

Veröffentlichung im Amtsblatt	Ja /Nein
Publication in the Official Journal	Yes /No
Publication au Journal Officiel	Oui /Non

Aktenzeichen / Case Number / N^o du recours : T 337/88

Anmeldenummer / Filing No / N^o de la demande : 81 106 349.4

Veröffentlichungs-Nr. / Publication No / N^o de la publication : 0 046 285

Bezeichnung der Erfindung: Process for the preparation of polyolefinic
Title of invention: plasto-elastomeric compositions by means of
Titre de l'invention : dynamical vulcanization

Klassifikation / Classification / Classement : C08L 23/02

ENTSCHEIDUNG / DECISION

vom / of / du 21 March 1990

Anmelder / Applicant / Demandeur :

Patentinhaber / Proprietor of the patent /
Titulaire du brevet :

Montedison S.p.A.

Einsprechender / Opponent / Opposant :

Bayer AG

Stichwort / Headword / Référence : Polymer/MONTEDISON

EPÜ / EPC / CBE Article 84, 102(3), 111(1), 123(3), Rule 88

Schlagwort / Keyword / Mot clé :

"Error in claims - included/excluded -
correction not obvious and not permitted"
"Broadening amendment not permitted"
"Extent of duty to consider objections not
discussed in decision of Opposition Division"

Leitsatz / Headnote / Sommaire



Case Number : T 337/88 - 3.3.2

D E C I S I O N
of the Technical Board of Appeal 3.3.2
of 21 March 1990

Appellant :
(Proprietor of the patent) Montedison S.p.A.
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Respondent :
(Opponent) Bayer AG, Leverkusen
Konzernverwaltung RP
Patente Konzern
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Representative :

Decision under appeal : Decision of Opposition Division of the European Patent
Office dated 11 May 1988 revoking European patent
No. 0 046 285 pursuant to Article 102(1) EPC.

Composition of the Board :

Chairman : P. Lançon

Members : R. Lunzer

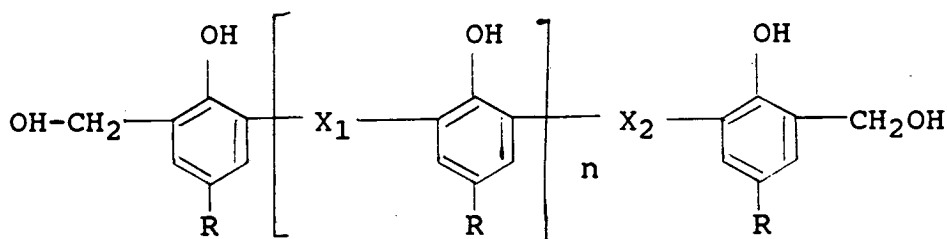
J. Stephens-Ofner

SUMMARY OF FACTS AND SUBMISSIONS

I. European patent No. 46 285 was granted on 7 August 1985 on the basis of application No. 81 106 349.4 filed on 14 August 1981. The main independent Claim 1 of the patent as granted was in the following form:

"1. Process for the preparation of plasto-elastomeric compositions, consisting in subjecting to mastication a mix consisting of 20% to 60% by weight of an olefinic polymer, and from 80% to 40% by weight of an unsaturated elastomeric terpolymer consisting of two α -olefinic monomers and of a dienic monomer, in the presence of a cross-linking system free of halogen donors and comprising:

(a) up to 10 parts by weight, for 100 parts by weight of said terpolymer, of a non-halogenated phenolic resin of the following general formula:



wherein:

X_1, X_2 , equal to or different from each other, are -CH- or -CH₂-O-CH₂- radicals;

R = alkyl, aryl or alkenyl radical, containing from 4 to 16 carbon atoms;

n = an integer comprised between 0 and 6, extremes excluded; and

(b) a metal compound chosen from amongst zinc oxide, magnesium oxide, iron oxide, titanium dioxide, calcium oxide, alumina, silica and calcium carbonate, in a

ponderal ratio with the phenolic resin comprised between 0.5:1 and 5:1;

at a temperature sufficient for melting said olefinic polymer and for a duration sufficient for obtaining a homogeneous mixture, and by then continuing with the mastication at a temperature at which there will occur at least a partial cross-linking of the elastomeric terpolymer.

- II. On 5 May 1986 an opposition was lodged by the Respondent on the grounds of lack of novelty, and/or lack of inventive step.

- III. At the oral proceedings held on 17 December 1987, the Respondent pointed out that the claims, unlike the description, referred to $n = 0$ to 6, "extremes excluded", whereas the description used the term "extremes included". The Patentee altered its main request (which related to amendments of a minor nature) to include the replacement of "excluded" in Claim 1 with "included", thus bringing the claims into conformity with the corresponding passage in the description. As an auxiliary request it sought the above mentioned minor amendments, and additionally the replacement in the description of "included" on page 3, line 19 by "excluded". This would have had the effect of making the description conform exactly with the narrower claims.

