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**Datasheet for the decision
of 15 February 2012**

Case Number: T 0019/05 - 3.3.05

Application Number: 98961103.3

Publication Number: 1027120

IPC: B01D 11/02

Language of the proceedings: EN

Title of invention:

Process and plant to extract and concentrate tannins from wood
and from other natural products

Patent Proprietor:

Proras S.R.L.

Opponent:

Nuova Rivart S.P.A.

Headword:

Tannin concentration/PRORAS

Relevant legal provisions:

EPC Art. 52(1), 54(1)(2), 56

Keyword:

"Availability to the public of relevant technical information
(no)"

"Novelty (yes) - cited documents are not state of the art"

"Inventive step (yes) - opponent's reasoning based on
information not made available to the public"

Decisions cited:

T 0799/91, T 0037/96, T 1081/01, T 1134/06

Catchword:

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Case Number: T 0019/05 - 3.3.05

D E C I S I O N
of the Technical Board of Appeal 3.3.05
of 15 February 2012

Appellant: Nuova Rivart S.P.A.
(Opponent) S.S. Cassia Km. 149
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Representative: Corradini, Corrado
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Respondent: Proras S.R.L.
(Patent Proprietor) Via Brenta, 2/A
I-00198 Roma (IT)

Representative: Gervasi, Gemma
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Decision under appeal: Decision of the Opposition Division of the
European Patent Office posted 12 November 2004
rejecting the opposition filed against European
patent No. 1027120 pursuant to Article 101(2)
EPC.

Composition of the Board:

Chairman: G. Rath
Members: B. Czech
C. Vallet

Summary of Facts and Submissions

I. The appeal is from of the decision of the opposition division rejecting the opposition against European Patent No. 1 027 120.

II. Independent claims 1 and 15 of the patent as granted read as follows:

"1. Process to extract and concentrate tannin from solid natural products containing it, said process comprising the steps of subjecting the solid products to an extraction by percolation with an extracting medium constituted by water and/or steam as solvent, followed by a filtration step to stop particles greater than 10 μ m and concentrating the thus obtained aqueous tannin solution by nanofiltration with spiral wound membranes, said membranes being selected among the polyethersulfonic or polyamidic ones."

"15. Plant for carrying out the process of claim 1 comprising: an extraction unit (1) in which the solid material is subjected to an extraction by percolation with an extracting medium constituted by water and/or steam as solvent; a filtration unit (3) to stop particles greater than 10 μ m; a nanofiltration unit (5) operating with spiral wound membranes, said membranes being selected among the polyethersulfonic or polyamidic ones."

III. In the first instance proceedings, the parties referred *inter alia* on the following evidence:

- B1/B1': Technical Report of ADES S.R.L. dated July 1997
and translation thereof into English
- B2: Offer and cost estimate made by Hydro Air
Research S.R.L. to Sadepan Chimica S.R.L. dated
28 October 1997
- B7: Printout of several pages from the "Millipore"
internet product catalogue
- B8: Declaration of Mr Dalla Croce,
employee/director of the appellant
- B9: Declaration of Mr Ricciarelli, former director
of the appellant
- B10: Declaration of Mr Rizzi, technical consultant
of the appellant and Sadepan Chimica S.R.L.
- D1: CZ 283179 B

IV. In the contested decision, the opposition division observed that no evidence had been provided which proved that document B1 or document B2 made its way to the public, or that the information contained in B7 was accessible to the public before the priority date of the patent in suit. The opposition division concluded that documents B1, B2 and B7 did "not constitute state of the art within the meaning of Article 54(2) EPC". Anyway, the opposition division considered that document B1 did not anticipate the subject-matter of independent claims 1 and 15 of the patent in suit since it was not disclosed in B1 to use

i) spiral wound membranes ("SWM" hereinafter),

ii) which are either polyetherosulphonic or polyamidic,
iii) and a pre-filtration unit to stop particles
greater than 10 µm.

During the oral proceedings on 21 October 2004, the
opponent, although being prompted by the opposition
division, did not present an attack on inventive step
based on other documents than B1, B2 and B7 (see
point 7 of the minutes). The opposition division did
not raise such an objection either and came to the
conclusion that the patent as granted met the
requirements of the EPC.

