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D E C I S I O N
of 31 January 2003

Case Number: T 0116/02 - 3.3.5

Application Number: 94905166.8

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Language of the proceedings: EN

Title of invention:
Filtration process

Patentee:
E.I. DU PONT DE NEMOURS AND COMPANY

Opponent:
Pannevis B.V.

Headword:
Filtration process/DU PONT

Relevant legal provisions:
EPC Art. 54(2)

Keyword:
"Public prior use - yes, free use of an apparatus after sale"

Decisions cited:
T 0482/89, T 0782/92

Catchword:
-



Case Number: T 0116/02 - 3.3.5

D E C I S I O N
of the Technical Board of Appeal 3.3.5
of 31 January 2003

Appellant: Pannevis B.V.
(Opponent) Elektronweg 24
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Representative: Duxbury, Stephen
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Respondent: E.I. DU PONT DE NEMOURS AND COMPANY
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Representative: Jones, Alan John
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Decision under appeal: Decision of the Opposition Division of the
European Patent Office posted 22 November 2003
rejecting the opposition filed against European
patent No. 0 682 554 pursuant to Article 102(2)
EPC.

Composition of the Board:

Chairman: R. K. Spangenberg
Members: G. J. Wassenaar
J. H. Van Moer

Summary of Facts and Submissions

I. The appeal is from the decision of the Opposition Division to reject the opposition against European patent No. 0 682 554. The patent was based on the European patent application No. 94 905 166.8, filed on 24 January 1994 with a claimed priority date of 5 February 1993. The patent was granted with 19 claims.

Claim 1 thereof reads as follows:

"A method of displacing carboxylic acid-containing mother liquor comprising acetic acid or water from a solids material in the form of terephthalic acid crystals which are slurried in said mother liquor, said method comprising:

forming the solids material into a layer on a movable filter medium (100);

transporting the layer by means of the filter medium through a washing zone (Z2) in which the layer is contacted along the path of movement thereof with a wash medium, the wash medium serving to displace mother liquor from the layer and passing through the filter medium (100); said method characterised by

establishing over said layer an inert gaseous atmosphere from which inert gas passes through the layer; and

supplying inert gas to the gaseous atmosphere so as to produce a concentration gradient within the gaseous atmosphere such that the mother liquor content of the gas passing through said layer increases in a direction

counter-current to the direction of travel of said layer."

- II. The opposition grounds were lack of novelty and lack of inventive step (Article 100(a) EPC). The prior art relied on by the appellant (opponent) was public prior use of processes performed at the premises of the firm Sisas in Limite near Milan. The Opposition Division accepted the prior use of a Pannevis gas-tight belt filter for filtering and purification of isophthalic acid, but held that there was not sufficient evidence that this use was public before the priority date of the patent in suit.

In the decision, *inter alia*, the following prior art documents were considered:

- D3: Letter of Massimo Ravizza (ING, RAVIZZA & C.) to Lex Orizand (Pannevis bv) dated 23 January 1987,
- D6: Drawing No. 86144.1-A,
- D16: Drawing No. 003131, dated 27 May 1987,
- D25: Declaration of Piero Cugnasca, dated 27 September 2001,
- D26: Declaration of Franco Codignola, dated 27 September 2001,
- D31: Secrecy agreement between Pannevis bv and ICI Chemicals & Polymers Ltd, dated 14 June 1991.

- III. In the statement of the grounds of appeal, the appellant maintained that information concerning said

prior use was publicly available and offered to other customers by Pannevis during an open day on 25 January 1990. Moreover, after the regular sale to Sisas, the Pannevis belt filter and its use entered into the public domain. At the Sisas premises not only isophthalic acid but also terephthalic acid was produced. The production was also not limited to the schematic drawing according to D6 but included methods in which the recycled nitrogen gas was introduced into the filter housing in counter current relation with the direction of travel of the layer of solids material. There was no secrecy agreement between Pannevis and Sisas. In this respect reference was made to D25 and D26 and to two further declarations of Dr Massimo Ravizza and Ing. Alphons A.J.A. Prinssen, filed during the appeal proceedings. But even assuming that the feature of supplying the inert gas in a counter current direction was not publicly available, the supply of the inert gas in such a way was obvious to the skilled person.

- IV. The respondent refuted the arguments of the appellant and maintained that the process for producing isophthalic acid at the premises of Sisas did not form part of the public domain. According to D3 a secrecy agreement existed between Mr Ravizza and Pannevis. Employee's of ICI visited the Sisas premises on 16 October 1991 and inspected the belt-filter of Pannevis. Because of the confidentiality agreement between Pannevis and ICI (D31) everything which was discussed during this visit and the method of operation of the belt-filter was confidential. Even if no formal confidentiality agreement existed between Sisas and Pannevis concerning the operation of the belt-filter, the contractual relations were such that a secrecy

agreement could be assumed to exist. There was no evidence that terephthalic acid was filtered on the Pannevis belt filter. But even if it were the case, the inert gas was not supplied in the counter current direction as required by the patent in suit. In this respect a declaration of Dr Graham R. Aird, dated 25 October 2002 was filed. With reference to decision T 782/92 it was stressed that in cases of alleged prior use the standard of proof is a high one, ie beyond any reasonable doubt.

- V. During the oral proceedings, which were held on 31 January 2003, the appellant requested that if the declarations D25 and D26 were not sufficient to prove the public prior use of the method according to claim 1 as granted, Mr Cugnasca and/or Mr Codignola, who signed these declarations, should be heard as witnesses. They could testify as follows:

"A method was publicly known of claim 1, wherein the solid material is in the form of terephthalic acid crystals, and wherein the nitrogen gas travels counter current to the direction of travel of the mother liquid such that the mother liquid content of the gas passing through said layer increases in a direction counter current to the direction of travel of said layer over substantial the whole length of the filter cake such that the gas sweeps evaporated acetic acid/water upstream to prevent recontamination of the cake especially in the final washing stages and beyond".

