Europäisches Patentamt
Beschwerdekammern

European Patent Office
Boards of Appeal

Office européen des brevets
Chambres de recours

Veröffentlichung im Amtsblatt	Ja/Nein
Publication in the Official Journal	Yes/No
Publication au Journal Officiel	Oui/Non

000836

15

Aktenzeichen / Case Number / N° du recours : T 268/85 - 3.3.2

Anmeldenummer / Filing No / N° de la demande : 82 201 284.5

Veröffentlichungs-Nr. / Publication No / N° de la publication : 0 077 590

Bezeichnung der Erfindung: Process for the production of polymer filaments having high tensile strength and modulus
Title of invention:
Titre de l'invention :

Klassifikation / Classification / Classement : D01F 6/04

ENTSCHEIDUNG / DECISION

vom / of / du 20 May 1988

Anmelder / Applicant / Demandeur : STAMICARBON B.V.

Patentinhaber / Proprietor of the patent /
Titulaire du brevet :

Einsprechender / Opponent / Opposant :

Stichwort / Headword / Référence : Polymer filaments/STAMICARBON

EPÜ / EPC / CBE Article 54 - Rule 67

Kennwort / Keyword / Mot clé : "Novelty - misinterpretation of the description"
"Procedural violation - failure to appreciate a clear submission"

Leitsatz / Headnote / Sommaire

Europäisches Patentamt
Beschwerdekammern

European Patent Office
Boards of Appeal

Office européen des brevets
Chambres de recours

Case Number : T 268/85 - 3.3.2

D E C I S I O N
of the Technical Board of Appeal 3.3.2
of 20 May 1988

Appellant : STAMICARBON B.V.
Postbus 10
NL-6160 MC Geleen

Representative : Leherte, Georges Maurice Lucien Marie
Octrooibureau DSM P.O. Box 9
NL-6160 MA Geleen

Decision under appeal : Decision of Examining Division 024 of the European Patent Office dated 19 June 1985 refusing European patent application No. 82 201 284.5 pursuant to Article 97(1) EPC

Composition of the Board :

Chairman : P. Lançon
Members : G. Szabo
E. Persson

Summary of Facts and Submissions

I. European patent application No 82 201 284.5, filed on 15 October 1982 (publication No. EP-A-0 077 590) claiming priority from a prior application of 17 October 1981 was refused by the decision of the Examining Division 024 of the European Patent Office dated 19 June 1985. That decision was based on the description as originally filed, with the amendments suggested in the letter of 19 March 1985; Claims 1 and 2, filed with the letter of 19 March 1985; Claim 3 and Claim 10 (renumbered 4) as originally filed.

II. Claim 1 filed with the letter of 19 March 1985 and forming the subject of the decision to refuse the application reads as follows:

1. Process for the production of polyethylene filaments having high tensile strength, wherein a solution of an ethylene polymer or copolymer containing at most 5% by wt of one or more alkenes with 3 to 8 carbon atoms and having a weight-average molecular weight Mw higher than 4.10^5 kg/kmole with at least 80% by wt of solvent is spun at a temperature above the gel point of that solution, the spun product is cooled to below the gel point and the filament obtained is stretched, in the form of a gel containing or not containing a solvent, to form a filament having a tensile strength of more than 1.5 GPa, measured at room temperature, characterized in that a polyethylene is used having a weight/number-average molecular weight ratio Mw/Mn lower than 5.

The above claim is equivalent to the originally filed Claim 1 and expresses the same subject-matter in a

characterizing form, limiting the molecular weight ratio. Original Claim 2 was independent and not restricted to the critical molecular weight ratio. In fact, there was no mention of molecular weight at all in that Claim 2, and there were differences in other features as well, as for instance the necessity for twisting while stretching.

Each of these original claims was accompanied by a precisely corresponding counterpart in the description. Each counterpart was introduced by the phrase "In the process according to the invention ..." (cf. page 1, lines 18-27 and page 2, lines 10-17).

III. The reasons given for the refusal were that Claim 1 lacked novelty in the light of the disclosures (explicit and implicit) of GB-A-2 042 414 ... (1). In particular:

(i) The preamble of Claim 1 corresponded to original Claim 1 and the latter had been found to lack novelty in the light of (1);

(ii) The characterising portion of Claim 1, pertaining to a weight/number average molecular weight ratio (Mw/Mn) lower than 5 could justifiably be assumed to be a feature of the polymers of (1), even though not explicitly disclosed, because in the fifth paragraph on page 2 of the description of the application it was indicated that the polymers of the application were identical with those of (1) (cf. page 2, lines 21-23 of the description);

(iii) The identity of the polymers of the application with those of (1) had not been contested by the Applicant, who, being the Applicant also in the case of (1), could be expected to be familiar with the contents of that document.

IV. A Notice of Appeal was lodged by the Applicant on 14 August 1985, the appeal fee being paid at the same time. A Statement of Grounds was filed on 18 October 1985. The statement of grounds contained substantially the following arguments:

(i) It had already been stated in the description of the application in suit (cf. page 1, lines 12-17) that the known processes e.g. according to (1) used a higher (Mw/Mn) ratio than the invention;

(ii) Both Claim 1 under refusal and original Claim 1 contained the distinguishing feature of the particularly low Mw/Mn ratio; therefore, there could be no lack of novelty in the light of (1);

(iii) The allegation that the polymers of the application were identical with those of (1) had indeed been contested by the Applicant, expressly in his letter of 19 March 1985.

V. The Appellant requests that the decision of the Examining Division be set aside with subsequent grant of the European patent and that the appeal fee be reimbursed.