V. In its statement of grounds of appeal, the
appellant/opponent (Nuova Rivart S.P.A.) maintained
that the claimed subject-matter did not involve an
inventive step. As a proof of the "sale" of document B1
by ADES S.R.L. to the appellant, the latter
additionally filed document

B11: Offer letter of ADES S.R.L. to Nuova Rivart S.p.a.
dated 9 June 1997 signed by Prof. Mustacchi
(Director).

VI. In its reply, the respondent (patent proprietor)
considered the appeal to be inadmissible and rebutted
the objection of the appellant regarding inventive step.

VII. The board issued a communication wherein it
i) indicated that documents B2 and B11 would only be
considered provided a translation into one of the
official languages of the EPO was filed within a time
limit set by the communication;
ii) drew the parties' attention to decision T 1134/06
concerning the "*consideration of internet disclosures*

such as D[sic]7" (B7 was obviously meant); and
iii) pointed out that in the absence of a request for oral proceedings from the appellant, a decision negatively affecting the latter could be taken at any time after the expiry of the time limit set by the communication.

VIII. In response to said communication the appellant filed documents B2' and B11', namely translations of documents B2 and B11 into English, without any further comments or requests addressing the issues raised by the respondent or the board.

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

The **appellant** (opponent) held that document B1 had been made available to the public by virtue of having been sold to him. The sale of B1 was confirmed by document B11. After said sale, no confidentiality existed for the purchaser (opponent), who divulged the content of B1 to a possible supplier of the installation, namely to the company Hydro Air Research which prepared document B2. The appellant thus considered that the content of document B1 pertained to the state of the art.

Concerning the issue of inventive step, the appellant referred to some of its written submissions made during the opposition proceedings and confirmed the arguments set forth therein. Moreover, it held that, irrespective of the availability of document B1 to the public, this document contained a statement which was to be

understood as "a clear indication that the invention does not involve any inventive step".

Furthermore, the appellant held that adopting the features of claim 1 which were not disclosed in the "prior art available to the Examiner", i.e.

- i) the use of SWM membranes,
 - ii) selected from polyethersulfonic or polyamidic membranes, and
 - iii) an upstream pre-filtration step suitable for stopping all particles > 10 µm,
- was not inventive in view of document B7, which document disclosed SWM "Millipore Helicon RO 300" membranes requiring pre-filtration.

With respect to document B7, the appellant argued that the "date of the document does not seem to be so important, because it discloses a feature (pre-filtration) which is common to all the SWM membranes, and the SWM membranes were well known at the priority date of the patent in suit, so as it has been acknowledged by the Examining Division".

The **respondent** held that the appeal was not admissible since the appellant merely contested the decision without presenting new information or evidence in order to overcome the objections of the opposition division.

The respondent also maintained that no evidence of the alleged public availability of the content of documents B1, B2 and B7 before the priority date of the patent in suit had been provided by the appellant, although the burden of proof rested on the latter in this respect. Document B11 merely confirmed the existence of a

relationship between ADES and the appellant, which relationship had, however, already been acknowledged by the opposition division.

Since documents B1 and B7 did not belong to the prior art, attacks on inventive step based thereon should be dismissed. The respondent also pointed out that at the oral proceedings before the opposition division, the opponent had not submitted any inventive step objection based on other documents than B1, B2 and B7.

- X. The appellant requested that the decision under appeal be set aside and that the patent be revoked.

The respondent requested that the appeal be dismissed.

Reasons for the Decision

- 1. Admissibility of the appeal
 - 1.1 The board is satisfied that the appeal of the opponent meets the requirements of Article 108 und Rule 64 EPC 1973.
 - 1.2 Said provisions do not require that an appellant submits new information or evidence in order for the appeal to be admissible. The reference, by the respondent, to the Guidelines E-XI, 7.1(iii) is of no relevance in the present case, since the passage in question is concerned with criteria for interlocutory revision in ex parte cases (see Article 109(1) EPC).
 - 1.3 Hence, the appeal of the opponent is admissible.

2. Availability of documents B1, B2 and B7 to the public

2.1 Document B1

2.1.1 According to the appellants own submissions (see grounds for opposition, point 1.1), it was the appellant that approached Prof. Mustacchi and commissioned a study concerning a process for concentrating tannin solutions using membranes. The study was carried out by the company ADES S.R.L. in collaboration with employees of the appellant, was fully paid by the appellant and resulted in technical report B1, which mentions the involvement of *inter alia* Prof. Mustacchi (see last page). Copies of document B1 were given to the appellant in July 1997. None of this was disputed by the respondent.