There was argument at the oral proceedings with respect to the allowability of the main request, an adjournment to consider it, and a ruling that the broadening of the claims according to the main request was not allowable. The oral proceedings continued on the basis of the auxiliary request, in relation to which the issues of novelty and inventiveness were argued.

Although not mentioned in the protocol of the oral proceedings before the first instance, it was asserted by the Appellant (Patentee), and not contested by the Respondent, that at the previous oral proceedings the Opponent wrote on the blackboard an account of certain experimental work which had been carried out, and which allegedly showed that the benefits of the invention asserted by the patentee were not obtainable.

That further evidence was allegedly excluded by the Opposition Division largely, if not exclusively, on the ground of its tardy introduction into the case, but the minutes made no reference even to the attempt to introduce this material.

After considering all the arguments on the merits of the case, there was a clear ruling by the Chairman that the Opposition Division intended to maintain the patent in the form of the auxiliary request.

- IV. On 2 February 1988 the Opposition Division sent out a communication pursuant to Rule 58(4), enclosing a copy of the specification as amended in accordance with the auxiliary request.
- V. On 5 February 1988 the Office received a letter from the Respondent, which stated merely that they did not agree with the maintenance of the patent. It made no comment on the amendments. On 11 March 1988 a letter was received from the Appellant. It is quoted here in full:

"In response to the communication pursuant to Rule 58(4) EPC, the proprietor does not agree to the text with which the opposition division intends to maintain the subject European patent, but wishes to

proceed with the main request submitted during the oral proceedings dated 12 November 1987 according to which "excluded" in Claim 1 should be replaced by "included".

- VI. By its written decision dated 11 May 1988, the Opposition Division revoked the patent on the sole ground that the proposed amendment of the patent in accordance with the main request was not allowable having regard to the provisions of Article 123(3), and that there was no alternative amendment before the Opposition Division. It also included in its decision the observation that Rule 88 EPC was not applicable in this case, "as it applies to the correction of errors in documents filed with the European Patent Office".
- VII. An appeal against this decision lodged on 14 July 1988, the appeal fee was paid on the same day, and the Grounds of Appeal filed on 19 September 1988. The Appellant sought the reversal of the decision of the Opposition Division refusing the amendment contained in the main request, and, as an auxiliary request, that the patent should be maintained substantially in accordance with what had been the auxiliary request before the Opposition Division. (See points III. and IV. above.)
- VIII. Oral proceedings were held on 21 March 1990.
- IX. In the course of its written and oral submissions, the Appellant contended that the proposed amendment to replace "excluded" by "included" should be allowed pursuant to Rule 88 EPC as the correction of an obvious mistake. Alternatively, it asked that the patent should be upheld in accordance with its auxiliary request, which it sought to modify by the correction of CH to read CH₂ in the definition of X₁ and X₂, together with the other minor

amendments which had also been allowed by the Opposition Division.

- X. The Respondent did not object to the correction of CH to CH₂, accepting that the error in this regard was clear. It objected to the overall amendment of the claim on the ground that the scope of the claim was unclear, contrary to Article 84 EPC, and maintained that it was entitled to raise this objection having regard to the fact that the Appeal involved an amendment to the claims. The lack of clarity was said to arise from the fact that although the proportions of (a) to (b) were defined in the claim, as there was no lower limit, both could be zero, i.e. both (a) and (b) could be wholly absent from the claimed composition. While acknowledging that the claim could not be attacked on the ground of lack of novelty, the Respondent sought to attack it on the ground of lack of inventive step. In particular it contended that it would be unfair if the Appeal Board were merely to reconsider the decision under appeal, which did not deal with this issue, and to allow an amended patent to be upheld without the Respondent having had any opportunity to argue this issue, either before the first instance or an appeal.
- XI. In the course of the oral proceedings, the Board having indicated that it would not be prepared to accede to the main request involving the substitution of "included" in place of "excluded", the Appellant converted its auxiliary request into a single request by modifying it, so that it comprised the minor amendments, and left the description at page 3, line 19 unaltered. The Respondent sought the refusal of the proposed amendments, and a decision revoking the patent on the ground of lack of any inventive step.

Reasons for the Decision

1. The appeal complies with Articles 106 to 108 and Rule 64 EPC and is, therefore, admissible.
2. In the view of the Board, the substitution of "included" for "excluded" is a broadening amendment which can not be permitted having regard to the provisions of Article 123(3) EPC.
3. This is not a case in which it might be possible to have allowed the amendment as being a correction under the terms of Rule 88 EPC. As is illustrated in the Decision T 200/89 of 7 December 1989 (to be published in the OJ EPO), the second part of that rule requires that "the correction must be obvious in the sense that it is immediately evident that nothing else would have been intended than what is offered as the correction". In that Decision, two corrections were sought. As to one of them, it was clear, as it is in the present case, that there was an inconsistency between the description and the claims, but it was not apparent which was intended. That correction was refused. In contrast, with respect to the second correction, it was clear from the combined effect of the description and the examples that the error lay in the claim, with the consequence that the correction was permitted.
 - 3.1 In the present case the second part of Rule 88 is not satisfied. It is neither clear that an error has been made, nor is it clear whether the intention of the draftsman was to use the word "included", which occurs in the description, or "excluded", which appears in the English language claims. It is true that the claims, as translated into French and German, use terms conveying the idea of "included", but the Board does not accept that it

is possible to arrive at the intention of the draftsman by a mere count of the number of instances in which the relevant words appeared. In interpreting a patent specification, it is proper to attach particular weight to the wording used in the claims, and, in the case of a European patent where the claim appears in three languages, it is proper to attach particular significance to the wording used in the original language of the patent.

