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

Case Number: T 0836/04 - 3.3.03

Application Number: 99960030.7

Publication Number: 1159336

IPC: C08G 69/48

Language of the proceedings: EN

Title of invention:

Intrinsically gel-free, randomly branched polyamide

Patentee:

DSM IP Assets B.V.

Opponent:

BASF Aktiengesellschaft, Ludwigshafen

Headword:

-

Relevant legal provisions:

EPC Art. 113(1)

Keyword:

"Substantial procedural violation (yes)"

Decisions cited:

T 0263/93

Catchword:

-



Case Number: T 0836/04 - 3.3.03

D E C I S I O N
of the Technical Board of Appeal 3.3.03
of 3 August 2006

Appellant:
(Patent Proprietor)

DSM IP Assets B.V.
Het Overloon 1
D-6411 TE Heerlen (NL)

Representative:

Krijgsman, Willem
DSM Intellectual Property
Office Geleen
P.O. Box 9
NL-6160 MA Geleen (NL)

Respondent:
(Opponent)

BASF Aktiengesellschaft, Ludwigshafen
-Patentabteilung - C6-
Carl-Bosch-Strasse 38
D-67056 Ludwigshafen (DE)

Representative:

-

Decision under appeal:

Decision of the Opposition Division of the
European Patent Office posted 3 May 2004
revoking European patent No. 1159336 pursuant
to Article 102(1) EPC.

Composition of the Board:

Chairman: R. Young
Members: C. Idez
E. Dufrasne

Summary of Facts and Submissions

I. The grant of the European patent No. 1 159 336 in the name of DSM N.V (later DSM IP Assets B.V), in respect of European patent application No. 99 960 030.7 filed on 13 December 1999 and claiming priority of the NL patent application No. 1010819 filed on 16 December 1998 was announced on 25 September 2002 (Bulletin 2002/39) on the basis of 11 claims.

Independent Claims 1, 9, 10 and 11 read as follows:

1. Intrinsically gel-free, randomly branched polyamide comprising at least units derived from:
 1. AB monomers, which monomers have both a carboxylic group (A) and an amine group (B),
 2. at least one compound I, being a carboxylic acid (A_v) having a functionality $v \geq 2$ or an amine (B_w) having a functionality $w \geq 2$,
 3. at least one compound II, being a carboxylic acid (A_v) having a functionality $v \geq 3$ or an amine (B_w) having a functionality $w \geq 3$, compound II being a carboxylic acid if compound I is an amine or compound II being an amine if compound I is a carboxylic acid, characterized in that the amounts of units derived from all carboxylic acids and amines in the polyamide satisfy formula 1

$$P < 1 / [(F_A - 1) \cdot (F_B - 1)] \quad (1)$$

where:

$$P = [\sum (n_i \cdot f_i)]_x / [\sum (n_i \cdot f_i)]_y \quad (2)$$

where $P \leq 1$ and either $X = A$ and $Y = B$, or $X = B$ and $Y = A$, and

$$F_X = \frac{\sum(n_i \cdot f_i^2)}{\sum(n_i \cdot f_i)} \quad (3)$$

for, respectively, all carboxylic acids ($X = A$) and all amines ($X = B$), where f_i is the functionality of either the carboxylic acid ($f_i = v_i$) or amine ($f_i = w_i$), n_i being the number of moles of the carboxylic acid or amine and the summation involving all units derived from carboxylic acids and amines in the polyamide except:

randomly branched polyamides comprising units derived from carboxylic acids (A_v) having a functionality v and amines (B_w) having a functionality w , in the following amounts (in $\mu\text{mol/g}$ of polyamide):

- B_1 (20), B_3 (60) and A_2 (20)
- B_1 (10), B_3 (60) and A_2 (30)
- B_1 (120), B_2 (30) and A_3 (60)
- B_1 (150), B_2 (30) and A_3 (70)
- B_1 (170), B_3 (30), A_2 (60) and A_3 (60).

9. Process for the preparation of a polyamide film, characterized in that a polyamide according to any one of claims 1-8 is chosen as polyamide.
10. Fibre, film, foam or moulded article obtained from a polyamide according to any one of claims 1-8.
11. Flat film obtained from a polyamide according to any one of claims 1-8."

II. On 24 June 2003, a Notice of Opposition was filed by BASF AG, in which revocation of the patent as a whole was requested on the grounds of Article 100(a) (lack of novelty, lack of inventive step), Article 100(b) (insufficient disclosure) and Article 100(c) EPC (extension of disclosure). Oral proceedings were requested in the case this request should not be granted in the written procedure.

The opposition was supported by the following documents:

D1: EP-A-345 648; and

D2: DE-A-19 654 179.

In the Notice of Opposition, the Opponent argued that the disclaimer incorporated in granted Claim 1 was not allowable under Article 123(2) EPC. Concerning Article 100(b) EPC, the Opponent submitted that the patent in suit did not disclose the invention in a manner sufficiently complete for it to be carried out by a person skilled in the art, since there was no indication in the patent in suit how the parameter "gel-free" should be determined.

