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Bezeichnung der Erfindung: Process for preparing copolymers
Title of invention:
Titre de l'invention :

Klassifikation / Classification / Classement : C08F 212/12

ENTSCHEIDUNG / DECISION

vom / of / du 14 December 1989

Anmelder / Applicant / Demandeur :

Patentinhaber / Proprietor of the patent /
Titulaire du brevet :

Sumitomo Naugatuck Co. Ltd.

Einsprechender / Opponent / Opposant :

01) Bayer AG, Leverkusen
02) Naamloze Vennootschap DSM

Stichwort / Headword / Référence :

Extent of opposition/SUMITOMO

EPÜ / EPC / CBE

Articles 83, 100, 114(1), Rules 55(c), 56(1)

Schlagwort / Keyword / Mot clé :

"Insufficiency alleged but not supported" -
"Scope of claim attacked in support of ground
of lack of inventive step" - "Patent revoked on
ground of insufficiency" - "Insufficiency not
established" - "Procedure in opposition
proceedings having regard to extent of
opposition".

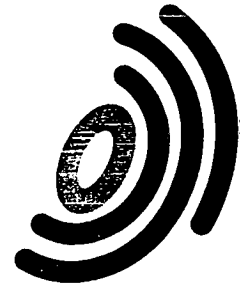
Leitsatz / Headnote / Sommaire

I. In order to establish insufficiency, the burden of proof is upon an opponent to establish on the balance of probabilities that a skilled reader of the patent using his common general knowledge would be unable to carry out the invention. A mere statement that one of several examples in a patent has been repeated once "exactly as described" without obtaining exactly the results claimed in the patent is in principle inadequate to discharge that burden (Decisions T 292/85 (OJ EPO 1989, 275) and 281/86 (OJ EPO 1989, 202) followed).

II. The purpose underlying the relevant provisions of the EPC requires that an Opposition Division should normally decide at the same time all grounds of opposition which have been both alleged and supported (as required by Rule 55(c) EPC) in the notice of opposition; and that it should not decide potential grounds of opposition which have not been alleged in the notice of opposition.

III. If a notice of opposition contains allegations as to grounds of opposition which are not supported as required by Rule 55(c) EPC, such allegations in principle should be rejected on the same basis as if they were inadmissible under Rule 56(1) EPC.

IV. In principle, Article 114(1) EPC should not be interpreted as requiring the Opposition Division or a Board of Appeal to investigate whether support exists for grounds of opposition which have not been properly supported by an Opponent, but should be interpreted as enabling the EPO to investigate fully the grounds of opposition which have been both alleged and properly supported as required by Rule 55(c) EPC.



Case Number : T 182/89 - 3.3.1

D E C I S I O N
of the Technical Board of Appeal 3.3.1
of 14 December 1989

Appellant : Sumitomo Naugatuck Co. Ltd.
(Proprietor of the patent) No. 3-2-4, Nakanoshima Kita-ku
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Respondent : Bayer AG, Leverkusen
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Representative :

Respondent : Naamloze Vennootschap DSM
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Representative : Hoogstraten, Willem Cornelius Roeland
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Decision under appeal : Decision of the Opposition Division of the European
Patent Office dated 7 December 1988, posed on
17 January 1989, revoking European patent
No. 0 041 703 pursuant to Article 102(1) EPC.

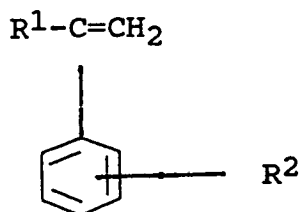
Composition of the Board :

Chairman : K. Jahn
Members : G.D. Paterson
C. Gérardin

Summary of Facts and Submissions

- I. European patent No. 41 703 was granted to Sumitomo Naugatuck Co. Ltd. on 8 May 1985, including two claims. Claim 1 reads as follows:-

"A process for the emulsion polymerization of an α -alkylstyrene represented by the formula



wherein R^1 is a $\text{C}^1\text{-C}^3$ alkyl group and R^2 is a hydrogen atom, a $\text{C}^1\text{-C}^3$ alkyl group or a halogenated $\text{C}^1\text{-C}^3$ alkyl group, and an unsaturated nitrile copolymerisable therewith in a weight proportion of 70:30 to 80:20 in the presence of a radical initiator, characterized in that at the stage of completion of the introduction of the monomers, the amount of unreacted unsaturated nitrile in the reaction system is not less than 31% by weight of the total amount of unreacted monomers in the system."

