Europäisches Patentamt
Beschwerdekammern

European Patent Office
Boards of Appeal

Office européen des brevets
Chambres de recours

T 146

Case Number: T 21 / 83

DECISION

of the Technical Board of Appeal 3.3.1

of 6 April 1984

Appellant: Gebr. Soepenberg B.V.
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Representative: Van der Beek, George Frans, Ir.
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Decision under appeal: Decision of Examining Division 22 of the European Patent Office dated 30 August 1982 refusing European patent application No 80200556.1 pursuant to Article 97(1) EPC

Composition of the Board:

Chairman: D. Cadman
Member: K. Jahn
Member: L. Gotti Porcinari

SUMMARY OF FACTS AND SUBMISSIONS

I. European Patent appliction No. 80 200 556.1 filed on 13 June 1980 and published on 7 July 1980, claiming the priority from a prior Netherlands application of 14 June 1979, was rejected by a decision of the European Patent Office dated 30 August 1982 on the basis of claim 1 in the published application reading as follows:

"1. A starch product suitable for use in drilling muds obtained by drying the debris recovered from peeling potatoes"

II. The stated ground for the rejection was that since everybody had already seen dried debris of potato peelings and since the indication of use had no limitting effect, the subject-matter of claim 1 was not novel.

III. On 28 October 1982 the appellant lodged an appeal against the abovementioned decision of rejection, followed on 28 December 1982 by a Statement of Grounds, the essence of which was that material claimed in the application had been subjected to a drying process and therefore had a very low water content, which was not the case with the partially dry peelings of the type admittedly seen by many people. New claim 1 was also proposed in the Statement of Grounds whereby it would be restricted to debris dried at a final temperature of at least 100°C.

IV. In a communication, the Board of Appeal pointed out that if drying the peeling debris at elevated tempera-

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ture was essential for the achievement of particular properties in the dried material, then the claims should be limited accordingly. On the other hand, there was no specific support in the specification for "a temperature of at least 100°C."

Also referred to in the communication was SU-A-645 957 (1), which discloses drying the waste from potato starch manufacture and employing it as an additive to drilling mud and which, it was suggested, places the appellants' material and its uses in the state of the art.

V. The appellant contested the arguments in the communication, in particular by the counter-argument that the process described in (1) involved first rasping the whole potato without separating peel and subsequently separating out debris in the course of the manufacture of starch, whereas the debris of the application in suit was that from a peeling process which left the body of the potato intact.

At the same time (4 October 1983) a new set of claims was filed, which reads as follows:

"1. A starch product suitable for using drilling muds, charcterized in that is obtained by drying the debris recovered from peeling potatoes on a stream heated drying roll.

2. The material according to claim 1 characterized in that the debris recovered by peeling potatoes is first fed to a decanter for the removal of the greater part of water and then dried on a drying roll.

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3. The material according to claim 1 or 2, characterised in that it comprises also additives added thereto.

4. The material according to claim 3, characterized in that the material comprises an amount of preservative included therein.

5. The material according to claim 3 or 4 characterised in that the material comprises potassium persulfate, borax and/or magnesium sulfate included therein.

6. A drilling mud characterized by a content of the material accordng to claim 1-5.

7. A method for drilling a shaft characterized by using a material according to claim 1-7.

8. A method for preparing a starch derivative for use in preparing a drilling mud characterized in that the debris obtained by peeling potatoes is roll dried on a steam heated roll at a temperature of at least 100°C and that optionally one or more additives are included therein.

9. The method of claim 8, characterized in that first a large acount of the water is removed from the debris by draining while employing a decanter.

10. The method according to claim 8 or 9, characterised in that a preservative is added.

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inguish the claimed material from fortuitously dry potato peelings.

4. On the finding of lack of novelty by the Examining Division, the Board is of the view that the personal knowledge of the examiner, unsupported by documentary material or evidence of disclosure or use forming part of the state of the art, cannot of itself destroy the novelty of a claim. That is not to say, however, that an examiner may not use his own knowledge and experience when assessing the techical information contained in a document from some other source.

5. The question to be decided, then, is whether the claim 1 in its present form lacks novelty having regard to the state of the art and, in particular, to document (1), which is the most pertinent cited in the search report on the application in suit.

6. Document (1) describes the use of a waste-product from the manufacture of starch from potatoes. The waste-product is dried at a temperature of 150-170°C and is then added to a drilling mud in a quantity of 2-5% by weight. Information is given about the composition of the dried material which shows that its major component is starch, but that it also contains appreciable amounts of cellulose, pectin, pentosane, protein and lignin.

7. Now, it can reasonably be assumed that whatever parts of the original potato are comprised in the waste-product of (1), the skin of the potato must be one of them, and there is thus generated a prima facie case for supposing that the dried material of (1) and the

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dried material of the application in suit are substantially identical. This the appellant denies, but here gets into some difficulty, since his application gives no numerical precision to the chemical composition of the dried potato peeling material. What is said at the top of page 2 of the published document implies that the material contains starch and then goes on to mention as other components proteins, fats, peel fragments, cellulose and fibrous material, a list which does not render convincing the appellant's denial of anticipation by (1), but rather leaves the question open.

8. It would, of course, not be right if an applicant or appellant could successfully rebut a plausible prima facie allegation of anticipation by pleading vagueness and lack of information in his own application. In such a case, the onus passes to the applicant or appellant to produce evidence which demonstrates that the claimed product is not anticipated by the cited document. In the present case, such evidence could take the form of a chemical analysis of the claimed material or, possibly, documentary information which supported the contention that the claimed material and the material described in (1) are different.

9. The conclusion of the Board, therefore, is that further examination of the question of the novelty of claim 1 of the application in suit having regard to the state of the art, and especially to document (1), is necessary, and that such further examination would be appropriately performed by the first instance. The appellant should be aware, however, that even if he successfully establishd the novely of his claimed

material, it would then be necessary to proceed to examine whether or not the invention claimed was obvious, which might again result in the application being refused.

ORDER

It is decided that:

(i) The decision of the Examining Division of the European Patent Office of 30 August 1982 is set aside.

(ii) The application is remitted to the first instance for further prosecution having regard particularly to the state of the art represented by Soviet patent SU-A-645 957.

The Registrar — The Chairman

J. Rückerl — D.L.T. Cadman