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D E C I S I O N
of 27 September 2004

Case Number: T 1081/01 - 3.3.1

Application Number: 90912467.9

Publication Number: 0497976

IPC: C07D 493/04

Language of the proceedings: EN

Title of invention:
Method of producing acetals

Patentee:
NEW JAPAN CHEMICAL CO., LTD.

Opponent:
-

Headword:
Acetals/NEW JAPAN CHEMICAL

Relevant legal provisions:
EPC Art. 54(2)
EPC R. 55(c)

Keyword:
"Novelty (yes) - information not made available to public"

Decisions cited:
T 0300/86, T 0289/91, T 0842/91, T 0522/94, T 0932/96,
T 0011/99, T 0050/02

Catchword:
Information provided subject to a confidentiality agreement does not become available to the public merely by reason of the expiry of the obligation to keep it confidential. Some separate act of making it available to the public would be needed.



Case Number: T 1081/01 - 3.3.1

D E C I S I O N
of the Technical Board of Appeal 3.3.1
of 27 September 2004

Appellant: NEW JAPAN CHEMICAL CO., LTD.
(Proprietor of the patent) 13, Yoshijima Yaguracho
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Representative: VOSSIUS & PARTNER
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Decision under appeal: Decision of the Opposition Division of the
European Patent Office posted 17 July 2001
revoking European patent No. 0497976 pursuant
to Article 102(1) EPC.

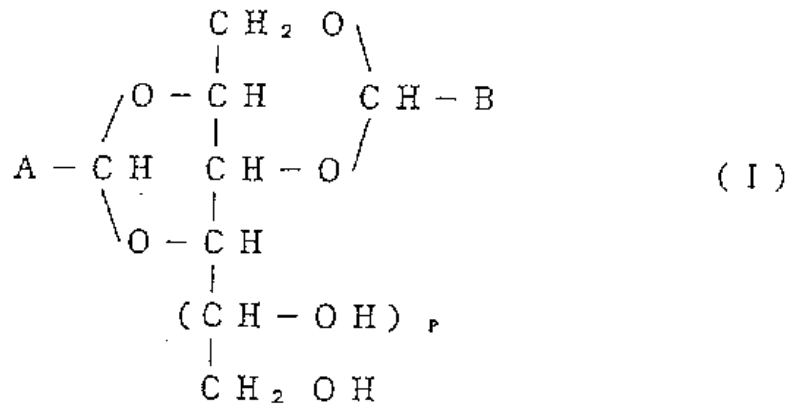
Composition of the Board:

Chairman: A. J. Nuss
Members: P. P. Bracke
S. C. Perryman

Summary of Facts and Submissions

I. The Appellant (Proprietor of the patent) lodged an appeal against the decision of the Opposition Division on the revoking of European patent No. 0 497 976, which had been granted with 20 claims with the only independent claim reading:

"1. A process for producing an acetal compound represented by the general formula



wherein A and B are the same or different and are each phenyl, naphthyl or tetrahydronaphthyl, the phenyl, naphthyl or tetrahydronaphthyl having or not having 1 to 5 substituents selected from among C₁-C₄-alkyl group, C₁-C₄-alkoxy group, halogen atom, carboxyl group, (C₁-C₂₀ alkyloxy)carbonyl group, (C₁-C₂₀ alkyloxy)ethylozycarbonyl group, (C₁-C₁₂ alkyl)phenyl group, halogenated phenyl group, (C₁-C₁₂ alkoxy)phenyl group, (C₁-C₁₂ alkyloxy)ethyloxyethylozycarbonyl group and (C₁-C₁₂ alkyloxy)ethyloxyethylozyethylozycarbonyl group, and p is 0 or 1 by subjecting (%) at least one of aldehyde compounds represented by the general formula

A-CHO (II)

and the general formula

B-CHO (III)

wherein A and B are as defined above, and (B) a polyhydric alcohol selected from among a pentahydric alcohol and a hexahydric alcohol to condensation in the presence of (C) a lower alcohol selected from the group consisting of a saturated aliphatic alcohol having 1 to 4 carbon atoms, allyl alcohol or furfuryl alcohol, (D) a hydrophobic organic solvent not forming a gel in any way or not forming a tough gel with the acetal compound of the general formula (I) prepared, serviceable as a dispersion medium and having a boiling point of about 40 to about 200°C and (E) an acid catalyst, the process being characterized in that the procedure of charging the lower alcohol into a reactor and thereafter withdrawing more than one-half of the charge of lower alcohol from the reaction system along with water is repeated at least three times during the condensation reaction."

II. The opposition was filed solely on the ground that the subject matter of the patent as a whole was not new, based on evidence that there had been various agreements between the Patentee and the Opponent, that pursuant to these agreements technical information as identified in Exhibit JWR1 to an affidavit of a Mr John W. Rekers had been supplied to the Opponent already in 1980, that according to the agreements after the 23 March 1990 the Opponent was no longer bound to keep the information supplied confidential and was free in

law and equity to use the information and to disclose it without fetter, so that from 24 March 1990, before the filing date of the patent in suit, the information as identified in Exhibit JWR1 was available to the public, being in the hands of the relevant public, namely the Opponent. There was no reliance on any further disclosure of the information by the Opponent to anyone else as being in itself a making of the information available to the public.

