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D E C I S I O N
of 7 December 2005

Case Number: T 1130/03 - 3.3.06

Application Number: 96942614.7

Publication Number: 877120

IPC: D21H 17/45

Language of the proceedings: EN

Title of invention:
Papermaking Process

Patentee:
Hymo Corporation

Opponent:
Eka Chemicals AB

Headword:
Papermaking method/HYMO

Relevant legal provisions:
EPC Art. 54

Keyword:
"Novelty (yes): the ambiguous reference in a first document to disclosure contained in another document cannot contribute to what is directly and unambiguously disclosed in said first document (points 1.5 to 1.6.2 of the reasons for the decision) "

Decisions cited:
-

Catchword:
-



Case Number: T 1130/03 - 3.3.06

D E C I S I O N
of the Technical Board of Appeal 3.3.06
of 7 December 2005

Appellant:
(Opponent)

Eka Chemicals AB
S-445 80 Bohus (SE)

Respondent:
(Proprietor of the patent)

Hymo Corporation

Representative:

Dr. Volker Vossius
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Decision under appeal:

Interlocutory decision of the Opposition
Division of the European Patent Office posted
27 August 2003 concerning maintenance of the
European patent No. 877120 in amended form.

Composition of the Board:

Chairman: P. Krasa
Members: P. Ammendola
A. Pignatelli

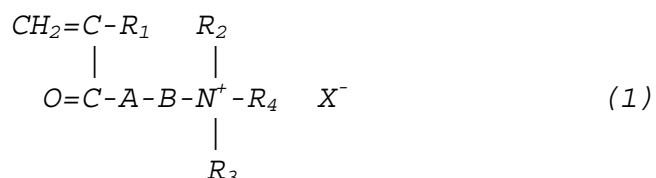
Summary of Facts and Submissions

I. This appeal is from the interlocutory decision of the Opposition division concerning the maintenance in amended form of European patent No. 0 877 120 according to the then pending main request of the Patent proprietor.

II. Claim 1 of this request (hereinafter "claim 1 as maintained") read:

"1. A papermaking method comprising the steps of:

adding to paper stuff in a papermaking step an ionic water-soluble polymer obtained by a polymerization method for obtaining a dispersion of fine polymer particles by polymerizing (A) 3 to 100 mol% of a water-soluble cationic vinyl monomer represented by the following formula (1)



(wherein A is O or NH; B is C₂H₄, C₃H₆ or C₃H₅OH; R₁ is H or CH₃; R₂ and R₃ are each CH₃ or C₂H₅; R₄ is H, CH₃, C₂H₅ or benzyl group; and X⁻ is an anionic counter ion), or a mixture thereof, (B) 0 to 30 mol% of a water-soluble anionic vinyl monomer, and (C) the remainder consisting of a water-soluble non-ionic vinyl monomer based on the total amount of all the monomers under agitation in an aqueous salt solution capable of dissolving the monomers and not the produced polymer in the presence of a

dispersant which is composed of a polymer electrolyte soluble in the aqueous salt solution;

mixing said ionic polymer with the paper stuff, and

adding and mixing an anionic additive consisting of organic anionic (co)polymer or a mixture of organic anionic (co)polymer and anionic colloidal silica and/or bentonite so as to improve retention and/or drainage property."

The remaining claims 2 to 16 were as granted and defined preferred embodiments of the papermaking method of claim 1.

III. The Opponent had sought revocation of the patent in suit only on the grounds of lack of novelty (Article 100(a) in combination with Articles 52(1) and 54 EPC). During the opposition proceedings it had cited among others Document (1) = EP-A-0 752 496 which is state of the art only under the provisions of Article 54(3) and (4) EPC.

IV. The Opposition division found that the subject-matter of claim 1 as maintained was novel vis-à-vis the prior art disclosed in this citation because the claimed papermaking method required the use of an anionic additive necessarily comprising an anionic organic (co)polymer (hereinafter "anionic polymer"). In particular, no such anionic polymer was used in example 1 of Document (1), which was the only portion of this citation disclosing the preparation of a paper

furnish comprising all the other ingredients required by claim 1 as maintained.

V. The Opponent (hereinafter Appellant) lodged an appeal against this decision. In the grounds of appeal it cited Document (4) = WO 94/05595.

