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# D E C I S I O N
# of 27 July 1999

**Case Number:** T 0461/96 - 3.3.5

**Application Number:** 89107443.7

**Publication Number:** 0343387

**IPC:** G01N 33/545

**Language of the proceedings:** EN

**Title of invention:**
Transfer of macromolecules from a chromatographic substrate to an immobilizing matrix

**Patentee:**
Yale University

**Opponent:**
Heinz Kauke

**Headword:**
-

**Relevant legal provisions:**
EPC Art. 99(1), 101, 54(1), 54(2)
EPC R. 55

**Keyword:**
"Admissibility of opposition (yes)"
"Novelty (no)"
"Availability (yes)"

**Decisions cited:**
G 0001/92, G 0004/97

**Catchword:**

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Europäisches Patentamt | European Patent Office | Office européen des brevets

Beschwerdekammern | Boards of Appeal | Chambres de recours

**Case Number:** T 0461/96 - 3.3.5

**D E C I S I O N**
**of the Technical Board of Appeal 3.3.5**
**of 27 July 1999**

**Appellant:** (Proprietor of the patent)
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**Decision under appeal:** **Decision of the Opposition Division of the European Patent Office posted 26 April 1996 revoking European patent No. 0 343 387 pursuant to Article 102(1) EPC.**

**Composition of the Board:**

**Chairman:** R. K. Spangenberg
**Members:** A.-T. Liu
J. H. van Moer

## Summary of Facts and Submissions

I. The appeal is against the decision of the opposition division revoking European patent No. 343 387 upon opposition filed by Mr Heinz Kauke.

II. The decision under appeal was based on the set of 19 claims as granted. Claim 1 reads as follows:

"A solid phase assay system wherein a macromolecule is immobilized in the solid phase on a surface of chromatographic substrate, characterized by employing as said solid phase a hydrophilic, porous positive charge modified microporous membrane comprising an organic microporous membrane having a charge modifying amount of a cationic charge modifying agent bonded to substantially all of the wetted surfaces of said membrane, which is a reaction product of a polyamine with epichlorohydrin, the reaction product having:

(i) tertiary amine or quaternary ammonium groups, and

(ii) epoxide groups along a polyamine chain, the epoxide groups capable of bonding to the membrane."

III. The following documents, inter alia, were relied upon in the decision:

(A) Gershoni et al., Analytical Biochemistry 124, 396-405 (1982)

(T) US trademark application papers, Serial No. 406431

IV. The opposition division held that it had no legitimate doubt concerning the real identity of the opponent. Furthermore, it was found that document (T) was proof that the subject-matter of at least independent claim 1 of the patent in suit lacked novelty in view of document (A).

V. In his statement of grounds of appeal, the appellant maintained his objection against the admissibility of the oppposition on the ground that there was serious doubt about the true identity of the opponent.

The following new affidavits were submitted to the effect that document (T) should not be used as evidence that the membrane known under the tradename Zetabind was made available to the public before the priority date of the patent in suit:

(D) Affidavit of David E. Dougherty dated 8 May 1996

(F1) Supplemental Affidavit of Michael E. Zall dated 26 August 1996

(G) Affidavit of Jonathan M. Gershoni dated 15 September 1996

(M) Affidavit of Rosalie Milone dated 9 September 1998

It was argued that the first use of Zetabind mentioned in document (T) consisted in a single shipment made by AMF/Cuno to Prof. Gershoni under the pledge of confidentiality. The public therefore could not have known that the membrane disclosed under the trademark Zetabind had the specifications as stipulated in

claim 1 of the patent in suit.

VI. The respondent refuted the appellant's suspicion concerning the use of a "straw man". In particular, it was pointed out that the appellant had not provided any facts or evidence in support of his allegation that the opponent was not the person responsible for filing the opposition.

