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**Datasheet for the decision  
of 5 March 2007**

**Case Number:** T 0601/04 - 3.3.06

**Application Number:** 95921014.7

**Publication Number:** 0711371

**IPC:** D21H 23/76

**Language of the proceedings:** EN

**Title of invention:**  
Manufacture of paper

**Patentee:**  
Ciba Specialty Chemicals Water Treatments Limited

**Opponent:**  
EKA CHEMICALS AB

**Headword:**  
Manufacture of paper/CIBA

**Relevant legal provisions:**  
EPC Art. 108, 56, 113  
EPC R. 84a(1)

**Keyword:**  
"Inventive step (yes)"

**Decisions cited:**  
G 0004/92

**Catchword:**  
-



Case Number: T 0601/04 - 3.3.06

**D E C I S I O N**  
of the Technical Board of Appeal 3.3.06  
of 5 March 2007

**Appellant:** EKA CHEMICALS AB  
(Opponent) Patent Department  
Box 11556  
S-100 61 Stockholm (SE)

**Representative:** -

**Respondent:** Ciba Specialty Chemicals Water Treatments  
(Patent Proprietor) Limited  
P.O. Box 38  
Low Moor  
Bradford  
West Yorkshire BD12 0JZ (GB)

**Representative:** -

**Decision under appeal:** Interlocutory decision of the Opposition  
Division of the European Patent Office posted  
11 March 2004 concerning maintenance of  
European patent No. 0711371 in amended form.

**Composition of the Board:**

**Chairman:** P.-P. Bracke  
**Members:** G. Dischinger-Höppler  
A. Pignatelli

## Summary of Facts and Submissions

I. This appeal is from the decision of the Opposition Division concerning maintenance in amended form of the European patent No. 0 711 371 entitled "Manufacture of Paper".

II. A notice of opposition had been filed against the granted patent, wherein the Opponent sought revocation of the patent on the grounds of lack of novelty and inventive step (Articles 100(a), 54 and 56 EPC). The opposition was based *inter alia* on the following documents:

(1) EP-A-0 235 893 and

(3) EP-A-0 499 448.

During opposition proceedings, the Patent Proprietor filed an amended set of claims as its only request in a letter dated 9 January 2003, the only independent Claim 1 reading:

"1. A process for making paper comprising

forming a thick stock cellulosic suspension having a solids content of at least 2.5% by weight from at least one thick stock component cellulosic suspension having a solids content of at least 2.5% by weight,

flocculating the thick stock by adding to the thick stock or to at least one thick stock component suspension a synthetic, substantially water soluble, first, polymeric material having a theoretical cationic

charge density of not more than around 3 meq/g and an intrinsic viscosity of at least 4 dl/g,

diluting the flocculated thick stock to form a thin stock having a solids content of not more than 2% by weight,

adding to the thin stock before drainage a coagulant selected from cationic inorganic coagulants and/or second polymers which have an intrinsic viscosity of below 3 dl/g and a theoretical cationic charge density of above 4 meq/g,

draining the thin stock through a screen to form a sheet,

and drying the sheet."

Dependent Claims 2 to 9 relate to preferred embodiments of the subject-matter of Claim 1.

III. Pursuant to requests made by both parties, the Opposition Division, under cover of a letter dated 4 February 2003, summoned to attend oral proceedings. The summons was accompanied by a communication, wherein the parties were informed of the Opposition Division's provisional opinion that the subject-matter of the claims was novel in view of the cited prior art. Concerning inventive step, the Opposition Division indicated that inventive step remained to be demonstrated at least in view of D1 and D3.

In response to the summons, the Opponent withdrew its request for oral proceedings in a letter dated 8 May 2003 and the Patent Proprietor announced not to attend the hearing in a letter dated 19 June 2003.

Oral proceedings before the Opposition Division were then held in the absence of both parties.

IV. In its decision, the Opposition Division found that the subject-matter of the claims of the Patent Proprietor's single request was novel and inventive in view of the cited prior art.

Concerning inventive step, the Opposition Division argued that the disclosure of D3 as the closest prior art differed from the subject-matter of Claim 1 in that the thick stock had a consistency of 2%, instead of at least 2.5% as called for in Claim 1. D3 contemplated the addition of a cationic flocculant either to the thick stock or to the thin stock. However, in the case of adding it to the thick stock, the consistency of 2% of the stock was rather low. In view of D3, a skilled person wishing to work with a higher consistency stock of at least 2.5% would, therefore, add the cationic flocculant to the thin stock as described in the examples of D3 and not to the thickened thick stock. From the remaining cited documents only D1 disclosed in a comparative example the addition of the cationic flocculant to the thick stock followed by the addition to the thin stock of bentonite instead of the claimed cationic inorganic coagulant. Since this example performed worst in terms of retention and since D1 taught that the best results were achieved when the polymer was added to the thin stock, a skilled person

was led away from the subject-matter of Claim 1 when combining the teachings of D3 and D1.

