
Candidate's Answer C

Notes to client

1. The priority of claim 3, as far as dependent from claim 1, is not valid. See the notice of opposition.

2. Annex 6 has not been used, since no suitable arguments for this opposition could be found in it.

3. Annex 5 (A5) can be used in the opposition, and this has been done, as can be seen in the notice of opposition. A5 can be used as proof of what has been made available to the public (in this case you and two of your colleagues) before the priority date of A1. A5 is clearly the result of a breach of secrecy by the (undisclosed) author; however, after this breach of secrecy and upon provision of the contents of the disclosure by the recipient (who was clearly not bound to secrecy), Mr Hansen, to you, the contents did become public according to Art 54(2) EPC.

In principle, the breach of secrecy by the sender, could be invoked by the patent proprietor as an evident abuse against him when he was an applicant, and therefore the contents could have been exempt from being prior art under Art 54 by virtue of the exclusion under Art 55(1)(a). However, the exemption under Art 55(1)(a) only applies if the disclosure occurred no earlier than six months preceding the filing date of the application, which is not the case here: it occurred less than 6 months before the priority date, but the relevant date for the 6 months of Art 55(1) is the filing date, not the priority date (G3/98 = G2/99).

Hence, the proprietor will not be successful when trying to invoke Art 55(1) EPC, and therefore the disclosure to you made the contents of A5 prior art according to Art 54 EPC.

We will need to file evidence about the disclosure, preferably in the form of written affidavits by you and your two colleagues, to prove the facts of the disclosure.

The sender of the letter may remain unknown, as it was Mr Hansen who made the relevant disclosure to you.

4. It is not possible to have the patent revoked for only DE, IT and ES: an opposition shall apply to the European patent in all the Contracting States in which that patent has effect (Art 99(2) EPC).

5. It is not possible to argue that claim 6 concerns a different invention from that described in the other claims, because lack of unity (Art 82 EPC) is not a ground for opposition (the grounds are exhaustively given in Art 100 EPC). Furthermore, unity is not relevant in opposition (G1/91). Claim 6 is attacked however (see notice).

6. Your attorney in the US may accompany me and speak during oral proceedings, under strict conditions (G4/95): - he needs permission of and under discretion of the EPO, - this must be requested and motivated in advance, - and the submissions must be made under the responsibility of the professional representative in addition to his complete presentation of the case.



Tabulation Marks

Notice of Opposition to a European Patent

To the
European Patent Office

		for EPO use only	
I. Patent opposed		Opp. No.	OPPO (1)
Patent No.		EP 1011 743 B1	
Application No.		99123321.4	
Date of mention of the grant in the European Patent Bulletin (Art. 97(4), 99(1) EPC)		16.06.2004	
Title of the invention:		Liner and lining method	
II. Proprietor of the Patent		USE Kunststofftechnik GmbH	
first named in the patent specification			
Opponent's or representative's reference (max. 15 spaces)		OREF	
III. Opponent		OPPO (2)	
Name	ALLPLAST GmbH		
Address	Am Alsterwasser 1 D - 20149 Hamburg		
State of residence or of principal place of business	Germany		
Telephone/Telex/Fax			
Multiple opponents	☐ further opponents see additional sheet		
IV. Authorisation		OPPO (9)	
1. Representative (Name only one representative to whom notification is to be made)			
Name	R. Ambo		
Address of place of business	Hauerstrasse 47 D - 81547 Munich		
Telephone/Telex/Fax			
Additional representative(s)	☐ (on additional sheet/see authorisation)		OPPO (5)
2. Employee(s) of the opponent authorised for these opposition proceedings under act. 133(3) EPC	Name(s):		
Authorisation(s)	☒ not considered necessary		
To 1./2.	☐ has/have been registered under No.		
	☐ is/are enclosed		

— claim(s) No(s).

VI. Grounds for opposition:

(a) the subject-matter of the European patent opposed is not patentable (Art. 100(a) EPC) because:

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- ☒

- ☐

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VII. Facts and arguments

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presented in support of the opposition are submitted herewith on a separate sheet (annex 1)

VIII. Other requests:

Oral proceedings (Art 116 EPC) are requested in the event that the patent opposed is not to be revoked by the Opposition Division as requested.

