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D E C I S I O N
of 28 April 1999

Case Number: T 0480/98 - 3.2.4

Application Number: 93100867.6

Publication Number: 0564764

IPC: A01K 15/02

Language of the proceedings: EN

Title of invention:

An article for animals entertainment

Applicant:

Ciuffo Gatto S.r.L.

Opponent:

-

Headword:

-

Relevant legal provisions:

EPC Art. 123(2), 84

Keyword:

"Trade mark - definition in claim - unallowable
generalisation"

"Trade mark - definition at priority and filing dates unclear"

Decisions cited:

-

Catchword:

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Boards of Appeal

Chambres de recours

Case Number: T 0480/98 - 3.2.4

D E C I S I O N
of the Technical Board of Appeal 3.2.4
of 28 April 1999

Appellant: Ciuffo Gatto S.r.L.
Via Alfieri, 17
10121 Torino (IT)

Representative: Gerbino, Angelo
c/o Jacobacci & Perani S.p.A.
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Decision under appeal: Decision of the Examining Division of the
European Patent Office posted 28 November 1997
refusing European patent application
No. 93 100 867.6 pursuant to Article 97(1) EPC.

Composition of the Board:

Chairman: C. A. J. Andries
Members: M. G. Hatherly
J. P. B. Seitz

Summary of Facts and Submissions

- I. On 15 January 1998 the appellants (applicants) filed an appeal against the decision of the examining division dispatched on 28 November 1997 to refuse the European patent application No. 93 100 867.6 (publication No. 0 564 764). The appeal fee was paid on 15 January 1998 and the statement of grounds of appeal was received on 31 March 1998.
- II. In its decision the examining division found that the various requests then on file failed due to addition of subject-matter beyond that derivable from the application as originally filed or insufficiency of disclosure.
- III. The following documents were mentioned during the appeal proceedings:
- D1: EP-A-0 247 606
- D2: WO-A-91/16825
- D3: Brochure "Mater-Bi® - La più nuova tra le materie plastiche presenta il concreto valore della biodegradabilità. Oggi 1991" in Italian from Novamont
- D3': Translation of D3 into English
- D4: Novamont - The Living Chemistry - Mater-Bi Technical Bulletin, August 1991

Enclosure A

Degradable Polymers - Principles and Applications,
edited by Gerald Scott and Dan Gilead, published in
1995 by Chapman & Hall, London, Chapter 6, pages 112 to
137, by Catia Bastioli

Enclosure B

Letter dated 25 March 1998 from Angelo Gerbino of
Jacobacci & Perani to Dr Bastioli of Novamont S.p.A.

Enclosure C

Letter dated 26 March 1998 from Dr Bastioli of Novamont
S.p.A. to Dr Angelo Gerbino of Jacobacci & Perani

- IV. The following versions of the independent claim 1 were
presented in condensed form at the oral proceedings
before the examining division on 13 October 1997, were
set out fully in section 1 of the board's communication
dated 30 September 1998 and now form the basis for the
different requests for the grant of a patent:

Main request:

"An animal chew of the type provided with a familiar
appealing shape for the animal to whom it is aimed,
characterized in that it is basically composed of a
thermoplastic material made with substances of
vegetable origin and with synthetic substances, that
lead to a structure interpenetrated at the molecular
level and linked by hydrogen bonding."

First auxiliary request:

"An animal chew of the type provided with a familiar appealing shape for the animal to whom it is aimed, characterized in that it is basically composed of a thermoplastic material made with natural polymers such as starch and with hydrophilic and biodegradable synthetic polymers, that lead to a structure interpenetrated at the molecular level and linked by hydrogen bonding."

Second auxiliary request:

"An animal chew of the type provided with a familiar appealing shape for the animal to whom it is aimed, characterized in that it is basically composed of a plastics material commercially known as MATER-BI (registered trademark)."

Third auxiliary request:

"An animal chew of the type provided with a familiar appealing shape for the animal to whom it is aimed, characterized in that it is basically composed of a plastics material commercially known as MATER-BI (registered trademark) according to the formulation known until 8th April 1992."

Fourth auxiliary request:

"An animal chew of the type provided with a familiar appealing shape for the animal to whom it is aimed, characterized in that it is basically composed of a plastics material commercially known as MATER-BI

(registered trademark) according to the formulation known until 21st January 1993."

- V. In the appeal proceedings the appellants submitted Enclosures A to C to clarify which materials were sold by Novamont under the trade-name Mater-Bi. Enclosure A summarises the history of the development of starch-polymer composites and Mater-Bi so as to fully and exhaustively explain which materials could be considered to be indicated by the trademark Mater-Bi at the time of the conception of the present invention. The appellants argued specifically for the allowability of the third and fourth auxiliary requests.

