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D E C I S I O N
of 14 June 2005

Case Number: T 1197/03 - 3.3.1

Application Number: 93111181.9

Publication Number: 0568115

IPC: C09K 5/04

Language of the proceedings: EN

Title of invention:

Near-azeotropic blends for use as refrigerants

Patentee:

E.I. DU PONT DE NEMOURS AND COMPANY

Opponent:

ELF ATOCHEM S.A.
Imperial Chemical Industries PLC
STAR REFRIGERATION LIMITED
SOLVAY SOLEXIS S.p.A.
RHÔNE-POULENC CHIMIE

Headword:

Azeotropic blends/DU PONT

Relevant legal provisions:

EPC Art. 108, 111(1), 123(2)
EPC R. 64(b)
RPBA Art. 10a(2)

Keyword:

"Appeal admissible (yes) - based on fresh request - reasons of contested decision no longer apply - situation covered by RPBA"

"Amendments: main request (not allowable) - combination of separate embodiments; auxiliary request 1 (allowable) - combination of numerical ranges"

"Novelty (yes) - different proportions of components"

"Remittal to first instance (yes) - outstanding issues"

Decisions cited:

T 0002/81, T 0105/87, T 0563/91, T 0162/97, T 0717/01,
T 0934/02

Catchword:

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Case Number: T 1197/03 - 3.3.1

D E C I S I O N
of the Technical Board of Appeal 3.3.1
of 14 June 2005

Appellant: E.I. DU PONT DE NEMOURS AND COMPANY
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Decision under appeal: Decision of the Opposition Division of the
European Patent Office posted 29 September 2003
revoking European patent No. 0568115 pursuant
to Article 102(1) EPC.

Composition of the Board:

Chairman: A. J. Nuss
Members: R. Freimuth
R. T. Menapace

Summary of Facts and Submissions

- I. The Appellant (Proprietor of the Patent) lodged an appeal on 21 November 2003 against the decision of the Opposition Division posted on 29 September 2003 revoking European patent No. 568 115 and on 9 February 2004 filed a written statement setting out the grounds of appeal.
- II. Notice of Opposition had been filed by the Respondents I, II and III (Opponents 01, 02 and 04) and by the Opponents 03 and 05, requesting revocation of the patent in its entirety on the grounds of lack of novelty and inventive step (Article 100(a) EPC), and of extending the subject-matter of the patent in suit beyond the content of the application as filed (Article 100(c) EPC). The following document was submitted *inter alia* in opposition proceedings:

(2) EP-A-419 042.

The Opponents 03 and 05 withdrew their oppositions on 16 and 17 June 2003, respectively, before the Opposition Division took the decision under appeal.

- III. The Opposition Division held that the patent according to the then pending requests, i.e. main request and second, eighth and ninth auxiliary request, extended beyond the content of the application as filed pursuant to Article 123(2) EPC. Additionally the patent according to the then pending second auxiliary request was found to lack of novelty vis-à-vis document (2). The numerical ranges indicated for the components in

claim 1 of that request overlapped with those disclosed in this document.

IV. The Appellant, annexed to the Statement of the Grounds of Appeal, submitted a fresh main request and six fresh auxiliary requests, thus superseding any previous request. Independent claim 1 of the main request read as follows:

"1. A near azeotropic composition comprising a blend of chlorodifluoromethane, propane and pentafluoroethane in the proportions of 30 to 65 weight percent chlorodifluoromethane, 1 to 10 weight percent propane and 33 to 69 weight percent pentafluoroethane."

At the oral proceedings before the Board, held on 14 June 2005, the Appellant substituted the "new first auxiliary request (A')" for the first auxiliary request annexed to the Statement of the Grounds of Appeal, claims 1 and 2 of that new request reading as follows:

"1. A near azeotropic composition which is a blend of chlorodifluoromethane, propane and pentafluoroethane in the proportions of 30 to 65 weight percent chlorodifluoromethane, 1 to 10 weight percent propane and 33 to 69 weight percent pentafluoroethane.

