

**Beschwerdekammern des
Europäischen Patentamts**

**Boards of Appeal of the
European Patent Office**

**Chambres de recours de
l'Office européen des brevets**

Geschäftsstelle

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Please find enclosed the headnote of the decision T376 / 90 - 3.3.3

Veillez trouver en annexe une copie du sommaire de la décision / -

A	X	B		C	
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File No.: T 0376/90 - 3.3.3
Application No.: 82 300 927.9
Publication No.: 0 059 106
Classification: C08F 6/06
Title of invention: Process for the separation treatment of polymer from polymer solution

D E C I S I O N
of 8 September 1993

Applicant: -
Proprietor of the patent: Sumitomo Chemical Company, Ltd.
Opponent: Hüls Aktiengesellschaft

Headword: Polymer solution/SUMITOMO

EPC: Art. 54, 56; R. 55(c) and 56

Keyword: "Admissibility of opposition (affirmed) - separate appeal not admitted by Opposition Division (upheld)"; "extent of opposition - interpretation taking into account surrounding circumstances"; "novelty - yes"; "inventive step - remittal"

Headnote
Catchwords

If the extent to which a patent is opposed is in serious doubt, the opposition may be rejected as inadmissible (cf. Reasons, point 2.2.1).

Case Number: T 0376/90 - 3.3.3

D E C I S I O N
of the Technical Board of Appeal 3.3.3
of 8 September 1993

Appellant:

(Proprietor of the patent) Sumitomo Chemical Company, Ltd.
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Representative:

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Respondent:

(Opponent)

Hüls Aktiengesellschaft
Patentabteilung/PB 15
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Representative:

Decision under appeal: Decision of the Opposition Division of the
European Patent Office of 8 December 1989, issued
on 5 March 1990 revoking European patent
No. 0 059 106 pursuant to Article 102(1) EPC.

Composition of the Board:

Chairman: F. Antony
Members: H.H.R. Fessel
S.C. Perryman

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Keyword: Admissibility of opposition (affirmed) - separate appeal not
admitted by Opposition Division (upheld); extent of opposition -
interpretation taking into account surrounding circumstances.
Novelty - yes. Inventive step - remittal.

Headnote
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Summary of Facts and Submissions

- I. European patent No. 0 059 106 in respect of European patent application No. 82 300 927.9, which had been filed on 23 February 1982 claiming three Japanese priorities, viz. JP 25 753/81 dated 23 February 1981, JP 79 872/81 dated 25 May 1981 and JP 85 111/81 dated 2 June 1981, was granted on 10 June 1987, on the basis of 15 claims, of which Claim 1 read as follows:

"A process for concentrating a polymer solution by flashing a polymer solution, characterized in that said polymer solution is heated under an elevated pressure sufficient to maintain said solution in a liquid state and is sent into a flashing tank kept at an inner surface temperature of at least 140°C and a pressure ranging from atmospheric pressure to 5 kg/cm²G, and said solution is flashed to evaporate and separate the solvent, thereby concentrating said solution, so that the concentration of the polymer in said solution becomes at least 80% by weight, the concentrated solution being recovered from the bottom part of the flashing tank."

- II. Notice of opposition was filed on 25 February 1988, objecting *inter alia* to lack of any inventive step of Claim 1 (cf., e.g., page 3, lines 19 to 28).

The opposition was *inter alia* supported by:

- D1 DE-B-1 770 318
D4 DE-A-2 917 171 and
D5 EP-A-0 027 700, an application filed on 7 October 1980 and published on 29 April 1981.

III. By an interlocutory decision of 28 December 1988 the Opposition Division held the opposition to be admissible and stated that this decision could only be appealed together with the final decision (Art. 106(3) EPC). In its final decision, given at the end of oral proceedings held on 8 December 1989 during which Claim 1 had been amended, and issued on 5 March 1990, the Division revoked the patent.

The Opposition Division stated that the request for revocation clearly defined the extent to which the patent was opposed and that the grounds of Opposition were sufficiently identified (Art. 100(a) and (b) EPC); and an indication of the facts, evidence and arguments in support of the grounds was adequately given by the cited documents together with the various statements of the Opponent linked to specific passages therein.

As to patentability, compliance of amended Claim 1 with the requirements of Article 83 having been conceded by the Opponent, it was held that the patent in suit lacked novelty over D5, whereas the novelty objection based on D4 was dismissed.

IV. On 2 May 1990 an appeal was lodged against said decision together with payment of the prescribed fee. On Monday 16 July 1990 a Statement of Grounds was filed.