Claim 2 is dependent upon Claim 1 and sets out further details of the polymerisation process.

- II. Notices of opposition were filed by Bayer AG and Naamloze Vennootschap DSM (Opponents I and II respectively), requesting revocation of the entire patent on the grounds of lack of novelty and inventive step and insufficiency (Articles 100(a) and (b) EPC).

In their statements under Rule 55(c) EPC in support of the above grounds, the following documents were cited in support of the allegations of lack of novelty and inventive step:

- (1) DE-B-1 810 993
- (2) P. Wittmer: Copolymerisation in Systemen mit einem Polymerisations-Depolymerisationsgleichgewicht (Makromolekulare Chemie 103 (1967) pages 188-213)
- (3) FR-A-1 243 075
- (4) EP-A-0 000 419
- (5) US-A-3 991 136
- (6) NL-A-7 112 599.

However, although both Opponents commented upon and criticised the wording and scope of Claim 1 of the patent having regard to the description of the invention contained therein, neither of the notices of opposition contained any indication of facts, evidence or argument in support of an allegation that the disclosure of the invention was not sufficiently clear for it to be carried out by a skilled person, as such.

Thus Opponent I criticised the lack of any temperature limitations in the claim; Opponent II suggested that the wording of Claim 1 did not exclude a one-step process, in which the object of the invention, namely to reduce the amount of residual unreacted monomer, would not be achieved: and further suggested that it was unclear at what stage in the process the percentage of acrylonitrile should be 31% or more in order to reduce the residual monomer, and that essential features of the invention had therefore been omitted from the claim, and the claim was therefore not adequately supported by the description.

- III. In his observations in reply to both notices of opposition, the Patentee contested the submissions of the Opponents in respect of lack of novelty and inventive step, and denied that there was any need for further limitations in the claim, whose features were already clear. In particular, a one-step process was excluded, and the acrylonitrile concentration of not less than 31% related to the concentration of unreacted acrylonitrile to the total unreacted monomers in the reactor.
- IV. On 10 June 1987 the Opposition Division issued a communication giving its preliminary view that Claim 1 lacked novelty over document (4). Further observations were also filed by both Opponents in relation to inventive step and the scope of the claim. In reply the Patentee filed a detailed statement dated 8 December 1987 explaining the nature of the claimed invention and the alleged differences from inter alia document 4, and further contesting that any of the cited documents made the claimed invention obvious.
- V. A summons to oral proceedings was issued on 21 July 1988, in which it was indicated that the grounds of lack of novelty and inventive step would be considered during the oral hearing.
- VI. By letter dated 8 September 1988 Opponent I filed some comparative test results. Examples 2 and 4 of the opposed patent were said to have been repeated exactly as described (Tests A and C), and also repeated with slight modifications in the proportions of methylstyrene to acrylonitrile within the mixtures thereof, so as to fall just outside Claim 1 (Tests B and D). According to the results achieved, the conversion of the polymerisation in all four tests was similar, and the requirement in Claim 1 that "the amount of unreacted unsaturated nitrile in the

reaction system is not less than 31% by weight of the total amount of unreacted monomers in the system", was obtained in Test A but not in Test C, (which was alleged to correspond with Example 4 of the patent).

According to Opponent I, the conclusion to be derived from these tests was that no recognisable connection existed between on the one hand the methylstyrene content of the polymer and the unreacted monomer content, respectively, and on the other hand the main requirement of the claims as to the unreacted nitrile content.

In reply, the Patentee was unable to explain the results achieved by Opponent I, and was doubtful whether the experiments had been carried out by a person with sufficient skill in the art, but considered that according to the known means available to an appropriately skilled man, the claimed results would be achieved.

- VII. Oral proceedings were held on 7 December 1988, at which both Opponents agreed that the claims were novel. Submissions were made by all parties upon the performance and feasibility of the invention in connection with the scope of the claimed process and its technical effect.

At the conclusion of the hearing the Decision was announced orally that the patent was revoked on the ground of insufficiency (Article 100(b) EPC).

