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D E C I S I O N
of 9 September 1998

Case Number: T 0591/94 - 3.2.5

Application Number: 89302077.6

Publication Number: 0331485

IPC: B29C 31/06

Language of the proceedings: EN

Title of invention:

Melt extruded polymeric compositions and processes of moulding them

Patentee:

W.R. Grace & Co.-Conn.

Opponent:

DS-Chemie GmbH

Headword:

-

Relevant legal provisions:

EPC Art. 54(2), 111(1)

Keyword:

"Public prior use"
"Remittal to the first instance"

Decisions cited:

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Catchword:

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Case Number: T 0591/94 - 3.2.5

D E C I S I O N
of the Technical Board of Appeal 3.2.5
of 9 September 1998

Appellant:
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Decision under appeal: Decision of the Opposition Division of the
European Patent Office posted 4 July 1994
revoking European patent No. 0 331 485 pursuant
to Article 102(1) EPC.

Composition of the Board:

Chairman: A. Burkhart
Members: J. H. van Moer
H. P. Ostertag
W. D. Weiss
W. Moser

Summary of Facts and Submissions

- I. The appellant (proprietor of the patent) lodged an appeal against the decision of the Opposition Division revoking the patent No. 0 331 485.

Opposition was filed against the patent as a whole and based on Article 100(a) EPC (lack of novelty and inventive step).

The Opposition Division held that the grounds for opposition mentioned in Article 100(a) EPC prejudiced the maintenance of the patent having regard to a public prior use alleged by the respondent (opponent).

This prior use was based on the testimony of two witnesses, Mr Schlenk and Mr Przygode and on the following pieces of evidence:

D15: DS - Chemie - Farbraktionsbericht - No. 126,
Sorte: Svelon 855-21

D16: DS - Chemie - Fabrikationsbericht - No. 127,
Sorte: Svelon 855-22

D18: "TNT - Frachtbriefkopie" No. 3 834 166, dated
13 October 1987

D19: Copy of a laboratory report, sample Nos. 112 to
133

- II. Oral proceedings were held on 9 September 1998 before

the Board of Appeal.

- (i) The appellant requested that the decision under appeal be set aside and that the patent be maintained on the basis of the
 - (a) **Main request:** claims 1 to 14, filed on 17 May 1994 as main request; or
 - (b) **First auxiliary request:** claims 1 to 9, filed on 17 May 1994 as first auxiliary request; or
 - (c) **Second auxiliary request:** claims 1 to 10, filed on 1 June 1994; or
 - (d) **Third auxiliary request:** claims 1 to 9, filed on 17 May 1994 as fifth auxiliary request; or
 - (e) **Fourth auxiliary request:** claims 1 to 11, filed on 17 May 1994 as third auxiliary request.
- (ii) The respondent requested that the appeal be dismissed.
- (iii) Claim 1 of the main request reads as follows:

"1. A process of making a plurality of moulded articles of thermoplastic composition comprising thermoplastic polymeric material which does not contain polyvinyl chloride or other chlorine-containing polymer at a rate of more than 100 per minute by providing continuous supply of the said thermoplastic composition in molten form, continuously cutting the supply into molten pieces and transferring the molten pieces to a moulding position by cutting and transfer means, and moulding the transferred pieces into the desired moulded articles, characterised in that the composition includes a melt-release material and there is a melt-release layer on the cutting and transfer means and this layer is continuously replenished by melt-release material from the molten composition that is cut and transferred by the cutting and transfer means."

III. The appellant argued essentially as follows:

The testimony of the witnesses Schlenk and Przygode given before the Opposition Division and the documents D15, D16, D18 and D19 did not prove that sample compounds of the Svelon 855-21 of 855-22 type were ever sent to MWF Hückeswagen and that these sample compounds were successfully tested on the Sacmi machine in autumn 1987. The chain of proof for the alleged prior use contained too many gaps and inconsistencies to establish the alleged prior use up to the hilt.

The witness Schlenk had no personal knowledge whether

and how the sample compounds of Svelon 855-21 and 855-22 had actually been delivered to MWF Hückeswagen, how the test runs at MWF Hückeswagen were carried out, whether these tests were successful and whether crown corks manufactured in these tests were passed to a customer of MWF Hückeswagen. He affirmed that no visit or test reports referring to these tests existed.

Document D18 did not prove that the compounds Svelon 855-21 or 855-22 specified in documents D15 and D16 and mentioned in document D19 had actually been delivered to MWF Hückeswagen, since the handwritten wording "Svelon 855-21" on document D18 could have been added later. The witness Schlenk had not been able to explain at what time, by whom and in what circumstances this addition had been made.

