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**Datasheet for the decision  
of 2 October 2012**

**Case Number:** T 1165/10 - 3.3.06  
**Application Number:** 99203886.9  
**Publication Number:** 1002572  
**IPC:** B01J 19/00, G01N 21/00,  
G01N 22/00  
**Language of the proceedings:** EN

**Title of invention:**

The combinatorial synthesis of novel materials

**Patentees:**

The Regents of The University of California  
Symyx Solutions, Inc.

**Opponents:**

Evonik Degussa GmbH  
hte Aktiengesellschaft the high throughput  
experimentation company  
BASF SE  
HENKEL KGaA

**Headword:**

Identification of materials/UNIVERSITY OF CALIFORNIA

**Relevant legal provisions:**

RPBA Art. 12(4)

**Relevant legal provisions (EPC 1973):**

EPC Art. 76(1)

**Keyword:**

"Admissibility of the auxiliary requests submitted with the statement of the grounds of appeal: no - abuse of procedure"

"Added matter (main request): yes - combination of technical features does not emerge clearly and unambiguously from the original parent application"

**Decisions cited:**

T 0023/10, T 0686/99

**Catchword:**

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Case Number: T 1165/10 - 3.3.06

**D E C I S I O N**  
of the Technical Board of Appeal 3.3.06  
of 2 October 2012

**Appellant I:**  
(Patent Proprietor 1)                      The Regents of The University of California  
1111 Franklin Street  
12th Floor  
Oakland, CA 94607      (US)

**Appellant II:**  
(Patent Proprietor 2)                      Symyx Solutions, Inc.  
415 Oakmead Parkway  
Sunnyvale CA 94085      (US)

**Representative:**  
Eisenführ, Speiser & Partner  
Postfach 10 60 78  
D-28060 Bremen      (DE)

**Respondent I:**  
(Opponent 1)                                  Evonik Degussa GmbH  
Rellinghauser Straße 1-11  
D-45128 Essen      (DE)

**Representative:**  
Evonik Degussa GmbH  
Intellectual Property Management  
PATENTE & MARKEN  
Rodenbacher Chaussee 4  
D-63457 Hanau      (DE)

**Respondent II:**  
(Opponent 2)                                  hte Aktiengesellschaft  
the high throughput experimentation company  
Kurpfalzring 104  
D-69123 Heidelberg      (DE)

**Representative:**  
Tostmann, Holger Carl  
Wallinger Ricker Schiotter Tostmann  
Patent- und Rechtsanwälte  
Zweibrückenstrasse 5-7  
D-80331 München      (DE)

**Respondent III:** BASF SE  
(Opponent 3) D-67056 Ludwigshafen (DE)

**Representative:** Hössle, Markus  
Hössle Kudlek & Partner  
Postfach 10 23 38  
D-70019 Stuttgart (DE)

**Respondent IV:** HENKEL KGaA  
(Opponent 4) Henkelstrasse 67  
D-40589 Düsseldorf (DE)

**Representative:** Ioannidis, Johannes  
Henkel AG & Co. KGaA  
VTP Patente  
D-40191 Düsseldorf (DE)

**Decision under appeal:** **Decision of the Opposition Division of the European Patent Office posted 23 March 2010 revoking European patent No. 1002572 pursuant to Article 101(3)(b) EPC.**

**Composition of the Board:**

**Chairman:** P.-P. Bracke  
**Members:** L. Li Voti  
J. Geschwind

## Summary of Facts and Submissions

- I. The present appeal is from the decision of the Opposition Division to revoke the European patent No. 1 002 572, concerning a process for the identification of materials.
- II. In their notices of opposition the four Opponents sought the revocation of the patent on the grounds of Articles 100(a), (b) and (c) EPC 1973.
- III. With the communication of 01 September 2009, sent together with the summons to attend oral proceedings, the Opposition Division informed the Patent Proprietors of its preliminary opinion (see point VII of the decision under appeal). In particular, the Opposition Division specified that
- some of the objections raised under Article 100(c) EPC 1973 against claim 1 as granted by Opponent 02 appeared to be well founded;
  - claim 1 appeared also to lack novelty over some of the cited documents and
  - none of the then pending auxiliary requests appeared to be allowable.

The Patent Proprietors withdrew with the fax of 05 November 2009 their request for oral proceedings and announced that they would not attend the oral proceedings before the Opposition Division (see point VIII of the decision under appeal).