2. A composition as claimed in claim 1 which has 45 to 65 weight percent chlorodifluoromethane, 2 to 5 weight percent propane and 33 to 53 weight percent pentafluoroethane."

Claims 3 and 4 of that new request were directed to a process evaporating the compositions according to

claims 1 or 2 and to the use of these compositions, respectively.

The second to sixth auxiliary request were also directed to compositions of chlorodifluoromethane, propane and pentafluoroethane differing from each other, and from those of the main and the first auxiliary request in the proportions of the components.

- V. The Appellant argued that the appeal was admissible according to established case law, see e.g. decision T 162/97, since he presented together with the Statement of the Grounds of Appeal fresh claims which were restricted in scope to overcome the grounds of the decision of the first instance; otherwise a patentee would be deprived of any opportunity of still getting a patent.

The Appellant argued that the fresh requests overcame the objections raised in the decision under appeal of extending beyond the content of the application as filed. The amendments made to the claims in the main request, in particular the specific numerical ranges indicated for each component, were disclosed in the form of preferred embodiments in the application as filed. The definition of the composition according to claim 1 of the main request as merely "comprising" the three particular components was supported by page 10, line 21 of the application as filed disclosing not only ternary but also "higher" blends. The auxiliary requests were based each on different individual compositions of the application as filed. Thus, the requirements of Article 123(2) EPC were met. As the decision under appeal did not consider the issue of

inventive step and scarcely that of novelty, the case should be referred back once the requirements of Article 123(2) EPC were found to have been complied with.

The subject-matter claimed was also novel over document (2) since the numerical ranges indicated for each component in the compositions of claim 1 according to the main and the first auxiliary request, in particular the indication of a minimum amount of 33 weight percent for pentafluoroethane, were delimited from those disclosed in that state of the art.

VI. The Respondent III challenged the admissibility of the appeal. He objected that the Appellant did not maintain any request on which the decision under appeal was based. The fresh requests presented on appeal were directed to different subject-matter thereby changing the factual framework of the proceedings. The Appellant, thus, conceded at the same time, so the Respondent III argued, that the Opposition Division was correct in revoking the patent in suit. The Statement of the Grounds of Appeal neither indicated the reasons why the decision under appeal was challenged as provided for in Article 10a(2) of the Rules of Procedure of the Boards of Appeal, nor indicated the reasons why the fresh requests were in reply to the objections raised in that decision. Furthermore, the appeal was inadequately substantiated since it referred to the patent specification for showing that the amended claims satisfied the requirements of Article 123(2) EPC.

The Respondents II and III argued that none of the fresh requests met the requirements of Article 123(2)

EPC. The feature of amended claim 1 according to the main request and the auxiliary requests 1 to 3 and 6 using the term "composition comprising" allowed the presence in the composition of any further component in addition to those listed. However, there was no support for that amendment in the application as filed which excluded the presence of further components. Furthermore, the boundaries of the specific numerical ranges of two components in the compositions according claim 1 of all auxiliary requests were formed by combining twice preferred ranges thereby extending beyond the content of the application as filed.

In respect of novelty vis-à-vis document (2), the Respondents II and III argued that this document disclosed at column 3, lines 8 to 12 specific numerical ranges which either overlapped or came very close to those now claimed. Therefore compositions falling within the scope of claim 1 were directly and unambiguously derivable from document (2).

The Respondent III addressed in respect of novelty also document

(2a) GB Serial Number 8920634,

which is the first priority of document (2), and argued that this document generally encompassed the claimed invention.

VII. The Respondent I did not file any submission in appeal proceedings.

VIII. The Appellant requested that the decision under appeal be set aside and that the patent be maintained on the basis of the main request filed on 9 February 2004, or of the first auxiliary request (A') filed during the oral proceedings or the second to sixth auxiliary request filed on 9 February 2004.

The Respondents II and III requested that the appeal be dismissed. The Respondent I did not file any request.