The board gave its provisional opinion in two communications that each of the five requests was unallowable. Claim 1 of each of the main request and first auxiliary request was unclear, vague and general and their alleged definitions of Mater-Bi were merely generalisations of the full definition. Moreover on the priority date the term Mater-Bi covered a plurality of products and did not have a clear technical meaning so that wording based thereon necessarily was unclear.

- VI. In accordance with the appellants' additional auxiliary request, the board summoned the appellants to oral proceedings on 28 April 1999. The appellants sent a facsimile on 21 April 1999 stating that they would not be attending the oral proceedings and withdrawing their request therefor. The board informed the appellants by facsimile on 23 April 1999 that the oral proceedings would nevertheless take place. The appellants did not appear on 28 April 1999. Since they were duly summoned, the oral proceedings were continued without them, in

accordance with Rule 71(2) EPC. At the end of the oral proceedings the present decision was taken.

- VII. In writing the appellants requested that the examining division's decision be set aside and that a patent be granted on the basis of one of five requests based on claims 1 as defined in section 1 of the board's communication dated 30 September 1998 (one main and four auxiliary requests). The appellants further requested that the case be remitted to the first instance for further prosecution.

Reasons for the Decision

1. The appeal is admissible.
2. The statement of grounds specifically defends the appellants' third and fourth auxiliary requests but gives no specific arguments in support of the main, first auxiliary and second auxiliary requests. Nevertheless all requests have been considered by the board.

The appellants did not deal in detail in their letter of 25 November 1998 with all the provisional objections made in the board's communication of 30 September 1998. Moreover they did not reply to the board's communication of 1 April 1999. The board has nevertheless reconsidered the case but essentially confirms its previous provisional opinion.

3. *Claim 1 of the main request*

- 3.1 Page 2 of the priority document and page 2 of the originally filed application say that "in a preferred embodiment of the invention, a product commercially known as MATER-BI and manufactured by NOVAMONT COMPANY, is used as this plastics material."
- 3.2 The wording "a thermoplastic material made with substances of vegetable origin and with synthetic substances, that lead to a structure interpenetrated at the molecular level and linked by hydrogen bonding" has been extracted from D3' or D4 to describe Mater-Bi and added to claim 1 of the main request. According to a declaration filed by the appellants with their letter of 24 November 1995, these documents were publicly distributed in 1991.
- 3.3 However D3' and D4 were not mentioned in the originally filed application and so were not part of the original disclosure. While the skilled person asking on the priority or filing date for details of Mater-Bi might well have received these documents, he might also have received other information. The introduction into claim 1 of the main request of what is moreover merely a part of the information presented by these non-referenced documents contravenes Article 123(2) EPC.
- 3.4 Even if it were accepted that information could be added from D3' or D4, then the added information would still be objectionable.
- 3.5 The second half of the characterising portion of claim 1 of the main request "a structure interpenetrated at the molecular level and linked by hydrogen bonding" does not seem to be the necessary

result of the first half "basically composed of a thermoplastic material made with substances of vegetable origin and with synthetic substances". It is unclear what limitation is placed on the components of the first half by the definition of the structure in the second half.

It appears from page 3 of D3' that the interpenetrated structure of the second half is the result of the substances of the first half being "combined through the NOVAMONT process". The claim however does not specify this NOVAMONT process (whatever this might be).

The alleged definition of Mater-Bi in claim 1 of the main request is thus, at least for this reason, merely a generalisation of the full definition of Mater-Bi. Therefore the claim is broader in scope than allowed by the original reference to Mater-Bi in the description, contrary to Article 123(2) EPC.

It is also pointed out that during the oral proceedings before the opposition division (see section 2 of the minutes) the "applicant stated that MATER-BI is a very specific term: a thermoplastic with starch and hydrophilic plastic, produced by NOVAMONT." The very specific characteristics of starch and hydrophilic plastic are not to be found in claim 1 of the main request leading to doubts as to just what Mater-Bi really is.

- 3.6 The originally filed claim 1 specified that the article "is basically composed of a plastics material obtained from natural polymers" (and the remainder of the originally filed application was in line with this

restriction) whereas claim 1 of the main request does not even mention natural polymers. Thus in this respect the subject-matter of the application is extended beyond that of the originally filed application (contrary to Article 123(2) EPC).

- 3.7 Claim 1 of the main request specifies a **thermoplastic** which however has no basis in the originally filed application.
- 3.8 Contrary to Article 84 EPC, the characterising portion of the claim is unclear in that its two halves are not linked to each other, as explained in the above section 3.3. Moreover the wording is itself vague and general.
- 3.9 As an example of this vagueness, the difference between the "substances of vegetable origin" and the "synthetic substances" is not clear since even an ethylene copolymer is commercially produced from a hydrocarbon feedstock (oil of originally vegetable origin).
- 3.10 It will be explained in section 5 below that the term Mater-Bi is unclear so that wording based thereon would seem necessarily also to be unclear.
- 3.11 Consequently the board finds claim 1 of the main request to be unallowable for contravention of Articles 123(2) and 84 EPC.

