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**Datasheet for the decision  
of 6 October 2009**

**Case Number:** T 1089/07 - 3.3.10

**Application Number:** 97934335.7

**Publication Number:** 0923590

**IPC:** C07F 19/00

**Language of the proceedings:** EN

**Title of invention:**

Combinatorial method of identifying potential polymerisation catalysts of the organometallic type

**Patentee:**

SYMYX TECHNOLOGIES

**Opponent:**

Henkel AG & Co. KGaA  
Degussa AG

**Headword:**

Combinatorial method/SYMYX

**Relevant legal provisions:**

EPC Art. 100(c)

**Keyword:**

"Amendments (not allowable) - not unambiguously derivable from application as filed, neither explicitly nor implicitly"

**Decisions cited:**

T 0389/86, T 0296/96, T 0823/96, T 0427/99, T 0860/00,  
T 1206/01, T 0003/06

**Catchword:**

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Case Number: T 1089/07 - 3.3.10

**D E C I S I O N**  
of the Technical Board of Appeal 3.3.10  
of 6 October 2009

**Appellant:** Henkel AG & Co. KGaA  
(Opponent 01) Patente (FJP)  
D-40191 Düsseldorf (DE)

**Party as of right:** Degussa AG  
(Opponent 03) Rodenbacher Chaussee 4  
D-63457 Hanau-Wolfgang (DE)

**Respondent:** SYMYX TECHNOLOGIES  
(Patent Proprietor) 3100 Central Expressway  
Santa Clara  
CA 95051 (US)

**Representative:** Broughton, Jon Philip  
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**Decision under appeal:** Interlocutory decision of the Opposition  
Division of the European Patent Office posted  
7 May 2007 concerning maintenance of European  
patent No. 0923590 in amended form.

**Composition of the Board:**

**Chairman:** R. Freimuth  
**Members:** J.-C. Schmid  
J.-P. Seitz

## Summary of Facts and Submissions

I. The Opponent 01 (Appellant) and Opponent 03 lodged appeals on 1 March 2007 and 23 May 2007, respectively, against the interlocutory decision of the Opposition Division, posted on 7 May 2007, which found that the European patent No. 923590 in the form as amended during the oral proceedings of 15 November 2006 met the requirements of the EPC, claim 1 reading as follows:

"1. A method for the identification of one or more active polymerisation catalysts from a group of organometallic potential catalysts comprising making an array of more than 3 different activated organometallic potential catalysts at known locations on a substrate and subjecting the array when in contact with one or more polymerisable monomers to polymerisation conditions and screening said array at the known locations for indication of polymerisation catalytic activity, conversion efficiency and/or selectivity through study of the effect of said array on the one or more polymerisable monomers."

II. Notices of opposition were filed against the granted patent requesting revocation of the patent in suit in its entirety. The patent was opposed under Article 100(a) EPC for lack of novelty and inventive step, under Article 100(b) EPC for insufficiency of disclosure and under Article 100(c) EPC on the ground of extending the subject-matter beyond the content of the application as filed.

III. The Opposition Division held *inter alia* that the requirement of Article 123(2) EPC was met for the

expressions objected to by the opponents as extending beyond the content of the application as filed, the claims complying, thus, with said requirement.

- IV. On 18 August 2008, the Board issued a communication indicating that it was not directly apparent where was the disclosure in the application as filed of the method for the identification of one or more polymerisation catalyts according to claim 1 and requested the Respondent to indicate the support of all features of the claim in their particular combination.
- V. According to the Respondent's (patent proprietor's) interpretation of the case law (decisions T 860/00; T 296/96; T 823/96; none published in OJ EPO), the content of the application as filed not only encompassed what could be directly and unambiguously deduced from its disclosure, but also included the implicit disclosure of the patent application, i.e. what any person skilled in the art would necessarily understand as a clear and unambiguous consequence of what was explicitly mentioned. The relevant question was whether a skilled person would seriously contemplate combining the different features cited in the application as filed. Whether or not a feature was disclosed in the application as filed was a matter of the whole content thereof and not solely based on isolated parts of the description.

The paragraph headed "Field of the Invention" on page 1, lines 9 to 15, of the application as filed specified that the invention related to methodologies for the synthesis, screening and characterization of organometallic compounds and catalyts. The methods

provided for combinatorial synthesis, screening and characterization of libraries of supported and unsupported organometallic compounds and catalysts. It was thus clear from these first few lines that the disclosed subject matter included a method for the identification of one or more catalysts from a group of organometallic potential catalysts comprising making an array of different organometallic potential catalysts at known locations on a substrate and screening said array at the known locations for indication of catalytic activity.

"Identification" was clearly and unambiguously implicitly comprised in "screening". Such an identification to find catalysts could not take place except from a library of potential catalysts, and no such identification could take place unless the library of different compounds was provided in the form of an array on a substrate, which would have to be, by their nature, at known locations, otherwise no identification and/or screening could occur.

- VI. At the oral proceedings held on 6 October 2009 the Appellant withdrew its request for reimbursement of the appeal fee. It contested the finding of the Opposition Division as regards the issue of amendments extending beyond the content of the application as filed in arguing *inter alia* that the application as filed did not disclose any method for the identification of one or more polymerisation catalysts. The term "screening" was not tantamount to the term "identification" since the claimed method for the identification included among others a step of screening the array. Furthermore, screening an array of organometallic compounds did not

necessarily comprise a step of identification of active catalysts, as apparent from the application as filed itself on page 16, lines 6 to 15.