IX. At the end of the oral proceedings the decision of the Board was announced.

Reasons for the Decision

1. *Admissibility of the appeal*

1.1 The statement setting out the grounds of appeal pursuant to Article 108, third sentence and Rule 64(b) EPC, as a general rule, should specify the legal and/or factual reasons on which the contested decision is to be set aside, i.e. reasons why the contested decision is wrong. According to established jurisprudence of the Boards of Appeal an appeal of the proprietor of the patent is considered to be sufficiently substantiated as well when an amended set of claims is filed together with the statement of grounds which amended set changes the subject of the proceedings, and when the statement of grounds specifies why the reasons given in the contested decision no longer apply in view of the amendments made to the claims thereby depriving the contested decision of its basis (see e.g. decisions T 105/87, point 1 of the reasons; T 563/91, point 1 of

the reasons; T 162/97, point 1 of the reasons; T 717/01, point 2 of the reasons; T 934/02, point 2 of the reasons; none published on OJ EPO). This conclusion on admissibility of an appeal is based on the finding that it would be unnecessary and pointless to oblige the proprietor of the patent for the purpose of adequately substantiating an appeal to file grounds in support of the version of claims underlying the contested decision which claims, however, are no longer defended in appeal proceedings.

- 1.2 In the present case the appealing Proprietor of the patent submitted amended sets of claims as fresh main request and auxiliary requests 1 to 6 together with the Statement of the Grounds of Appeal (see point IV *supra*). The claims according to any of those fresh requests were amended by restricting the claimed compositions to comprise three individual components in specific proportions thereby changing the subject of the proceedings. In the Statement of Grounds the Appellant indicated that the fresh requests were in keeping with the requirements of Article 123(2) EPC (points 2.1 and 2.2), which the contested decision found the then pending requests not to comply with (see point III *supra*). The Statement of Grounds also specified in detail why the reasons given in the contested decision no longer applied due to the amendments made to the claims according to the fresh requests (points 5 to 13 on pages 5 to 12).

Hence, the appeal of the Proprietor of the patent is sufficiently substantiated.

1.3 The Respondent III challenged the admissibility of the appeal for the reason that the Appellant in the Statement of Grounds did not defend the patent in suit on the basis of any request underlying the contested decision and that the fresh requests presented on appeal changed the subject of the proceedings. Furthermore, he argued that the statement of grounds failed to indicate the reasons why the decision under appeal was wrong and why it was "challenged" as provided for in Article 10a(2) of the Rules of Procedure of the Boards of Appeal.

However, as set out in detail in point 1.1 *supra*, the filing of fresh requests together with the Statement of Grounds changing the factual basis of the proceedings is a way for an appealing proprietor to sufficiently substantiate his appeal thereby rendering it pointless to defend the patent in suit on the basis of no longer pending requests and to indicate reasons why the contested decision based on those no longer pending requests was wrong. This finding is also in keeping with the Rules of Procedure of the Boards of Appeal (entered into force on 1 May 2003) as Article 10a(2), second sentence, is not to be construed, what the Respondent III did, to preclude the appealing proprietor of the patent to file amended claims together with the Statement of Grounds; rather, the contested decision may be "challenged" as provided for in that section of the Rules of Procedure by submitting an amended set of claims depriving the contested decision of its basis which is in line with established jurisprudence of the Boards of Appeal (see point 1.1 *supra*).

The Respondent's III allegation that the present Statement of Grounds did not indicate the reasons why the fresh requests were in reply to the objections raised in the contested decision does not comply with the facts since those reasons are well indicated in that statement (see point 1.2 *supra*).

The Respondent's III objection that the appeal was not sufficiently substantiated since it referred to the patent specification for showing that the requirements of Article 123(2)EPC were satisfied is, however, not a matter of admissibility of the appeal but rather a matter of its merits, namely whether or not the appeal is well founded. Therefore the Respondent's objection cannot be taken into account when assessing the admissibility of the appeal.

- 1.4 For these reasons, the appeal meets the requirements of Article 108, third sentence and Rule 64(b) EPC. Since compliance with the further requirements, in particular those of Articles 106 to 108 and Rule 64 EPC, was not challenged and the Board sees no reason to do it, the appeal of the Proprietor of the patent is admissible.