In its decision, the Opposition Division further demonstrated in an annex its view that it could be concluded from the examples illustrated in Tables 3 to 5 of the patent in suit that, compared with the processes disclosed in D3 and D1, the claimed method yielded enhanced values for formation and dewatering, while maintaining good drainage times (point 3.4 of the contested decision and annex thereto).

- V. This decision was appealed by the Opponent (hereinafter Appellant) who essentially argued in its statement of grounds of appeal dated 4 July 2004 that given the disclosure of D3, a skilled person would seriously contemplate thick stock addition of the cationic flocculant (retention aid). Moreover, the Opposition Division's conclusions made from the examples of the patent in suit were misleading since the examples did not indicate the solids content of the stocks used and no comparison was made with a process in accordance with D3, making use of thick stock addition of the cationic flocculant and thin stock addition of a cationic coagulant. Therefore, the technical problem actually solved by the process of Claim 1 in view of that of D3 consisted in the provision of an alternative process. However, solving this problem by concentrating the thick stock from a consistency of 2% to a value of at least 2.5% would not be inventive since the consistency range used to define a thick stock was broad, as was evident from D1, D3 and the patent in suit.

VI. Under cover of a letter dated 2 November 2004, the Respondent (Patent Proprietor) filed counter-arguments. In particular, it was argued that the disclosure of D1 was the closest prior art, that the claimed subject-matter differed therefrom in that a cationic coagulant was added to the thin stock after diluting the thick stock, which yielded improved formation and retention as compared with D1, and that D3 did not motivate a skilled person to use a cationic coagulant in order to improve formation and retention.

VII. In a communication dated 11 August 2006, sent as a registered letter with advice of delivery, the Board summarised the facts of the case as it stood, indicated its non-binding provisional opinion and allowed a two-month period of time for the parties to submit a reply. The content of the communication is as follows:

- "1. This communication refers to the amended set of 9 claims and the adapted description on the basis of which the Opposition Division decided to maintain the patent in suit (see interlocutory decision of the Opposition Division).
2. From the content of the file, it appears that the only issue open to be addressed in this appeal is whether or not the claimed subject-matter is based on an inventive step in view of D1 and D3.
3. In this respect, the Board wishes to draw the parties' attention to the Board's provisional and non-binding opinion.

3.1 Whilst the parties appear to disagree on the question whether D1 or D3 represent the closest prior art, the Board, at present, is of the opinion that both documents are equally suitable as a starting point for the assessment of inventive step since both address, inter alia, the technical problem underlying the patent in suit of providing a papermaking process that gives good retention, dewatering and formation properties (see patent in suit, page 3, paragraphs 20 and 21; D1, page 4, lines 48 to 53; D3, page 3, lines 54 to 56).

3.2 The parties, further, seem to disagree on the question whether the examples in the patent in suit as the only evidence on file provide a basis for an effect achieved by the claimed subject-matter in view of D1 and D3.

The Board notes that the Opposition Division, in its decision, was of the opinion that the examples of the patent in suit actually show an improvement in view of D1 and D3 and that no arguments to the contrary were submitted by the Appellant during opposition proceedings.

3.3 During the opposition proceedings, the Appellant merely stated that the claims as granted did not involve an inventive step since any feature of the claims not explicitly or implicitly disclosed in D1 or D3 would be clearly obvious in view of D4 to D8 (see page 4, fourth paragraph, of the notice of opposition). With its reply to the notice of opposition, the Respondent filed the now pending



amended set of claims and argued that the teaching of both D1 and D3 led away from the claimed process since D1 taught that the polymer must be added to the thin stock and D3 did not mention a cationic coagulant but taught to add an anionic coagulant after flocculation (see letter dated 9 January 2003, pages 3 and 4).

In its communication annexed to the summons to attend oral proceedings, dated 4 February 2003, the Opposition Division indicated that it still had to be demonstrated whether an inventive step was associated with the features distinguishing the claimed subject-matter from the disclosure of D1 and D3 (point 5.3).

None of the parties replied to this communication or attended the oral proceedings before the Opposition Division.

It appears that the Opposition Division then decided to give the benefit of doubt to the Respondent and, consequently, to maintain the patent in amended form since the parties did not provide the required further arguments or evidence. For this purpose, the Opposition Division compared the examples of the patent in suit and it seems that the decision under appeal is implicitly based on the fact that the Opposition Division was convinced that the thick stocks used in the examples contained always the same value of at least 2.5% by weight of solids and the thin stocks always the same value of at most 2% by weight. Otherwise, no comparisons could have been made by

the Opposition Division. Moreover, it further appears that the Opposition Division was of the opinion that, due to the low consistency of only 2%, the thick stock mentioned in D3 corresponded to the thin stock rather than to the thick stock of the patent in suit (point 3.2 of the decision). The examples in Table 4 and the fourth example in Table 6 of the patent in suit appear, therefore, to be representative for the thick stock addition of cationic retention aid mentioned in D3.

- 3.4 The Appellant, in its statement of grounds of appeal appears to question for the first time an improvement over both, the disclosure of D1 and D3 based on the arguments that the examples did not indicate the solids content of the stocks used and since no comparison was made with an embodiment, allegedly disclosed in D3, in which the cationic retention aid was added to the thick stock and a cationic coagulant was added to the thin stock.

