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D E C I S I O N
of 8 October 2003

Case Number: T 0305/01 - 3.2.2

Application Number: 92905906.1

Publication Number: 0627014

IPC: C22B 7/04

Language of the proceedings: EN

Title of invention:

Recovery of non-ferrous metals from dross

Patentee:

AGA AKTIEBOLAG, et al

Opponents:

Linde Aktiengesellschaft, Wiesbaden
NORSK HYDRO ASA

Headword:

-

Relevant legal provisions:

EPC Art. 83, 128(4)

EPC R. 93, 67, 76

Keyword:

-

Decisions cited:

-

Catchword:

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Case Number: T 0305/01 - 3.2.2

D E C I S I O N
of the Technical Board of Appeal 3.2.2
of 8 October 2003

Appellant:
(Opponent 2)

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Representative:

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Party as of right:
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Representative:

-

Decision under appeal:

**Interlocutory decision of the Opposition
Division of the European Patent Office posted
18 January 2001 concerning maintenance of
European patent No. 0627014 in amended form.**

Composition of the Board:

Chairman: W. D. Weiß
Members: R. Ries
R. Menapace

Summary of Facts and Submissions

- I. European patent No. 0 627 014 was granted on 2 July 1997 on the basis of European patent application No. 92905906.1 which resulted from international application number PCT/SE92/00111.
- II. The granted patent was opposed by the opponents OI and OII on the grounds that its subject matter lacked novelty (OI) and inventive step (OI, OII) with respect to the state of the art (Article 100(a) EPC and 56 EPC) and that its subject matter was not disclosed in a manner sufficiently clearly and completely to be carried out by a person skilled in the art (OI); (Articles 83, 100(b) EPC).

Opponent OII further objected that it was not allowed file inspection of the applicant's (now proprietor's) letter of 14 March 1994 submitted during the international preliminary examination and cited during the substantive examination of the European patent application.

In the opposition proceedings, six documents were considered.

- III. With its interlocutory decision posted on 18 January 2001 the opposition division held that the patent could be maintained in amended form on the basis of the documents filed on 24 November 2000.

- IV. An appeal against this decision was filed on 13 March 2001 by opponent OII and the fee for appeal paid at the same time. The statement of grounds was submitted on 17 May 2001.
- V. In a letter dated 15 May 2003, opponent OI who is a party as of right, not making any substantial submissions to the case, informed the Appeal Board that it would not attend the oral proceedings which were held on 8 October 2003.
- VI. The appellant (opponent II) requested that the decision under appeal be set aside and the patent revoked in its entirety. Reimbursement of the appeal fee was also requested.

The respondent (patentee) requested that the appeal be dismissed and the patent be maintained on the basis of the set of claims 1 to 7 and an amended description both as filed at the oral proceedings (auxiliary request), and additionally column 4, lines 37 to 40 of the description re-introduced as in the granted version (main request)

- VII. Independent claim 1 reads as follows:

"1. A method of recovering aluminum metal from a dross starting material which forms on the surface of molten aluminium or an aluminium alloy during melting, holding and handling operations and which contains aluminum or an aluminum alloy, said method comprising the steps of introducing the starting material into a rotary furnace or a rotatable converter having a refractory lining, heating the starting materials to a temperature above

the melting point of the aluminum while rotating the furnace continuously or intermittently with a speed of 5 rpm, or lower, and removing the resultant molten aluminum from the overlying residue, wherein the step of heating the starting material is performed in the absence of a protective salt layer with an oxy-fuel-burner which is operated with a fossil fuel and with a gas that contains at least 80% oxygen, wherein the oxy-fuel burner is supplied with fuel and oxygen in stoichiometric relationships, or in a relationship in which oxygen is present in an amount which is at most 20% below the stoichiometric amount, when delivering heat to the furnace burden."

Dependent claims 2 to 7 relate to preferred embodiments of the method of claim 1.

VIII. The arguments put forward by the appellant were as follows:

In a letter of 20 August 1996 (letter A) directed to the examining division of the EPO, the applicant (now patent proprietor-respondent) referred to claims and arguments submitted with its letter of 14 March 1994 filed under the PCT preliminary examination proceedings (letter B). In so doing, letter B has been introduced into the examination proceedings and, consequently, a copy of letter B should have been annexed to the applicant's letter A to be accessible to the public for file inspection. The arguments given in letter B evidently convinced the examining division of the EPO that the claimed subject matter involved an inventive step vis-à-vis the cited prior art so that the objection raised in

the former Official Communication dated 7 June 1996 was waived.