The witness Przygode could not link the samples delivered from DS-Chemie to DS-Chemie Product Numbers. He had no idea of the content of these samples, except that they were PVC-free compounds. From D19 it was clear that DS-Chemie had other PVC-free test products prepared for MWF Hückeswagen in October 1987 including Svelon 855-20 and 855-11, which did not contain a silicon oil. Therefore, the testimony of the witness Przygode was unclear as to which Svelon type compound had actually been tested in October 1987 at MWF Hückeswagen.

Moreover, the witness Przygode was not personally present at the tests carried out on the Sacmi machine. Therefore, it was not clear from the testimony of the witness Przygode whether the crown corks handed over by

him to Coca-Cola contained the compound type Svelon 855-21 or 855-22 or other Svelon types.

Both witnesses had affirmed that DS-Chemie and MWF Hückeswagen had a close relationship for testing new compounds of DS-Chemie on the Sacmi machine at MWF Hückeswagen and that the tests with the Svelon compounds on the Sacmi machine were carried out under the control of Mr Nüssen, an employee of DS-Chemie. This suggested that DS-Chemie and MWF Hückeswagen considered those test runs confidential on the basis of an implicit obligation to secrecy. There was no evidence that MWF-Hückeswagen would have considered themselves free in equity and law to pass on samples or information about the samples to any interested third party, such as the appellant. Moreover, the letter of Coca-Cola of 15 May 1995 confirmed that they would treat test samples handed over to them for test purposes by suppliers of liner material as confidential.

Therefore, from the testimony of the witnesses Schlenk and Przygode and the documents relied on in this respect it was not clear what exactly was used and what was made available to the public.

IV. The respondent argued essentially as follows:

Both witnesses had affirmed that there had been no secrecy agreement between the companies DS-Chemie and MWF Hückeswagen relating to the delivery of the test compounds Svelon 855-21 and 855-22 and the test runs carried out on the Sacmi machines of MWF Hückeswagen,

and that the company MWF Hückeswagen, which had been the "public" in the instant case, had been free and had had the possibility to pass information about the said compounds and test runs to third parties.

The "when" and "what" questions of the alleged prior use had been answered on the basis of the credible testimony of the witnesses Schlenk and Przygode and the evidence according to the documents D15, D16, D18 and D19. With regard to the "balance of probabilities", which was the proper approach when evaluating the testimony and the evidence presented in the instant case, the alleged prior use had been sufficiently established.

If the Board were to regard the evidence as insufficient, the case should be remitted to the Opposition Division for further taking of evidence.

When the evidence had been taken by the Opposition Division, two witnesses who could have added to the evidence, and who could have in fact supplied all the missing items on which the appellant now tried to rely, were not available. At that time, Mr Nüssen and Mr Busch had left the company DS-Chemie and were working for competitor firms; they had been, for personal reasons, not ready to assist the respondent then. However, now Mr Busch and Mr Nüssen were ready to appear as witnesses. Mr Nüssen, in particular, who had been directly involved in the delivery and test runs of the Svelon 855-21 and 855-22 samples, could testify what actually happened in October 1987, and he would be happy to confirm all details of his visit to MWF

Hückeswagen, in particular the running of the compounds on the Sacmi machine, the behaviour of DS-Chemie's compounds during this production, and everything else that Mr Schlenk and Mr Przygode could not confirm from personal knowledge.

Reasons for the Decision

1. The appeal is admissible.

2. The Opposition Division found that a compound having the composition as disclosed in documents D15 and D16 became state of the art in October 1987 by delivery of that compound to MWF Hückeswagen without any express or tacit agreement on secrecy, and that, therefore, the prior public use of the process of making on a Sacmi machine a plurality of moulded articles of thermoplastic composition comprising thermoplastic polymeric material which does not contain polyvinyl chloride or other chlorine containing polymer and which includes a melt release material had been established and the process had thus to be considered prior art (see paragraph 14 of the minutes of the oral proceedings and page 12, paragraph No. 3 of the decision of the Opposition Division).

The Opposition Division based its finding on the testimony of the witnesses Schlenk and Przygode and on the documents D15, D16, D18 and D19.

3. Since the above finding of the Opposition Division was challenged by the appellant, the Board has to decide

this issue.

3.1 It is established jurisprudence of the Boards of Appeal (see "Case Law" of the Boards of Appeal, 1996, page 68, paragraph 3.4) that to be able to determine whether an invention has been made available to the public by prior use, the following circumstances have to be clarified:

- (a) the date on which the prior use occurred,
- (b) exactly what was in prior use,
- (c) the circumstances surrounding the prior use.

