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**Datasheet for the decision
of 28 November 2008**

Case Number: T 1619/06 - 3.3.01

Application Number: 97901468.5

Publication Number: 0967866

IPC: A01N 27/00

Language of the proceedings: EN

Title of invention:

Composition and method of sprout inhibition in potatoes

Patentee:

Platte Chemical Company

Opponent:

PIN/NIP Inc.

Headword:

Sprout inhibitors/PLATTE

Relevant legal provisions:

EPC Art. 100(a),(b) and (c)

Relevant legal provisions (EPC 1973):

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Keyword:

"Novelty (no) - the information was made public as it was not covered by the secrecy agreement"

Decisions cited:

T 0541/92, T 1076/93, T 0480/95

Catchword:

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Case Number: T 1619/06 - 3.3.01

D E C I S I O N
of the Technical Board of Appeal 3.3.01
of 28 November 2008

Appellant: Platte Chemical Company
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Representative: Grünecker, Kinkeldey,
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Respondent: PIN/NIP Inc.
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Representative: Prins, Adrianus Willem
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Decision under appeal: Decision of the Opposition Division of the
European Patent Office posted 28 July 2006
revoking European patent No. 0967866 pursuant
to Article 102(1) EPC.

Composition of the Board:

Chairman: P. Ranguis
Members: C. M. Radke
C.-P. Brandt

Summary of Facts and Submissions

- I. The patent proprietor filed an appeal against the decision of the opposition division posted on 28 July 2006 revoking European patent no. 0 967 866. The notice of appeal was received by the EPO on 09 October 2006 and the appeal fee was paid on the same day. The statement setting out the grounds of appeal was received by the EPO on 07 December 2006.
- II. The opposition was directed against the patent in its entirety and was based on grounds under Article 100 (a), (b) and (c) EPC.
- III. The decision under appeal is based on the claims 1-40 as granted (main request) and on the claims of the first to third auxiliary requests.

Claims 1 and 33 as granted read as follows:

- "1. A composition adapted for inhibiting sprout formation in tubers during storage, comprising:
CIPC; and
a substituted naphthalene."
- "33. A method of inhibiting sprout formation on tubers during storage, comprising the steps of:
applying CIPC to the tubers in an amount effective to form a residue thereon and inhibit sprout formation therefrom;
applying a substituted naphthalene to the tubers in an amount effective to form a residue thereon and to inhibit sprout formation therefrom; and

storing the tubers for a period of time, wherein the CIPC and substituted naphthalene residues are both present for at least a portion of the period of time the tubers are stored"

In these claims, CIPC stands for isopropyl-3-chlorophenylcarbamate, a compound commonly referred to as chlorpropham.

IV. The following documents were *inter alia* cited during the opposition procedure:

- (D2) "VOLATILE POTATO SPROUT SUPPRESSANT CHEMICALS", PhD thesis by James L. Beveridge, 270 pages, undated
- (D3) CA-A-1 203 394
- (D4) NRA Special Review of Chlorpropham, November 1997, NRA Special Review Series 97.3, Chemical Review Section, National Registration Authority, Canberra/AU, pages i-viii and 1-66
- (D9) Telecopy dated 22 April 1993 from Mike Everest-Todd to Darol Forsythe of PIN-NIP Inc., one page, to which was attached document
- (D1) Report "THE EFFICACY OF VARIOUS FORMULATIONS OF CHLORPROPHAM WHEN APPLIED TO STORED POTATOES FOR THE CONTROL OF SPROUTING", 4 pages, all the five pages of documents (D9) and (D1) showing a headline apparently generated by the telecopier, said headline consisting of the date ("22-04-1993"), the time of the day (from "14:03" to "14:06"), the information "FROM MR.M.EVEREST-TODD TO 01012089399721" and a consecutive page numbering
- (D11) Telecopy dated 14 April 1993 from Mike Everest-

Todd to Darol Forsythe of PIN-NIP Inc., including a secrecy agreement signed on behalf of PIN/NIP DF and Everest-Todd Research and Development Ltd., 2 pages

(D12) Copy of the leaflet "PRODUCT INFORMATION SPECIALITY CHEMICALS PRODUCT Sure Sol[®]-187 Specification", dated 11/92, Koch Chemical Company, Corpus Christi/US.