4. *Claim 1 of the first auxiliary request*

- 4.1 The objections under Articles 123(2) and 84 EPC to claim 1 of the first auxiliary request are basically

the same as those set out in sections 3.3 to 3.5, 3.7, 3.8 and 3.10 for claim 1 of the main request.

4.2 Moreover while the originally filed claim 1 specified that the article "is basically composed of a plastics material obtained from natural polymers" (and the remainder of the originally filed application was in line with this restriction), claim 1 of the first auxiliary request specifies that the article is basically composed of a thermoplastic material made not only of natural polymers but also of hydrophilic and biodegradable synthetic polymers.

4.3 Consequently the board finds also claim 1 of the first auxiliary request to be unallowable for contravention of Articles 123(2) and 84 EPC.

5. *Claim 1 of the second auxiliary request*

5.1 This claim specifies that the animal chew "is basically composed of a plastics material commercially known as MATER-BI (registered trademark)".

5.2 The appellants assert that the term Mater-Bi used in this claim 1 has a very precise meaning (see e.g. their letter of 10 September 1997, page 1, paragraph 4).

5.3 The board however considers that the term Mater-Bi - as such - does not have a clear technical meaning and that it is not clear how a group of materials defined only by the term Mater-Bi differs from any other material.

Even in 1991 the term Mater-Bi covered a plurality of products (seven are listed on page 7 of D4) having

different compositions and properties (see pages 13 to 25 of D4). To go further, according to page 11 of D4 concerning the identification formula "Mater-Bi CTNNB" it is said of the two numbers "NN" that "In progression, associated with class and technology, they identify the formula". Numbering one of the seven products listed on page 7 of D4 as AI35H (i.e. NN = 35) implies that there were at this time even more than the seven products listed on page 7 of D4.

5.4 Thus there is a lack of clarity resulting mainly from the unknown products which would fall under the vague term "Mater-Bi". Thus the meaning of Mater-Bi at the priority date is not clear.

5.5 This objection is not overcome by providing evidence (Enclosures B and C) that Mater-Bi of classes A and Z are both suitable for the production of pet toys.

Neither is the objection overcome by Enclosure A which was published after the priority date (8 April 1992) and filing date (21 January 1993) of the present application and so was not available to the skilled person on these dates. While it contains a lot of information it is not clear when much of this information became available to the public i.e. whether this information was available at the priority date. Moreover Enclosure A is entitled "Starch-polymer composites" and deals with these in general terms so that it is not clear how much of the information applies in particular to Mater-Bi. The appellants only specifically cite "Paragraph 6.4 (pages 129 to 131), the only relevant content of which is that "Mater-Bi products include three main classes: A, Z and V"

(bottom of page 129) and associated dates on pages 130 and 131 (A: "since 1990", Z: "introduced into the market at the beginning of 1992", and V: "introduced into the market at the beginning of 1993"). In view of the filing date being 21 January 1993 the last statement that the V class materials were introduced into the market at the beginning of 1993" is not proof that there was not a public disclosure of the V class materials before the filing date.

5.6 Since Mater-Bi does not have a unequivocally clear technical meaning, it cannot be used in a claim (Article 84 EPC).

5.7 Accordingly the board finds claim 1 of the second auxiliary request to be unallowable.

6. *Claim 1 of the third auxiliary request*

This claim 1 additionally specifies that the Mater-Bi is "according to the formulation known until 8th April 1992" i.e. the priority date. This was done to counter the objection that the meaning of Mater-bi might not stay the same throughout the life of the patent.

However the additional wording does not overcome the basic objection made in the above section 5 that the meaning of Mater-Bi at the priority date was uncertain.

Accordingly the board finds claim 1 of the third auxiliary request unallowable.

7. *Claim 1 of the fourth auxiliary request*

This claim 1 specifies that the Mater-Bi is "according to the formulation known until 21st January 1993" i.e. the filing date.

The board's objections are basically those in sections 5 and 6.

Accordingly the board finds claim 1 of the fourth auxiliary request unallowable.

8. The appellants request that the case be remitted to the first instance for a two-level judgement also in respect of the evidence filed with the statement of grounds of appeal. However the board sees no need for two instances to review this evidence and so makes use of the authority given it by Article 111(1) EPC to "exercise any power within the competence of the department which was responsible for the decision appealed".
9. For the above reasons, the board finds that the claim 1 of each of the five requests is unallowable under Article 123(2) EPC and/or Article 84 EPC. Accordingly the requests as a whole are unallowable. In these circumstances to examine whether the claimed subject-matter involves an inventive step in view of D1 and D2 is superfluous.

Order

For these reasons it is decided that:

The appeal is dismissed.

The Registrar:

The Chairman:

N. Maslin

C. Andries