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D E C I S I O N
of 12 March 2004

Case Number: T 1141/03 - 3.3.3

Application Number: 99922271.4

Publication Number: 0998522

IPC: C08K 3/26

Language of the proceedings: EN

Title of invention:
Particulate carbonates and their preparation and use in theremoplastic film compositions

Applicant:
Imerys Minerals Limited

Opponent:
-

Headword:
-

Relevant legal provisions:
EPC Art. 84, 111(1), 113(1)
EPC R. 67

Keyword:
"Clarity (yes)"
"Substantial procedural violation (no)"
"Reimbursement of appeal fee (no)"

Decisions cited:
T 0068/85

Catchword:
-

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Beschwerdekammern | Boards of Appeal | Chambres de recours

Case Number: T 1141/03 - 3.3.3

D E C I S I O N
of the Technical Board of Appeal 3.3.3
of 12 March 2004

Appellant: Imerys Minerals Limited
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Decision under appeal: **Decision of the Examining Division of the European Patent Office posted 26 June 2003 refusing European application No. 99922271.4 pursuant to Article 97(1) EPC.**

Composition of the Board:

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

Summary of Facts and Submissions

I. European patent application No. 99 922 271.4, based on International application No. PCT/GB99/01420, filed on 21 May 1999, claiming US priorities of 22 May 1998 and 4 September 1998 (US 60/086493 and US 60/099239), and published under No. WO-A-99/61521 on 2 December 1999 (EP-A-0 998 522), was refused by a decision of the Examining Division announced orally on 22 May 2003 and issued in writing on 26 June 2003.

II. The first communication of the Examining Division had been issued on 14 May 2002 and was based on Claims 1 to 20 as originally filed.

Independent Claims 1 and 20 read as follows:

"1. A method of producing a breathable film which comprises the steps of:
(a) producing an inorganic filler by treating particles of an inorganic particulate material comprising an alkaline earth metal carbonate compound by reaction with a hydrophobising surface treatment agent comprising one or more aliphatic carboxylic acids having at least 10 chain carbon atoms to produce a hydrophobic coating on the particles under conditions such that the inorganic filler produced has a total surface moisture level comprising moisture adsorbed on the particles and trapped within the hydrophobic coating thereon of not greater than 0.1% by weight based on the dry weight of the inorganic particulate material;

(b) producing a filled thermoplastic composition by mixing the inorganic filler produced in step (a) with a heated thermoplastic polymer; and
(c) shaping the composition produced in step (b) by heat processing to form a film product.

20. A particulate inorganic material for use in the manufacture of breathable thermoplastic films which comprises the inorganic filler produced by the method according to any one of claims 1 to 15."

Claims 2 to 19 were dependent on Claim 1.

III. In its first communication the Examining Division stated that the subject-matter of Claim 20 was not novel in the sense of Article 54(1) and (2) EPC in view of documents D1(JP-A-61-097363 in form of its Derwent Abstract), D2(EP-A-0 214 859), and D3(WO-A-95/17441), and that the subject-matter of Claims 1 to 20 lacked novelty in the sense of Article 54(3) and (4) EPC in view of document D4(WO-A-99/28050).
In this communication it was further held that the subject-matter of Claims 1 to 18 lacked inventive step in view of D1, and that Claims 2 and 3 did not meet the requirements of Article 84 EPC, since they attempted to define the invention by a result to be achieved.

IV. With its response dated 17 September 2002 the Applicant submitted a replacement page (i.e. page 43; page corresponding to Claims 19 to 20) including an amendment in original Claim 20 (i.e. original Claims 1 to 19 remained unchanged).

Claim 20 read as follows:

"A particulate inorganic material for use in the manufacture of breathable thermoplastic films which comprises the inorganic filler produced by the method according to step (a) of any one of claims 1 to 15."