The Opposition Division thus issued a communication, dated 20 January 2010, in which the parties were informed that the date for oral proceedings was maintained and that the Division intended to revoke the patent in its entirety (see point IX of the decision under appeal).

Oral proceedings were held on 9 February 2010 in the absence of all parties. As specified under point XI of the decision under appeal, read in combination with point VI, basis for the decision were the patent as granted (main request), the claims of the auxiliary requests 1 to 11 submitted with the letter dated 20 June 2008 as well as the second to sixth series of requests for an independent claim submitted with the same letter, which requests consisted in combinations of features of said first to eleventh auxiliary requests.

IV. The Opposition Division found in its decision *inter alia* that claim 1 as granted extended beyond the content of the original parent application of which the original application of the patent in suit was a divisional. Moreover, none of the auxiliary requests were able to overcome the deficiencies of added matter expressed in section 3 of the reasons for the decision.

In particular, the Division commented in said section 3 the objections raised in writing by Opponent 02 with regard to added matter and concluded, by referring to T 686/99, that although the technical features of claim 1 could be derived from pages 4, 5, 14 and 50 of the original parent application, the combination of

these features did not emerge clearly and unambiguously from the parent application as originally filed.

V. Claim 1 of the set of 26 claims as granted reads as follows:

"1. A process for the identification of materials comprising

i. forming an array of more than 10 different materials on a substrate in regions, the materials being inorganic materials, organometallic materials or non-biological organic polymers the array being formed by

a. delivering two or more components of the materials to the regions of the substrate,

b. varying the composition and/or stoichiometry of the delivered components between regions and

c. simultaneously reacting the components to form the more than ten different materials at the predefined regions, wherein the array of non-biological organic polymers is formed without stepwise coupling by a method further comprising adding an initiator to the regions, polymerising the components in the regions of the substrate and allowing the polymerising reaction to proceed to form the non-biological polymers, and

ii. screening the materials of the array for a property selected from an electrical, thermal, mechanical morphological, optical, magnetic and a chemical property."

VI. An appeal was filed against this decision by the Patent Proprietors (Appellants).

The Appellants filed with the statement of the grounds of appeal six sets of claims as first to sixth auxiliary requests.

They submitted *inter alia* that claim 1 as granted was based on the general disclosure of the invention contained in page 4, lines 14 to 24 and page 15, lines 2 to 13 of the original parent application in combination with one specific embodiment reported on page 6, lines 6 to 8; therefore, it was not based on the combination of the general disclosure provided on page 4 with two specific separate embodiments of the invention, as submitted by Opponent 02. The wording of claim 1 thus was supported by the original disclosure of the parent application. Moreover, the modifications of claim 1 contained in the six auxiliary requests submitted with the grounds of appeal were also supported by the original disclosure of the parent application.

The Appellants requested also that oral proceedings be held in case the Board would not intend to decide according to any of the submitted requests.

- VII. The set of claims according to the **first auxiliary request** differs from the set of claims as granted, representing the **main request**, insofar as in claim 1 the materials are limited to inorganic materials and the provisions of step (i.c.) concerning non-biological organic polymers are deleted.

The set of claims according to the **second auxiliary request** differs from that according to the first



auxiliary request insofar as claim 1 ends with the additional wording "by screening the array of materials".

The set of claims according to the **third auxiliary request** differs from that according to the second auxiliary request insofar as step (i.a.) of claim 1 ends with the additional wording "wherein the reactant components in the individual reaction regions are prevented from moving to adjacent reaction regions".

The set of claims according to the **fourth auxiliary request** differs from that according to the third auxiliary request insofar as claim 1 ends with the additional wording "using a detection system".

The set of claims according to the **fifth auxiliary request** differs from that according to the third auxiliary request insofar as claim 1 ends with the additional wording "in parallel" and claims 25 and 26 are deleted.

The set of claims according to the **sixth auxiliary request** differs from that according to the fifth auxiliary request insofar as claim 1 ends with the additional wording "using a scanning detection system".

- VIII. The Respondents and Opponents 02 and 03 submitted in writing that the Patent Proprietors had deliberately not attended the oral proceedings before the Opposition Division; hence, it had foregone the opportunity to file additional auxiliary requests addressing the objections of the Opponents and the concerns of the Opposition Division and had deliberately withheld

auxiliary requests which could have been easily filed for submitting them later during appeal; the Appellants' conduct amounted in the Respondents' view to an abuse of procedure.

In the Respondents' view the Board's decision thus had to be limited to the requests and grounds of opposition that have been the subject of the decision under appeal to revoke the patent and all claims not filed at first instance were not admissible.