However, it appears for the reasons set out above that the decision under appeal implicitly deals with those arguments. Therefore, it might appear that the Appellant merely contests the decision under appeal which might be insufficient at the present stage of proceedings.

In other words, it might appear that the Appellant, who carries the burden of proof in the present appeal case, failed to prove that the decision of the Opposition Division was wrong since the claimed process actually did not provide an improvement in formation and dewatering while

maintaining good drainage times when compared with the processes disclosed in D1 or D3 (see also Case Law of the Boards of Appeal of the European Patent Office, 4th edition 2001, chapter VI.J.6.2).

4. The Board wishes to note that under the circumstances of the case as it stands, it seems that the benefit of doubt must still be given to the Respondent, irrespective of whether D1 or D3 is used as the starting point for assessing inventive step. The reasons are as follows:

If D1 was used as the starting point, the Board does not have sufficient evidence to conclude that the Respondent's arguments presented in its letter dated 2 November 2004 which are based on an improvement of retention and drainage were wrong.

If D3 was used as the starting point, and considering the effect identified by the Opposition Division in its decision (point 3.4 and figure), the technical problem actually solved by the claimed subject-matter appears to consist in an improvement of formation and dewatering at good drainage and the solution seems to consist in that the cationic flocculant is added at a consistency of at least 2.5%. It appears that D3 does not contain any hint either that any additive might be added at a consistency higher than 2% or that alum (or any cationic coagulant) might be added at a different consistency than the flocculant. It further appears that the disclosure of D1 is rather counter-intuitive since it suggests in Example 12 that the retention is considerably

worsened if the cationic flocculant is added to thick stock of 3.5% consistency instead of to thin stock of 0.7% consistency.

5. Any reply of the parties to this communication should be filed within two months of its deemed date of receipt."

VIII. Neither of the parties replied to this communication.

IX. The Appellant requests that the decision under appeal be set aside and that the patent be revoked.

It follows from the letter dated 2 November 2004 that the Respondent requests that the appeal be dismissed.

The Respondent further requests oral proceedings in case its above request is rejected. No request for oral proceedings was made by the Appellant.

## **Reasons for the Decision**

### 1. *Amendments and novelty*

The Board is satisfied that, for the reasons set out in the contested decision, the amendments made to the claims meet the requirements of Article 123(2) and (3) EPC and the claimed subject-matter complies with the requirements of novelty in accordance with Articles 52(1) and 54 EPC. Since no objections have been made by the Appellant in this regard, no further reasons need to be given.

2. *Inventive step*

The Appellant essentially based its case on the argument that no beneficial effect was demonstrated for the claimed subject-matter in view of the disclosure of D3 and that, therefore, the technical problem actually solved by the claimed subject-matter in view of that prior art was to provide an alternative process.

2.1 As set out in the Board's communication dated 11 August 2006 (point 3 of the communication), the Appellant carries the burden of proving its allegation that the decision of the Opposition Division was wrong since the claimed process did not provide an improvement when compared with the process of D3. Reference was made in this respect to the Case Law of the Boards of Appeal of the European Patent Office, 4th edition, 2001 (chapter VI.J.6.2) according to which it is the established jurisprudence of the Boards of Appeal that in a case where a party has achieved a favourable decision at first instance, the burden of proof shifts to the other party which then must disprove or at least negate the evidence relied on in the contested decision in order to achieve a decision in its favour.

2.2 In the present case, the contested decision in favour of the Respondent was based on an effect which the Opposition Division deemed to have been achieved by the claimed subject-matter. Therefore, the Appellant was informed by the Board in its communication (points 3 and 4) that it might not be sufficient for the Appellant to merely doubt the finding of the Opposition Division and that the benefit of doubt must still be

given to the Respondent if the Appellant did not provide evidence to disprove said finding.

2.3 As the Appellant has not submitted evidence in support of its allegation and not even replied to the Board's communication, the Board has no reason to deviate from the conclusions drawn in its communication in regard of inventive step and, thus, is satisfied that the subject-matter of Claim 1 meets the requirements of Articles 52(1) and 56 EPC for the reasons set out in the communication.

2.4 The dependent Claims 2 to 9 refer to specific embodiments of Claim 1 and derive their patentability therefrom.

3. *Procedural matters*

The present decision against the Appellant was delivered in accordance with Rule 84a(1) EPC. It could be given in writing since the Appellant has neither requested oral proceedings nor used the occasion to submit further arguments in reply to the Board's communication and since the Respondent's request for oral proceedings was only conditional (points VIII and IX). As the decision is, further, based only on the facts and evidence already put forward during the written proceedings, in particular as set out in the Board's communication, the Appellant's right to be heard under Article 113(1) EPC within the meaning of opinion G 4/92 (OJ EPO 1994, 149) was not violated by issuing this decision without a summons to a hearing.

**Order**

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

The appeal is dismissed.

The Registrar:

The Chairman:

G. Rauh

P.-P. Bracke