V. The opposition division decided that document (D1) was not considered to belong to the state of the art since the documents (D9) and (D11) made it clear that Mr. Everest-Todd considered the data on the formulations containing CIPC and substituted naphthalenes as confidential; the subject-matter of claim 33 of the main request is not novel in view of document (D2); the subject-matter of claims 1, 9 and 19 of the main request and claim 1 of the first auxiliary request did not involve an inventive step in view of document (D3) if combined with documents (D2) and (D4); claims 33 and 35 of the second auxiliary request were not admissible under Article 123 (2) EPC; and that the subject-matter of claim 12 of the third auxiliary request was not novel in view of document (D2).

VI. The claims on which this decision is based are

- claims 1 to 40 as granted (Main Request),
- claims 1 to 37 of the First and claims 1 to 33 of the Second Auxiliary Requests, both filed with the letter dated 07 December 2006,
- claims 1 to 36 of the Third and claims 1 to 32 of the Fourth Auxiliary Requests, both filed with the letter dated 16 October 2008.

The wording of claims 1 and 33 of the Main Request is given under point III above.

The wording of claim 1 is identical for all the auxiliary requests and reads as follows:

"1. A composition adapted for inhibiting sprout formation in tubers during storage, comprising:
CIPC; and
a substituted naphthalene,
wherein the weight ratio of CIPC to substituted naphthalene is from 1:1 to 1:4."

VII. The Appellant claimed that the restriction of the claims of the auxiliary requests to a certain range for the weight ratio of CIPC to substituted naphthalene and/or the limitation of the substituted naphthalene to dimethylnaphthalene (DMN) and diisopropylnaphthalene (DIPN) was based on page 3, lines 31-35 of the application as originally filed.

He argued that the description and the examples of the application as originally filed gave ample information to the person skilled in the art as how to carry out the invention claimed.

He was of the opinion that the telecopy forming part of document (D9) which was sent to Darol Forsythe fell under the secrecy agreement enclosed with document (D11). Therefore, document (D1) which had been enclosed with the telecopy (D9) was not disclosed to the public by means of said telecopy and could not deprive the subject-matter of the present claims of novelty.

- VIII. The Respondent claimed that the following amendments contravened the requirements of Article 123 (2) EPC:
- the amendments in claim 33 of the Main Request,
 - the amendments in claims 8, 26, 27, 29 and 31 of the First Auxiliary Request and in the respective claims of the Second Auxiliary Request, and
 - the amendments in claims 8, 26, 27 and 29 of the Third Auxiliary Request and in the respective claims of the Fourth Auxiliary Request.

These amendments concerned *inter alia* the introduction of a range of weight ratios for the components into the claims (see point VI above) and the limitation of the substituted naphthalenes to certain specified compounds.

The Respondent argued that Table II of the patent in suit demonstrated that the claimed compositions showed no advantages with respect to the use of their component CIPC alone and that the subsequent application of the two components according to claim 33 of the Main Request did not inhibit sprouting if the time period between the two application was rather long. He concluded that grounds under Article 100 (b) EPC prejudiced the maintenance of the patent in suit.

He considered the subject-matter claimed in all the requests on file not to be novel in view of document (D1) which was sent to Mr. Forsythe as an enclosure to the telecopy forming part of document (D9). Mr. Forsythe was not obliged to keep this information secret as the telecopy (D9) was not designated to be

secret and confidential, contrary to the provision 1.1 of the secrecy agreement enclosed with document (D11).

IX. The Board annexed a communication to the summons to oral proceedings in which it gave reasons for its preliminary opinion that grounds under Article 100 (b) EPC did not prejudice the maintenance of the patent.

X. The Appellant requested that the decision under appeal be set aside and the patent be maintained as granted, or on the basis of the claims of the First or the Second Auxiliary Requests, both filed with the letter dated 07 December 2006, or on the basis of the claims of the Third or Fourth Auxiliary Requests, both filed with the letter dated 16 October 2008.

