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**D E C I S I O N**  
**of 23 February 1995**

**Case Number:** T 0239/92 - 3.2.5

**Application Number:** 82301082.2

**Publication Number:** 0061245

**IPC:** B29C 39/12

**Language of the proceedings:** EN

**Title of invention:**

Process for providing colour contrast on surface of moulded article

**Patentee:**

IMPERIAL CHEMICAL INDUSTRIES PLC

**Opponent:**

ATOCHEM  
Schock & Co. GmbH  
VEDRIL S.p.A.

**Headword:**

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**Relevant legal provisions:**

EPC Art. 100(b), 107  
EPC R. 65(1), 67

**Keyword:**

"Sufficiency of disclosure (no)"  
"Appeal inadmissible"  
"Reimbursement of appeal fee (rejected)"

**Decisions cited:**

T 0041/82, T 0324/90

**Catchword:**

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Case Number: T 0239/92 - 3.2.5

**D E C I S I O N**  
of the Technical Board of Appeal 3.2.5  
of 23 February 1995

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**Decision under appeal:** Interlocutory decision of the Opposition Division  
of the European Patent Office dated 14 February  
1992 concerning maintenance of European patent  
No. 0 061 245 in amended form.

**Composition of the Board:**

**Chairman:** G. O. J. Gall  
**Members:** W. D. Weiß  
A. Burkhart

### Summary of Facts and Submissions

- I. Three oppositions based on Articles 10(a) (lack of inventive step) and 100(b) EPC (insufficient disclosure) were filed against the European patent No. 0 061 245.

At the end of oral proceedings in the course of which a set of five amended claims and an amended description had been filed the Opposition Division delivered a decision maintaining the patent as such amended. The amended description differed from its predecessor as granted inter alia in that it did no longer contain Example 3.

The independent Claim 1 of this version reads as follows:

"1. A method of moulding a shaped article from a curable composition in which the composition is cured in a mould comprising at least two mould parts defining a cavity in which prior to introducing the curable composition into the mould cavity, and before curing the composition to form the shaped article, at least a part of the surface forming the mould cavity is provided with a deposit of a material which provides a colour contrast with the curable composition, the deposit being provided on areas of the mould which correspond to the areas on the cured moulding on which the colour contrast is required to be reproduced, characterised in that the deposit consists of at least one finely divided pigment mixed with at least one finely divided filler having an average particle size of 10 microns or less and the mixture is applied as a suspension in a volatile liquid carrier, the deposit being made free from liquid carrier before the curable composition is introduced into the mould cavity."

II. Opponent II (Schock & Co. GmbH/Appellant I) as well as the Proprietor of the patent (Appellant II) appealed against this decision.

The Opponents I and III did not file an appeal and, therefore according to Article 107 EPC, are parties to the appeal proceedings as of right.

III. The only basis for the Proprietor's appeal is that Example 3 of the patent as granted was cancelled during the oral proceedings before the Opposition Division is felt to be unjustified, because the formulation "consists of" as used in Claim 1 had to be taken in its meaning "consists essentially of" rather than "consists only of" as construed by the Opposition Division. Moreover, it is contended that there has been a procedural violation in that a decision had been given without giving the proprietor an opportunity to approve the text.

IV. The Appellant I (Opponent II) based its appeal on the sole ground that the patent, in particular as such amended, fails to disclose the invention in a manner sufficiently clear and complete for it to be carried out by a person skilled in the art (Article 100(b) EPC). Results of own experiments are reported as a proof for this assertion.

V. In a communication, dated 13 July 1994, the Board drew the attention to the fact that, according to the minutes of the oral proceedings before the Opposition Division, there had, at this stage, been only one final request of the Proprietor (Annex B4) which had been fully granted by the decision under appeal. Therefore the Board could not recognise why the Proprietor should be adversely

affected by the decision under appeal and, therefore, should belong to the persons which were entitled to appeal according to Article 107 EPC.

Moreover, the Board stated that it could not see any reason why the word "consist of" should not be interpreted according to its usual definition which in particular according to the steady practice in the patent field meant that it stood for an exhaustive enumeration of the components which define a composition.

