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**Datasheet for the decision
of 3 July 2006**

Case Number: T 1010/03 - 3.3.05

Application Number: 97309363.6

Publication Number: 0845438

IPC: C02F 1/20

Language of the proceedings: EN

Title of invention:

Oxygen scavenger and boiler water treatment chemical

Patentee:

Kurita Water Industries Ltd.

Opponent:

Ciba Speciality Chemicals Water Treatments Ltd.

Headword:

-

Relevant legal provisions:

EPC Art. 99(1), 100(a)

EPC R. 55(c), 56

Keyword:

-

Decisions cited:

G 0009/91, T 0199/92, T 0919/97

Catchword:

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Case Number: T 1010/03 - 3.3.05

D E C I S I O N
of the Technical Board of Appeal 3.3.05
of 3 July 2006

Appellant: Ciba Speciality Chemicals Treatments Ltd.
(Opponent) Cleckheaton Road
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Representative: Bernhardt, Wolfgang Willy-Hans
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Respondent: Kurita Water Industries Ltd.
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Tokyo (JP)

Representative: Jenkins, Peter David
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Decision under appeal: Decision of the Opposition Division of the
European Patent Office posted 29 July 2003
rejecting the opposition filed against European
patent No. 0845438 pursuant to Article 102(2)
EPC.

Composition of the Board:

Chairman: M. Eberhard
Members: A. T. Liu
S. Hoffmann

Summary of Facts and Submissions

I. European patent No. 845 438, based upon the application number 97 309 363.6, was granted with a set of 9 claims. The mention of the grant of the patent was published in the European Patent Bulletin 2001/38 on 19 September 2001.

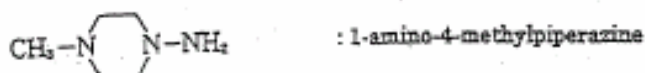
II. The independent Claim 2 as granted, *inter alia*, reads as follows:

2. Use of a heterocyclic compound with N-substituted amino group or water soluble salt thereof as an oxygen scavenger of boiler water, the compound being selected from:

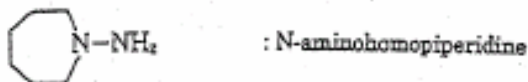
N-aminomorpholine;



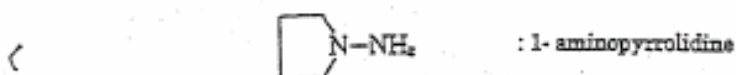
1-amino-4-methylpiperazine;



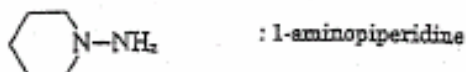
N-aminohomopiperidine;



1-aminopyrrolidine;



and 1-aminopiperidine;



III. A notice of opposition, dated 14 June 2002, was lodged on 17 June 2002. In the notice, it was requested that the patent be revoked in its entirety on the grounds of Article 100(a) EPC; further, reference was made to two documents:

D1a: G. Petri: *Acqua Industriale*, No.5, 1960

D1b: G. Petri: *Acqua Industriale*, No.5, 1960, English translation.

A copy of D1a, an incomplete copy of D1b, as well as three further documents were enclosed with the notice of opposition, in particular:

D2: Centre belge d'étude et de documentation des eaux, Sep-Oct 1965, No 262-263, pages 467-472.

IV. In a communication dated 20 June 2002 and faxed to the opponent on the same day, the opponent was informed that the transmitted notice of opposition was incomplete since it stopped at page 3 (of 5), after the reference to the cited documents.

V. The confirmation copy of the notice of opposition, containing the missing pages 4 and 5, was received on 20 June 2002.

VI. Oral proceedings before the opposition division were held on 17 July 2003 and concluded with the announcement that the opposition was rejected as inadmissible. The reasoned decision was issued in writing on 29 July 2003.

VII. An appeal was lodged by the opponent on 24 September 2003, followed by a statement of the grounds of appeal, filed on 28 November 2003.