The Applicant contradicted the findings of the Examining Division and argued that Claim 20 was novel over D1 to D3, that D4 did not destroy the novelty of Claims 1 to 20, that inventive step of the subject-matter of Claims 1 to 18 was given over D1, and that Claims 2 and 3 did not contravene Article 84 EPC. It further requested oral proceedings in the event that the Examining Division still felt minded to refuse the application.

V. In the annex to the summons, issued on 11 December 2002, to oral proceedings to be held on 22 May 2003, the Examining Division summarized its provisional opinion. While the Examining Division stated that document D4 was a novelty destroying document for Claim 20, it however raised no objection of lack of novelty against Claims 1 to 19 (which corresponded to Claims 1 to 19 as originally filed) in view of this document. There was no mention in the annex of an objection of lack of novelty of Claim 20 in view of documents D1 to D3 and no reference to the previous objections of lack of inventive step of Claims 1 to 18 in view of D1 or of lack of clarity of Claims 3 and 4 raised in the first communication of 14 May 2002.

VI. With its letter dated 2 May 2003, the Applicant submitted additional Claims 21 and 22, which were respectively dependent on Claims 1 and 20. It considered that the only issue remaining was the question of novelty of Claim 20 in view of D4. In that respect, it submitted a detailed argumentation and concluded that the objection of lack of novelty against Claim 20 in view of D4 raised by the Examining Division was unfounded.

VII. An informal consultation by telephone took place on 14 May 2003 between the first Examiner and the Representative of the Applicant. The minutes of this consultation by telephone were sent on 21 May 2003, i.e. one day before the date of the oral proceedings, and received by the Applicant on 23 May 2003, i.e. after the oral proceedings. According to the minutes of the telephone consultation, the Applicant was informed during this consultation that Claim 1 did not meet the requirements of Article 84 EPC on the grounds that the feature "under conditions such that" was not clear.

VIII. At the oral proceedings held on 22 May 2003, the Examining Division decided to refuse the application on the grounds that it did not meet the requirements of Article 84 EPC. The decision was issued in writing on 26 June 2003. The decision was based on a set of 22 claims consisting of Claims 1 to 18 as originally filed, of Claims 19 to 20 as submitted with letter of 17 September 2002, and of Claims 21 to 22 as submitted with the letter of 2 May 2003. In its decision, the Examining Division stated that Claim 1 lacked clarity:

(i) since the wording "under conditions such that" in Claim 1 lacked clarity "per se"; and

(ii) since an essential feature, i.e. the drying step must be applied immediately before the coating step, in order to obtain the required level of moisture of not greater than 0.1% by weight was missing in Claim 1.

IX. A Notice of Appeal against the decision was lodged on 23 August 2003 by the Appellant (Applicant). The prescribed fee was paid on 26 August 2003.

In the Statement of Grounds of Appeal filed on 24 October 2003, the Appellant argued essentially as follows:

(i) The issue of clarity must be approached in a global sense, in particular taking into account the total wording of the claim, not isolated phrases.

(ii) There was no legal or jurisprudential basis for the position that the expression "under conditions such that" lacked clarity *per se.*

(iii) It could not be concluded as had the Examining Division that a drying step must be applied immediately before step (a) of the claimed process.

(iv) As described in the application in suit there was a wide range of preliminary processing conditions which might be used to prepare the starting inorganic filler.

(v) It was essential that the inorganic filler produced had a total surface moisture of not greater than 0.1% by weight. The drying conditions which might be used would vary from case to case and were never unduly burdensome for the skilled person to work out.

(vi) A suitable method for determining the residual water content was disclosed in the application. Furthermore, the control of moisture content was absolutely standard practice in the carbonate processing industries.

(vii) Thus, there was no basis for the objections of lack of clarity raised by the Examining Division against Claim 1.

(viii) A substantial procedural violation had occurred in this case for the following reasons:

(a) The Applicant had not been given a fair warning of the nature of the Examining Division's objections prior to the oral proceedings.

