shown in bold):

"Process for preparing an EPDM composition **which when extruded or shaped has a high gloss finish** in a manner known per se ...".

- (c) According to the opposition division, the only interpretation that the skilled person would have put on the original documents, and indeed the only technical meaningful interpretation, was that the properties of the carbon blacks related to the carbon blacks to be incorporated and not that as added. Thus, the properties of the carbon blacks as defined in the granted claims (ie to be added) were considered to form part of the original disclosure, hence meeting the requirements of Article 123(2) EPC.
  
- (d) Claim 1 of both requests was not entitled to the claimed priorities since the patent in suit was not the first filing for the subject-matter of both Claims 1. In D1, having earlier priority dates than the patent in suit, there was already a disclosure of the subject-matter of Claim 1 according to both requests.
  
- (e) The main request was considered not allowable because the subject-matter of Claim 1 was not novel over D1 and D2 (Article 54(3) EPC) and the subject-matter of Claim 4 was not novel over D9 (Article 54(2) EPC).
  
- (f) Auxiliary request I was not allowable because the feature "which when extruded or shaped has a high gloss finish" in independent Claims 1 and 4 did not meet the requirements of Article 84 EPC.

IV. On 4 June 2003, the appellant (proprietor) filed a notice of appeal against the above decision with simultaneous payment of the prescribed fee. The appellant requested that the decision under appeal "*be set aside and the patent be upheld*".

With the statement of grounds of appeal filed on 14 August 2003, the appellant filed an auxiliary request II. Its arguments may be summarized as follows:

- (a) The finding of the opposition division that the claimed priority would be invalid was wrong. D1 did not disclose the same invention as the patent in suit. It might be that D1 described in Table 7 an EPDM composition similar to the EPDM compositions used in the presently claimed process. However, the technical teaching of the claimed invention, namely to prepare highly glossy products by using a mixture having very well defined properties, could not directly and unambiguously be derived from D1.
  
- (b) D1 did not anticipate the present invention. The presently claimed general teaching, ie to prepare a highly glossy product, by using compounds having very well defined property ranges was neither described nor inherently disclosed in D1. Table 7 of D1 merely referred to tests determining the melt properties of the compositions claimed in D1.

Furthermore, neither D2 nor D9 anticipated the invention as claimed.

- (c) The appellant objected to the finding of the opposition division that auxiliary request I did not meet the requirements of Article 84 EPC. The feature of having a high gloss finish when extruded or shaped was readily obvious to the person skilled in the art and accordingly this person skilled in the art could easily distinguish whether the feature of high gloss was fulfilled or not.
- (d) Apart from that, the term "high gloss" was especially defined in paragraph [0003] of the patent specification as "having a high degree of reflectance when viewed at any angle". To further emphasize that the general teaching of the present invention could objectively be assessed, this definition had been introduced into the claims of auxiliary request II.
- (e) The claims of auxiliary request II corresponded to the claims as granted, except that Claims 1 and 4 read as follows (amendments shown in bold and by strikethrough):

"1. Process for preparing a EPDM composition **which, when extruded or shaped has a high degree of reflectance when viewed at any angle** in a manner known per se [~~wherein~~], **comprising mixing** EPDM and [a] carbon black having a CTAB of 10 m<sup>2</sup>/g to 30m<sup>2</sup>/g and a ratio of DBP/CTAB greater than 4 [~~wherein the carbon black is present~~] in an amount of 100 to 300 parts by weight carbon black per

100 parts by weight EPDM [~~are used~~] **and extruding or shaping the resulting mixture.**

4. Process for preparing a EPDM composition **which, when extruded or shaped has a high degree of reflectance when viewed at any angle** in a manner known per se [~~wherein~~], **comprising mixing** EPDM and [~~a~~] carbon black having a CTAB of 30 m<sup>2</sup>/g to 70 m<sup>2</sup>/g and a DBP greater than 125 cm<sup>3</sup>/100 g [~~, wherein the carbon black is present~~] in an amount of 100 to 300 parts by weight carbon black per 100 parts by weight EPDM [~~are used~~] **and extruding or shaping the resulting mixture."**

V. The arguments of the respondent (opponent) presented in its letter dated 22 December 2003, may be summarized as follows (as far as they are relevant to this decision):

- (a) Although the appellant's requests were not clear, the respondent assumed that the requests before the opposition division, namely the main request and auxiliary request I, as well as auxiliary request II were part of the present proceedings.
- (b) Since the statement of grounds of appeal contained no reasons as to why the decision under appeal was wrong to reject the main request for lack of novelty, the appeal should be rejected as inadmissible in so far as the main request was concerned.



Apart from that, the subject-matter of the Claims 1 and 4 as granted was not novel over D1, D2 and D9.

- (c) The feature "high gloss" in Claims 1 and 4 of auxiliary request I and the feature "high degree of reflectance when viewed at any angle" in Claims 1 and 4 in auxiliary request II did not meet the requirements of Article 84 EPC.