The written reasons for the Decision were issued on 17 January 1989, in which it was held that the claims were novel. The finding of insufficiency was based upon the experimental results of Opponent I set out as Test C in his letter dated 8 September 1988 (see paragraph VI above). In particular, it was stated that "the Examples should describe experiments in such a way that the results

are reproducible. Since with the data and information given in at least Example 4 the required result is not obtained as shown by Opponent I, the Opposition Division is convinced that an essential measure is missing in this Example and thus in Claim 1 of the patent".

As to the ground of inventive step, the Decision stated that "as matters stand, the ground of inventive step does not need to be considered".

VIII. A Notice of Appeal was filed, and the appeal fee paid, on 14 March 1989, and grounds of appeal were filed on 17 May 1989. The Appellant submitted inter alia that he was entirely dissatisfied with the attitude of the Opposition Division, because it had simply admitted the results of Opponent I's Test C as negating the results set out in the Examples of the patent, without any reasonable ground. The Appellant furthermore set out reasons why Opponent I's experimental results should be considered as incredible.

In his observations in reply, Opponent I/Respondent I submitted further experimental results relating to a further alleged repetition of Example 4 of the patent. These results showed that the amount of unreacted nitrile in the reaction system was only 24%, compared to the requirement in Claim 1 of not less than 31%.

IX. Oral proceedings were held on 14 December 1989, during which an experimental report was filed on behalf of the Appellant. The Appellant in essence confirmed his submissions as set out in the grounds of appeal. In response, Respondent I accepted that the experimental results which he had submitted during the proceedings before the Opposition Division were directed essentially to criticising the formulation and scope of the claims in order to support his allegation of lack of inventive

step. In this circumstance, all three parties to the appeal proceedings requested that the case be remitted to the Opposition Division for examination and decision upon the ground of lack of inventive step. Accordingly, the decision of the Board was announced to the same effect.

Reasons for the Decision

1. The appeal complies with Articles 106 to 108 and Rule 64 EPC and is admissible.
2. **Insufficiency**

It is quite clear that neither of the Respondents seriously contended during the proceedings before the Opposition Division that the patent should be held invalid on the ground of insufficiency. The Notices of Opposition contained formal allegations covering Article 100(b) EPC, but the evidence and arguments in support of this ground were directed towards criticising the feasibility of the claimed invention in connection with its scope, and were therefore clearly related to the ground of lack of inventive step. There was no evidence or argument from either Respondent to suggest that a skilled reader of the patent would be unable to carry out the claimed invention in any embodiment. On the contrary, the experimental results of Respondent I in his letter dated 8 September 1988 demonstrated that his repetition of Example 2 of the patent achieved results that were in accordance with the claimed invention.

It is the established case law of the Boards of Appeal that an invention is sufficiently disclosed for the purpose of Articles 83 and 100(b) EPC if at least one way is clearly indicated enabling the skilled person to carry

out the invention - see eg. Decision T 292/85 (OJ EPO 1989, 275). Furthermore, in relation to the suggestion of lack of reproducibility contained in the Decision under appeal, it was held in Decision T 281/86 (OJ EPO 1989, 202) that "there is no requirement under Article 83 EPC to the effect that a specifically described example of a process must be exactly repeatable...As long as the description of the process is sufficiently clear and complete i.e. the claimed process can be put into practice without undue burden by the skilled person taking common general knowledge also into consideration, there is no deficiency in this respect".

This is in itself sufficient to cause the finding of insufficiency by the Opposition Division to be set aside. In any event, however, in order to establish insufficiency, the burden of proof is upon an opponent to establish on the balance of probabilities (i.e. that it was more likely than not, see Decision T 381/87 dated 10 November 1988, to be published) that a skilled reader of the patent using his common general knowledge would be unable to carry out the invention. A mere statement by an opponent that one example of a patent has been repeated once "exactly as described" without obtaining exactly the described results as set out and claimed in the patent is clearly in principle quite inadequate to discharge that burden of proof. Indeed, if a Notice of Opposition only alleged insufficiency under Article 100(b) EPC as the sole ground of opposition, and only contained such a statement as the only indication of "facts, evidence and arguments" in support of such ground, in the Board's view there would be good grounds for rejecting such a Notice of Opposition as inadmissible, on the basis that it contained no sufficient indication of facts and evidence which, even if subsequently proved, could provide legal and factual reasons for revoking the patent.

