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D E C I S I O N
of 9 September 1999

Case Number: T 0890/96 - 3.3.6

Application Number: 91300886.8

Publication Number: 0444788

IPC: D21H 17/45

Language of the proceedings: EN

Title of invention:

Treatment of coated broke

Patentee:

Nalco Chemical Company

Opponent:

Vianova Resins GmbH & Co KG Patent- und Lizenz-Abteilung

Headword:

Evidence for oral disclosure by lecture/NALCO

Relevant legal provisions:

EPC Art. 52, 54(2), 56

Keyword:

"Evidence by manuscript of lecture not accepted for feature beyond the essence of that lecture"

Decisions cited:

-

Catchword:

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Boards of Appeal

Chambres de recours

Case Number: T 0890/96 - 3.3.6

D E C I S I O N
of the Technical Board of Appeal 3.3.6
of 9 September 1999

Appellant: Nalco Chemical Company
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Respondent: Vianova Resins GmbH & Co KG
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Representative: -

Decision under appeal: Decision of the Opposition Division of the
European Patent Office posted 7 August 1996
revoking European patent No. 0 444 788 pursuant
to Article 102(1) EPC.

Composition of the Board:

Chairman: P. Krasa
Members: H. H. R. Fessel
M. Lewenton

Summary of Facts and Submissions

- I. European patent No. 0 444 788 in respect of European patent application No. 91 300 886.8 filed on 4 February 1991 and claiming a US priority of 26 February 1990 (US 485026) was granted on 21 December 1994 (Bulletin 94/51) on the basis of 11 claims, of which independent Claims 1 and 11 were directed to a method of forming a fibre slurry for use in paper manufacture and to the use of a polymer containing at least 20 weight percent diallyl dimethyl ammonium chloride (DADMAC) for coagulating white pitch on fibres of a slurry of re-pulped coated broke.
- II. Notice of Opposition was filed on 16 August 1995 by Hoechst AG requesting revocation of the patent in its entirety based on the grounds of lack of novelty and inventive step (Article 100(a) EPC).

The opposition was supported by the following documents:

- D1: Wochenblatt für Papierfabrikation, Nr. 15, August 1991, pages 569-575, "Laborstudie zur Simulation und Unterdrückung von Polymer-Aggregaten (white pitch) bei der Wiederverarbeitung gestrichener Ausschußpapiere"; and
- D2: Ind.Eng.Chem.Prod.Res.Dev., 19, pages 528-532 (1980).

In its notice of opposition, the Opponent alleged D1 to be the manuscript of a lecture given at the PTS-Streicherei-Symposium in September 1989 in Munich. To

prove correspondence of the lecture and D1

D3: a declaration (eidesstattliche Erklärung) of Dr Hentzschel, the lecturer, who was also the author of D1, was submitted by the Opponent on 22 June 1996.

Further documents being still relevant were:

D4: Technisches Merkblatt of October 1984 and

D5: Tagungsprogramm des 14. PTS-Streicherei-Symposiums.

III. By a decision given orally on 25 July 1996, issued in writing on 7 August 1996 the Opposition Division revoked the patent for lack of inventive step of the subject-matter of Claims 1 and 11 as granted (main request), and of a first auxiliary request as well as of the subject-matter of Claims 1 and 10 of a second auxiliary request, both auxiliary requests having been filed during oral proceedings.

Claim 1 of the main request read as follows:

"A method of forming a fibre slurry for use in paper manufacture comprising beating and re-pulping coated broke in an aqueous slurry and admixing with said slurry a polymer containing at least 20 weight percent of the monomer diallyl dimethyl ammonium chloride ("DADMAC") to coagulate white pitch of the slurry."

Claim 1 of the first and second auxiliary request differed from Claim 1 of the main request in that the

polymer was specified to be one "which is a homopolymer of DADMAC or a copolymer of DADMAC" or "a copolymer of DADMAC", respectively.

The Opposition Division and the parties raised no doubts as to the admissibility of these amendments with regard to Articles 123(2) and (3) EPC. The Opposition Division held the subject-matter of Claim 1 of the three different sets of claims to be novel since in particular D1 gave no information when the polymer DADMAC was actually added (before, during or after forming the fibre slurry).