IX. Evidence presented		for EPO use only
Enclosed = ☐ will be filed at a later date = ☐		
A. Publications:		Publication date
1 Particular relevance (page, column, line, fig.):		
2 Particular relevance (page, column, line, fig.):		
3 Particular relevance (page, column, line, fig.):		
4 Particular relevance (page, column, line, fig.):		
5 Particular relevance (page, column, line, fig.):		
6 Particular relevance (page, column, line, fig.):		
7 Particular relevance (page, column, line, fig.):		
Continued on additional sheet ☐		
B. Other evidence		
Continued on additional sheet ☐		

X. Payment of the opposition fee is made

☒ as indicated in the enclosed voucher for payment of fees and costs (EPO Form 1010)

☐
XI. List of documents:

Enclosure No.:

No. of copies

- | | | |
|----|--|---|
| 0 | ☒ Form for notice of opposition | <input type="text" value="2"/> (min. 2) |
| 1 | ☒ facts and arguments (see VII.) | <input type="text" value="2"/> (min. 2) |
| 2 | Copies of documents presented as evidence (see IX.) | |
| 2a | ☒ — Publications | <input type="text" value="2"/> (min. 2 of each) |
| 2b | ☒ — Other documents | <input type="text" value="2"/> (min. 2 of each) |
| 3 | ☐ Signed authorisation(s) (see IV.) | <input type="text"/> |
| 4 | ☒ Voucher of payment of fees and costs (see X.) | <input type="text" value="1"/> |
| 5 | ☐ Cheque | <input type="text"/> |
| 6 | ☐ Additional sheet(s) | <input type="text"/> (min. 2 of each) |
| 7 | ☒ Other (please specify here):
form for acknowledgement
receipt of documents | <input type="text" value="1"/> |

**XII. Signature
of opponent or representative**

Place Munich

Date 10/03/2005

XXX

Dr. R. Ambo

Please print name under signature. In the case of legal persons, the position which the person signing holds within the company should also be printed.

Facts and arguments

The English version of A1 is opposed (A1 means Annex 1).

Reference will be made in the following to the continuous page numbers appearing on the bottom at the left. The letter “p.” denotes the page number, the letter “l.” denotes the line number(s); if applicable, paragraph numbers are given between square brackets (e.g. [004] refers to paragraph 4).

Priority date of claims of A1

Claims 1, 2, 4, 5 and 6 are entitled to the priority date, 27/11/98, because their content was disclosed in the priority document. Claim 3, as far as dependent on claim 2, also is entitled to the priority date of 27/11/98, because the subject-matter claimed in claim 3 dependent from claim 2 was disclosed in the priority document, and because for an or-claim it is possible to have different priorities for the alternative embodiments (Art 88(2) EPC + G2/98). However, claim 3 as dependent from claim 1 is not entitled to the priority date and hence has as effective date the filing date, i.e. 26/11/99. The subject-matter of claim 3 as dependent from claim 1 could not be derived by the skilled person directly and unambiguously, using common general knowledge, from the priority application as a whole (G2/98): because the text of the priority application only disclosed the embodiment of claim 2, and claim 3 as filed was only dependent from 2, the skilled person could not derive clearly and unambiguously that the method of claim 3 could also be used in the more general terms of claim 1: therefore the subject-matter of claim 3 as dependent from claim 1 is not disclosed in the priority document, and the priority of this alternative in claim 3 is not valid (G2/98), so that claim 3 as dependent from claim 1 has the filing date as effective date.

Documents referred to

(a) Publications

- A1 the patent in suit
- A2 (German) is from a handbook published in April '88, i.e. before the priority date of A1, and therefore is state of the art under Art 54(2) EPC. Since it is a handbook, the person skilled in the art will know its contents as being common general knowledge (T171/84).

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- A3 (English) is a European patent application having a filing date before and a publication date after the priority date of A1, and is therefore prior art under Art 54(3) EPC (jo Art 54(4) + Rule 23a EPC) for the claims entitled to priority, and is so in all designated states of A1 (since all states designated in A1 have been validly designated in A3; an abstract of the Register showing the payment of the designation fees for A3 will be provided upon request). A3 is published before the filing date of A1, and is therefore prior art under Art 54(2) EPC for subject-matter that is not entitled to priority (i.e. for claim 3 dependent from claim 1).
 - A4 (English) is published on 14/4/93 and is state of the art according to Art 54(2) EPC.