VIII. Oral proceedings before the board took place on 3 July 2006.

IX. The arguments of the appellant can be summarised as follows:

- The context of the opposition made it clear that, as specific grounds for opposition, only novelty and inventive step were to be argued, and not the other grounds referred to in Article 100(a) EPC.
- The purely formalistic question of whether or not the notice of opposition explicitly indicated a specific ground of opposition was of no practical relevance. Either a cited document was found to be novelty-destroying of the subject-matter of a claim or not. If not, then the next matter to be considered would be the issue of inventive step.
- The issue of admissibility of the opposition thus mainly concerned the requirement of Rule 55(c) EPC, third condition.
- The term "indication" in Rule 55(c) EPC meant that the content of the notice of opposition must be such that the patentee was able to understand the case that was being made against the patent, without undue burden.

- According to the case law, in particular decisions T 199/92 and T 919/97, the above requirement did not exclude a certain amount of interpretation such as could reasonably be expected from a person skilled in the art.
 - The cited documents D1a and D1b were very short and therefore easy to comprehend. One could easily infer from the title that they dealt with antioxidant reagents, i.e. oxygen scavengers.
 - Furthermore, D1a taught that N-aminomorpholine, referred to (in Italian) as "Idramina" and, in D1b, (in English) as "hydramine", could react with oxygen.
 - The decision under appeal was flawed in that it found the term hydramine (or "Idramina") to lack clarity because of a remark in D1a, according to which the manufacturer would not specify the content of -NH_2 in hydramine.
 - The disclosure of D2 was also novelty-destroying of the claimed subject-matter.
- X. The arguments of the respondent were essentially the following:
- According to the case law, Rule 55c EPC made sense only when interpreted as having the double function of governing the admissibility of the opposition and of simultaneously establishing the legal and factual framework within which the substantive examination of the opposition was in principle to be conducted. Grounds not actually supported by facts, evidence and

arguments could not be regarded as making up the "legal and factual framework" of the opposition.

- In the present case, both a legal and a factual framework was missing from the notice of opposition, which stated neither a specific ground of opposition under Articles 52 to 57 EPC nor the arguments relating to such ground(s).
- The case law did not permit an interpretation of Rule 55(c) EPC whereby the mere citation of prior art documents could be accepted as "arguments" within the meaning of the rule.
- In the absence of any reasoned statement, the respondent could not be expected to make a guess and speculate on the nature of the attack on his patent.
- D1a and D1b could not be construed as novelty-destroying of the subject-matter of Claim 2 since the exact meaning of the term "hydramine" was unclear.
- D2 referred back to D1a.

XI. The appellant (opponent) requested that the decision under appeal be set aside, that the admissibility of the opposition be acknowledged and the case be remitted to the opposition division for further prosecution.

The respondent requested that the appeal be dismissed.

Reasons for the Decision

Admissibility

1. The admissibility of the appeal is not disputed. The only admissibility issue to be addressed here is therefore that concerning the opposition.
2. *Admissibility of the opposition, Rule 56 EPC*

The legal and factual framework required for an opposition to be admissible are set out in Rule 56 EPC. Specifically, Rule 56(1) stipulates that the notice of opposition shall be rejected as inadmissible if, *inter alia*, it does not comply with the provisions of Article 99, paragraph 1, Rule 1, paragraph 1, and Rule 55, subparagraph (c), unless the deficiencies have been remedied before expiry of the opposition period.

- 2.1 Notice of opposition, Article 99(1) EPC

Article 99(1) EPC stipulates that a notice of opposition must be filed in a written **reasoned statement** (emphasis added) within nine months from the publication of the mention of grant of the European patent. In the present case, the required time limit expired on 19 June 2002. In consequence, the notice of opposition dated 14 June 2002, including pages 1 to 3, received by the EPO on 17 June 2002, were filed in time and form the factual and legal basis for the assessment of admissibility pursuant to Rule 56(1) EPC. On the other hand, it is not in issue that pages 4 and 5 of the notice were only sent with the confirmation copy and received on 20 June 2002, i.e. after the expiry

date. The content of these pages, therefore, cannot be taken into consideration for deciding the admissibility of the opposition.

2.2 Content of the notice of opposition, Rule 55 EPC

According to Rule 55, subparagraph c, EPC, the notice shall contain a statement:

- (i) of the extent to which the European patent is opposed (first condition) and
- (ii) of the grounds on which the opposition is based (second condition), as well as
- (iii) an indication of the facts, evidence and arguments presented in support of these grounds (third condition).