Regarding the objection of lack of inventive step the Opposition Division held that whereas the actual addition of DADMAC to the slurry had not been explicitly mentioned in D1 this would have been obvious for a person skilled in the art since the only problem which had to be solved was to decide whether it was better to add the cationic polymer during or after the formation of the slurry. Finding the best mode of addition was regarded as normal design procedure within the skills of a person concerned having ordinary skills.

IV. On 30 September 1996 an appeal with separate payment of the prescribed fee was lodged against that decision by the Appellant (Patentee). In the Statement of Grounds of Appeal, received on 3 December 1996, the Appellant disputed the alleged lack of inventive step based on D1. His arguments were in essence as follows:

- (i) the Respondent (Opponent) alleged that D1 was an offprint of a presentation given orally by

Dr Hentzschel in September 1989 on the PTS-Streicherei-Symposium at Munich. However, Dr Hentzschel's late filed declaration (D3) merely stated that the content of D1 corresponded with the content of the said oral presentation ("... , daß der Inhalt des Artikels ... übereinstimmt mit dem Inhalt des von ihm gehaltenen Vortrags am 12. September 1989 ..."). No evidence had been produced to support that the crucial passage in D1, i.e. that "Hoe S 3529 is a poly-DADMAC" (left hand column on page 571) had been part of the lecture. Therefore, the Opponent having the burden of proof, did not show that this particular passage had been made available to the public before the publication date of D1.

(ii) even if the declaration was taken for being sufficient the opposition division was wrong to revoke the patent in relation to the second auxiliary request.

V. In its written submissions the Respondent argued in essence that any doubts relating to D3 could have been resolved by hearing Dr Hentzschel, who was present during oral proceedings before the opposition division, as a witness. In the absence of a request to that end, the Appellant conceded the correctness of D3. By letter of 21 June 1999, the EPO was informed by Vianova Resins GmbH & Co KG that the opposition against EP-B-0 444 788 belonged to the field of business "Polykondensate" which had been transferred from Hoechst AG to the former company, which consequently replaced Hoechst as the Opponent. The Appellant raised doubts whether the transfer satisfied the conditions laid down in G 4/88

(OJ 1989, 480) and invited the Board to investigate this issue.

VI. During oral proceedings, held on 9 September 1999 before the Board of Appeal, the Chairman informed the parties that, on the basis of the available evidence, the Board had no reason to doubt Vianova Resins GmbH & Co KG to be the legitimate Respondent.

(i) The Appellant was satisfied that the transfer has been checked by the Board and accepted the result. He maintained his doubts as to the admissibility of the opposition in view of the late filing of D3. He further disputed that the declaration amounted to evidence for identity of lecture and publication D1 in particular as far as the identification of Hoe S 3529 as poly-DADMAC was concerned and produced various arguments in support. As to inventive step he argued that in case the content of D1 was not to be considered to represent prior art, the other document D2 was silent as to the object of the patent in suit as specified on page 2, line 48 ff. and would thus not hint at the claimed solution.

(ii) The Respondent stressed that already in the notice of opposition further evidence had been offered for equivalency of the content of D1 and the lecture given on 12 September 1989 by Dr Hentzschel and that, consequently, the opposition complied with all the requirements of Article 99(1) and Rule 55 EPC. He submitted that D3 confirmed the correspondence of the contents of D1 with that of this lecture and inferred

therefrom that in his lecture the additive to be used in the respective process had been designated as poly-DADMAC. As to the lecture itself the Respondent argued that such lectures were in general addressed to users of the products, i.e. to promote products and thus were seen by the lecturers as some sort of commercial and not scientific events. As to inventive step, the Respondent argued that even in case the content of D1 would not be considered to represent prior art, D2 rendered obvious the claimed subject-matter since it was known from D2 to use poly-DADMAC in paper industry. The homopolymer and the acryl amide copolymer were said to be adsorbed by the pulp fibre surface (loc.cit. page 532, left hand column, second full paragraph) as in the patent in suit (see, page 2, lines 48 to 50).