In the Board's judgment, therefore, for the above reasons the experiments of Opponent I in the present case do not begin to establish the ground of insufficiency under Article 100(b) EPC, even if they had been intended to have that effect. The Decision of the Opposition Division would therefore have been set aside on that basis, whether or not the parties had requested this as set out in paragraph VIII above.

3. Procedural matters

- 3.1 In the present case, the Board can see no justification for the Opposition Division not having decided the question of inventive step at the oral proceedings before it, this being the only ground on which in reality both Opponents intended to rely. While there may be cases in which it is sensible for an Opposition Division only to decide upon one of several grounds of opposition which have been alleged, and to say nothing in its decision about the other grounds of opposition which were alleged, in the Board's view the circumstances of the present case as set out above make it plain that this is not such a case. In fact, in the present case the summons to oral proceedings before the Opposition Division dated 21 July 1988 expressly indicated that the main grounds of opposition, i.e. lack of novelty and inventive step, would be the subject of the oral proceedings, and contained no indication that the ground of insufficiency should be discussed.

In the present case, by failing to decide the ground of inventive step, at least one year in the total time of the opposition proceedings has been wasted, (in spite of the fact that the Board of Appeal examined and decided this appeal soon after it was filed). Thus the "General

Principles" for "Opposition Procedure in the EPO" (OJ EPO 1989, 417), as set out in paragraph 2 thereof, do not appear to have been fulfilled in the present case ("The EPO's aim remains to establish as rapidly as possible, in the interests of both the public and the parties to the opposition proceedings, whether or not the patent may be maintained given the Opponent's submissions. It seeks to achieve this by means of a speedy and streamlined procedure...") (emphasis added). These "General Principles" have previously been endorsed by the Board of Appeal - see Decision T 295/87 dated 6 December 1988 (to be published). They clearly reflect the underlying intention of the relevant procedural provisions for the conduct of opposition proceedings as set out in particular in Articles 101 and 102 and Rules 55 to 58 EPC. This underlying intention of the EPC will not be achieved if, as in the present case, the Opposition Division decides only upon a ground of opposition which is not properly supported by the Opponents within the meaning of Rule 55(c) EPC, and fails to decide grounds of opposition which are so supported.

- 3.2 In this connection this Board doubts the correctness of the interpretation of the EPC which is set out in Decision T 493/88 dated 13 December 1989 (to be published), according to which an Opposition Division should not only decide the grounds of opposition which are alleged by the Opponent in his Notice of Opposition and which are the subject of his statement under Rule 55(c) EPC contained therein, but should also decide upon all the possible grounds of opposition which are set out in Article 100(a)(b) and (c) whether or not all such grounds even alleged in the Opponent's statement under Rule 55(c) EPC. Although such an interpretation is perhaps superficially plausible if the provisions of Articles 101 and 102 EPC are considered in isolation, when these

provisions are considered in a broader context the appropriateness of such interpretation becomes more questionable. In particular, such an interpretation would require the Opposition Division to re-examine and decide upon issues which should already have been investigated by the Examining Division before grant, even though such issues have not been alleged and supported in the Notice of Opposition in accordance with Rule 55(c) EPC. This seems to be contrary to the legitimate expectation of the Patentee, as well as to the explanation of the EPC given by the Enlarged Board of Appeal in G 1/84 (OJ EPO 1985, 304), paragraph 9, "that opposition procedure is not designed to be, and is not to be misused as, an extension of examination procedure".

Furthermore, if such interpretation is correct, it would appear that the requirements of Rule 55(c) EPC and the examination for admissibility under Rule 56(1) EPC in respect of the requirements of Rule 55(c) EPC become rather pointless. (If a procedure in accordance with such interpretation had been the intention underlying this part of the EPC, Rule 55(c) EPC would have been written simply so as to require that at least one ground of opposition should be alleged and supported by an indication of facts, evidence and arguments). Furthermore, the workload of the Opposition Division as a whole and of the Boards of Appeal will be considerably increased if such interpretation is correct, which in turn will make the aim of the EPO as set out in the "General Principles" of the Opposition Division more difficult to achieve in every case.

- 3.3 In the Board's view it would be very desirable that this question of interpretation should be considered and decided in the near future by the Enlarged Board of Appeal. Decision T 493/88 was not available to this Board until after the oral proceedings in the present case

during which the present decision was announced. In any event, even if the Board had been aware of Decision T 493/88 during the oral proceedings in the present case, it would have been wrong for this Board to inflict a further indefinite period of delay upon the parties in the present case during the Enlarged Board's consideration of a referred question under Article 112 EPC.