Whereas from the testimony of the witnesses Schlenk and Przygode it is clear that in October 1987 a PVC-free Svelon-compound has been delivered to MWF Hückeswagen by DS-Chemie for testing purposes, the Board considers the evidence on file not sufficient to establish what compound was then exactly delivered to MWF Hückeswagen by DS-Chemie and subsequently tested on the Sacmi machine at MWF Hückeswagen. Thus, in the Board's judgement and contrary to the opinion of the Opposition Division, the aforementioned condition (b) has not been sufficiently substantiated.

3.2 The reasons for the Board's view are as follows:

- According to document D19, four PVC-free Svelon-type compounds, namely Svelon 855-11, 855-20, 855-21 and 855-22, were prepared at DS-Chemie for the customer MWF Hückeswagen. Out of these

compounds only the Svelon 855-21 and 855-22 contained a silicon oil acting as a melt release agent (see documents D15 and D16).

- Document 18 is a carbon copy sheet from a TNT way bill handed over to DS-Chemie by TNT upon receipt of the package for dispatch on 13 October 1987. This carbon copy of the way bill carries the wording "Svelon 855-21" added in writing in ink. The witness Schlenk was not able to explain at what time, by whom and in what circumstances this addition had been made. No evidence was given as to whether this way bill carried this wording at that time, or whether this wording was later added.

The carbon copy of the waybill itself makes no reference to a specific compound. With respect to the package content, it carries only the general remark "Granulat, kein Gefahrgut".

- With respect to the delivery of the compound Svelon 855-22, no piece of evidence was presented.
- The witness Schlenk said that he had not personally been involved in the preparation and delivery of the compounds Svelon 855-21 and 855-22 and that, with respect to the actual delivery of the compound Svelon 855-21 to MWF Hückeswagen, he relied on document D18, and that, with respect to the actual delivery of the compound Svelon 855-22 he did not remember how this compound was delivered, and that he did not know from his own memory, whether the compounds Svelon 855-21 and

855-22 had actually been manufactured or delivered on 11 and 14 October 1987 (see page 7, third and fourth paragraph of the minutes of the hearing of the witness Schlenk).

- Therefore, neither the testimony of the witness Schlenk nor documents D15, D16, D18 and D19 sufficiently prove that the compounds Svelon 855-21 and 855-22 were actually delivered in October 1987 to MWF Hückeswagen by DS-Chemie.

- The witness Przygode said that he could not link the compound samples delivered to MWF Hückeswagen by DS-Chemie to specific DS-Chemie product numbers and that he had no idea of the composition of these samples, except that they were PVC-free compounds (see page 4, second paragraph of the minutes of the hearing of the witness Przygode).

Therefore, also the testimony of the witness Przygode does not sufficiently prove that the compounds Svelon 855-21 and 855-22 were actually delivered to MWF Hückeswagen by DS-Chemie in October 1987.

- None of the witnesses Schlenk and Przygode was personally present at the test runs carried out on the Sacmi machine at MWF Hückeswagen. No written visit or test reports exist about these test runs. There is no testimony on file about the actual process parameters and the outcome of the test runs.

- Hence, the evidence on file does not sufficiently prove that the compounds Svelon 855-21 and 855-22 have been actually delivered to MWF Hückeswagen by DS-Chemie in October 1987, and it is therefore unclear, whether and under what circumstances test runs were carried out with these compounds on the Sacmi machine at MWF Hückeswagen in October 1987.

4. In contrast to the above finding of the Board, the Opposition Division considered the evidence on file sufficient to establish what was exactly in prior use and, logically, closed the procedure without challenging further evidence from the respondent in this respect.

In a situation like the present one, where the Board does not concur with the finding of the Opposition Division, and where the respondent offers further witnesses (namely Messrs. Nüssen and Busch) who have already been mentioned in the testimony of the former witnesses Schlenk and Przygode as having been personally involved in the alleged prior use, and who are said to be able to clarify the "what" circumstance of the alleged prior use, the Board considers it equitable and necessary to hear these witnesses, as has been suggested by the respondent during the appeal proceedings.

The Board considers it also appropriate that such a hearing of further witnesses be carried out by the Opposition Division, in order not to deprive the parties of the opportunity to have this fresh matter examined by two instances.

Therefore, the Board exercises its discretion under Article 111(1) EPC to remit the case to the Opposition Division for further prosecution.

Order

For these reasons it is decided that:

1. The decision under appeal is set aside.
2. The case is remitted to the Opposition Division for further prosecution.

The Registrar: The Chairman:

A. Townend

A. Burkhart