The Board, in this communication, pointed to that the test results presented by Appellant I (Opponent II) could induce the conclusion that the European patent did not disclose the invention in a manner sufficiently clear and complete for it to be carried out by a person skilled in the art in the meaning of Article 100(b) EPC).

VI. Appellant II (Proprietor of the patent), when duly summoned for oral proceedings before the Board, declared by letter of 23 December 1994 that he would not attend or be represented at the oral proceedings.

Opponent I, a party to the appeal proceedings as of right, also informed the Board that it would not attend the oral proceedings (letter of 17 October 1994). No own arguments were presented, but reference was made to the arguments of Opponent III.

Consequently, only Appellant I (Opponent II) and a party as of right (Opponent III/Vedril S.p.A.) were present at the oral proceedings before the Board.

VII. The arguments submitted by Appellant I (Opponent II) and by the Party as of Right represented at the oral proceedings (Opponent III) can be summarised as follows:

The teaching of the patent as maintained by the Opposition Division was incomplete and, therefore, did not enable it to be carried out by a person skilled in the art, because it was contrary to normal experience of life that a dry deposit consisting exclusively of pigment and filler powders should be more resistant against displacement than pigmented gel-coating layers according to the state of the art.

This expectation had only been confirmed by the experiments which had been carried out by Appellant II and the results of which had been annexed to his letter of 17 July 1992. Insofar as "Asterite" had been used as a low viscosity curing composition, these experiments followed as closely as possible the instructions given for Example 2 of the patent in suit.

In this connection it had to be considered that, according to Example 2 of the patent in suit, the curable composition was only required to be similar to that defined in Example 5 of document GB-A-1 493 393 originating from the proprietor of the patent in suit. According to the information available to Appellant I, Asterite was marketed by the proprietor as falling under the scope of document GB-A-1 493 393. This fact had indeed not been refuted by the Proprietor who, in his letter of 2 September 1994, had merely generally stated that Asterite did not have the same composition as that described in Example 5 of GB-A-1 493 393.

As far as "Silacron" had been used as a curable composition, the respective tests aimed at demonstrating that the results were not too sensitive with respect to

the viscosity of the curable composition. Unexpectedly however, the use of Silacron resulted in slightly better, although still not acceptable, products than the use of a lower viscosity composition "Asterite".

The fill rates and pressures used when performing the experiments corresponded to the instructions of the manufacturer of the curable compositions. The results of the experiments had proved to be more sensitive with respect to the position of the filling opening than with respect to these parameters. There was, however, no position which resulted in an acceptable product.

It was tried to use a single pass technique to deposit the pigment mixture on areas of the mould. Since these attempts, which were carried out with varying deposition speeds, lead to unsatisfactory results, a correcting pass had always to be applied.

VIII. In his letter of 2 September 1994, Appellant II (Proprietor) accepted the reasoning of the Board of Appeal in regards the position of the Proprietor's Appeal. He argues, however, as the Proprietor was deemed not to be a party adversely affected by the decision of the Opposition Division under Article 107 EPC the Proprietor might not file an appeal. Consequently, as the submissions made in the Proprietor's letters of 9 April 1992 and 29 May 1992 could not be regarded as the Notice and Grounds of Appeal then it followed that no payment of an Appeal Fee should have occurred which should, therefore, be returned.

The arguments submitted in writing against the objections with respect to Article 100(b) EPC can be summarised as follows:



The commercially available curing materials known as "Asterite" and "Silacron", which had been used by Appellant I with the alleged intention to repeat Example 2 of the patent in suit, did not have the same composition as that defined in Example 5 of GB-A-1 493 393. Furthermore, the commercially available material known as "Silacron" had rheological properties as measured by the Appellant which were completely different from that of Example 5 of the said British document.

The Proprietor had contemplated that the most suitable manner in which the skilled person could perform the claimed invention from the description as granted using an appropriate level of innate knowledge would be to demonstrate how such a method is performed in practice by showing a video tape. It had, however been decided not to do so, because the viewing of such a video could provide the other parties with knowledge of the Proprietor which was not related to the issue under consideration but which would adversely prejudice the commercial interest of the Proprietor.