The Respondent requested that the appeal be dismissed.

XI. At the end of the oral proceedings, the decision of the Board was announced.

Reasons for the Decision

1. The appeal is admissible

2. *Article 123 EPC*

2.1 *Article 123 (2) EPC*

The wording of the claims of the Main Request is identical with the one of the claims as originally filed.

Claim 1 of the First Auxiliary Request is based on claims 1 and; claims 2 to 7 on original claims 2-4 and 6-8; claim 8 on original claim 9 and page 3, lines 31-33; claims 9-17 on original claims 10-18; claim 18 is based on original claims 19 and 20; claims 19 to 30 on original claims 21-32; claim 31 on original claims 33 and page 3, lines 31-33; claims 32-37 on original claims 34-38 and 40.

Claim 1 of the Second Auxiliary Request is based on claims 1 and page 3, lines 31-33 of the application as originally filed; claims 2 to 7 on original claims 2-4 and 6-8; claim 8 on original claim 9 and page 3, lines 31-33; claims 9-14 on original claims 11, 13-15, 17 and 18; claim 15 is based on original claims 19 and 20; claims 16 to 27 on original claims 21-32; claim 28 on original claims 33 and page 3, lines 31-33; claims 29-33 on original claims 34-38.

Claim 1 of the Third Auxiliary Request is based on claims 1 and page 3, lines 31-33 of the application as originally filed; claims 2 to 7 on original claims 2-4 and 6-8; claim 8 on original claims 9, 4 and 5; claims 9 to 17 on original claims 10-18; claim 18 on original claims 19 and 20; claims 19 to 30 on original claims 21-32; claim 31 on original claims 33, 38 and 39; claims 32 to 36 on original claims 34-37 and 40, respectively.

Claim 1 of the Fourth Auxiliary Request is based on claims 1 and page 3, lines 31-33 of the application as originally filed; claims 2 to 7 on original claims 2-4 and 6-8; claim 8 on original claims 9, 4 and 5; claims 9 to 14 on original claims 11, 13-15, 17 and 18;

claim 15 on original claims 19 and 20; claims 16 to 27 on original claims 21-32; claim 28 on original claims 33, 38 and 39; claims 29 to 32 on original claims 34-37, respectively.

Hence, the Board does not share the view of the Respondent that the claims do not meet the requirements of Article 123 (2) EPC (see the first two paragraphs under point VIII above). In view of the outcome of this appeal it is not necessary to give more detailed reasons.

2.2 *Article 123 (3) EPC*

The claims of all the auxiliary requests limit the protection conferred by the claims as granted (i.e. the claims of the Main Request) in that the former specify the weight ratio of the components.

2.3 For these reasons, the patent in suit as amended does not contravene the requirements of Article 123 EPC and grounds under Article 100 (c) EPC do not prejudice its maintenance.

3. *Article 100 (b) EPC*

The ground under this Article applies if the patent does not "disclose the invention in a manner sufficiently clear and complete for it to be carried out by a person skilled in the art."

The advantages the Respondent referred to are no features of the invention as defined in the present

claims. Therefore, the invention can be carried out even if these advantages are not achieved.

When applying the two components subsequently according to claim 33 of the Main Request, the person skilled in the art could clearly see from table II of the patent in suit that the time period between the applications of the two components was to be kept short in order to inhibit sprouting.

Hence, the Board does not share the view of the Respondent and comes to the conclusion that no grounds under Article 100 (b) EPC prejudice the maintenance of the patent. In view of the outcome of this appeal it is not necessary to give more detailed reasons.

4. *Novelty*

- 4.1 Document (D11) contains a secrecy agreement signed by Mr. Everest-Todd on 14 April 1993 and by Mr. Forsythe on behalf of PIN/NIP Corporation on 20 April 1993. Point 3 of this agreement sets out that it came into force on the date it had been duly signed. This means that it came into force on 20 April 1993.

Point 1.1 of the agreement reads as follows:

"We will treat all Information designated as Secret and Confidential in the manner prescribed."