In these grounds of appeal and during further proceedings, especially the Oral Proceedings on 8 September 1993, the Appellant continued to contest the admissibility of the opposition, relying in particular on decision T 222/85 (OJ EPO 1988, 128).

The notice of opposition had to present the facts, evidence and arguments in a way to enable the Patent Proprietor and the Opposition Division to examine the alleged ground for revocation without recourse to independent enquiries. Unsubstantiated assertions or a mere reference to patent documents as in the present case were not enough.

In response to the novelty objection the Appellant during Oral Proceedings filed a new Claim 1 reading as follows:

"A process for concentrating a polymer solution by flashing a polymer solution, characterised in that said polymer solution is heated under an elevated pressure sufficient to maintain said solution in a liquid state and is sent into a flashing tank kept at an inner surface temperature of at least 140°C by heating the outside of the flashed product duct and the outside of the flashing tank and a pressure ranging from atmospheric pressure to 5 kg/cm²G, and said solution is flashed to evaporate and separate the solvent, thereby concentrating said solution, so that the concentration of the polymer in said solution becomes at least 80% by weight, the concentrated solution being recovered from the bottom part of the flashing tank."

In his view D5 was prior art under Article 54(3) EPC, thus relevant for novelty only, which was provided by the heating of the outside of the flashing tank, not mentioned in D5. Nor could D4 destroy the novelty of Claim 1 since nowhere in that document was there disclosed any heating of the outside of a flashed product duct.

- V. The Respondent disputed the Appellant's arguments concerning by alleged inadmissibility (Rule 56(1) EPC), since the course of the opposition proceedings clearly showed that the Appellant as well as the Opposition Division understood the Grounds of Opposition. Towards the end of proceedings, the Respondent conceded novelty, but maintained his attack concerning lack of inventive step.
- VI. The Appellant requested that the decision under appeal be set aside and that the patent be maintained on the basis of the request submitted during the oral proceedings and subsidiary claims and description to be adapted.

The Respondent requested that the appeal be dismissed.

Reasons for the Decision

1. The appeal is admissible.
2. The first question to be decided is whether the opposition was admissible, and whether it was correct for the preliminary decision on this point to be made appealable only together with the final decision.
 - 2.1 As to the latter point, the Opposition Division decided on the admissibility in an interlocutory decision within the meaning of Article 106(3) EPC, i.e. a decision which did not terminate the proceedings as regards one of the parties. According to the clear language of that provision such an interlocutory decision can only be appealed together with the final decision, unless the decision allows separate appeal. Whether to allow such a separate appeal was within the discretion of the

Opposition Division. The Board is of the opinion that this discretion under Article 106(3) EPC was properly exercised by the Opposition Division with a view to enabling a decision on the substantive issues to be reached as soon as possible.

2.2 The Appellant's request that the notice of opposition be rejected as inadmissible was based on Rule 56(1) in conjunction with Rule 55(c) EPC, specifying that the notice of opposition shall contain:

- i. a statement of the extent to which the European patent is opposed; and
- ii. of the grounds on which the opposition is based; as well as
- iii. an indication of the facts, evidence and arguments presented in support of these grounds.

2.2.1 As to point (i), the Board proceeds on the accepted principle that statements are to be interpreted in the way that an addressee would understand them taking into account the surrounding circumstances ("objektiver Erklärungswert"; cf. Decision T 1/88 of 26 January 1989, not published).

It has been the general practice, in past cases where patents were opposed without an explicit statement of the extent to which they were opposed, to indiscriminately interpret the absence of such statement as an indication of the opponent's intention to oppose the concerned patent in its entirety. In view of the Enlarged Board's decision G 9/91 (OJ EPO 1993, 408) holding that the power of an Opposition Division or a Board of Appeal to examine and decide on the maintenance of a European patent depends upon the extent to which

the patent is opposed in the notice of opposition pursuant to R. 55(c) EPC, it may be necessary in future to scrutinise such extent more carefully than in the past, in order to safeguard that the EPO does not exceed its power under the EPC. It therefore appears questionable whether the above-referred "liberal" practice can be continued. In the extreme, where the extent to which a patent is opposed is in serious doubt, this may indeed lead to a rejection of an opposition as inadmissible.

In the present case this point of law need not be decided, however, because there can be no such serious doubt.

The patent contained only one independent claim, Claim 1, and this as well as the subject matter of dependent Claims 4, 5, 6 and 7 was expressly attacked in the notice of opposition, which also contained general statements to the effect that the solutions claimed to the problem of polymer adhering to the walls were derivable from the prior art. The opponent did not indicate that it would be content if the patent were maintained on the basis of a more restricted main claim. In these circumstances the Board takes the view that it is implicit that the opponent was seeking the revocation of the patent in its entirety.