Main request

2. *Amendments (Article 100(c) EPC)*

- 2.1 Claim 1 is directed to a "composition comprising a blend of" three individual components. The term "comprising" is an open definition allowing in the composition the presence of any further component(s) in addition to that blend.

Claim 1 of the application as filed, however, discloses a "composition which is a blend of" those three individual components. The term "is" defines the composition to be composed only of that ternary blend, thus excluding the presence of any further component(s). This finding is in line with the description of the application as filed. On page 9, line 16 to 21 thereof the particular ternary blend made of the individual components of present claim 1 is disclosed as an alternative in a list of several blends. That list starts on page 7, line 32 of the application as filed with the definition that "the blends of the present invention have the following compositions". The term "have" excludes the presence of any further component(s) in the composition in addition to the individual components indicated for the blend.

Therefore, neither original claim 1 nor page 7, line 32 in combination with page 9, lines 16 to 21 of the application as filed are a proper basis for the amendment made to present claim 1 of "comprising" that ternary blend.

- 2.2 The Appellant argued that page 10, line 21 of the application as filed disclosed "ternary (or higher) blends", the term "higher" indicating that further components in addition to the three individual components could be present in the compositions claimed. This original disclosure supported the open definition "composition comprising" in present claim 1.

The section addressed by the Appellant starts on page 9, line 34 with the wording "There are other ternary and higher blends..". The term "other" makes plain that

this section, which embraces the Appellant's citation on page 10, line 21, addresses a separate embodiment different to that preceding it. However, the preceding section ending on page 9, line 33 is just the list of several alternative blends including the claimed one which starts on page 7, line 32 (see point 2.1 *supra*). Therefore the Appellant's argument amounts to freshly combining two distinct embodiments separately disclosed in the description of the application as filed, namely to a combination of the claimed ternary blend with "other" ones, which is not properly supported by the original disclosure.

- 2.3 For these reasons, the Board concludes that claim 1 extends the subject-matter claimed beyond the content of the application as filed, thus justifying the ground for opposition pursuant to Article 100(c) EPC. Therefore, the Appellant's main request is not allowable.

Auxiliary request 1

3. *Amendments (Article 100(c) EPC)*

- 3.1 Claim 1 is based on original claim 1. The proportion of propane in the blend of 1 to 10 weight percent is the preferred range disclosed on page 9, line 18 of the application as filed. The proportions of 30 to 65 weight percent chlorodifluoromethane and of 33 to 69 weight percent pentafluoroethane in present claim 1 are supported by the paragraph on page 9, lines 16 to 21 of the application as filed. That paragraph specifies a preferred range of 30 to 85 weight percent chlorodifluoromethane and a most preferred range

thereof of 45 to 65 included in the preferred range and, moreover, it specifies a preferred range of 14 to 69 weight percent pentafluoroethane and a most preferred range thereof of 33 to 53 included in the preferred range. Since both endpoints of the claimed range of 30 to 65 weight percent chlorodifluoromethane as well as both endpoints of the claimed range of 33 to 69 weight percent pentafluoroethane are specifically named in that paragraph of the application as filed, these amendments do not generate any new subject-matter within the meaning of Article 123(2) EPC (see decision T 2/81, OJ EPO 1982, 394, point 3 of the reasons).

The Respondents' objection that the ranges in claim 1 have been generated by combining twice numerical ranges, i.e. the ranges for chlorodifluoromethane and for pentafluoroethane, thereby extending beyond the content of the application as filed, does not convince the Board since the claimed ranges for chlorodifluoromethane and for pentafluoroethane have been disclosed in combination with themselves as well as in combination with the range of 1 to 10 weight percent for propane in the application as filed, namely in one paragraph on page 9, lines 16 to 21.

3.2 Claim 2 is supported by claim 3 of the application as filed in combination with page 7, line 32, the latter disclosing that the claimed composition "has" the proportions in question. Claims 3 and 4 are backed up by claims 4 and 5 of the application as filed.

3.3 Therefore all the amendments made to the claims as granted comply with the requirements of Article 123(2) EPC.

These amendments restrict the scope of the claims and, thus, of the protection conferred thereby, which is in keeping with the requirements of Article 123(3) EPC.