Concerning novelty, the Opponent submitted four Figures 1 to 4 based on calculations derived, in its opinion, from the disclosure of documents D1 and D2, in order to show that there was an overlap between the subject-matter of Claim 1 of the patent in suit and the disclosures of D1 and D2.

- III. In its letter dated 9 December 2003, the Patentee submitted that the disclaimer in granted Claim 1 was present in the application as originally filed. Concerning Article 100(b) EPC it pointed out that in Claim 1 reference was made to "intrinsically gel free" and not to "gel free" polyamides. It hence argued that it was the specific choice of the specific components which gave the claimed polyamides the property of being "intrinsically gel-free".
- Concerning novelty it contested the validity of Figures 1 to 4 submitted by the Opponent. It further argued that the possibly novelty destroying examples of D1 had been disclaimed, and that in the range of overlap there was the novel technical teaching of the polyamide compositions to be intrinsically gel free. Consequently, Claim 1 must be considered as novel over D1.
- IV. In its letter dated 5 April 2004, the Opponent conceded that Figure 3 submitted with its Notice of Opposition was not correct. It submitted new Figures 1 to 4, in which the zones corresponding to the non intrinsically gel free polyamides were coloured in grey and the zones corresponding to the respective disclosure of D1 (diagrams 1 and 4) and D2 (diagrams 2 and 3) were coloured in blue.
- In the Opponent's view Figures 1 and 4 showed the overlap between D1 and Claim 1 of the patent in suit and Figures 2 to 3 the overlap between D2 and Claim 1 of the patent in suit.

V. By a decision dated 3 May 2004, the Opposition Division revoked the patent for lack of novelty. More precisely, the Opposition Division rejected the grounds of opposition under Articles 100(b) and 100(c) EPC raised by the Opponent but came to the conclusion that document D1 was a novelty destroying document for the subject-matter of Claim 1 of the patent in suit. In that respect, the Opposition Division considered, that it was, in its view, not clear how the teaching of D1 would have to be correctly drawn in Figure 1 submitted with letter dated 5 April 2004 of the Opponent. It nevertheless took the view, that the representation in that figure of Examples 9 and 14 of D1 which have been disclaimed (cf. third and fourth disclaimer in Claim 1 of the patent in suit) was correct. Since, according to that figure, these two examples were very close to each other, the Opposition Division stated that in the vicinity of these two examples the area of the part which is according to Claim 1 of the patent in suit intrinsically gel free and the part as defined in Claim 1 of D1 overlapped. The Opposition Division did not accept the argument of the Patentee that in the range of overlap there was the novel technical teaching of the polyamide being "intrinsically gel free" and it considered that the skilled person, on the basis of the general disclosure of D1 and the specific values of Examples 9 and 14, would seriously have contemplated applying the technical teaching of D1 in the vicinity of the Examples 9 and 14. Consequently, according to the Opposition Division, the claimed range of "intrinsically gel-free polyamides" was not new.

VI. Notice of Appeal was filed on 23 June 2004 by the Appellant (Patentee) with simultaneous payment of the prescribed fee.

With the Statement of Grounds of Appeal filed on 12 August 2004, the Appellant filed a set of Claims 1 to 16 as new main request.

In the Statement of Grounds of Appeal, the Appellant submitted that the argument of the Opposition Division according to which the subject-matter of Claim 1 was not novel, since the skilled person would seriously contemplate applying the technical teaching of D1 in the vicinity of the examples of D1, had not been raised by the Opponent and had been communicated to the Patentee for the first time in the decision revoking the patent.

Consequently, in the Appellant's view, the decision of the Opposition Division violated Article 113(1) EPC. Maintenance of the patent on the basis of the Main Request and the reimbursement of the appeal fee were requested. Oral proceedings were requested in the case the Board did not intend to grant these requests.

VII. In its letter dated 4 November 2004, the Respondent (Opponent) indicated that it relied on its arguments presented in its Notice of Opposition, and requested a decision according to the state of the file.

VIII. In a communication dated 16 November 2005, the Board informed the Parties of its the provisional view that the requirements of Article 113(1) EPC could not be considered as having been complied with in the decision under appeal. The Board was thus of the provisional opinion that the decision of the Opposition Division should be set aside, that the appeal fee be reimbursed,

and that the case should be remitted to the first instance for further prosecution on the basis of the main request submitted by the Appellant with its Statement of Grounds of Appeal. Consequently, the Appellant was invited to reconsider its request for oral proceedings before the Board.

- IX. In its letter dated 23 February 2006, the Appellant withdrew its request for oral proceedings provided the decision of the opposition division would be set aside, the appeal fee be reimbursed, and the case be remitted to the first instance for further prosecution on the basis of the main request submitted with the Statement of Grounds of Appeal.