- 2.2.2 The Board is also satisfied that items (ii) and (iii) are met. Since it is sufficient if the notice of opposition mentions and substantiates one of the opposition grounds of Article 100 EPC, the Board simply refers to the attack of lacking inventive step (Article 56 in conjunction with Art. 100(a) EPC). This ground was mentioned on page 3, line 24 of the notice of opposition. Facts and evidence were provided in the form of various prior art documents cited, summarised and

commented on in the notice of opposition. The attack on Claim 1 was developed starting from the problem specified in the patent specification, arguing that viscosity was responsible for the indicated problems, and that a man skilled in the art would know how to manipulate viscosity and thus arrive at the claimed solution.

While the argumentation in the seven page statement of opposition might have been clearer, there was no failure in this case to comply with Rule 55 EPC. The facts of decision T 255/85 were quite different.

3. The wording of the new Claim 1 differs from that of the granted version in that the phrase "by heating the outside of the flashed product duct and the outside of the flashing tank" has been introduced after "at least 140°C".

The Board is satisfied that this amendment meets the requirements of Art. 123(2) and (3) EPC, since the amendment does not extend the protection conferred by the claims of the patent as granted and is supported by the disclosure on page 7, lines 20 to 26; page 10, lines 6 to 8; page 18, lines 7 and 8 as well as on page 22, lines 20 and 21 of the original text, corresponding to page 3, lines 31 to 34; page 4, lines 1 and 2; page 5, line 54 and page 8, lines 10 to 14 of the patent specification.

4. The claims and the Example of D5 disclose a process for concentrating a polymer solution by flashing, using a steamfeed to improve the efficiency. The Comparative Example omits this last mentioned feature. In the process according to Example 1 and Comparative Example 1, the polymer solution is heated to 180°C under a pressure of 20 kg/cm² G. It is then passed to a

flashing zone at a temperature of 180°C and a pressure of 1.3 kg/cm² G. The resulting solution contains 97.2% or 95% polymer, respectively. From the Figure it is apparent that the concentrated polymer solution is collected from the bottom of the flashing tank.

There is no explicit or implicit disclosure in D5 of external heating of the outer wall of the flashing tank in order to maintain the inner surface temperature at "at least 140°C".

By contrast thereto, the process of Claim 1 of the patent in suit, for keeping the temperature of the flashing tank at "at least 140°C" does provide for such a heating of the outside of the flashing tank.

Accordingly, the subject-matter of Claim 1 of the patent in suit is novel over this prior art.

5. D4 discloses in its Claim 1 in conjunction with Example 1 and the Figure, a process for concentrating an AP-polymer solution by flashing to evaporate and separate the solvent up to a polymer concentration of 97.8%. In the said process the flashing tank is provided with a heating jacket on its outside which is heated by means of a heating medium having 230°C. There is, however, no disclosure of a flashed product duct heated at its outside. The subject-matter of Claim 1 of the patent in suit thus is also novel over D4.

6.. Since novelty of Claim 1 as amended is no longer in dispute a more detailed discussion of this point is not necessary.

7. As to inventive step, the decision under appeal mentioned only that the subject-matter of Claims 6 to 15, acknowledged to be novel, lacked inventive step since there was no evidence that the novel features contributed in any way to the solution of a technical

problem. However, the Opposition Division has not yet had a chance to appraise any contribution of the novel features of the present claims to the solution of a technical problem.

Moreover, when investigating the existence of any inventive step the question of the priority date to which the claimed subject-matter is entitled may become of importance, considering that only the first of the three Japanese priorities claimed is earlier than the publication date of D5.

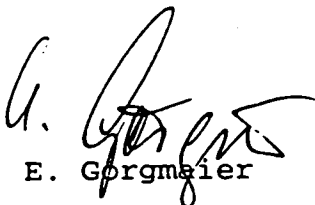
8. For these reasons and since the Appellant did not express any preference to the contrary, it appears appropriate to the Board to make use of the power conferred on it by Art. 111 EPC and to remit the case to the Opposition Division for further prosecution.

Order

For these reasons, it is decided that:

1. The decision under appeal is set aside.
2. The case is remitted to the Opposition Division with the order that the proceedings be continued on the basis of the Claim 1 submitted during the oral proceedings.

The Registrar:


E. Gorgmeier

The Chairman:


F. Antony