2.2.1 In the present case, the notice of opposition states:

"it is requested that the above-mentioned European Patent be revoked in its entirety". Thus, the first condition of Rule 55(c) EPC is met by this statement. This is not in dispute.

2.2.2 The expression "grounds on which the opposition is based" in Rule 55(c), second condition, corresponds to the legal term "Grounds for opposition" referred to in the headline of Article 100 EPC. In the present case, the notice of opposition requests the revocation "on the grounds of Article 100(a) EPC". This wording can *a priori* be interpreted as referring to all the grounds for opposition specified by Article 100(a) EPC, namely,

that the subject-matter of the opposed patent is not patentable within the terms of Articles 52 to 57 EPC. Thus, the board holds that the notice of opposition also formally complies with the second condition of Rule 55(c) EPC.

- 2.2.3 The third condition of Rule 55(c) EPC is that the notice of opposition should contain an indication of the **facts, evidence and arguments in support of the grounds for opposition** (emphasis added). The German and the French versions of the EPC do not contain terms precisely corresponding to facts / evidence / arguments (German: "Angabe der zur Begründung vorgebrachten Tatsachen und Beweismittel"; French: "les faits et justifications invoqués à l'appui de ces motifs"). In spite of the somewhat differing wordings in the three languages, the implication of the third condition of Rule 55(c) EPC amounts to the same requirement. Thus, the notice of opposition must not only state the facts and evidence the opponent wants to rely on, but must also indicate the link between these facts and evidence and the objections raised. This interpretation of the third condition of Rule 55(c) EPC is also in conformity with the requirement in Article 99(1) EPC for a "reasoned statement" of the opposition (German: "Einspruch ... zu begründen", French: "opposition ... motivée").

Applying the above principles to the present case, to be admissible, each of the grounds for opposition under Articles 52 to 57 EPC in combination with Article 100(a) EPC must thus be substantiated ("reasoned"), with an indication of the corresponding facts and evidence. In the notice of opposition, it is stated under the

heading "Indication of Facts, Evidence, and Arguments" that "Opponent sets out below an indication of the facts, evidence, and arguments in support of the grounds mentioned above". However, it is not in issue that the faxed copy of the notice of opposition was incomplete and merely contained a reference to the cited documents D1a and D1b, together with a recitation of Claims 1 to 8 (see item III above), without further comment. In the board's judgment, this reference to documents D1a and D1b can be considered as an indication of the "facts and evidence", so that the third requirement of Rule 55(c) EPC is considered to be partially fulfilled. However, it is irrefutable that the notice of opposition does not place the presented "facts and evidence" in juxtaposition to any specific ground of opposition. Due to the lack of such reasoning, the requirement regarding the indication of arguments in support of the grounds of opposition is not considered to be fulfilled in the present case.

2.3 The appellant has submitted that the board should not use a formalistic approach in applying Article 99(1) and Rule 55(c) EPC but should interpret its notice of opposition in the way that a reasonable skilled reader would.

2.3.1 In this respect, the board would like to observe that, as explicitly indicated in the decision of the Enlarged Board of appeal G 9/91 (OJ EPO 1993,408):

"Rule 55(c) only makes sense interpreted as having the double function of governing (together with other provisions) the admissibility of the opposition and of establishing at the same time the legal and factual

framework within which the substantive examination of the opposition in principle shall be conducted. The latter function is of particular importance in that it gives the patentee a fair chance to consider his position at an early stage of the proceedings." (see reasons point 6).

Following the above decision of the Enlarged Board of appeal, the skilled reader must be able recognise the gist of the attack on the patent in order that he or she can determine the factual framework and logical line of the opposition.

If therefore the notice of opposition does not enable a reasonably skilled reader to reach a clear-cut conclusion as to the legal and factual framework of the opposition by the end of the time limit for filing the notice of opposition, the opposition will be inadmissible.