(b) The only objection mentioned in the summons to oral proceedings was a novelty objection against Claim 20.

(c) Contrary to what was mentioned in the report of the consultation by phone on 14 May 2003, Claim 1 was never discussed during the telephone conversation.

(d) Thus, it was clear that all the Applicant was expecting to have to deal with at the oral proceedings was the novelty of Claim 20. It had therefore been taken by surprise by the introduction of the new objections at the oral proceedings.

The Appellant thus requested that:

(1) The decision to refuse the application be set aside and a patent be granted on the basis of Claims 1 to 22 annexed to the decision to refuse the application,

(2) that the appeal fee be reimbursed in view of the substantial procedural violation (Rule 67 EPC), and

(3) that oral proceedings under Article 116 EPC be held in the event that the Board of Appeal was not able to comply with these requests on the basis of the written material.

X. In a communication dated 10 February 2004, the Board presented its provisional opinion. It told the Appellant that it was unable to discern any substantial procedural violation, and that the reasons given in the decision did not appear to justify the refusal of the application. It thus informed the Appellant of its

intention to set aside the decision of the Examining Division and to remit the case to the first instance for further prosecution (cf. paragraph 3 of the communication).

XI. With its letter dated 25 February 2004, the Appellant withdrew its request for oral proceedings on the condition that the decision of the Board would be issued in the terms set out in paragraph 3 of the communication of the Board of 10 February 2004.

Reasons for the Decision

1. The appeal is admissible.

2. *Procedural matters*

2.1 A substantial procedural violation has been alleged by the Appellant on the grounds that it was not provided with fair warning of the nature of the Examining Division's objections, i.e. lack of clarity of Claim 1, which led to the refusal of the application, prior to the oral proceedings, and that, as a result thereof, it was taken by surprise.

2.2 In the Board's view, it should first be clarified whether the Applicant was informed of these objections before the oral proceedings.

2.2.1 In that respect, it is, on the one hand, noted by the Board that, according to the minutes of the Oral Proceedings of 22 May 2003, the Examining Division at the beginning of the oral proceedings referred to the

consultation by telephone of 14 May 2003 (cf. Section VII above) during which, according to the report of this consultation, the Applicant was told that Claim 1 did not meet the requirements of Article 84 EPC, since the expression "under conditions such that" was unclear.

2.2.2 On the other hand, it is further noted by the Board, in view of the submissions made by the Applicant in the Statement of Grounds of Appeal (cf. page 6, first paragraph), that there are conflicting declarations as to what was said during the consultation by telephone of 14 May 2003 since, according to the Appellant, Claim 1 was never discussed during this consultation.

2.2.3 Telephone conversations are, however, not provided for in the EPC and do not, as such, form part of the formal procedure before the Office. Thus, the Board does not consider it necessary to conduct a detailed investigation seeking to clear up what was said in the above-mentioned telephone consultation.

2.2.4 Since the minutes of this telephone consultation were received by the Appellant one day after the oral proceedings, the Board comes to the conclusion that the Applicant was formally made aware of the introduction of this new objection (i.e. lack of clarity of the wording "under conditions such that") for the first time at the oral proceedings.

The same conclusion applies for the further objection under Article 84 EPC according to which Claim 1 lacked clarity on the ground that an essential feature (i.e. the drying step should occur just before the treating the particles with the hydrophobising agent) was missing from that claim, since this objection had never

been mentioned prior to the oral proceedings by the Examining Division.

2.3 Although it would have been highly preferable that these objections of lack of clarity against Claim 1 as originally filed, which led to the refusal of the application, should have been raised in the first communication of the Examining Division and not for the first time at the oral proceedings, the Examining Division, in the Board's view, was not, however, prevented from raising these objections at such a late stage of the proceedings. This is not altered by the fact that one might have concluded from the annex to the summons to oral proceedings (cf. paragraph V above) that there was no problem of clarity any more, since this annex reflected only the provisional and non binding view of the Examining Division. Indeed, it is not unusual that objections under Article 84 EPC might be raised for the first time at oral proceedings, e.g. when dealing with the features used by the Applicant to distinguish its invention from the prior art.