2.1.2 Document B11 is an offer and cost estimate signed by Prof. Mustacchi in the name of ADES S.R.L., and is addressed to the Nuova Rivart S.p.a., i.e. the present appellant. B11/B11' specifies the price for carrying out a "Feasibility study for a tannin production plant" and refers to "preliminary contents" thereof indicated in "enclosure A", which enclosure is not, however, part of the document B11.

For the board, B11 corroborates that it was the study commissioned by the appellant that led to the preparation of the report B1. It is also credible that the appellant paid an amount as specified in document B11 (see "terms of payment" in B11') upon receipt of the report B1.

2.1.3 As already noted by the opposition division, B1 is a company generated technical paper and can thus not be assumed to have automatically made its way to the public, see e.g. decision T 0037/96 of 7 February 2000, point 2.1.2 of the reasons. Moreover, the study which resulted in report B1 was commissioned and paid for by the appellant, who provided the initial input, and closely cooperated with ADES S.R.L. during the study.

2.1.4 Hence, the payment made by the appellant to ADES S.R.L. cannot be equated to a conventional sale of a printed company generated paper by a first company to any customer, i.e. an economically unrelated second company. On the contrary, the study was thus undertaken within the framework of a close technical/business cooperation between ADES S.R.L. and the appellant. Such a cooperation is usually based on trust and hence under a tacit confidentiality agreement. For the board, the commissioning of the study established a special relationship (in the sense of decision T 1081/01 of 27 September 2004, reasons points 6 to 8) between the donor of the information, i.e. ADES S.R.L., and its recipient, i.e. the appellant. Consequently, in the board's judgement, the appellant and its employees (see e.g. declarations B8 and B9) and consultants (see e.g. declaration B10) cannot be considered to be members of the public within the meaning of Article 54(2) EPC.

2.1.5 There is also no evidence on file, and it was not argued, that the content of document B1 was made available to any member of the public, i.e. to somebody unrelated to ADES S.R.L. or the appellant before the effective filing date of the patent in suit and without an at least tacit confidentiality agreement.

2.1.6 In the board's judgement it has not been shown that document B1 or its contents were made available to the public before the effective filing date of the patent in suit. Hence, the disclosure of document B1 does not pertain to the state of the art pursuant to Article 54(2) EPC.

2.2 Document B2

2.2.1 Document B2 is an offer bearing the number "Estimate P-3090" and made by Hydro Air Research S.R.L. This project cost estimate (see B2', page 5, Part "1. Premises") concerns a plant for treating a pre-filtered/clarified liquid containing tannin and stemming from a chestnut extraction step involving membrane ultrafiltration and evaporation to obtain a tannin concentrate.

2.2.2 The offer had been requested by Sadepan Chimica S.R.L., a "sister company" of the appellant in the latter's own words, i.e. a company in very close business relationship with the appellant (see the appellant's notice of opposition, point 2.1). According to the appellant, the offer is based on information, more particularly the content of document B1, provided by Sadepan Chimica S.R.L. to Hydro Air Research S.R.L. within the framework of a commercial relationship which is usually based on trust and hence under a tacit confidentiality agreement. The company Hydro Air Research S.R.L. can thus be considered as a "subcontractor" in the sense of decision T 0799/91 of 3 February 1994, point 4.1 of the reasons. Hence, the board does not consider it as any "third party" or "member of the public". Moreover, said request for an

offer clearly established a special relationship in the sense of decision T 1081/01 (points 6 to 8 of the reasons) between the donor of the information, i.e. Sadepan Chimica S.R.L. and the appellant, and its recipient, i.e. Hydro Air Research S.R.L. Consequently, employees of the latter cannot be considered as members of the public.

2.2.3 Moreover, there is no evidence on file showing that Hydro Air Research S.R.L. made document B2 available to a member of the public, i.e. to a person not employed by or in business relationship with Sadepan Chimica S.R.L or the appellant.

2.2.4 In the board's judgement the content of document B2 was thus not made available to the public before the (effective) filing date of the patent in suit and without a confidentiality agreement. Hence, document B2 does not pertain to the state of the art pursuant to Article 54(2) EPC either.

