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D E C I S I O N
of 19 February 1997

Case Number: T 0556/93 - 3.3.3

Application Number: 89907246.6

Publication Number: 0422064

IPC: C08L 101/00

Language of the proceedings: EN

Title of invention:

Polymer compositions comprising waste rubber and/or scrap
leather as ingredient

Patentee:

ARIADNE KERESKEDELMIKFT.

Opponent:

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Headword:

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Relevant legal provisions:

EPC Art. 84, 123(2)

Keyword:

"Deletion of an essential feature - unallowable extension"

Decisions cited:

T 0409/91, T 0133/85, T 0659/93

Catchword:

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Case Number: T 0556/93 - 3.3.3

DECISION
of the Technical Board of Appeal 3.3.3
of 19 February 1997

Appellant:

ARIADNE KERESKEDELMIKFT.
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H-1015 Budapest (HU)

Representative:

Wolfram, Gustav, Dipl. -Ing.
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Decision under appeal:

Decision of the Examining Division of the
European Patent Office posted refusing European
patent application No. 89 907 246.6 pursuant to
Article 97(1) EPC.

Composition of the Board:

Chairman: C. Gérardin
Members: H. H. Fessel
J. A. Stephens-Ofiner

Summary of Facts and Submissions

I. European patent application No. 89 907 246.6 was filed on 16 June 1989 and published under the Patent Cooperation Treaty on 11 January 1990 under the international publication number WO 90/00184 with one claim which read as follows:

"Polymer composition containing an ingredient and workable by processing methods of thermoplastics, characterized in that it contains as ingredient 10-70 % by mass of crushed waste rubber of preferably 2-5 mm grain size and/or shredded leather fibres, as well as one or more tensides, and, if desired, additives or auxiliaries corresponding to the field of application, such as fire retardants, blowing agents, moisture-binding agents, traditional fillers, colouring agents and pigments, lubricants and stabilizers, crosslinking agents."

The application was refused by a decision of the Examining Division 2.1.15.014 of the European Patent Office dated 18 January 1993. That decision was based on a set of 11 claims filed on 2 November 1992 of which Claim 1 reads as follows:

"A shaped body containing

- a matrix of a polymer composition comprising an ethylene vinyl acetate polymer and polyethylene and
- between 10 and 70 % by mass of a filler ingredient from the group consisting of ground rubber particles, scrap leather particles and combinations thereof."

II. The reason for the decision was that the claimed subject-matter met the provisions of Article 123(2) EPC, but did not involve an inventive step (Article 56 EPC) vis-à-vis the following documents:

- D1: FR-A-2 342 155;
- D2: US-A-4 287 252;
- D3: US-A-3 489 710.

III. On 8 March 1993 a Notice of Appeal was filed together with payment of the prescribed fee. The Statement of Grounds was submitted on 25 May 1993.

IV. In a communication issued in preparation for the oral proceedings the Appellant's attention was drawn to an inconsistency arising from the deletion of tensides out of the claimed subject-matter which was objectionable under both Article 84 and Article 123(2) EPC.

V. During the oral proceedings on 19 February 1997 the Board maintained these objections and drew the attention of the Appellant (i) to page 4, lines 26 to 29; page 4, line 33 to page 5, line 33 and page 13, lines 8 to 14 of the application as originally filed (PCT document), (ii) to the original claims, and (iii) to the "Observations on the international application" accompanying the International Preliminary Examination Report, from which the importance of tensides clearly appeared. The Appellant offered to delete some of the passages of the description as e.g. page 5, lines 3 to 33 to establish consistency with the claimed subject-matter. As to the subject-matter as claimed the Appellant argued that nearly all of the examples supported that subject-matter and he should thus be allowed to restrict the claims to that subject-matter.

Although expressly invited by the Board to file, at least an auxiliary request, a set of claims incorporating the presence of tensides as a compulsory feature of the claimed compositions, the Appellant's Representative merely stated that he had no instruction in that respect.

VI. The Appellant requested:

That the decision under appeal be set aside and a patent be granted on the basis of the claims of the decision under appeal.