4. *Novelty*

The Respondents challenged the novelty of the claimed invention exclusively with regard to documents (2) and (2a), not relying on any further document cited so far in the proceedings. Therefore, the Board limits its considerations with respect to novelty to those documents.

4.1 The Board observes that it is a generally applied principle that for concluding lack of novelty, there must be a direct and unambiguous disclosure in the state of the art which would inevitably lead the skilled person to subject-matter falling within the scope of what is claimed.

4.2 In the present case, document (2) discloses at column 2, lines 8 to 12 and in claim 4 a composition comprising the individual components propane, chlorodifluoromethane and pentafluoroethane in specific proportions. The maximum amount of pentafluoroethane is 25 weight percent, whereas the minimum amount thereof according to present claim 1 is 33 weight percent. Thus, there is no overlap of the compositions of document (2) with those claimed thereby delimiting the subject-matter of the invention from that state of the art.

4.3 The Respondents argued that claim 1 and the section at column 2, lines 20 to 28 of document (2) generally

disclosed a composition having the three components (i) to (iii) which encompassed the individual components indicated in claim 1 of the invention. They argued moreover that the proportions of those components were specified at column 3, lines 2 to 6 and in claim 2 of that document.

However, document (2) lists two equivalent alternatives for each of the components (i) and (ii). In order to arrive at a composition comprising the three individual components according to claim 1 of the invention a selection within each of these two lists is necessary, namely the selection of chlorodifluoromethane as component (i) and of pentafluoroethane as component (ii). According to established jurisprudence of the Boards of Appeal the general disclosure of a document does not qualify for the specific disclosure of a particular composition if that composition can only be derived from the general disclosure by selecting one component from each of two or more lists of alternative components. In the absence of any pointer to the particular combination of the components propane, chlorodifluoromethane and pentafluoroethane in those sections of document (2) addressed by the Respondents, this combined selection of individual components does not emerge clearly and unambiguously therefrom.

Furthermore, the proportions referred to by the Respondents are also delimited from those claimed since the maximum amount of pentafluoroethane is 25 weight percent, while the minimum claimed is 33 weight percent.

4.4 Document (2a), which is one of the priority documents of document (2), discloses on page 3, paragraph 4 one

single individual composition of propane, chlorodifluoromethane and pentafluoroethane. Therein, the amount of pentafluoroethane is 25 weight percent and is, thus, below the minimum of 33 weight percent indicated in present claim 1.

The Respondent's III argument that document (2a), on page 3 generally disclosed compositions of propane, chlorodifluoromethane and pentafluoroethane does not support his novelty objection since the whole document is silent on the proportions of the components comprised therein, apart from the one individual composition addressed in the above paragraph.

- 4.5 For these reasons, the Board concludes that the subject-matter of independent claim 1, and, by the same token, that of dependent claim 2 and that of independent claims 3 and 4 directed to the evaporation and the use of the composition of claim 1, is novel over documents (2) and (2a) pursuant to Article 54 EPC.

5. *Remittal*

Having so decided, the Board has not taken a decision on the whole matter since the decision under appeal was solely based on a violation of Article 123(2) EPC and on a novelty objection vis-à-vis document (2) which objections are no longer pertinent. As the Opposition Division has not yet ruled on novelty vis-à-vis the other documents in the proceedings as well as on the other grounds for opposition, the Board considers it appropriate to exercise its power conferred on it by Article 111(1) EPC to remit the case to the Opposition Division for further prosecution on the basis of the

claims according to auxiliary request 1, in order to enable the department of first instance to decide on the outstanding issues.

Auxiliary requests 2 to 6

6. Since the preceding auxiliary request 1 is remitted to the department of first instance for the reasons set out above, there is no need for the Board to decide on the lower ranking auxiliary requests 2 to 6.

Order

For these reasons it is decided that:

1. The decision under appeal is set aside.
2. The case is remitted to the department of first instance for further prosecution on the basis of claims 1 to 4 filed as first auxiliary request during the oral proceedings before the Board.

The Registrar:

The Chairman:

N. Maslin

A. Nuss