- 3.4 In the Board's view the relevant provisions of the EPC indicate that its underlying purpose is as expressed in the above-identified "Guiding Principles", and require that an Opposition Division should normally decide at the same time all the grounds of opposition which have been both alleged and supported in accordance with Rule 55(c) EPC (if appropriate, using its powers under Article 114(1) EPC); and that it should not decide grounds of opposition which have not been alleged in the Notice of Opposition.

If, as in the present case, a ground of opposition is alleged in the Notice of Opposition but not per se properly supported as required by Rule 55(c) EPC within the nine-month period for opposition (in the sense that if it were the only ground of opposition alleged in the Notice of Opposition, the opposition would be rejected as inadmissible under Rule 56(1) EPC), then that ground of opposition should be rejected on the same basis as if it were inadmissible under Rule 56(1) EPC (see e.g. paragraph 2 above).

If this course is not followed, abuse of procedure may easily arise, in that an Opponent may allege more than one ground of opposition in his Notice of Opposition but only support one of such grounds in his Notice of Opposition; then, at a later stage in the opposition proceedings he may bring forward facts and evidence in support of the other alleged grounds of opposition, causing delay and

increase in costs. In the Board's view this should not be allowable: Rule 55(c) EPC in conjunction with Rule 56(1) EPC clearly requires every ground of opposition which is alleged in the Notice of Opposition to be supported by "facts, evidence and arguments" within the nine-month opposition period: and for the Notice of Opposition (at least to the extent that Rule 55(c) EPC has not been complied with) to be rejected as inadmissible if this has not been done. Article 114(1) EPC should not be interpreted as requiring the Opposition Division or a Board of Appeal to investigate whether support exists for grounds of opposition which have not been properly supported by an Opponent, but should be interpreted as enabling the EPO to investigate fully the grounds of opposition which have been both alleged and properly supported as required by Rule 55(c) EPC.

4. Rule 55(c) EPC requires a Notice of Opposition to contain a statement in respect of each of two kinds of extent:
 - (i) "the extent to which the European patent is opposed";
and
 - (ii) "the extent of the grounds on which the opposition is based etc ...".

The discussion in paragraphs 3.1 to 3.4 above is concerned only with the second kind of extent. Decision T 9/87 dated 18 August 1988 (OJ EPO 1989, 438) was specifically concerned with the first kind of extent.

Decision T 648/88, dated 23 November 1989, was issued by this Board in a different composition and is concerned with the first kind of extent and refers to Decision T 9/87.

Decision T 9/87 was concerned with a case in which "the extent to which the European patent was opposed" was limited in the Notice of Opposition to certain claims. During the appeal stage of the opposition proceedings, these claims were deleted and corresponding amendments in the remainder of the text were made, so that the amended text only claimed subject-matter which was outside the extent of the Notice of Opposition.

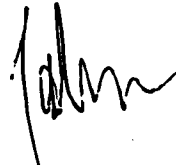
Decision T 648/88 is similarly concerned with a case where the extent to which the European patent was opposed was limited in the Notice of Opposition to certain claims. The Opposition Division considered that these two claims contravened the requirements of the EPC, and in the absence of a proposal to amend the patent so as to exclude these claims, they revoked the patent. It is stated in Decision T 648/88 (paragraph 2 and the Order, paragraphs 1 and 2) that the Opposition Division was wrong to revoke the patent having regard to Decision T 9/87. However, there is a clear distinction between the factual situations in T 9/87 and T 648/88, in that in T 9/87 the patentee excluded the only opposed claims from the patent by amendment; in T 648/88, no such amendment was proposed, so that the Opposition Division was procedurally right to revoke the patent (having regard to its views on the merits of the opposition), pursuant to Articles 102(1) and 113(2) EPC. In Decision T 648/88, this distinction from T 9/87 was not recognised. The above identified parts of Decision T 648/88, namely paragraph 2 of the Reasons and paragraphs 1 and 2 of the Order, should consequently not be followed.

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

1. The Decision of the Opposition Division is set aside.
2. The case is remitted to the Opposition Division for a decision on the ground of lack of inventive step.

The Registrar:

M. Beer

The Chairman:

K. Jahn

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