VI. The Appellant argued substantially as follows.

The presence at page 5, lines 11 to 13, of Document (1) of a reference to Document (4) rendered the technical teaching of this latter citation part of the disclosure of the former one. Such interpretation would be in line with the decision of the Board of Appeal T 153/85 (OJ EPO 1988, 1).

Since Document (4) described stable suspensions of silica and bentonite possibly comprising anionic dispersing agents such as, *inter alia*, polyacrylic acid and salts thereof, the Opposition division would have erred in recognising the novelty of the subject-matter of the above-cited claim 1 vis-à-vis the prior art disclosed in Document (1).

VII. The Proprietor (hereinafter Respondent) refuted the Appellant reasoning by presenting *inter alia* the following arguments.

The subject-matter of claim as maintained would differ from the method disclosed in Example 1 of Document (1) only for the absence of an anionic polymer, but would be even more remote from the generic disclosure in the same citation.

The sentence of Document (1) making reference to Document (4) would not mention the possible presence of an anionic polymer as dispersing agent and, hence, also in accordance with T 153/85, it would not be admissible to combine the disclosures of Documents (1) and (4) in such way so as to arrive to a papermaking methods which had no basis in Document (1).

Moreover, Document (4) disclosed as preferred the aqueous suspensions of silica and bentonite free of any further additive.

VIII. In its reply to the grounds of appeal the Respondent requested oral proceedings in the event the appeal would not be dismissed and made reference to a communication of the Opposition division dated 10 August 2001.

It then filed two amended versions of claim 1 labelled as Auxiliary requests I and II and indicated in the accompanying letter dated 6 July 2005 that both auxiliary requests comprised also claims 2 to 16 as granted.

IX. The Board summoned the parties to oral proceedings to be held on 28 September 2005.

In a letter dated 25 August 2005 the Appellant announced that it would not attend the scheduled hearing.

On 21 September 2005 the Board cancelled the oral proceedings.

- X. The Appellant has requested that the decision under appeal be set aside and the patent be revoked.
- XI. The Respondent has requested that the appeal be dismissed and the patent maintained in the amended form that the Opposition division found to comply with the requirements of the EPC or, alternatively, that the patent be maintained on the basis of any of the sets of claims of the Auxiliary requests I and II filed under cover of the letter dated 6 July 2005. It has also requested oral proceedings in the event the appeal would not be dismissed.

Reasons for the decision

1. Claim 1 as maintained: Novelty (Article 100(a) in combination with Articles 52(1) and 54 EPC)
- 1.1 The papermaking method of claim 1 (see above point II) requires, *inter alia*, the use of an anionic additive consisting of the anionic polymer optionally mixed with colloidal silica and/or bentonite.
- 1.2 The Appellant has argued that the Opposition division has erred in finding that Document (1) would not disclose the use of an additive comprising an anionic polymer because the use of mixtures comprising an anionic polymer, silica particles and bentonite is instead described therein. It has pointed to the reference at page 5, lines 11 to 13 of Document (1) to the mixtures of silica particles and bentonite disclosed in Document (4) and stressed this latter citation explicitly discloses at page 5, lines 9 to 12,

polyacrylic acid and the salts thereof as optional anionic dispersing agents for these mixtures. The Appellant has referred in this respect also to the decision T 153/85.

- 1.3 According to the established jurisprudence of the Boards of Appeal, a prior document provides evidence for novelty destroying prior art if it discloses **directly and unambiguously** the subject-matter in question (see Case Law of the Boards of Appeal of the EPO, 4th edition, December 2001, page 57, point 2.3). It is also established case law of the Boards of Appeal that when assessing novelty, the disclosure of a prior document must be considered in isolation (see Case Law of the Boards of Appeal of the EPO, 4th edition, December 2001, page 67, point 3.1).

However, as indicated also in the decision T 153/85 cited by the Appellant, a prior document may incorporate part or all of a second prior document into its disclosure, by specific reference to the second document's technical teaching.

- 1.4 The Board concurs with the Respondent (see above point VII) that Example 1 of Document (1) - but not the general description of this citation - discloses a papermaking process which comprises all the features of the papermaking method of claim 1 as maintained, except for the undisputed absence of an anionic polymer, because the anionic additive used in this example is a silica based sol. Already the Opposition division came at this conclusion at points 1 and 1.1 of its communication dated 10 August 2001 (also cited at point 3.1.1 of the Respondent's reply to the grounds of

appeal). Since this has not been disputed by the Appellant in the appeal proceedings, further details in respect of this finding need not to be given.