Concerning novelty, it was again emphasized that the trademark registration (document T) was clear evidence that Zetabind was in the public domain, as it was used and sold in commerce before the priority date of the patent in suit. Copies of letters and interoffice correspondence were filed to prove that Cuno provided the information on the invention freely and with no legal ties to several companies:

(B1) to (B10) AMF/Cuno, Letters and Interoffice correspondence

VII. At the oral proceedings held on 27 July 1999, the appellant submitted amended claims as the basis for an auxiliary request. The new set of 15 claims corresponded to the claims of the patent in suit, the difference being that claims 12 to 15 of the patent in suit had been deleted and the remaining claims renumbered accordingly. The deleted claim 12 was directed to products as such, as alternatives to the products according to claim 1, with claims 13 to 15 being dependent thereon.

VIII. At the end of the oral proceedings, the parties' requests were as follows:

- The appellant (patentee) requested that the decision under appeal be set aside and the patent be maintained as granted or, auxiliarily, according to claims 1 to 15 submitted during the oral proceedings before the Board of Appeal and a description to be adapted.

- The respondent (opponent) requested that the appeal be dismissed.

## Reasons for the Decision

1. Admissibility of the opposition

Without the existence of an admissible opposition, the EPO in general and the boards of appeal in particular have no competence to decide upon the fate of a granted European patent.

In his statement of the grounds of appeal, the appellant has argued that the opposition should not be admissible because there were serious doubts about the real identity of the opponent. However, in decision G 4/97, OJ 1999, 270, the Enlarged Board of Appeal held that an opposition is not inadmissible purely because the person named as opponent according to Rule 55(a) EPC is acting on behalf of a third party. It would be ruled inadmissible if the involvement of the opponent is to be regarded as circumventing the law by abuse of process. In such a case, the burden of proof is borne by the person alleging that the opposition is inadmissible (see Headnote points 1(a), 1(b) and 2).

The appellant had been made aware of that decision by a communication of the Board in the appeal case involving the parent application (T 459/96) which was dealt with on the same day as the present case. In said communication, the Board drew the parties' attention to decision G 4/97 of the Enlarged Board of Appeal addressing the question of admissibility of an opposition filed by a straw man. The parties were invited to submit evidence pertaining to this particular aspect of the appeal. The appellant, however, expressly declared at the beginning of the oral proceedings that he did not wish to make further submissions concerning the admissibility of the opposition. At the end of said proceedings, he did not maintain his request to this effect.

It follows that the appellant has not advanced arguments, let alone clear evidence, that the law has been circumvented in the present case by an abuse of process. Therefore, irrespective of whether Mr Kauke has acted on his own behalf or on behalf of a third party, the Board holds that, for the reasons set out in decision G 4/97, the opposition is admissible.

*Main request*

2. *Novelty*

2.1 Document (A) relates to the use of a positively charged nylon membrane as an immobilizing matrix for the electrophoretic transfer of proteins from a polyacrylamide gel. The membrane is referred to as "Zeta-bind, a gift from AMF, Specialty Materials Group/Cuno Division" (see Summary and page 396, right-

hand column, last paragraph). It is undisputed that document (A) explicitly discloses all the technical features as stipulated in claim 1 of the patent in suit except the exact nature of the filter membrane to be used. The question therefore arises as to whether the structural features by which this membrane is defined in claim 1 are implicitly disclosed therein by the mentioning of Zeta-bind.

2.2 As is shown in document (T), the trademark Zetabind has been applied by AMF Incorporated for "Nylon charge modified immobilizing matrices for use in electrophoresis" before the United States Patent and Trademark Office (USPTO). According to a statement included in said document, dated 14 December 1982, signed and sworn by D. E. Dougherty, this trademark was first used in interstate commerce at least as early as 13 October 1982 (see (T): "The trademark was first used at least as early as October 13, 1982; was first used in interstate commerce at least as early as October 13, 1982; and is now in use in such commerce").

2.3 The appellant has asserted that the only shipment of Zetabind, to serve as proof of commerce for the purpose of trademark application, was to Prof. Gershoni under the pledge of secrecy. During the oral proceedings, the appellant relied on statements in various affidavits for support of this allegation and rejected AMF/Cuno letters and interoffice correspondence as proof to the contrary.