(b) Other evidence

A5 is a letter, which is used to indicate the contents of a public disclosure to Mr Sandler and two of his colleagues, on their journey to the “Interkunststof” trade fair held in Amsterdam from 12-14 October 1998. The contents of this letter were disclosed to them by Mr. Hansen, and therefore became public before the priority date of A1, without any confidentiality implied on the recipients of the contents (see last sentence), so that the disclosure amounts to a public disclosure being state of the art under Art 54(2) EPC. Written affidavits by Mr Sandler and his two colleagues, confirming what has been disclosed to them, will be provided as proof in due course.

Observations on novelty and inventive step of A1 (Art 100(a) EPC)

1. Claim 1 (independent; eff date 27/11/98)

1.1 Claim 1 lacks novelty over A3 (Art 54(3) EPC)

A3 discloses a method (see A3, [004], showing that the contents of A3 pertain to a method) of lining a sewer pipe (p.23 I.4 mentions sewer pipe) with a tubular film (see p.23 I.4-5: “sewer pipe is to be lined with an elastic liner tube 32”; note: although the word “film” is not disclosed verbatim in A3, the disclosed liner tube is implicitly considered to be a film, as A1 does not give further limitations to the term “film”, e.g. in terms of thickness, and further it is clear from Fig. 1 of A3 that the liner tube 32 is thin and therefore can be considered a “film” in as far as the latter term implies that it should be “thin”). The liner tube 32 has an outer diameter D1 substantially matching (“corresponding to”) the inner diameter of pipe 31 (A3 p.23 I.5 + Fig. 1).

The disclosed method comprises (i): elastically deforming (= “modifying the shape”) the liner tube 32 into a liner tube 32’ with a considerably reduced diameter D2 (p.23 I.8-11),

which allows it to be introduced into the sewer pipe (implicit: preferably D2 is 20-35% smaller than D1, and evident from next step). The deformed liner tube 32' is then inserted into pipe 32 that has to be lined (p.23 l.18-19), thus disclosing step (ii) of claim 1 of A1.

When the liner tube 32' is at the desired position in the pipe 31, it is restored to its original shape ("springs back to its original circular cross-section", p.23 l.22-25), thus disclosing step (iii) of claim 1 of A1. A3 therefore discloses each and every element of claim 1. Claim 1 therefore lacks novelty (Art 52(1), 54(3), 100(a) EPC).

1.2 Claim 1 lacks novelty in view of A4 (Art 54(2) EPC)

A4 discloses in its claim a method that comprises all limitations of claim 1 of A1: A4 (claim, p.16 l.15-19) discloses a method for lining a pipe (from the disclosed embodiment it is clear that the pipe can be a sewer pipe: see p.15 l.8 ("sewer pipe 41")) with a liner tube (implicitly is a tubular film, see arguments under 1.1 above) having an outer diameter corresponding to the maximum inner diameter of the pipe (implicitly means that this outer diameter of the liner tube substantially matches the inner diameter of the pipe), the method comprising: reducing in cross-section (= modifying the shape) a liner tube, allowing it to be introduced into the sewer pipe (see e.g. p.15 l.19; further implicit from next step), (ii) inserting the reduced liner tube into the pipe to be lined, and (iii) heating the liner tube above its activation temperature to return to its original cross-sectional dimension (= restoring the original shape). Therefore, A4 discloses all elements of claim 1. Claim 1 therefore lacks novelty over A4 (Art 52(1), 54(2), 100(a) EPC).

Claim 2 (dependent from claim 1; eff date 27/11/98)

2.1 Claim 2 lacks inventive step over A4 in view of common general knowledge

2.1.1 A4 discloses all features of claim 1 (see above under point 1.2).

2.1.2 A4 is the closest prior art for claim 2, as A4 is within the same field (lining of pipes), and further has the most technical features in common with claim 2.