Furthermore, the Respondents 03 and 04 submitted in writing that each claim 1 according to all the submitted requests extended beyond the content of the original parent application.

In particular, Respondent 03 argued that the Appellants did not consider in their argumentation, submitted with the statement of the grounds of appeal, technical feature (i.b.) of claim 1 reading "varying the composition and/or stoichiometry of the delivered components between regions"; in the Respondent's view, this feature would not be disclosed in the passages indicated by the Appellants and it was apparently derived from a passage bridging pages 56 and 57, relating to a further specific embodiment of the invention which could not be combined with the other embodiments indicated by the Appellants as support for the granted claim 1.

IX. With the letter of 14 August 2012 the Appellants withdrew their request for oral proceedings and informed the Board that they would not attend the oral proceedings scheduled for 2 October 2012.

The oral proceedings were held before the Board on 2 October 2012 and were attended by Respondent 03 only.

The Respondent 03 maintained during oral proceedings all the objections raised in writing and, by referring to T 686/99, argued that the original parent application would not contain a clear and unambiguous disclosure of a process as claimed, concerning the identification of materials, comprising the steps listed in claim 1 as granted.

- X. The Appellants requested in writing that the decision under appeal be set aside and the oppositions be rejected, i.e. the patent be maintained on the basis of the claims as granted, or, in the alternative, that the patent be maintained in amended form on the basis of any of the first to sixth auxiliary requests submitted with the letter of 2 August 2010.
  
- XI. The Respondents requested in writing and orally that the appeal be dismissed or, in the case that a request would be found to be novel and not comprising added subject-matter, that the case be remitted to the department of first instance for further prosecution.

## **Reasons for the Decision**

- 1. *Admissibility of the Appellants' first to sixth auxiliary requests*
  - 1.1 According to Article 12(4) RPBA, the admission into the procedure of new requests which could have been submitted by a party in the first instance proceedings

is at the Board's discretion. This ensures a fair and reliable conduct of the judicial appeal proceedings (see T 23/10, point 2.4 of the reasons).

The Board notes that the Appellants have not indicated in their statement of the grounds of appeal if any of the first to sixth auxiliary requests is based on any of the eleven auxiliary requests submitted at first instance, which were the basis for the decision under appeal (see point III above); moreover they have not clarified why these auxiliary requests could overcome the deficiencies of added subject-matter or novelty indicated in the decision under appeal in the case the Board would find them to be correct.

It is at first sight apparent to the Board that none of the auxiliary requests submitted by the Appellants corresponds exactly with any of the eleven auxiliary requests addressed to in the decision under appeal.

In fact, even the set of claims according to the second auxiliary request (see point VII above), which is the only set of claims containing a claim 1 which appears to correspond with one claim 1 of the eleven auxiliary requests before the Opposition Division (specifically claim 1 of the ninth auxiliary request), contains 26 claims and it thus differs from the corresponding set of claims according to the ninth auxiliary request attached to the decision under appeal, which contains only 25 claims.

The Board notes also that the so-called second to sixth variations requested by the Patent Proprietors at first instance and addressed to in the decision under appeal

(point III above) were never submitted as a complete set of claims; in fact, the Opposition Division related in its decision only to a possible independent claim amended following the indication given in writing for such requests.

Therefore, these possible variations of the other complete sets of claims filed by the Patent Proprietors at first instance cannot be compared with any of the full sets of claims according to the auxiliary requests filed in appeal.

The Board remarks also that the Appellants, by not attending deliberately the oral proceedings before the Board (see point IX above), have withheld any possible clarification regarding the reason and aim of the filed auxiliary requests.

It is thus to be decided if these auxiliary requests 1 to 6, which do not correspond to any of the requests submitted before the Opposition Division, can be admitted into the proceedings under Article 12(4) RPBA.

- 1.2 It is clear from the decision under appeal (points VII to IX) that the Opposition Division had informed the Patent Proprietors in the summons to oral proceedings of its preliminary opinion that none of the then pending requests appeared to be allowable on the grounds of the objections raised by the Opponents as to the novelty of the claimed subject-matter and the extension beyond the content of the original parent application. Moreover, subsequent to the announcement of the Patent Proprietors that they would not attend the oral proceedings, the Opposition Division had

informed the parties in writing that the oral proceedings were maintained and that it intended to revoke the patent.

After this communication by the Opposition Division the Patent Proprietors did not file additional requests or submissions (see point III above).