VII. On 2 October 2009, Opponent (03) withdrew its appeal. It had filed no submissions as regards the issue of amendments extending beyond the content of the application as filed. As a Party as of right, it did not file any request in these appeal proceedings.

VIII. The Appellant requested that the decision under appeal be set aside and that the patent be revoked.

The Respondent requested in writing that the appeal be dismissed.

IX. The oral proceedings were held in the absence of the Party as of right and of the Respondent, which latter after having been duly summoned, informed the Board that it will not attend. At the end of the oral proceedings the decision of the Board was announced.

## **Reasons for the Decision**

### *1. Admissibility of the appeal*

The Appellant filed its notice of appeal on 1 March 2007 against the decision of the Opposition Division pronounced at the end of the oral proceedings on 15 November 2006, the reasoned decision being notified to the parties on 7 May 2007. The appeal was thus filed before the commencement of the two-month time limit stipulated in Article 108, first sentence, EPC.

However, the time limit stipulated in Article 108, first sentence, EPC by no means precludes the filing of an appeal before the decision has been notified but merely requires that it must be filed no later than two months from the date of its notification (see decision T 389/86, OJ EPO 1988, 87; T 427/99, not published in OJ).

The appeal was thus filed in due time. All the other requirements being met as well, the appeal is admissible, which finding has never been contested by the Respondent.

2. *Non-appearance at oral proceedings*

According to Article 11(3) of the Rules of Procedure of the Boards of Appeal (RPBA) the Board is not obliged to delay any step in the proceedings, including its decision, by reasons only of the absence at oral proceedings of any party duly summoned who may then be treated as relying only on its written case. In deciding not to attend the oral proceedings, the Respondent chose not to avail itself of the opportunity to present its observations and counter-arguments orally but instead to rely solely on its written case. Insofar the Respondent is deemed to have expected that during the oral proceedings the Board would consider any objections and arguments raised either by the Appellant and by the Board its communication.

In the present case the Board had therefore the power and the duty to take a final decision at the oral

proceedings on the case before it, notwithstanding the announced absence of the duly summoned Respondent.

3. *Amendments*

3.1 Claim 1 is directed to a method for the identification of one or more active polymerisation catalysts from a group of organometallic potential catalysts which has been objected to by the Appellant for having no support in the application as filed since the terms "screening" and "identification" were not tantamount to each other.

3.2 In order to determine whether or not the subject-matter of a claim in a patent extends beyond the content of the application as filed it has to be examined whether that claim comprises technical information which a skilled person would not have objectively and unambiguously derived from the application as filed (see decisions T 296/96, point 3.1 of the reasons, penultimate paragraph; T 823/96, point 4.5 of the reasons, second paragraph; T 860/00, point 1.1 of the reasons; T 1206/01, point 2.1 of the reasons; T 3/06, see point 4.1.4 of the reasons; none published in OJ EPO).

The content of an application as filed encompasses what is directly and unambiguously disclosed therein either explicitly or implicitly. In this context "implicit disclosure" means disclosure which any person skilled in the art would objectively consider as necessarily implied in the explicit content, e.g. in view of general scientific laws (T 860/00, *loc. cit.*).



Hence, the term "implicit disclosure" should not be construed to mean matter that does not belong to the content of the technical information provided by a document but may be rendered obvious on the basis of that content. Whilst common general knowledge must be taken into account in deciding what is clearly and unambiguously implied by the explicit disclosure of a document, the question of what may be rendered obvious by that disclosure in the light of common general knowledge is not relevant to the assessment of what is implied by the disclosure of that document. The implicit disclosure means no more than the clear and unambiguous consequence of what is explicitly mentioned (T 823/96; *loc. cit.*).

- 3.3 It is matter of fact that the application as filed does not explicitly disclose a method for the identification of one or more active polymerisation catalysts from a group of organometallic potential catalysts.

The Respondent submitted that the first few lines of the paragraph on page 1, lines 9 to 15 headed "Field of the Invention" disclosing a method of screening organometallic compounds was the support for the claimed method for the identification of one or more organometallic compounds, since "identification" was clearly and unambiguously implicitly comprised in "screening". Nevertheless, the Respondent was silent as to the reasons for that finding.

- 3.4 However, the terms "identification" and "screening" have different meanings in the sense of the patent-in-suit. That is clear from the wording of the claim itself, where the claimed method for the identification

includes among others a step of "screening" the array. Accordingly "identification" cannot be tantamount to "screening", that amendment thereby extending beyond the content of the application as filed.

Furthermore, screening an array of organometallic compounds for catalytic properties in polymerisation reactions generally means investigating said organometallic compounds as to whether they show catalytic polymerisation properties, such as selectivity, conversion efficiency or activity (see page 16, lines 6 to 15 of the application as filed). Hence, screening an array of organometallic compounds does not necessarily comprise the step of identifying active polymerisation catalysts. Hence, the Board cannot agree with the Respondent's allegation that "identification" is clearly and unambiguously implicitly comprised in "screening".

3.5 Consequently, the passage in the application as filed on page 1, lines 9 to 15 headed "Field of the Invention" referred to by the Respondent disclosing a method of screening organometallic compounds does provide an adequate support for the method for the identification of one or more organometallic compounds according to claim 1; nor is the Board aware of any other passage of the application as filed which does.

3.6 Therefore the Board concludes that claim 1 extends the subject-matter claimed beyond the content of the application as filed justifying the ground for opposition pursuant to Article 100(c) EPC, so that the Respondent's request must be rejected.

**Order**

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

1. The decision under appeal is set aside.
2. The patent is revoked.

The Registrar

The Chairman

C. Rodríguez Rodríguez

R. Freimuth