- VII. The Appellant requested that the decision under appeal be set aside and that the patent be maintained as granted or alternatively be maintained in amended form on the basis of the auxiliary request 2 attached to the decision under appeal (auxiliary request 1) or on the basis of the auxiliary request submitted during the oral proceedings (auxiliary request 2).

The Respondent requested that the appeal be dismissed.

Reasons for the Decision

1. The appeal is admissible.
2. The Board considers that the opposition was filed in

time and in proper form which has not been disputed. It is also supported by reasoned statements, i.e. facts, evidence and arguments to support the grounds (Rule 55(c) EPC). The notice of opposition contained as reasons lack of novelty and of inventive step (Articles 100(a), 54 and 56 EPC) and as facts, evidence and arguments that the subject-matter claimed in the patent in suit had been made available in a lecture given by Dr Hentzschel in September 1989 at the PTS-Streicherei-Symposium. A paper published in August 1991, i.e. D1, was provided with the notice of opposition and the relevant passages to support the grounds were specified. On page 569, i.e. on the first page of D1, a foot-note is found "Vorgetragen beim PTS-Streicherei-Symposium 1989 in München" indicating that the contents of the paper had already been delivered orally in 1989. Further the Opponent offered that Dr Hentzschel, the author of D1, would confirm the correspondence of the lecture and D1 if necessary. The Board is thus satisfied that the provisions of Rule 55(c) EPC were met by the notice of opposition, since even in case of need the evidence provided later was already specified. It follows that the opposition was admissible.

3. Evaluation of the prior art, i.e. the lecture given by Dr Hentzschel in September 1989.

Prior art may only be based on evidence which shows, beyond any reasonable doubt, that a particular disclosure was available to the public and, thus, has become state of the art.

In the present case the date of the lecture was

according to D3 12 September 1989, which was not disputed eventually. It was only disputed that the use of poly-DADMAC to coagulate white pitch was part of the prior art. It had thus to be established whether the respective passages in D1 (page 571, left hand column, second full paragraph; page 574, left hand column, line 2 and/or page 575, left hand column, last line) were part of the lecture given by Dr Hentzschel. Since no verified transcripts of what was actually delivered orally are at hand and the only written evidence is D1, the question boils down to whether poly-DADMAC as such or its identity with Hoe S 3529 was mentioned in the lecture or whether the auditory was aware that Hoe S 3529 was poly-DADMAC.

The only evidence provided in this respect was D3 declaring that the contents of D1 corresponded with that of the lecture of 12 September 1989 (see above point IV). D3 cannot be understood as explaining that the written document D1 and the oral lecture were identical, which was also conceded by the Respondent when submitting that the formulation "Inhalt" was used in a similar way as it can be found in Article 69 EPC implying possible differences in the form but correspondence in respect to the terms (submission of 21 April 1997, second paragraph of No. 2).

The Board accepts D3 as sufficient evidence that the essence of D1 correspond with those of the lecture. As already indicated, however, the issue at stake is whether or not a very specific information, i.e. the identity of Hoe S 3529 and poly-DADMAC was either common general knowledge of those skilled in the art or was made available to the public at said lecture.

3.1 The Respondent did not provide any evidence showing that the identity of Hoe S 3529 and of poly-DADMAC was part of the common knowledge. Sheet 1 of D4 provided with the letter dated 21 June 1996 did not mention poly-DADMAC and sheet 2, mentioning DADMAC, could not be identified as genuine part of D4. For these reasons the Board concludes that the identity of Hoe S 3529 and poly-DADMAC did not belong to the common general knowledge of those skilled in the art.

3.2 As to the mentioning of poly-DADMAC or of its identity with Hoe S 3529 in the lecture the only evidence provided was D3 in which Dr Hentzschel declared that the content (Inhalt) of D1 corresponded with that of the lecture (see above point IV). For evaluating the bearing of this general statement in respect to the availability of the particular information concerned further aspects were considered by the Board. It was admitted by the Respondent during oral proceedings before the Board that said symposium had a commercial aspect since the audience addressed to were practitioners working in paper industry or related fields, a fact which is supported by D5, the programm of that symposium provided with the letter dated 21 June 1996. The Respondent also remarked that such symposia were seen by the lecturers as a kind of promotion event for supporting the sales of the products of their companies. In the Board's view the essence of Dr Hentzschel's lecture was thus to inform the audience of products suitable for the given purpose. Since the audience were not scientists the chemical composition of the products concerned was beyond the essence of the lecture because what they were interested in were the names of the products,

their performance when applied and where to buy. It follows that the identity of Hoe S 3529 and of poly-DADMAC cannot be considered to as essential feature of the lecture. Therefore, it was not proved beyond any reasonable doubt that during the lecture poly-DADMAC, an unessential feature in this context (see above), was mentioned.