On 31 March 1998, the opponent (now appellant) requested the inspection of letter B and, acting upon the formalities officer's proposal, repeated this request at the oral proceedings before the opposition division which refused the opponent's request. The opposition division notified that the arguments given in letter B of 14 March 1994 did not influence its decision and, consequently, did not adversely affect the opponent's position.

Given that letter B, by its citation, is part of the file of the European patent application and, according to Article 128(4) EPC, files relating to published patent applications and the resulting European patents are accessible to the public, the opposition division's refusal of the opponent's request represents a substantial procedural violation. The request for reimbursement of the appeal fee is therefore justified.

Moreover, the opposition division had given a provisional (negative) opinion on the case in the summons for oral proceedings. Although the claims remained un-amended, the division reversed its position completely at the end of the oral proceedings. However, a justification for this behaviour was not given by the division in the minutes which contravenes what is laid down in the Guidelines E-III,10.2.

Claim 1 of the patent in the version underlying the decision under appeal does not include all the technical features so that the claimed process can be successfully

carried out. In particular, the technical feature stipulating a stoichiometric or sub-stoichiometric combustion of the gases in the oxy-fuel burner which, according to the description column 3, lines 3 to 15, represents a key feature is missing. Moreover, despite the excluded part of the description, the technical term "dross" still can be interpreted to mean dross alone or dross mixed with scrap which makes it difficult to distinguish the claimed subject matter from the prior art. The requirements of Article 83 EPC are, therefore, not met.

IX. The respondent argued as follows:

The contents of letter B did not influence at all the outcome of the substantive examination of the application by the examining division and, consequently, could not have adversely affected the opponent's position. Hence, the fact that the opponent had not access to letter B did not constitute a procedural violation.

Contrary to the opponent's contention, the patent as granted was amended and a new (main and single) request was submitted during the oral proceedings before the opposition division, that request comprising a restriction of the description in order to make it clear that dross is the only starting material. The request and the patentee's comments thereto, clearly reflected in the minutes, overcame the division's preliminary objections, so that the Guidelines E-III,10.2, therefore, were complied with.

The appellant did not object to the inventive merit of the claimed process as now amended vis-à-vis the cited six prior art documents. Hence, it was unchallenged that the claimed subject matter involves an inventive step.

Reasons for the Decision

1. The appeal is admissible.

2. *Main request, amendments:*

The patentee's main request resides in re-introducing the text of column 4, lines 37 to 45 of the description which was deleted during the opposition proceedings.

As the patentee itself did not appeal against the interlocutory decision of the opposition division, he is not allowed to return to the description of the patent in the form as granted, because in the present case the resulting amendment would result in a *reformatio in peius* of the opponent's position.

Hence, the patentee's main request must fail.

3. *Auxiliary request, amendments:*

Amended claim 1 originates from a combination of claims 1 and 5 as granted. This amendment represents an admissible limitation satisfying the requirements of Articles 123(2) and (3) EPC. It is also a necessary restriction to claim 1 with respect to the requirements of Article 83 EPC since providing a stoichiometric or

sub-stoichiometric combustion regimen by the oxy-fuel burner is an indispensable technical feature to successfully carry out the claimed process, i.e. to avoid or minimize the oxidation of Al or Al-alloy metal separated from the dross in the rotary furnace (cf. the specification column 3, lines 10 to 15).

Moreover and in order to prevent any misinterpretation, claim 1 includes the technical statement that the term "dross" does not mean "scrap" or "dross mixed with scrap" but specifies a material which forms on the surface of molten aluminium or aluminium alloy during melting, holding and handling operations. This statement fully complies with the skilled person's understanding of the technical term "dross", as set out in document D2, page 1, lines 4 and 5.

The description has been suitably adapted to the revised wording of claim 1.

The amendments to the claims and the description, therefore, satisfy the requirements of Articles 83, 84, 123(2) and 123(3) EPC. The appellant-opponent did not object to these amendments.