Reasons for the Decision

1. The appeal is admissible.
2. *Article 113 (1) EPC*
 - 2.1 According to decision T 263/93 of 12 January 1994 (not published in OJ EPO) the right to be heard laid down in Article 113(1) EPC requires that the party concerned be given sufficient time to submit an adequate response, if the EPO decides to communicate to a party to proceedings before it an objection raised by another party without an express invitation to reply within a specified time limit. As stated in that decision, although the length of the period of time necessary to comply with that requirement depends on the particular circumstances of the case, a party to opposition proceedings before the EPO can fairly expect that it

- would normally have at least two months to present its comments to such objections, before a decision based on them is taken (point 2.2.2 of the reasons).
- 2.2 In the present case, the Board firstly notes that the letter of the Opponent dated 5 April 2004 had been communicated to the Patentee on the 21 April 2004 by the EPO with the further mention "the coloured documents will follow".
- 2.3 The Board further notes that the decision of the Opposition Division revoking the patent in suit had been issued on 3 May 2004, i.e. only 12 days after the communication of the letter of 5 April 2004 of the Opponent to the Patentee and that the "coloured documents" mentioned in the communication of the EPO of 21 April 2004 were sent to the Patentee by the EPO on 4 May 2004, i.e. after the issue of the decision by the Opposition Division.
- 2.4 The Board also observes that the reasoning given in the contested decision contains essential elements derived specifically from the letter of the Opponent dated 5 April 2004 in respect to the question of novelty (cf. point V above).
- 2.5 Having regard to the case law mentioned above, the 12 day period which elapsed between the date of communication (i.e. 21 April 2004) by the EPO to the Patentee of the letter of the Opponent dated 5 April 2004 and the issuing of the decision revoking the patent on 3 May 2005 was manifestly too short to give the Patentee an adequate opportunity for comment.

- 2.6 Consequently, in accordance with the reasoning of decision T 263/93, for the above reasons, the contested decision must be regarded as procedurally flawed in a fundamental manner, so that the requirements of Article 113(1) EPC cannot be considered as having been complied with.
- 2.7 Although this substantial procedural violation already justifies setting aside the decision under appeal, the Board notes that a further substantial procedural violation has been alleged by the Appellant on the grounds that the conclusion of the Opposition Division that the subject-matter of Claim 1 lacked novelty was based on arguments which were communicated to the Appellant for the first time in the decision revoking the patent.
- 2.7.1 In that respect, it is noted by the Board that the objection of lack of novelty raised by the Opponent in view of D1 and D2 was based on the grounds that there was an overlap between the subject-matter of Claim 1 of the patent in suit and D1 and D2, and that this overlap was illustrated, in the Opponent's view, initially by Figures 1 to 4 filed with its Notice of Opposition.
- 2.7.2 It is also noted by the Board that the validity of the previous Figures 1 to 4 submitted by the Opponent with its Notice of Opposition has been contested by the Patentee in its letter dated 9 December 2003, and that this led the Opponent to file the new Figures 1 to 4 with its letter dated 5 April 2004 in order to illustrate this overlap.

2.7.3 In this connection, the Board observes that one of the main arguments of the Opposition Division for justifying, in its view, the lack of novelty of the subject-matter of Claim 1 of the patent in suit, was that, in the vicinity of the disclaimed Examples 9 and 14 of D1, which according to the Opposition Division were quite close to each other in the new Figure 1, the areas of the part which was intrinsically gel free (according to Claim 1 of the patent in suit) and the part as defined in Claim 1 of D1 overlapped.

2.7.4 It is hence clear that the reasoning of the Opposition Division has found, in the Board's view, its origin in the new Figure 1 submitted with the letter dated 5 April 2004, and that, consequently, this line of arguments has not been communicated to the Patentee before the issuing of the decision by the Opposition Division.

2.7.5 The same is also true for the subsequent argument of the Opposition Division in its decision that the skilled person would have seriously contemplated applying the technical teaching of D1 also in the vicinity of said Examples 9 and 14 of D1.

2.8 According to Article 113(1) EPC, decisions of the EPO may only be based on grounds on which the party concerned has had an opportunity to comment. In the present case, it is, however, evident that the Appellant did not have an opportunity to present its comments with regard to the grounds which led to the revocation of the patent in suit for lack of novelty in view of document D1.

- 2.9 Consequently, for these reasons also, the requirements of Article 113(1) EPC have not been complied with in the decision under appeal.
3. These substantial procedural violations justify setting aside the decision of the Opposition Division and the remittal of the case to the first instance.
4. Since the appeal of the Patentee is successful to the extent that the decision under appeal is to be set aside and since, in view of the foregoing, reimbursement of the appeal fee is equitable because of the substantial procedural violations, the requirements of Rule 67 EPC are met and the appeal fee should be reimbursed to the Patentee (Rule 67 EPC).

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 16 submitted by the Appellant with its Statement of Grounds of Appeal filed on 12 August 2004.
3. Reimbursement of the appeal fee is ordered.

The Registrar:

The Chairman:

E. Görgmaier

R. Young