VI. In a communication dated 14 March 2006, the board *inter alia* indicated that the appellant's request(s) was (or were) not clear. The appellant was invited to clarify its request(s), at the latest at the oral proceedings scheduled for 23 May 2006.

VII. In a letter dated 19 April 2006, the appellant stated that he would not attend the oral proceedings and requested a decision based on the contents of the file.

VIII. On 23 May 2006, oral proceedings were held before the board at which the appellant was not represented. Since it had been duly summoned, however, the oral proceedings were continued in its absence in accordance with Rule 71(2) EPC.

- (a) The board indicated that, taking into account the content of the file, the appellant apparently requested that the decision under appeal be set aside and the patent be maintained as granted (ie the main request before the opposition division), or, in the alternative, on the basis of auxiliary request I (identical with auxiliary request I before the opposition division), or on the basis

of auxiliary request II filed with letter dated 14 August 2003.

- (b) The respondent withdrew its request to reject the appeal as inadmissible in so far as the main request was concerned.
- (c) As regards the main request and auxiliary requests I and II, the respondent relied on its written submissions.
- (d) The respondent requested that the appeal be dismissed.

## **Reasons for the Decision**

### 1. *Requests of the appellant*

1.1 The board has invited the appellant (point VI, above) to clarify its requests. Since, however, no answer has been received in this respect and the appellant was not represented at the oral proceedings, the board had to establish the appellant's requests based on the content of the file.

1.1.1 In the notice of appeal the appellant requested that the decision under appeal "*be set aside and the patent be upheld*". This can only mean that the appellant pursues the main request before the opposition division, namely to maintain the patent as granted.

1.1.2 The filing of auxiliary request II with the statement of grounds of appeal, implies, in the board's view, that auxiliary request I of the decision under appeal is also pursued although no request in this respect has been formulated.

1.2 Consequently, the appellant's requests are established as follows:

- The appellant requests that the decision under appeal be set aside and the patent be maintained as granted (main request); or, in the alternative,
- on the basis of auxiliary request I which is identical with auxiliary request I before the opposition division; or
- on the basis of auxiliary request II filed with letter dated 14 August 2003.

## 2. *Admissibility of the appeal*

2.1 In the written procedure, the respondent requested that the appeal should be rejected as inadmissible in so far as the main request was concerned because the statement of grounds of appeal contained no reasons as to why the decision under appeal was wrong to reject the main request for lack of novelty.

2.1.1 However, this line of argumentation is not supported by the facts on file. The appellant not only disagreed with the finding in the decision under appeal on priority, an issue dealt with in the decision under appeal in relation to all requests, but also challenged

the finding on lack of novelty which led to the rejection of the main request. For example, the statement of grounds of appeal contains the following paragraph (page 3):

*"In the appealed decision the Opposition Division comes to the conclusion that D1 anticipates the present invention. Again, this opinion cannot be agreed due to the following reasons."*

Similar statements can be found with respect to D2 and D9. Hence, the appellant criticizes the decision under appeal with respect to the rejection of the main request and gives reasons for its criticism.

- 2.1.2 It may be that the arguments provided do not contain a tight logical chain and/or are not convincing. However, the issue of probable success of arguments cannot determine the admissibility of an appeal. This issue has to be considered when dealing with the merits of the appeal.
- 2.1.3 It is also noted that the respondent withdrew its request to reject the appeal as inadmissible in so far as the main request was concerned at the oral proceedings.
- 2.2 Since, furthermore, the appellant challenged the finding of the opposition division with respect to auxiliary request I, and filed a new auxiliary request II in order to overcome the deficiencies mentioned in the decision under appeal, the board comes to the conclusion that the appeal complies with

Articles 106 and 108 EPC and Rule 64 EPC and is therefore admissible.

3. *Main request (claims as granted)*

3.1 Priority entitlement

3.1.1 The patent in suit claims two priorities, namely from US 936818 (27 August 1992) and from US 86793 (2 July 1993).

3.1.2 There was no dispute that the first priority, ie from US 936818 (relating to an EPDM composition comprising carbon black having a certain iodine absorption number ( $I_2No.$ ) but not having the combination of parameters required in the patent in suit), is not valid.

3.1.3 As regards the second priority claim, ie from US 86793, the opposition division held that this priority claim was invalid as far as Claim 1 as granted was concerned because the patent in suit was not the first filing in this respect. The first filing of the invention was considered to be D1 (having a valid priority date of 25 June 1993) which discloses a composition meeting the requirements of Claim 1 as granted.