1.5 Therefore, and since the entire Appellant's reasoning is focused exclusively on demonstrating the disclosure in Document (1) (by means of a reference to Document (4)) of the presence of an anionic additive comprising an anionic polymer, it is evident that the subject-matter of present claim 1 would be disclosed in Document (1) **only** if such reference to Document (4) would incorporate into the disclosure of Document (1) a clear teaching to use in general - and, hence also in Example 1 - the anionic additive comprising an anionic polymer disclosed in Document (4).

1.6 In the present case the reference to Document (4) contained at page 5, lines 11 to 13, of Document (1) (hereinafter "the reference to Document (4)") reads as follows:

"Suitable mixtures of silica based particles and smectite clays, preferably natural sodium bentonite, are disclosed in WO 94/05595 which is likewise incorporated herein by reference, wherein the weight ratio of silica based particles to clay particles can be in the range of from 20:1 to 1:10, preferably from 6:1 to 1:3."

1.6.1 The Board observes that Document (4) discloses only aqueous suspensions of silica and smectite clay (preferably bentonite) particles (see claims 1 and 5 of Document (4)). Therefore, it is evident to the skilled person that the term "mixture" in the above-cited

wording in Document (1) must be read as equivalent to "aqueous suspension" in Document (4).

However, even taking into account this logic equivalence, the wording "*Suitable mixtures ... are disclosed...*" of the reference to Document (4) indicates unambiguously only the presence of suitable mixtures among the aqueous suspensions disclosed in this citation.

Therefore, the Board notes that the wording used in Document (1) for defining the reference to Document (4) leaves it open whether these "*suitable mixtures*" are

- a) **all** the aqueous suspensions disclosed in Document (4) which comprise silica and clay particles and, thus, also those comprising further ingredients (as implied by the Appellant's reasoning, see above point 1.2), or
- b) **only** the aqueous suspensions disclosed in Document (4) which comprise **exclusively** silica and clay particles and, thus, not those comprising further ingredients (as explicitly maintained by the Respondent, see above point VII, and supported by the fact that the only specific example of aqueous suspension of silica and bentonite "*of the type disclosed in WO 95/05595*" actually described in Document (1), i.e. example 6, comprises no other ingredient), or
- c) **another unspecified sub-group** of the aqueous suspensions disclosed in Document (4) different from the above (as also apparent to the Board in view of the literal content of the above-cited wording).

1.6.2 Thus, the Board finds that the reference in Document (1) to suitable mixtures disclosed in Document (4) is ambiguous and, hence, that it cannot contribute to what is directly and unambiguously disclosed in Document (1).

In particular, the Board finds that this ambiguous reference in Document (1) does **not** disclose directly and unambiguously that the mixtures disclosed in Document (4) **which may comprise an anionic polymer** are suitable for the papermaking method of Document (1).

Hence, the Appellant's reasoning (see above point 1.2) is not found convincing.

1.6.3 Of course, since the reference to Document (4) suffers of the above discussed ambiguity, it cannot even be considered a "specific reference" according to the line of reasoning expressed in the decision T 153/85 and relied upon by the Appellant. Hence, the decision T 153/85 is manifestly not relevant for the present case already for this reason.

1.6.4 Therefore, the Board concludes that the papermaking method according to claim 1 as maintained is novel and, thus, that the subject-matter of this claim complies with the requirements of Article 54 EPC.

2. *Claims 2 to 16 as maintained: Novelty (Article 100(a) in combination with Articles 52(1) and 54 EPC)*

Claims 2 to 16 refer to preferred embodiments of the papermaking method of claim 1 on which they depend and, hence, the Board finds that their subject-matter is

novel for the same reasons indicated above.

3. *Cancellation of the oral proceedings*

The present decision could be taken without holding oral proceedings, because the Respondent requested them only if the Board intended not to dismiss the appeal (see above point VI). As the Appellant did not request oral proceedings and announced its absence to the scheduled hearing, the oral proceedings were duly cancelled by the Board (see above point IX).

Order

For these reasons it is decided that:

The appeal is dismissed.

The Registrar:

The Chairman:

G. Rauh

P. Krasa