These facts are not contested by the Appellants and the Board has convinced itself that they reflect correctly the history of the first instance proceedings.

It is thus clear from the above that the decision taken by the Opposition Division and its reasons had to be expected by the Patent Proprietors.

Hence, the Patent Proprietors, by not attending the oral proceedings before the Opposition Division and by not filing any further written submission in advance of the oral proceedings, have deliberately forewent the opportunity of submitting further requests with the aim to overcome the known objections against the claims submitted in writing.

Since the Patent Proprietors, with the knowledge of the objections raised by the Opponents and of the opinion of the Opposition Division, could have submitted further requests in the first instance proceedings and had deliberately renounced to do so, the introduction of new requests during appeal proceedings can only be seen, in the Board's view, as an attempt of starting the opposition anew, which fact amounts to a clear abuse of procedure (see T 23/10, points 2.1 and 2.2 of the reasons).

Therefore, the Board finds that, in virtue of its discretionary power according to Article 12(4) RPBA, the new requests submitted with the statement of the grounds of appeal have not to be admitted into the proceedings (see T 23/10, point 2.8 and 2.10)

2. Main request (patent as granted)

2.1 *Extension beyond the content of the original parent application (Article 76(1) EPC 1973)*

According to the Appellants claim 1 as granted would be supported by specific passages of the general disclosure of the invention, contained in pages 4 and 15 of the original parent application (WO 96/11878), in combination with one specific embodiment contained on page 6 (see point VI above).

However, as correctly submitted by Respondent 03, none of the passages indicated by the Appellants relates to feature (i.b.) of the claimed process for the identification of materials, i.e. to "varying the composition and/or stoichiometry of the delivered components between regions".

Moreover, also pages 5 and 50, indicated by the Opposition Division (point 3.7 of the reasons), do not cite this technical feature. In particular, page 5 discloses that the components can be delivered to predefined regions on the substrate in any stoichiometry (see lines 2 to 4) but it does not specify if the stoichiometry of the delivered components varies within a single region or between

regions, as required in claim 1 as granted. Moreover, this passage of the description is silent about a variation of the composition of the delivered components between regions, or of their composition and stoichiometry at once, as encompassed by the wording of claim 1.

The passage of the description bridging pages 56 to 57, indicated by Respondent 03 as possible alleged support for the above mentioned technical feature, concerns admittedly the variation of stoichiometry of the delivered components, not only within a single region but also from one region to another (see page 57, lines 3 to 5); however, both the variation of the composition and the variation of composition and stoichiometry at once, mentioned in this part of the description, concern only the products of reaction and not the delivered components (see page 56, lines 29 to 31 and page 57, lines 6 to 8).

The Board notes also that this disclosure concerns explicitly "another embodiment of the invention" (page 56, line 29) and belongs to a section reading "IX: Alternative Embodiments" (page 55, line 15). Therefore, even though the skilled person could understand, by reading this part of the description, that the features described in this section can be combined with the general features of the invention disclosed on pages 4 and 15, which concern methods and apparatus for the preparation and use of a substrate having an array of diverse materials in predefined regions thereon (see page 4, lines 12 to 13 and page 15, lines 2 to 3), he would not find in the original parent application any suggestion that these specific alternative features can



be additionally combined with the other specific alternative embodiment disclosed on page 6, lines 6 to 8, reading "In another embodiment of the present invention, an array of inorganic materials on a single substrate at predefined regions thereon is provided. Such an array can consist of more than 10... different inorganic compounds.", which is allegedly the only support for part of step (i) of the claimed process for the identification of materials.

In fact, the embodiment bridging pages 56 and 57 is only one of the possible alternative embodiments listed in section IX from page 55 to page 59 and the above mentioned embodiment of page 6 is also only one of the possible alternative embodiments listed throughout pages 5 and 6 of the original parent application. It is thus clear, in the light of the numerous theoretical combinations possible of such alternative embodiments, that a specific combination of such alternative embodiments (like that of granted claim 1) would not be derivable from the text of the description in the absence of a specific pointer thereto.

Therefore, the Board concludes that a process for the identification of materials having the combination of technical features of claim 1 as granted does not clearly and unambiguously emerge from the original disclosure of the parent application (see also T 686/99, point 4.3.3 of the reasons).

Claim 1 as granted thus extends beyond the content of the original parent application and it does not comply with the requirements of Article 76(1) EPC 1973.

**Order**

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

The appeal is dismissed.

The Registrar:

The Chairman:

D. Magliano

P.-P. Bracke