- 2.3.2 For the purposes of discussion, the board can accept the appellant's arguments insofar as it is said that the citation of documents D1a and D1b could be interpreted as a factual statement referring to opposition grounds based on a lack of novelty or/and inventive step and not to the other grounds encompassed by Article 100(a) EPC. However, it is still irrefutable that the notice of opposition does not indicate how these documents adversely affect the novelty and/or the inventiveness of the subject-matter of the patent in suit.

Thus, to take the discussion further, the board will assume that the skilled reader would consult the cited

documents in order to "interpret" the opponent's attack on the patent. In doing so, he would infer from D1b (or the original publication document D1a), that sodium sulphite, hydrazine, morpholine and hydramine are being compared as anti-oxidant reagents, in particular for uses in boilers (D1a, page 2, left-hand column, first three paragraphs, and corresponding passage in D1b, page 2). None of these reagents is identical to any of the heterocyclic compounds used as oxygen scavengers of boiler water according to the claims of the opposed patent. Thus, there is no reason for the skilled reader to expect that these documents are cited with the aim of destroying the novelty of the claimed subject-matter. Furthermore, the notice of opposition does not contain the slightest indication as to whether the opponent wants to rely on these documents for an attack on inventive step or, if he does, how. The respondent is thus left in the dark as how to consider his position in reply to the opposition. Under these conditions, admitting the opposition would put the patentee in a situation where he would have to respond to grounds of opposition or arguments which the opponent may not have thought of. This situation is clearly against the principle as set out in the decision G 9/91 (see item 2.3.1 above).

- 2.3.3 The appellant has argued that the disclosure of document D1a (and D1b) regarding the use of hydramine is novelty-destroying of the use of N-aminomorpholine according to Claim 2 as granted. To substantiate this argument, he relies on the reaction equations indicated in these documents, wherein "Idramina" (or "hydramine") is represented by a formula corresponding to N-aminomorpholine (see D1a, page 3, middle column,

penultimate paragraph and the corresponding passage in D1b, page 4). Even if the board, in favour of the appellant, were to take the information on page 4 of D1b into consideration, the interpretation of the prior art documents put forward is, in the board's judgment, not consistent with the express disclosure therein. It is not in issue that in these documents it is stated that the exact formula for hydramine is not specified by the producer, in particular as to the number of NH_2 groups it contains (see D1a, page 3, middle column, third paragraph and the corresponding passage in D1b, page 4). Thus, the reaction equations in question can only be seen as a hypothesis, in an attempt to explain the reactivity of hydramine as oxygen scavenger. The fact remains that the exact composition of the reactant itself, namely that of hydramine, is expressly stated as being unknown. The board therefore concludes that, contrary the appellant's assertions, there is no clear and unambiguous disclosure of the use of N-aminomorpholine as an oxygen scavenger in D1a/D1b. The same considerations apply to the disclosure of D2, which refers back to D1a for experiments concerning the reaction of hydramine with oxygen. It cannot be expected from the respondent that he should have speculated and gone beyond said explicit disclosure in order to construe that disclosure as novelty destroying of the claimed subject-matter.

- 2.4 In the case which concerned decision T 199/92 (unpublished), a notice of opposition was also filed with a page 5 missing. In that case, however, the remainder of the notice of opposition contained enough information and arguments that the respondent could understand the precise nature of the obviousness attack

and make a correlation between the supporting evidence and that attack (see Reasons, items 1.3 and 1.4). Likewise, in case T 919/97 (unpublished), the notice of opposition also contained information needed for understanding the gist of the obviousness attack (Reasons, item 4.5).

In contrast to all the cases cited in the course of the proceedings, including the cases T 199/92 and T 919/97 on which the appellant particularly relied, the present notice of opposition contains neither any explicit grounds for opposition, namely lack of novelty and/or lack of inventive step, nor arguments clearly relating to either of these grounds. The board therefore considers that, in the different circumstances of this case, an undue burden was placed upon the respondent to understand the attack on its patent. To have been able to understand the attack would have required going beyond a mere interpretation of the notice of opposition, something that is precluded by the requirements of Rule 55(c) EPC. As a consequence, the opposition is held inadmissible in accordance with Rule 56(1) EPC.

Order

For these reasons it is decided that:

The appeal is dismissed.

The Registrar:

The Chairman:

C. Vodz

M. Eberhard