- III. The Patentee objected that the opposition was inadmissible because to the Opponent's own knowledge what they alleged did not make out a case of public prior use, and thus they had not complied with the requirement of Rule 55(c) EPC of indicating the facts and evidence in support of the ground of lack of novelty.
- IV. The Opposition Division found the opposition admissible. It accepted Exhibit JWR1 as sufficient evidence that the information provided under a secrecy agreement between the Appellant and the Respondent (Opponent) was specifically related to a process embraced within the wording of granted Claim 1. Therefore, the technical information provided under secrecy agreement corresponded to the claimed process.

Since the secrecy agreement expired before the filing date of the patent in suit, the exchanged information under secrecy was from the date of expiry of the secrecy agreement on to be considered available to the public. Claim 1 therefore did not meet the requirement of novelty.

- V. The Appellant maintained its objection that the opposition was inadmissible.
- VI. With letter of 15 July 2003 the Respondent withdrew its opposition.
- VII. The Appellant requested to set aside the appealed decision and to maintain the patent as granted. As an auxiliary measure he requested to be summoned for oral proceedings.

Reasons for the Decision

- 1. The appeal meets the requirements of Articles 106 to 108 and Rule 64 EPC and is admissible.

Admissibility of the opposition

- 2. As has been repeatedly stated in the case law (e.g. T 289/91 (OJ EPO 1994, 649,) or T 522/94 (OJ EPO 1998, 421) the admissibility of the opposition must be checked ex officio in every phase of the opposition and ensuing appeal proceedings. As in the present case the patentee had already challenged the admissibility of the opposition at the earliest opportunity in the opposition on the ground that it did not meet the requirements of Rule 55(c) EPC, and has maintained this position on appeal, it is appropriate for the Board to give a reasoned decision on this point.
- 3. The statement of opposition as originally filed set out the details of the agreements pursuant to which the Opponent had received technical information from the

patentee, and the technical information which was being relied on as destroying novelty was identified by reference to Exhibit JWR 1. The statement indicated the extent to which the patent was opposed and contained arguments as to why this information was on the facts given made available to the public. Evidence was supplied in the form of copies of the documents referred to. This was by itself sufficient to meet the requirements of Rule 55(c) EPC: the Patentee and the Opposition Division were informed precisely of the case for lack of novelty that was alleged. It is not a requirement for admissibility that an irrefutable case be made out by the Opponent, but merely that it is clear what the case is. Whether the case is successful or not is the substantive issue that will then have to be decided.

4. Given that the original opposition was admissible, it is not further relevant to admissibility that the Opponent filed further evidence introducing new facts relating to the same to amplify its case for lack of novelty. It was within the discretion of the opposition division to accept this into the proceedings.

State of the art

5. What can be considered as part of the state of the art is laid down in Article 54(2) EPC as everything made available to the public by means of a written or oral description, by use or in any other way, before the date of filing of the European patent application. The case law (see Case Law of the Boards of Appeal of the European Patent Office, 4th edition 2001 Section I.C.1.6.6) accepts that information is "available to

the public" if only a single member of the public is in a position to gain access to it and understand it, and if there is no obligation to maintain secrecy. However in every such case (see also T 932/96 of 16 June 1998 points 2.4.4.4 and 2.4.4.5, or T 11/99 of 10 October 2000 points 1.2.1 and 1.2.2) the information was made available to one or more persons who **at the time of the information being made available** could be described as a member or members of the public.

6. It is also part of the case law, as stated in decision T 300/86 of 28 August 1989, point 2.1, recently affirmed in this respect by decision T 50/02 of 29 June 2004, point 2.5.2, that for a document to be considered as being made available to the public **all the interested parties** must have an opportunity of gaining knowledge of the content of the document. These two strands of jurisprudence can only be reconciled on the basis that it is critical to show that the person(s) to whom the information was made available could **at the time of the information being made available** be treated as a member or members of the public, and thus representative of all interested persons.
7. If at the time of receipt of the information the recipient is in some special relationship to the donor of the information, then he cannot be treated as a member of the public, and the information cannot be regarded as published for the purpose of Article 54 EPC. Even if this special relationship should later cease, so that the recipient is now free to pass on the information, the mere cessation of this special relationship does not make the information available to anyone else.

8. Information provided subject to a confidentiality agreement does not become available to the public merely by reason of the expiry of the obligation to keep it confidential. Some separate act of making it available to the public would be needed.
9. This conclusion is in agreement with the conclusion reached in decision T 842/91 of 11 May 1993 (see point 2.1), where permission to publish a text was considered merely as permission to make the text available to the public, and not as actually making the text available to the public.
10. The technical information as identified in Exhibit JWR1 (see point II) is thus not considered to be made available to the public. As there is no evidence on file that any information relied on as novelty destroying was made available at any time to anyone who could be regarded as a member of the public, the decision under appeal must be set aside and the patent maintained as granted.
11. In the light of the above findings, there is no need for the Appellant to be heard in oral proceedings.

Order

For these reasons it is decided that:

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

The Registrar:

The Chairman:

N. Maslin

A. Nuss