4. *Novelty and inventive step:*

In its written statement of the grounds of appeal, the appellant did not submit any arguments with respect to novelty and inventive of the claimed process vis-à-vis the methods disclosed in the prior art cited during the opposition. At the oral proceedings before the Board, novelty and inventive step of the subject matter as amended during the oral proceedings were expressly

acknowledged by the appellant. The Board, having scrutinized the technical contents of the six documents considered in the decision under appeal, has no reason to challenge the appellant's evaluation in this respect. Novelty and inventive step of the claimed subject matter are, therefore, given for the purposes of the present decision.

5. *Procedural matter; reimbursement of the appeal fee:*

The appellant's request for inspecting letter B is based on Article 128 EPC in conjunction with Rule 93 EPC and on the fact that letter B of 14 March 1994 was mentioned in the Official communication dated 7 June 1996 by the examining division.

5.1 The appellant's assumption that letter B has become part of the file of the European patent application is, however, not correct. In the Official communication of 7 June 1996, (cf. page 1, third paragraph: claims) letter B was referred to merely to identify in the usual manner the version of claims under consideration that were enclosed with the said letter. In its official communication the examining division did, however, not comment on the arguments submitted with letter B.

5.2 The appellant further submitted that the applicant itself, in its reply of 20 August 1996 to the official communication, also referred to the claims and arguments submitted with letter B and that for this reasons letter B forms part of the European patent application.

5.3 As correctly pointed out in the notice of appeal, the examining division has not been allowed to transfer a letter (or copy thereof) from the PCT-file to the file of the European patent application, following correctly Rule 94(1) PCT as in force before 1 July 1998.

A formally correct conduct of the examination proceedings might have required it, for the sake of completeness of the file, to ask the applicant who had not enclosed a copy of letter with its reply of 20 August 1996 to submit a copy of that letter.

Under these circumstances it may well be that the file of the European patent application under consideration possibly does not disclose all the reasons which motivated the examining division to grant the patent. The EPC, however, does not prescribe such a disclosure. The decision to grant is taken by the examining division according to the members' final opinions which are normally (but not necessarily) given in the form of internal written statements and are not open to the public by file inspection. This has the consequence that third parties including a (prospective) opponent have no right to know the reasoning which led the examining division to grant the patent, such right being also in conflict with confidentiality of deliberation.

It is not uncommon that the file of a European patent application does not contain any discussion at all on the patentability of the subject matter, e.g. when the examining division "directly" granted a patent without prior official communication. Therefore, the appellant could not have been adversely affected by its ignorance

of the arguments submitted with the applicant's letter B, even if the examining division actually had taken into consideration these arguments in its internal votum for granting the patent. Moreover, there is no need for an opponent to refute the applicant's arguments in support of the grant of a patent, unless these arguments are relied upon again in the following opposition proceedings or in the decision under appeal.

- 5.4 The appellant has also referred to the Guidelines E-III,10.2 arguing that at the oral proceedings, the opposition division neither orally nor in the minutes gave any specific reasons for the change of division's former (negative) position.

However, the minutes contain the essentials of the oral proceedings including the statements of the parties and the patentee's responses to the questions by the opposition division, prompting the proprietor to submit "a new and single main request" at the oral proceedings (cf. the minutes, page 3, second paragraph). In the second full paragraph on page 4 and under point 3, the minutes reflect the division's opinion comprising a short statement of why patentability was held to be given and that the applicant's arguments submitted with letter B filed during the international preliminary examination proceedings were not considered relevant to the opposition proceedings.

The minutes of the oral proceedings before the opposition division, therefore, satisfy the requirements of Rule 76 EPC and are in line with the provisions laid down in the Guidelines Chapter E III-10.2.

- 5.5 As a consequence, a substantial procedural violation within the meaning of Rule 67 EPC did not occur in the case at hand and the appellant's request for reimbursement of the appeal fee has to be rejected.

Order

For these reasons it is decided that:

1. The decision under appeal is set aside.
2. The case is remitted to the first instance with the order to maintain the patent in amended form on the basis of the claims 1 to 7 and the description columns 1 to 4 both as filed at the oral proceedings and the figure as granted.
3. The request for refund of the appeal fee is rejected.

The Registrar:

The Chairman:

V. Commare

W. D. Weiß