It is conspicuous to the board that the teaching of D1 does not require a certain DBP/CTAB ratio whereas Claim 1 as granted requires a DBP/CTAB ratio greater than 4. Thus, one could argue that the DBP/CTAB ratio required in the patent in suit defines an invention different from D1. Therefore, the second priority date would be validly claimed. It appears, however, that the question as to the validity of the priority claim based

on US 86793 is not relevant in the present case. If the priority date of 2 July 1993 is valid, D1, D2 and D6 are prior art within the meaning of Article 54(3) EPC for all granted claims. If, on the other hand, the effective date for granted Claim 1 becomes the actual filing date, ie 27 August 1993, D1, D2 and D6 still are prior art within the meaning of Article 54(3) EPC for all claims.

3.1.4 Therefore, there is no need to decide on the validity of the priority because the outcome thereof is not relevant in the present case.

### 3.2 Novelty

3.2.1 As indicated in the discussion of the right to priority, the PCT application D1 published on 17 March 1994 validly claims the priority date of 25 June 1993. It has been supplied to the European Patent Office in one of its official languages and the national fee provided for in Article 22, paragraph 1 or Article 39, paragraph 1 of the Patent Co-operation Treaty has been paid. The requirements of Article 158(2) EPC are thus fulfilled. Its content as filed is therefore considered as comprised in the state of the art relevant to the question of novelty, pursuant to Article 54(3) and (4) EPC.

3.2.2 This earlier application D1 discloses in Example 9 the preparation of EPDM compositions on a Banbury BR mixer by mixing 100 parts by weight of EPDM resin with 200 parts by weight of various types of carbon black (Table 6). The fact that a Banbury mixer is used and an extrusion rate is measured indicates that the

compositions are extruded. According to Run 1 of Example 9 (Table 7), carbon black having a CTAB value of 25.3 m<sup>2</sup>/g and a DBP value of 132.5 cm<sup>3</sup>/100 g is used to prepare an EPDM composition. Thus, the ratio of CTAB/DBP of the carbon black used in Run 1 of Table 7 is greater than 4 (5.24 to be precise). Hence, Run 1 of Table 7 of D1 is, as pointed out in the decision under appeal and by the respondent, novelty destroying to the subject-matter of Claim 1 as granted.

- 3.2.3 The appellant's argument that "*the presently claimed general teaching namely to prepare a highly glossy product, by using compounds having very well defined property ranges is neither disclosed nor inherently disclosed in D1*" is irrelevant, because high gloss is not a requirement of Claim 1 as granted. Features relied upon for distinction from the prior art but not being present in a claim have to be disregarded when assessing novelty.
- 3.3 The subject-matter of Claim 1 of the main request being not novel over D1, the main request has to be refused.
4. *Auxiliary request I*
- 4.1 Amended Claims 1 and 4 of auxiliary request I contain the feature "**which when extruded or shaped has a high gloss finish**" (point III(b), above).
- 4.2 As pointed out in the decision under appeal, the patent specification is silent on any objective method for determining high gloss, and further provides no guidance as how to assess in an objective and reproducible manner whether a given sample is to be

classified as "high gloss" or not. Accordingly, this feature is considered to lack the necessary clarity to serve as a technical feature for the purposes of defining the subject-matter of a patent claim, in particular with the view of providing a distinction over the prior art.

Hence, Claims 1 and 4 of auxiliary request I do not meet the requirements of Article 84 EPC.

4.3 The appellant's argument that the feature of having a high gloss finish when extruded or shaped is readily obvious to the person skilled in the art and accordingly this person can easily distinguish whether the feature of a high gloss is fulfilled or not is not convincing if only for the reason that the appellant has not shown that there exists common general knowledge how this feature has to be assessed in an objective and reproducible manner. The reference in paragraph [0003] of the patent specification that "a smooth glossy finish has a high degree of reflectance when viewed at any angle" is not suitable either to clarify the ambiguity associated with the term "high gloss", because this passage in the patent specification merely explains an ambiguous definition by another ambiguous definition (see also point 5.2, below).

4.4 Claims 1 and 4 of auxiliary request I being not allowable, auxiliary request I has to be refused.



5. Auxiliary request II

5.1 Amended Claims 1 and 4 of auxiliary request II contain the feature "**which, when extruded or shaped has a high degree of reflectance when viewed at any angle**" (point IV(e), above).

5.2 However, the objection raised against the feature "which when extruded or shaped has a high gloss finish" in Claim 1 and 4 of auxiliary request I equally applies to the new feature in amended Claims 1 and 4 of auxiliary request II. The patent specification is silent on any objective method for determining the high reflectance, and further provides no guidance as how to assess in an objective and reproducible manner whether a given sample meets this requirement.

Hence, Claims 1 and 4 of auxiliary request II do not meet the requirements of Article 84 EPC.

5.3 Claims 1 and 4 of auxiliary request II being not allowable, auxiliary request II has to be refused.

**Order**

**For these reasons it is decided that:**

The appeal is dismissed.

The Registrar:

The Chairman:

E. Görgmaier

R. Young