The respondent confirmed during the oral proceedings that the method described in such a testimony would destroy the novelty of present claim 1. Such a method would, however, be contradictory to the process as

disclosed in D6 and D16. The appellant could not rely on contradictory evidence. If the appellant based his novelty argument on the new testimony, D6 and D16 should be removed from the file.

- VII. The appellant (opponent) requested that the decision under appeal be set aside and the European patent No. 0 682 554 be revoked or, in the alternative, that the case be remitted to the first instance for further prosecution.

The respondent (patentee) requested that the appeal be dismissed and that the patent be maintained.

Reasons for the Decision

1. It is undisputed that before the priority date of the patent in suit isophthalic acid was produced at the Sisas premises , whereby a slurry of the acid was filtered and washed on a belt-filter bought from and installed by Pannevis and functioning as indicated in D6 and D16. If a firm purchases a machine it is generally free to use it in any way and for any purpose unless the sale was made under a special arrangement between the contracting parties to restrict its use or to keep the whole or part of the purchased machine secret (see T 482/89, OJ EPO 1992, 646, point 3 of the reasons).
2. The respondent has not provided evidence for any arrangement between Pannevis and Sisas in this respect.

Mr Ravizza's request in D3 to consider the information therein as strictly confidential, relates to a

situation before the sale concerning the possible suitability of the Pannevis belt filter in the production process of isophthalic acid and terephthalic acid at the premises of Sisas. It has no bearing on the situation after the sale and does not affect the commercial relationship between Sisas and Pannevis.

The secrecy agreement of Pannevis with ICI relating to the use and suitability of the Pannevis belt filter for treating terephthalic acid (D31) was dated 14 June 1991, ie four years after the sale of the Pannevis belt filter to Sisas. It does not apply to Sisas and it cannot be deduced therefrom that a similar secrecy arrangement existed with Sisas. Such a secrecy arrangement with Sisas is further unlikely because Pannevis used the belt filter in operation at the Sisas premises to promote the sale of its belt filters to other potential customers. According to his own declaration, Mr Prinssen held a presentation at the Pannevis' premises in Utrecht on 25 January 1990 during which it was disclosed to about 70 representatives of potential customers, including representatives of ICI, that Pannevis had installed a belt-filter at the Limito site of Sisas for the production of both terephthalic and isophthalic acid.

The Board does not consider said declaration filed with the appellant's letter as late filed evidence which should be disregarded (Article 114(2) EPC, because it only confirms submissions made in the grounds of the appeal and is a direct response to submissions made in the respondent's letter of 10 October 2002 and the declaration of Mr Aird, filed with the respondent's letter of 29 October 2002.

After said presentation of Mr Prinssen in Utrecht Mr Aird, the TA(Terephthalic Acid) Project Technical Manager of ICI, visited, according to his own declaration, the Sisas plant on 16 October 1991 and discussed with people from Sisas in the presence of Mr Ravizza the use of the belt filter for the purification of aromatic dicarboxylic acids. Thus even if Sisas had not produced terephthalic acid before, at least since the visit of Mr Aird they were aware that their belt filter could be used for that purpose. There is no mention in the declaration of Mr Aird that the representatives of Sisas should keep secret their knowledge gained during the visit.

Taking further into consideration the explicit statements of employees of Sisas, D25 and D26, that the belt filter was not the subject of any confidentiality agreement between Sisas and Pannevis, and the explicit statement in the declaration of Mr Prinssen that there had never been a secrecy arrangement in force between Pannevis and Sisas, the Board holds that it is beyond reasonable doubt that the operation of the Pannevis belt filter for the production of isophthalic acid at the Sisas premises, and at least its potential use for the preparation of terephthalic acid, was publicly known before the priority date of the patent in suit. In the Board's opinion this finding is in agreement with the high standards for proof of an alleged prior use as formulated in T 782/92 of 22 June 1994, point 2.2 of the reasons.

3. The issues of novelty and inventive step should therefore be considered taking into account the methods of operation of the belt filter at the Sisas premises as state of the art within the meaning of Article 54(2)

EPC. Since novelty and inventive step have not been investigated by the Opposition Division, the Board deems it not appropriate to decide these issues without a decision on these matters by the first instance (Article 111(1) EPC).

4. According to the submissions of the appellant the belt filter at Sisas was not only used for the preparation of isophthalic acid but also for terephthalic acid, and not only operated as indicated in D6 and D16 but also in a way whereby the recycled nitrogen was only introduced at the downstream end of the belt. With reference to the declaration of Mr Aird, the respondent refuted that these alternative modes of operation were available to the Sisas representatives before the priority date of the patent in suit.

Since the parties disagree as to the operation modes for the nitrogen gas recycle actually performed in the belt filter used at the Sisas premises and the knowledge available to the skilled persons of Sisas responsible for the operation of the belt filter, the Opposition Division should hear the witnesses offered by the appellant.

5. Although the method according to the testimony offered is different from the method as indicated in D6 and D16, the acceptance of new evidence in the form of a hearing of witnesses cannot have the consequence that earlier evidence with a different content is removed from the file. Even if the appellant no longer wished to rely on D6 and D16, they would remain in the file. The Board sees, however, no reason why the appellant should not rely on the earlier evidence as well as the evidence to be submitted by said witnesses. The

evidence is not contradictory if it in fact relates to different methods performed at different times.

Order

For these reasons it is decided that:

1. The decision under appeal is set aside.
2. The case is remitted to the first instance for further prosecution.

The Registrar:

The Chairman:

U. Bultmann

R. Spangenberg