2.3 Document B7

2.3.1 Document B7 consists of a printout of web pages relating to membrane separation products commercialised by the company Millipore.

2.3.2 According to the case law of the boards of appeal of the EPO, if an internet disclosure is to be used as prior art, a strict standard of proof should be adopted. The particular facts and evidence required will normally have to answer inter alia the questions of when the internet disclosure was made available to the public and under which circumstances it was made

available to the public (see e.g. T 1134/06 of 16 January 2007, reasons point 4.1).

- 2.3.3 The date on which the printout was made is not apparent from document B7. The printout could thus have been made when the opposition was filed, i.e. after the publication of the granted patent. Moreover, as was already noted in the contested decision, document B7 contains no reference to the date at which said web pages were uploaded and their contents thus made available to the public.
- 2.3.4 No supporting evidence was provided during the opposition procedure which showed that the information content of B7 had been available to the public before the effective filing date of the patent in suit. Despite the findings of the opposition division and the general remark in the board's communication (point 2), no such evidence was submitted in the appeal proceedings either.
- 2.3.5 Since the availability to the public of the information content of B7 before the effective filing date of the patent in suit is not proven, the board sees no reason for overturning the finding of the opposition division in this respect. Hence, in the board's judgement, the information contained in document B7 does not pertain to the state of the art pursuant to Article 54(2) EPC either.
- 2.3.6 The argument of the appellant, according to which the date of the document "does not seem to be so important", is rejected. Due to the missing publication date information, document B7 cannot even serve the purpose

of establishing, as common general knowledge, that pre-filtration was a feature in common to all "SWM membranes" before the effective filing date of the patent in suit, as alleged by the appellant.

3. Novelty

3.1 Article 54(1) EPC stipulates that "an invention is considered as new if it does **not form part of the state of the art**" (emphasis added).

3.2 Article 54(1) EPC defines the state of the art to be taken into account as "everything made available to the public before the date of filing of the European patent application".

3.3 As noted by the respondent, the appellant raised no novelty objection in its statement of grounds of appeal. The board is also satisfied that none of the documents cited in the opposition proceedings that pertain to the state of the art pursuant to Article 54(2) EPC disclose a process or a plant according to claims 1 to 23. Since this was not in dispute, a detailed reasoning need not be given.

3.4 Hence, the subject-matter of claims 1 to 23 meets the novelty requirement (Article 52(1) and 54(1)(2) EPC).

4. Inventive step

4.1 Article 56 EPC stipulates that "an invention shall be considered as involving an inventive step if, **having regard to the state of the art**, it is not obvious to a person skilled in the art (emphasis added).

- 4.2 The assessment of inventive step according to the so-called "problem-solution-approach" applied by the boards of appeal comprises the following steps:
- i) recalling briefly what the invention is all about; here a process (claim 1) and a plant (claim 15) for extracting and concentrating tannin from solid natural products);
 - ii) identifying the closest prior art;
 - iii) determining the technical problem underlying the invention;
 - iv) identifying the solution proposed by the patent in suit;
 - v) assessing the success of the solution and, if required, reformulating the technical problem; and
 - vi) concluding on the obviousness of the solution in view of the state of the art.

4.3 The board notes that the appellant chose not to follow this approach. In particular, it neither clearly identified a specific document pertaining to the state of the art as closest prior art nor determined the technical problem to be solved in the light of this prior art. Moreover, the board observes that since documents B1, B2 and B7 do not belong to the state of the art pursuant to Article 54(2) EPC, inventive step objections involving considerations based on the disclosures of one or more of these documents cannot possibly lead to the conclusion (step vi mentioned above) that the claimed subject-matter was obvious **in view of the state of the art**. This is the case for all the following lines of argument submitted by the appellant, which must thus fail for this reason.

4.3.1 It is not clear whether the reference of the appellant (statement of grounds of appeal, page 3, fourth paragraph) to "the inventive difference of the subject-matter of claim 1 over the prior art available to the **Examiner**" (emphasis added) relates to the disclosure of document B1 (see point IV above) or to the disclosure of document D1, which was considered to represent the closest prior art in the pre-grant examination proceedings (see opponent's letter of 14 September 2004, point 3).