- 3.3 Apart from the above discussed statement Dr Hentzschel further confirmed in D3 that Hoe S 3529 was explicitly mentioned in his lecture. He did not confirm that he also mentioned that Hoe S 3529 was a poly-DADMAC. The pertinent passage of D3 reads: "In dem Vortrag wurde der Gebrauch von Hoe S 3529 als Additiv zur Unterdrückung von Polymer-Aggregaten (sog. white pitch) explicit genannt. Bei Hoe S 3529 handelt es sich um ein Homopolymeres von Diallyl-dimethyl-ammoniumchlorid ("Poly-DADMAC") mit einer mittleren molaren Masse von ca 200 000 g/mol, später 85 000 g/mol."

Whereas this statement confirms the use of the designation Hoe S 3529 in Dr Hentzschel's lecture, it strikes the eye that this statement is not extended to the designation poly-DADMAC. It follows that neither this passage nor any other passage of D3 does confirm that the identity of Hoe S 3529 and of poly-DADMAC, as disclosed in D1, had already been made available to the public in the course of Dr Hentzschel's lecture.

Since it was not rendered plausible beyond any reasonable doubt that the technical information of D1 and Dr Hentzschel's lecture coincided in respect of this crucial feature, the Board concludes that the disclosure of D1 is no state of the art.

4. Since D1 is not prior art the claimed subject-matter is considered to be novel.

5. *Inventive step*

The patent in suit relates to the treatment of coated broke and states that the problem to be solved is to avoid drawbacks caused by the use of coated broke in the manufacture of paper sheet, especially those caused by white pitch (page 2, lines 28 to 31). This problem is a very specific one in a very specific field of paper industry.

In view of the description, especially the examples, the Board has no doubt that this problem was effectively solved by the means specified in the claims.

Without giving arguments the Respondent saw the problem to be solved with the patent in suit in polymer adsorption by the pulp fiber. The Board, however, considers this to be part of the solution given in the patent in suit wherein polymer and white pitch were adsorbed on the fiber to solve the existing technical problem.

The only prior art document in the proceedings wherein poly-DADMAC was mentioned is D2.

This document relates to the cyclopolymerization of N,N-dialkyldiallylammonium halides and its use. On pages 531 and 532 industrial uses of DADMAC were specified such as the use in paper industry.

In D2 the use of poly-DADMAC in paper industry is mentioned and it is specified (see page 32, left column, second full paragraph) that these cationic polymers have been used to improve drainage, fines or filler retention, and paper strength through adsorption on the negatively charged pulp. As indicated further the homopolymer and the acrylamide copolymer were absorbed by the pulp fiber surface. Poly-DADMAC was also said to be useful as an electroconductive coating on paper.

Therefore, this document did not contain any hint to problems caused by white pitch and the solution given on page 2, lines 48 to 55 in conjunction with the claims of the patent in suit.

It can thus not be regarded as relevant prior art when applying the problem-solution-approach and cannot render obvious the claimed subject-matter (Article 56 EPC).

Hence the subject-matter of the independent Claims 1 and 11 of the main request is considered to meet the requirements of Article 52 EPC. Since the subject-matter of Claims 2 to 10 is dependent on that of Claim 1 and comprises all the features of that claim it also meets the provisions of Article 52 EPC.

Since the patent is maintained on the basis of the main request there is no need to deal with the auxiliary requests.

Order

For these reasons it is decided that:

1. The decision under appeal is set aside.
2. The patent is maintained as granted.

The Registrar:

The Chairman:

G. Rauh

P. Krasa