2.1.3 A4 further discloses that the tubular film (liner tube) consists of a thermally recoverable plastics material (p.15 l.9-10), and that step (i) (the shape modification) takes place above the material's activation temperature (p.15 l.14-16), and that the modified shape of the liner tube is fixed ("frozen") by cooling it to a temperature below the activation temperature (p.15 l.21-23). A4 further discloses that the restoration of the tube to its original shape (p.16 l.5-6) is carried out by heating to a temperature above the

activation temperature of the plastics material (p.16 I.1-2).

2.1.4 The difference between claim 2 and A4 is that the heating in A4 as disclosed is preferably effected by an infrared lamp, whereas the heating in claim 2 is effected by blowing air through the tubular film.

2.1.5 There is no technical effect associated with this difference.

2.1.6 The objective problem to be solved by the invention therefore consisted of providing an alternative means for heating the tubing to activate its memory.

2.1.7 Such an alternative means was common general knowledge available to the person skilled in the art, for instance a hot air current was known to give the same effect as an infrared lamp, as is evident from A2, p.9 I.32-34 (from a handbook relating to materials with shape memory).

2.1.8 Hence, the provision of this known alternative with the same effect does not comprise inventive activity, and the skilled person would arrive at the subject-matter of claim 2 without exercising any inventive skill.

2.1.9 Accordingly, the subject-matter of claim 2 does not involve an inventive step (Art 52(1), 56, 100(a) EPC) in view of A4 combined with common general knowledge.

3A. Claim 3 (dependent from claim 1; eff date 26/11/99)

3A.1 Claim 3 is not novel over A3 (Art 54(2) EPC)

Claim 1 is anticipated by A3, as outlined above (point 1.1). Continuing from that attack, A3 further discloses that the shape of the tubular film (liner tube) is modified ("deforming", p.23 I.9) by giving the tubular film a horseshoe-like cross-section (p.23 I.10-11; also: Fig. 2). Therefore, A3 discloses all elements of claim 3 dependent from claim 1. Claim 3 therefore lacks novelty (Art 52(1), 54(2), 100(a) EPC) over A3.

3A.2 Claim 3 lacks inventive step over A4 with public prior disclosure (Art 56 EPC)

3A.2.1 A4 destroys novelty of claim 1 (see above, point 1.2), and therefore is inherited as the closest prior art for claim 3 dependent from claim 1.

3A.2.2 The difference between claim 2 and A4 is the tubular film being modified to give it a horseshoe-like cross-section.

3A.2.3 The technical effect achieved by this difference is that it reduces the maximum outer dimension of the film (see A1, p.5 I.13-14).

3A.2.4 The objective technical problem to be solved by the invention therefore consisted of reducing the maximum outer dimension of the film.

3A.2.5 This problem was known to be solved by providing a roughly U-shaped tubing

(i.e. a horseshoe-like formed tubing), as was publicly disclosed before the priority date, as proven by for instance the first sentence of the second paragraph of A5 (“tubing cross-section changed from round to roughly U-shaped with relatively small outer dimensions”). The tubing concerned in A5 is made of shape-memory polyethylene (second sentence, first paragraph). Hence, the skilled person would apply the teaching of “A5” (the public prior disclosure of which he could have gained knowledge, and he would have because it is in the field of the problem, i.e. reducing dimensions of memory-shaped tubing) to solve the above problem, and would thereby come up with the solution as claimed.

3A.2.6 The skilled person would thus arrive at the subject-matter of claim 3 without exercising any inventive skill.

3A.2.7 Accordingly, the subject-matter of claim 3 does not involve an inventive step (Art 52(1), 56, 100(a) EPC) in view of A4 and public prior disclosure of the contents of A5.

3B. Claim 3 (dependent from claim 2; eff date 27/11/98)

3B.1 Claim 3 lacks inventive step over A4 with common general knowledge in combination with public prior disclosure (Art 56 EPC)

Continuing from the inventive step attack on claim 2 based on A4 and common general knowledge (see point 2.1 above), essentially the same arguments as given for lack of inventive step of claim 3 (dependent from claim 1) based on A4 + A5 are valid (see point 3A.2 above). Consequently, claim 3 (dependent from claim 2) lacks inventive step (Art 52(1), 54(2), 100(a) EPC) over A4 with common general knowledge in combination with public prior disclosure of A5.