Reasons for the Decision

1. The appeal is admissible.
2. *Objection raised under Article 123(2) EPC*

It has first to be considered and decided whether the patent application contains subject-matter which extends beyond the content of the application as filed. The only amendment which has been made hitherto is that amended claims were filed on 20 December 1990. Present Claim 1 differs from that originally filed in several respects, in particular by the deletion of tenside as mandatory component of the specified composition.

The problem whether deletion of a feature in a claim is an allowable amendment under Article 123(2) EPC is a well known problem and has been dealt with in various decisions of the Boards of Appeal. As a general principle it can be said that the removal of a feature from a claim may not violate Article 123(2) EPC provided that the skilled person would directly and unambiguously recognise that (1) the feature was not

explained as essential in the original disclosure, and (2) it is not, as such, indispensable for the function of the invention in the light of the technical problem it serves to solve.

As already mentioned above, in the present case it is specified on page 13, lines 8 to 14 that only in case of compositions containing a tenside, rubber and leather are well embedded in the polymer matrix, in a homogeneous manner, while in case of compositions not containing a tenside smaller adjoining surfaces between ingredient and polymer may be observed. All this is further supported by all the full paragraphs of page 5 of the description. The presence of tenside is thus explained to be essential and to be indispensable to obtain large adjoining surfaces between rubber and/or leather particles and polymer resulting in improved mechanical properties.

The Appellant's allegation that the majority, i.e. nearly all of the examples relate to tenside-free compositions of EVA and PE and thus disclose an invention as claimed in the subject-matter of the present request, cannot be followed. On the contrary, the interpretation which according to the description (page 12, line 32 to page 13, line 7) is to be given of Figures 1 to 4 makes it quite clear that (i) Figures 1 and 3, which show the structure of a product containing rubber respectively leather ingredient, both without tenside, concern products said to be known, and (ii) Figures 2 and 4, which show the structure of products with identical composition, but containing a tenside, correspond to the invention as originally disclosed. This means that only Examples 13 and 14 are within the scope of that invention and that consequently, Examples 1 to 12 are to be regarded as comparative examples.

3. *Objection raised under Article 84 EPC*

The subject-matter of Claim 1, amended in response to an observation in the PCT international preliminary examination report dated 31 August 1990, no longer contains "one or more tensides". This amendment gives rise to an objection under Article 84 EPC since the amended subject-matter is not supported by the description, especially with regard to page 5, lines 24 to 33 and page 12, line 32 to page 13, line 14 (annex to summons). It is explained there that "As a result of the tenside, the surface is increased in which favourable contact is established between the filler and polymer mixture." (page 5, lines 30 to 33). This beneficial effect is illustrated by Figures 1 to 4 which clearly and unambiguously demonstrate that in compositions containing a tenside the ingredient is well embedded in the polymer matrix, whereas in compositions not containing such a tenside, agglomerated structure and considerably smaller adjoining surfaces between the ingredient and polymer matrix may be observed (page 13, lines 8 to 14).

From the above cited passages it is evident that the presence of a tenside is essential and a subject-matter as claimed at present, i.e. one not containing a tenside as a mandatory feature, is not supported by the description and thus offends the provisions of Article 84 sec. sentence EPC.

As set out in various decisions of the boards of appeal (T 409/91, OJ EPO 1994, 653; T 133/85, OJ EPO 1988, 441; T 659/93 of 7 September 1994, not published in OJ EPO), the discrepancy between the description and the scope of the claims is objectionable under

Article 84 EPC, since the latter do not define the claimed subject-matter by reference to all its essential features. Insofar as these claims omit to include an essential feature, there are no definitions of the invention actually described, but mere incomplete descriptions of it.

4. It follows that Claim 1 on file does not meet the requirements of Article 84 EPC since it does not comprise a tenside said to be an essential feature. Moreover Claim 1 contains subject-matter which extends beyond the content of the application as filed (Article 123(2) EPC). For both reasons the wording of Claim 1 is thus objectionable.

Order

For these reasons it is decided that:

The appeal is dismissed.

The Registrar:


E. Görgmayer

The Chairman:


C. Gérardin