Nevertheless a single pass technique should have been used to deposit the pigment composition. Furthermore, it had to be noted that the fill rate used for the Appellant's experiments was extremely high.

IX. Appellant I (Opponent II) as well as the two parties as of right (Opponents I and III) request that the decision under appeal be set aside and that the European patent No. 0 061 245 be revoked.

The Proprietor, as implied by his letters of 2 September 1994 and of 23 December 1994, requests

1. that his own appeal be deemed not to have been filed;
2. that the appeal fee be reimbursed;
3. that the appeal by Appellant I be dismissed and, hence, that the patent be maintained in the form agreed by the Opposition Division.

### **Reasons for the Decision**

1. *Admissibility of Proprietor's appeal and reimbursement of Appeal Fee*

The decision of the Opposition Division to maintain the patent in amended form is based on the sole version proposed by the Proprietor of the patent. As the decision follows his request the Proprietor is not adversely affected and an appeal filed by him must be considered as inadmissible (Art. 107 EPC, first sentence; Rule 65(1) EPC).

This conclusion is not contested by the Proprietor who now requests the appeal fee to be reimbursed. Rule 67 EPC stipulates, as a condition for the reimbursement, that the appeal be allowable. An appeal is "allowable" if the Board of Appeal, in substance at least, follows the relief sought by the appellant. Since the appeal is rejected as inadmissible the request to reimburse the appeal fee fails.

The Appeal Board has no power to reimburse the appeal fee if the conditions of Rule 67 EPC are not met (T 41/82, OJ EPO 1982, 256). Inadmissible appeals must

be distinguished from appeals which are deemed not to have been filed (e.g. Art. 108 EPC, second sentence; Art. 14(5) EPC). If an appeal does not come into existence, any appeal fee paid cannot be retained. These considerations do not apply to appeals which are rejected as inadmissible (T 324/90, OJ EPO 1993, 33, reasons No. 9 on page 39).

2. *Insufficient disclosure*

- 2.1 According to Article 100(b) EPC a patent may be opposed on the ground that a European patent does not disclose the invention in a manner sufficiently clear and complete for it to be carried out by a person skilled in the art.

According to the present amended version of the patent, the deposit formed on at least part of the surface forming the mould cavity - after evaporation of the volatile carrier - consists of at least one finely divided pigment mixed with at least one finely divided filler having an average particle size of 10 micron or less.

According to the general encyclopedic definition the expression "consist of" is replaceable by: "to be made up" or "to be composed of" or "to have as its constituent substance or elements". All these expressions stand for an exhaustive enumeration of constituents. In particular in the patent practice, the expression "consist of" has been used to exhaustively define the composition of a substance.

Consequently, Claim 1 is clear in that the deposit, after having been made free of the volatile carrier, has no other constituents but a finely divided pigment and a finely divided filler. Example 3 of the patent as granted was in contradiction to this clear meaning of Claim 1.

2.2 According to the patent in suit (EP-B-0 061 245, page 2, lines 50 to 60), known moulding processes which comprise the features in the preamble of Claim 1 (FR-A-1 065 767) suffer from the drawback that the deposits on the mould surface which are the basis for desired contrasted areas on the final product may be displaced or flow away when the curable composition is injected into the mould. This is in particular the case when low viscosity curable compositions having a relatively high filler content, like those defined in GB-A-1 493 393, are used when carrying out this known method.

2.3 According to the description of the patent as granted (page 2, lines 25 to 48) this drawback of the state of the art is avoided when the deposit consists of at least one finely divided filler having an average particle size of 10 microns or less and the mixture is applied as a suspension in a volatile liquid carrier on to the mould surface which is maintained at an elevated temperature in preparation for the curing process. By this measure, the carrier in the suspension is rapidly volatilised leaving a dry powdery deposit on the mould surface. This teaching corresponds to that of the present Claim 1.

Consequently, the patent teaches that the drawback described under point 2.2 above is avoided, when a dry powdery deposit of a particular pigment/filler mixture is produced on the mould surface instead of the hitherto used binder containing paint layer. The whole context of

the patent transmits the impression that the gist of this solution lies in the particular average particle size of the filler used in the deposit mixture.