Reasons for the Decision

1. The appeal complies with Articles 106 to 108 and Rule 64 EPC and is, therefore, admissible.

2. The application in suit relates to the production of polymer filaments having high tensile strength and modulus.

In relation to the crucial feature of the Mw/Mn ratio being below 5 the argument used by the Examining Division in its finding of lack of novelty fell into two parts, the first part being the assumption that the passage of description at the fifth paragraph on page 2 of the application meant that the polymers of the application were identical with those of document (1) and therefore that document (1) disclosed, by implication, polymers having the specific Mw/Mn ratio claimed in Claim 1 and original Claim 1. This is essentially a technical issue since it relates to the interpretation of the technical content of the description.

The second part of the Examining Division's argument was that because the applicant had not challenged this assumption the latter must be justified thus forming a basis for refusing the application. This is a legal issue since it depends on whether or not the applicant made a particular submission.

3. In relation to the first part of the argument it must be examined more closely what was actually said in the controversial fifth paragraph on page 2. Starting at line 21: - "Generally, the polymers that can suitably be used in the process according to the invention are those as set forth in British patent application No. 8 004 157" (corresponds to document (1)). It will be recalled that "the process according to the invention" was defined in the application as originally filed, in two independent process claims of substantially differing scope, corresponding in effect to two different aspects. Since the difference in scope related, inter alia, to the nature of the polymers used, the question arises of whether the quoted phrase means all the polymers of the application or just those which are used in a particular aspect.

4. In the letter of 19 March 1985 the Appellant informed the Examining Division that the statement only related to the process described in original Claim 2, which did not refer to a Mw/Mn ratio.

5. Looking at the description immediately preceding the relevant statement at page 2, lines 21-23, it can be seen that separated from it by a single, briefly explanatory sentence, is indeed the descriptive counterpart corresponding precisely to original Claim 2, commencing at line 10 "In the process according to the invention ...". On the other hand, the descriptive counterpart corresponding to original Claim 1 is to be found earlier still on page 1. This is immediately followed by instructions how the polymers having the required specific Mw/Mn ratios can be prepared according to the literature (cf. page 1,line 28 to page 2, line 2). The product thus obtained has different properties (i.e. improved stretching efficiency and higher tensile strength for the same E modulus when compared with known processes) than those obtained according to Claim 2 (i.e. twisted filaments with reduced tendency to fibrillation and improved knot strength) (cf. page 2, lines 3-5 and 18-20, respectively).

6. It is clear from the above that the original independent claims related to two different inventions, one relying on the critical ratio and the other on an essential twisting around the axis whilst being stretched. This reading of the description is consistent with the description on page 1 at lines 15-17 wherein it is clear that known processes, document (1) being mentioned in this connection, use polyalkylene polymers, in particular polyethylenes, having a Mw/Mn ratio in the range 7.5 and above, i.e. outside the above quoted range of the invention.

Thus, the statement in the decision of the first instance that "it is indicated that the polymers of the application are identical with those of GB-A-2 042 414" is based on a technical misinterpretation of the description, since the materials involved in the citation are suitable to be used for the purposes of the modified process incorporating twisting, but not for the purposes of the present claim, wherein materials with a different Mw/Mn ratio are required. There was no reason to assume that any material according to document (1) would be suitable for the purposes of the present invention.

7. Since the decision of the Examining Division to refuse the application on the finding of lack of novelty depended on the above assumption and since this assumption has been found to be baseless, the lack of novelty has not been shown and the decision of the Examining Division must consequently be set aside. It cannot, however, be said that in wrongly interpreting the description the Examining Division has committed a major procedural error. Consequently, there could be no justification for repaying the appeal fee on this basis.

8. As to the argument in the impugned decision that the allegation of identity had not been contested, the Appellant, then Applicant, informed the Examining Division, in his letter of 19 March 1985, that the passage relied upon referred only to the process described in the independent original Claim 2 (see letter of 19 March 1985, paragraph 2, second sentence). He also restricted Claim 2 by making it dependent on Claim 1 and suggested deletion of the offending fifth paragraph on page 2 as well as of the counterpart to original Claim 2 on the same page, thus pre-emptively removing the broader class of polymers referred to in document (1) from the ambit of the application. Since the decision of the Examining Division was based on the

application documents with these amendments there was, actually, no statement left in the specification that the polymers used in the process according to the invention were those of document (1).

9. The pre-emptive removal of the broader class of polymers referred to in (1) from the ambit of the application made it unnecessary, on the part of the Applicant, more specifically to criticise the Examining Division's approach at this stage. That the Examining Division did not recognise this as challenging their assumption is not, in the Board's view, simply a matter of interpretation. It is a matter of a basic failure to appreciate the logical significance of a clear submission made by a party to the proceedings. Even if the significance of the submission had been overseen at the examination stage, it should have been picked up at the stage of interlocutory revision. That such failure formed the basis of a procedural step resulting in a loss of rights to the party concerned (in this case refusal of his application) amounts to a substantial procedural violation (Rule 67 EPC). In this case, the Board sees no alternative but to reimburse the appeal fee.

10. Since the full examination of the application, in particular with regard to novelty and inventive step, does not appear to have been carried out by the Examining Division, the Board has found it necessary to make use of Article 111 EPC and refer the case back to the Examining Division for completion of the examination procedure.

Order

For these reasons, it is decided that:

1. The decision of the Examining Division is set aside.

2. The application is referred back to the Examining Division for completion of the examination procedure.

3. The appeal fee is to be reimbursed to the Appellant.

The Registrar: The Chairman:

17/5-88