4. Claim 4 (independent; eff date 27/11/98)

4.1 Claim 4 lacks novelty over A2 (common general knowledge) (Art 54(2) EPC)

4.1.1 Claim 4 relates to a tubular film for lining a pipe. This is interpreted as a tubular film “suitable for” lining a pipe (Guidelines C-III, 4.8), and hence any tubular film that is suitable for lining a pipe (and comprises the other technical features claimed) will anticipate this tubular film, even if its purpose is not explicitly stated.

4.1.2 A2 discloses a heat shrink tubing (p.9 I.26), which has a thermally recoverable shape (p.9 I.27-28), and can for instance be made from polyethylene (p.9 I.6).

Polyethylene is a polyolefin (see A1 p.5 I.3). Since no technical limitations are apparent why the polyethylene heat shrink tubing would not be suitable for lining a pipe (it is noted that the claim is not limited to lining the interior of a pipe, and hence a tubular film that is

suitable for lining the exterior of a pipe is also covered by claim 4; heat shrink tubing is at least suitable for lining the exterior of a pipe), the disclosed (in fact, known as part of the common general knowledge since A2 is a handbook) heat shrink tube in A2, anticipates claim 4. Claim 4 therefore lacks novelty (Art 52(1), 54(2), 100(a) EPC) over A2.

4.2 Claim 4 lacks novelty over A4 (Art 54(2) EPC)

The remark concerning “suitable for” (see point 4.1.1 above) applies equally. A4 discloses a liner tube (p.15 I.9-10) (considered a tubular film as discussed above, point 1.1), which clearly is suitable for lining a pipe (the whole disclosure of A4 is about lining pipes, see for instance title). The liner tube of A4 consists of a thermally recoverable plastics material, preferably a thermally recoverable polyolefin (p.15 I.10). Hence, A4 discloses all features of claim 4. Claim 4 therefore is not novel (Art 52(1), 54(2), 100(a) EPC) over A4.

5. Claim 5 (independent; eff date 27/11/98)

5.1 Claim 5 is not novel over A4 (Art 54(2) EPC)

5.1.1 Claim 5 relates to a sewer pipe lined with a tubular film, wherein the tubular film is produced using a method according to claim 2. Claim 5 therefore is a product claim, and the limitation “produced using a method according to claim 2” is construed as it is for a “product-by-process” claim, i.e. such that the tubular film is obtainable by a method according to claim 2 (Guidelines C-III,4.7b mutatis mutandis). Since the process features do not cause the product to have different properties, the process features may be ignored (T815/93, T141/93, T205/83). A4 discloses a sewer pipe lined with a tubular film (the inevitable product of the disclosed process in A4; see also Fig. 4 of A4, showing a sewer pipe with a tubular film).

Although the process used in A4 is slightly different from that in claim 2 (see inventive step attack to claim 2 above, point 2.1), it is immediately clear that the resulting product, i.e. the sewer pipe lined with the tubular film is not influenced by the method used to heat the liner tube in the last step, as it was common general knowledge that the effect of blowing hot air through the tubular film (as claimed in claim 2) has the same result as heating with an infrared lamp (as disclosed in A4) (see A2 (handbook), p.9 I.33 for substantiating this; see also inventive step attack to claim 2 (point 2.1 above)).

Therefore, the sewer pipe lined with a tubular film as disclosed in A4 is indistinguishable from the claimed sewer pipe. Hence A4 discloses the subject-matter as claimed in claim

5. Claim 5 therefore lacks novelty (Art 52(1), 54(2), 100(a) EPC) over A4.

6. Claim 6 (independent; eff date 27/11/98)

6.1 Claim 6 is not patentable in view of Art 52(4) EPC

Claim 6 relates to a method for the treatment of the human or animal body by surgery (“implanting into damaged arteries or veins”), and is as such excluded from patentability under Art 52(4) EPC. The use claim is explicitly mentioned as not patentable in G5/83 hn I. Hence, claim 6 is not patentable (Art 52(1), 52(4), 100(a) EPC).

Based on these facts and arguments, it is requested that A1 is revoked in its entirety.