It is indeed surprising that such a powdery deposit, even if having a particular composition, should be more resistant against being displaced by the injected curable composition than a known binder containing varnish layer (gel coating technique). The decision under appeal, relying on the disclosure of the patent in suit, has convincingly based its considerations with respect to inventive step on this effect.

2.4 The comparative test results reported by Appellant I claim, insofar as the product "Asterite" is used as a curable composition, have repeated, as closely as possible on the basis of the given disclosure, the conditions of Example 2 of the patent in suit.

2.4.1 The Proprietor has criticised (letter of 2 September 1994, paragraph 5) that the commercially available material known as "Asterite dispersion does not have the same composition as that described in Example 5 of GB 1493393". Example 2 of the patent in suit, however, does not require that the curable composition be the same as but only that it is similar to that of Example 5 of GB 1493393. The Proprietor has not denied that the product "Asterite Batch No 2772" is a low viscosity curable composition falling into the scope of GB 1493393 and thus is similar to the particular composition of this document. On the other hand, the patent in suit fails to contain any teaching that the surprising advantageous effect is due to the synergistic cooperation of a very specific composition of the curable composition with the said composition of the

powdery deposit. Comparative tests performed with "Silacron", which has a much higher viscosity than "Asterite", result in even better - but also not acceptable - products.

If it were true that the tests must be performed with identically the same curable composition as that defined in Example 5 of GB 1493393 this would mean that the patent does not contain any guidance enabling the person skilled in the art to find similar suitable curable compositions capable of producing the same effect.

- 2.4.2 The Proprietor has criticised that the experiments show "that an even coating of pigment can be successfully applied to the relevant mould surfaces (using a single pass technique and which technique is well within the ability of the skilled person)". Moreover, the fill rates have been objected to have been "extremely high".

Appellant I convincingly explained that, even with varying depositing positions and speeds, he did not succeed in an acceptable deposit using a single pass, but had to use a second pass to repair defective spots. Moreover, the fill rates were said to correspond to the recommendations of the respective manufacturer of the curable composition.

The onus of proof for insufficiency of disclosure is on the opponent. Considering all facts of the case the probative value of the tests provided by the Appellant I (Opponent II) is such as to convince the Board that on balance of probabilities the man skilled in the art using his common general knowledge is not given enough guidance to carry out the invention.

2.4.3 Thus Appellant I (Opponent II) has discharged the burden of proof which was upon him and it would have been for the Proprietor to give counter-evidence. The Proprietor did not show that a person skilled in the art using common general knowledge would have taken measures to modify the tests in such a manner that the desired result was achieved. He indicated that he had "reappraised the previous comments of the Appeal Board and had concluded that the most suitable manner in which to show that the skilled person could perform the invention from the description as granted using an appropriate level of innate knowledge would be to demonstrate to the Appeal Board how such method was performed in practice." The Proprietor contemplated using a video tape but refrained from doing so because "the viewing of such video by the Appellants/Opponents could provide the Appellants with knowledge of the Proprietor which is unrelated to the issue under consideration but which, given that the Opponents/Appellants are competitors of the Proprietor, would adversely prejudice the commercial interests of the Proprietor". The Proprietor of the patent is of course free to refrain from giving evidence. This means that he does not take the opportunity to challenge the probative value of the tests of the Opponent by way of counter-evidence.

2.5 In view of the above considerations, the Board arrives at the conclusion that the European patent does not disclose the invention in a manner sufficiently clear and complete for it to be carried out by a person skilled in the art.

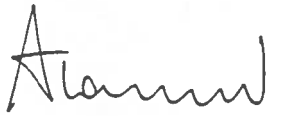
3. The patent, therefore, does not meet the requirements of Article 100(b) EPC.

**Order**

**For these reasons it is decided that:**

1. The appeal of the Proprietor of the patent is rejected as inadmissible.
2. The request of the Proprietor of the patent to reimburse the appeal fee is rejected.
3. The decision under appeal is set aside.
4. The patent is revoked.

The Registrar:



A. Townend

The Chairman:



G. Gall