Part (a) of document (D9) was sent by Mr. Everest-Todd and was received by Mr. Forsythe on 22 April 1993 (see the headline generated by the telecopier on the cover letter and on all four pages of the test report

enclosed; compare the respective headline on document (D11) which was signed by Mr. Forsythe after receipt and to which reference was made in the cover letter of document (D9)). This was two days after the secrecy agreement mentioned above had come into force.

- 4.2 Hence it has to be determined whether or not Mr. Forsythe was bound by the secrecy agreement forming part of document (D11) to keep secret the information disclosed in document (D1) attached to document (D9).

The secrecy agreement was signed by both parties and thus was legally binding for them. Therefore, the Board has to stick to the wording of the agreement and may only interpret it to the extent that terms are vague or ambiguous.

Point 1.1 of the secrecy agreement requires the information under this agreement to be designated as being secret and confidential (see point 4.1 above). This provision clearly excludes any information exchanged between the parties which was not clearly marked to be secret and confidential from the secrecy agreement with the effect that it did not need to be kept secret. Hence, the secrecy agreement forming part of document (D11) left no room for an implicit secrecy obligation for any information not designated as being secret and confidential.

The Board notes in that respect that neither document (9) nor document (1) attached to this cover letter contains any mention that the information disclosed therein was designated as secret and confidential.

The first sentence of the cover letter thanking Mr. Forsythe "for the signed modified Agreement and ... for correcting my errors." does not refer to the information disclosed in document (D1).

For these reasons, Mr. Forsythe was under no explicit or implicit obligation to treat the information disclosed in documents (D1) and (D9) to be secret and confidential.

- 4.3 This situation differs from situations where no secrecy agreement has been signed at all and where the circumstances of the relationship between parties exchanging information are to be considered (see the decisions T 0541/92 of 25 January 1994, last paragraph of point 4.2 of the reasons; T 1076/93 of 16 February 1995, point 4.1 of the reasons; T 0480/95 of 5 November 1996, the fifth paragraph of point 2 of the reasons).
- 4.4 Therefore, the information contained in documents (D1) and (D9) was made available to the public on 22 April 1993, i.e. prior to the priority date of the patent in suit.
- 4.5 Document (D1) deals with formulations of chlorpropham (C.I.P.C) in monomethyl naphthalene, dimethyl naphthalene or diisopropyl naphthalene and the application of these formulations to stored potatoes in order to control sprouting (see the title and the summary on the first page).

Chlorpropham is identical with the compound designated as CIPC in the patent in suit, namely as the first component mentioned in claim 1 of each request (see the

first sentence of paragraph [0004] of the patent). Monomethyl naphthalene, dimethyl naphthalene and diisopropyl naphthalene are preferred as substituted naphthalenes, i.e. as the second component mentioned in claim 1 of each request (see claim 4 as granted in combination with the last sentence of paragraph [0013] of the patent in suit).

Three of the six formulations tested contain 40 % wt/vol of CIPC in each of the three substituted naphthalenes mentioned above.

The monomethyl naphthalene used in these formulations was sold under the trade name Sure Sol[®] 187 and has specific gravity of 1.013 at 60 °F (see documents (D9) and (D12)).

The formulation no.1 listed on the first page of document (D1) contains 40 % wt/vol of CIPC in monomethyl naphthalene, namely 40 parts by weight of CIPC and $60 \times 1.013 = 60.8$ parts by weight of monomethyl naphthalene. This corresponds weight ratio of CIPC to monomethyl naphthalene of 1:1.52 which is within the range of from 1:1 to 1:4 indicated in claim 1 in each of the auxiliary requests.

Consequently, the subject-matter of claim 1 in each of the Main Request and the First to Fourth Auxiliary Requests is not novel in view of of document (D1).

For these reasons grounds under Article 100 (a) EPC prejudice the maintenance of the patent so that its revocation by the first instance was justified.

Order

For these reasons it is decided that:

The appeal is dismissed.

The Registrar:

The Chairman:

M. Schalow

P. Ranguis