However, irrespective of whether D1 or B1 was supposed to be the starting point, the missing features (i.e. pre-filtration for stopping particles > 10 µm, SWM modules with polyethersulfonic or polyamidic membranes) were alleged to be obvious in view of document B7.

For the reasons given above (points 2.3.3 to 2.3.6), document B7 neither pertains to the state of the art pursuant of Article 54(2) EPC nor is it of a nature suitable for to establishing an alleged "common practice" (see the opponent's letter 14 September 2004, page 5, fifth paragraph). So, this argumentation based on B7 cannot demonstrate a lack of inventive step.

4.3.2 In its statement of grounds of appeal, the appellant also included references to some of its written submissions made during the opposition proceedings, namely to point 3.1.2 of its statement of grounds for opposition and to its letter of 14 September 2004.

However, the respective lines of argument according to these submissions also both rely on the disclosure of document B7 having regard to the alleged obviousness of

the adoption of a "*filtration step to stop particles greater than 10 μ m*" arranged upstream of the filtration with "*spiral wound membranes*". But B7 does not pertain to the state of the art (see point 4.3.1 above).

Under point 3.1.2 of its grounds for opposition, the appellant had argued that the claimed process was obvious since its individual features were disclosed in the prior art. In this argumentation, the appellant relied on documents B1, B7 and at least two more prior art patent publications. In its letter dated 14 September 2004, point 3, the opponent only argued that the claimed process lacked inventiveness in view of a combination of either document D1 **or document B1** with alleged "common practice" as appearing from document B7.

But, as already indicated above (see points 2.3.3 to 2.3.6), document B7 neither pertains to the state of the art pursuant of Article 54(2) EPC nor is it of a nature suitable for establishing an alleged "common practice" (see the opponent's letter 14 September 2004, page 5, fifth paragraph). So, said two lines of argument involving considerations based on the content of B7 are not suitable either for demonstrating a lack of inventive step.

- 4.4 In the contested decision (reasons point 3), the opposition division had already found that the subject-matter of the granted claims was not objectionable for lack of inventive step on the basis of the prior art then on file.

- 4.4.1 The appellant neither submitted further prior art documents nor brought forward an objection of lack of inventive step based exclusively on documents pertaining to the state of the art pursuant to Article 54(2) EPC.
- 4.4.2 The board sees no reason for reversing the positive finding of the opposition division with regard to inventive step. More particularly, the board is also satisfied that taking into account, alone or in combination, only those prior art documents referred to in the opposition and appeal proceedings which belong to the state of the art pursuant to Article 54(2) EPC, the claimed invention is not objectionable for lack of inventive step. Since this was not in dispute, a detailed reasoning need not be given.
- 4.5 The appellant also considered that irrespective of the availability to the public of B1, this "document reports the technical opinion of Prof. Mustacchi and of other skilled men normally involved in concentration processes". Said opinion was said to be "based on a background of technical information which is well known to all engineers involved in the concentration processes at the date of the priority of the opposed patent, as results from paragraph 4 of the report". In said paragraph it was said "that the proposed technology is normally used since many years in the separation and concentration of natural products similar to the poliphenols considered by the invention". The latter statement allegedly was "a clear indication that the invention does not involve any inventive step".

- 4.5.1 However, the board notes that the quoted passage of B1 de facto reads (see B1', page 9, penultimate paragraph) as follows: "The process we propose uses a technology which is innovative with regard to wood, but for several years has had very advantageous applications in the industrial field, in the separation and concentration of natural products similar to the polyphenols considered by us".
- 4.5.2 For the board, this very general passage can at most be understood to mean that industrial processes for the separation and concentration of similar natural products using semi-permeable membranes were known to the contributors to the study.
- 4.5.3 Moreover, the contributors to the study themselves consider the previously unknown processes described therein as "innovative". Bearing this in mind, and in the absence of an argumentation of the appellant as to the obviousness of providing a process with all the feature of claim 1 without having to rely on the information contained in document B7, a mere reference to the quoted passage of B1 is not a conclusive attack on inventive step.
- 4.6 In the board's judgement, the subject-matter of claims 1 to 23 is thus not obvious in the light of the state of the art pursuant to Article 54(2) and, therefore, involves an inventive step as required by Article 52(1) and 56 EPC.

Order

For these reasons it is decided that:

The appeal is dismissed.

The Registrar

The Chairman

C. Vodz

G. Raths