2.4 Thus, in the Board's view, raising these objections for the first time at oral proceedings cannot *per se* amount to a substantial procedural violation. This could have led to a substantial procedural violation only if, contrary to Article 113(1) EPC, no opportunity had been given for the Applicant to consider these objections, if appropriate by way of an adjournment or a postponement of the oral proceedings, or by continuation of the proceedings in writing.

2.5 Consequently, the question of the alleged substantial procedural violation boils down to the question as to whether in the present case the Applicant was given an opportunity to comment on the objections which led to the refusal of the application.

2.6 In this connection it can be deduced from the minutes of the oral proceedings that the Applicant had had the opportunity to comment on the objections of lack of clarity of Claim 1 raised for the first time at the oral proceedings, since it argued in that respect that there was no need to limit the scope of Claim 1, since the novelty of product by process Claim 20 which was based on the process of Claim 1 had been formally acknowledged. It is further evident that the Applicant indicated that it did not intend to file any auxiliary requests, so that there was no reason for the Examining Division to consider an adjournment or postponement of the oral proceedings or to continue the procedure in writing.

2.7 Thus, the Board finds for the reasons indicated in paragraphs 2.3, 2.4, 2.5 and 2.6 above that the alleged substantial procedural violation has not been established. Consequently, the corresponding request of the Appellant for reimbursement of the appeal fee must be refused.

3. *Clarity of Claim 1*

3.1 It was held in the decision under appeal that Claim 1 lacked clarity (i) since the wording "under conditions such that" in Claim 1 lacked clarity "per se", and (ii) since an essential feature, i.e. a drying step

must be applied immediately before the coating step in order to obtain the required level of moisture of not greater than 0.1% by weight, was missing in that claim.

3.2 Concerning the feature "under conditions such that" it is firstly evident that this characteristic of the claimed invention cannot otherwise be defined more precisely without unduly restricting its scope. It is further clear that the result to be achieved (moisture content of the coated inorganic filler) is one which can be directly and positively verified by tests adequately defined in the description which do not require undue experimentation (cf. page 20, lines 10 to 18), and that the process steps to be taken in order to obtain this result are within the common general knowledge of the skilled person and can be determined by routine procedures (e.g. parameters of the drying process such as time or temperature).

3.3 Thus, in accordance with the principles set out in the decision T 68/85 (OJ EPO 1987, 228), the Board comes to the conclusion that this feature is not objectionable under Article 84 EPC.

3.4 Concerning the further objection, namely the alleged essential character of the feature that a drying step must be applied immediately before the coating step, it is clear, in the Board's view, from the description of the application in suit (cf. page 20, lines 13 to 16) that performing a drying step immediately before the coating step represents merely a preferred feature of the claimed process.

3.5 In that respect, while it is true that in the only example of the application in suit (i.e. Example 5 in Table 2) which shows the obtaining of a moisture level of less than 0.1% by weight, a specific drying step has been carried out before the coating step for a specific calcium carbonate filler, it cannot, however, be concluded from this specific example that such a step must inevitably be carried out for obtaining a coated filler having a moisture content not greater than 0.1% by weight.

3.6 Thus, the Board comes to the conclusion that the reasons given in the decision under appeal do not justify the refusal of the application. It follows that the decision under appeal must be set aside.

4. Since the decision under appeal only relied on the issue of clarity of Claim 1, it is considered appropriate, in accordance with Article 111(1) EPC, to remit the case to the first instance for further prosecution of the application.

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 Claims 1 to 22 as annexed to the decision under appeal.

3. The appeal fee shall not be refunded.

The Registrar: The Chairman:

E. Görgmaier R. Young