- 3.2 The Respondent opposed the proposal to leave the description unaltered, i.e. leaving the word "included" in the description, despite retaining "excluded" in the claims. It argued that the reference in Article 102(3) EPC to the requirements of the Convention had the effect of imposing on the Opposition Division, or in the present circumstances on the Appeal Board, a duty to consider each and every requirement of the the EPC, including Article 84 EPC, regardless of whether or not it had been raised in the opposition itself.

In the Board's view, the correct legal position is as set out in Case T 227/88 of 15 December 1988 (to be published) where the Board held as follows:

"(a) In all cases in which amendments are requested by the patentee and are considered to be free from objection under Article 123 EPC, Article 102(3) confers upon the Opposition Division, and on the Boards of Appeal, jurisdiction, and thus the power, to decide upon the patent as amended in the light of the requirements of the Convention as a whole. This jurisdiction is thus wider than that conferred by Articles 102(1) and (2) EPC, which expressly limit jurisdiction to the grounds of opposition mentioned in Article 100 EPC;

(b) When substantive amendments are made to a patent.... both instances have the power to deal with grounds and issues arising from those amendments, even though not specifically raised by the Opponent pursuant to Rule 55 EPC."

It follows in the present case that the Board does have the power, but not the duty, to decide the point which is alleged to arise under Article 84 EPC. In the exercise of that power, the Board has compared the existing description with the claims. It finds no inconsistency between a description which is expressed more broadly than are the claims: such narrowing-down from the description to the claims is unobjectionable, and is indeed common drafting practice.

- 3.3 The Board does not accept the Respondent's argument to the effect that the claim embraces the possible situation of both (a) and (b) being absent from the claimed compositions. The claim requires the presence of a cross-linking system comprising (a) up to 10 parts by weight of a resin of a certain formula, and a specified proportion of a metal compound (b). In the view of the Board, this claim is only satisfied by the presence of a sufficient proportion of (a) and (b) for the combination of the two to have the desired cross-linking effect. That excludes the possibility of both being absent, and the claim is not regarded as being unclear in this respect.
- 3.4 The Board agrees with the Respondent that the substitution of CH₂ in place of CH appearing in the claim is plainly the correction of an obvious error which is justified under Rule 88 EPC, and it allows this further amendment.

4. Regarding the issues of novelty and inventive step, upon which the Opposition Division did not give any ruling, the Board declines in the present circumstances to act as the tribunal of first instance. Its function as a final appeal body under Article 110 EPC is to examine appeals from existing decisions, subject to the limited exceptions provided by Article 114(1) EPC. Its task is to decide whether or not a first instance's decision was right or wrong; i.e. to decide for a second time upon the same or a closely similar case to that decided by the first instance. Appeals should not be used by the parties as a continuation of first instance proceedings by other and later means: see T 52/88 of 5 September 1988 (unpublished in OJ of EPO).

5. The Board refrains from giving any ruling as to what evidence may or may not be considered in its discretion by the Opposition Division when dealing with the issue referred back, observing only that the passage of time may have an influence on whether the late filed evidence is any longer an embarrassment to the Patentee.

- 5.1 Regarding the procedure followed by the Opposition Division, having in fact heard argument on the issues of novelty and inventiveness, and having given its decision orally, the Board finds the absence of any conclusions on those issues in its written decision regrettable.

- 5.2 Where the Opposition Division, or an Appeal Board, has actually given the parties an oral indication of its intended conclusions, both on specific issues, as well as on the overall outcome of oral proceedings, it is desirable that a written decision, corresponding in all relevant respects with the oral indication, should be given reasonably soon thereafter.

- 5.3 The letter from the Appellant of 11 March 1988 quoted in paragraph V above is open to the interpretation put upon it by the Opposition Division, i.e. that it was the intention of the Appellant to abandon its auxiliary request, and to seek a decision confined to its main request. However, if the Opposition Division so interpreted the letter, it was accordingly faced with a complete volte face on the part of the Appellant. In such circumstances, it ought to have tried to clarify this surprising situation by letter, before sending out a written decision which bore no resemblance to the intimation of its decision given at the end of the oral proceedings.
6. For the above reasons, the Board accepts that the claims may be amended in the manner set out above. In accordance with its powers under Article 111(1) EPC, the Board remits matter to the Opposition Division for consideration of the issues of novelty and inventiveness.

Order

For the above reasons, it is decided that:

1. The decision under appeal is set aside.
2. The case is remitted to the Opposition Division for further prosecution on the basis of the single request of the Patentee.

The Registrar:

The Chairman:

M. Beer

P. Lançon