According to the appellant, the AMF/Cuno papers merely reflect the company's effort to market the new product. However, all these preliminary contacts were to be

treated as confidential. Even when a purchase of Zetabind by MWM was announced in (B7), there is no further evidence that the transaction was indeed made or that such transaction was made without the seal of confidentiality.

The appellant has pointed out that, in paragraphs 10 and 11 of (D), Mr Dougherty not only confirms "that it was the policy of AMF and CUNO not to sell or publish information until a patent application was on file" but further reasons why "AMF did not have a product available for commercial sale under the mark "ZETABIND" before September 1983". This is consistent with the affidavit by Rosalie Milone (see document (M), in particular paragraph 8) as well as with Prof. Gershoni's declarations, both in writing (document (G)) and at the oral proceedings.

The Board concurs with the appellant in that documents (B1) to (B10) do not unambiguously disclose that a sale has taken place without the seal of secrecy. Without evidence to the contrary, it can also accept that the cited affidavits were written in good faith and that the commercial sale of a product under the trademark "Zetabind" had not been launched before September 1983 on a broad basis. However, these affidavits cannot be taken to categorically exclude the possibility that a previous sale might have been made without the knowledge of the signers.

2.4 The Board has no doubt that the person most knowledgeable in this matter is Mr Zall. As is succinctly put by Mr Dougherty, signer of the sworn statement in document (T), Mr Zall "had immediate and

direct responsibility for the trademark involved" (see document (D), paragraph 6). However, the latter's statement to this effect is at best ambiguous. Thus, in his more recent affidavit, document (F1), paragraph 6, it is said that:

"I can therefore say unequivocally, that the October 13, 1982 interstate use date referred to in the trademark application that was filed on September 27, 1983 was either (a) a typographical error, i.e. the true date was after the priority date of February 7, 1983 but before the trademark filing date of September 27, 1983 or (b) was the date of an isolated sale made for obtaining trademark protection".

Assumption (a) appears to be of no use since it is incorrect. Indeed, an examination of document (T) shows that the correct filing date of the trademark application is without any doubt 17 December 1982 while 27 September 1983 is the date on which a brochure used as promotional material for Zetabind was submitted to the USPTO (see document (T), cover page, Trademark Principle Register, Reg. No. 1,272,513 and letter signed by M. E. Zall bearing the date September 27, 1983).

Assumption (b) appears to acknowledge that an isolated sale had been made before the priority date, without providing firm proof that the mentioned sale was made under the seal of confidentiality.

In the Board's judgement, therefore, Mr Zall's statements do not constitute clear evidence that the sworn statement made before the USPTO was inaccurate.

Documents (D) and (M) are not in contradiction with document (F1), nor can they prove the inaccuracy of said sworn statement. Thus, the Board holds that a bona fide business transaction had taken place before the priority date of the patent in suit.

2.5 Even though a brochure advertising the properties of the membrane was not available at that time, the exact nature of the Zetabind membrane was made known to the public by this sale. This is in agreement with EPO case law as laid down in decision G 1/92, OJ 1993, 277, of the Enlarged Board of Appeal (see Headnote of the decision: "the chemical composition of a product is state of the art when the product as such is available to the public and can be analysed and reproduced by the skilled person, irrespective of whether or not particular reasons can be identified for analysing the composition").

Furthermore, it is not in dispute that the composition of the Zetabind membrane is covered by the definition of the membrane according to claim 1 of the patent in suit.

2.6 A skilled person, having knowledge of the composition of the membrane Zetabind, would thus have been in a position to reproduce the teaching of document (A) and thereby arrive at the subject-matter of present claim 1. As a consequence, the subject-matter of said claim lacks novelty with regard to document (A).

*Auxiliary request*

Claim 1 of the amended set of claims according to the

auxiliary request is the same as claim 1 of the main request. The above findings therefore apply mutatis mutandis to the present request.

## Order

## For these reasons it is decided that:

The appeal is dismissed.

The Registrar The Chairman

S. Hue R. Spangenberg