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D E C I S I O N
of 29 October 2003

Case Number: T 0701/01 - 3.3.5

Application Number: 93118220.8

Publication Number: 0598321

IPC: C01B 13/02

Language of the proceedings: EN

Title of invention:

Adsorption Process with mixed repressurization and
purge/equalization

Applicant:

AIR PRODUCTS AND CHEMICALS, INC.

Opponent:

-

Headword:

Adsorption/AIR PRODUCTS

Relevant legal provisions:

EPC Art. 113(2), 111(1)
EPC R. 67

Keyword:

"Substantial procedural violation, decision not based on the
valid claims on file"

Decisions cited:

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Catchword:

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Case Number: T 0701/01 - 3.3.5

D E C I S I O N
of the Technical Board of Appeal 3.3.5
of 29 October 2003

Appellant: AIR PRODUCTS AND CHEMICALS, INC.
P.O. Box 538
Allentown, PA 18195-1501 (US)

Representative: Marx, Lothar, Dr.
Patentanwälte Schwabe, Sandmair, Marx
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Decision under appeal: Decision of the Examining Division of the
European Patent Office posted 1 February 2001
refusing European application No. 93118220.8
pursuant to Article 97(1) EPC.

Composition of the Board:

Chairman: R. K. Spangenberg
Members: G. J. Wassenaar
H. Preglau

Summary of Facts and Submissions

- I. European patent application No. 93 118 220.8, publication number 0 598 321, filed on 10 November 1993 with claims 1 to 45, was refused by a decision of the Examining Division dated 1 February 2001.
- II. In a communication dated 8 January 1996, the Examining Division informed the appellant that the application did not meet the requirements of the EPC. With a letter dated 8 May 1996 the appellant filed new claims 16 and 29. With communications dated 16 December 1996 and 22 December 1997 the Examining Division informed the appellant again that the application did not meet the requirements of the EPC. In the last communication the appellant was required to remedy the deficiencies indicated therein within a period of 4 months. With a letter dated 14 April 1998, received in the office on the same day, the appellant requested an extension of 2 months for the reply. By letter dated 21 April 1998 an extension of the time limit for the reply of 2 months was given by the Examining Division to a total of 6 months. With a letter dated 22 June 1998, received in the office on the same day, the appellant filed a response to the communication dated 22 December 1997 together with a new claim 1 and amendments to the description. With a letter dated 24 March 2000 the appellant requested oral proceedings. With a letter dated 4 December 2000 the request for oral proceedings was withdrawn and an appealable decision was requested on the basis of the current state of the file.

III. A decision to refuse the application, dated 1 February 2001, was dispatched. The grounds for the decision read as follows:

"In the communication(s) dated 08.01.1996, 16.12.1996, 22.12.1997 the applicant was informed that the application does not meet the requirements of the European Patent Convention. The applicant was also informed of the reasons therein.

The applicant filed no comments or amendments in reply to the latest communication but requested a decision based on the state of file by a letter received in due time on 04.12.2000.

The application must therefore be refused."

IV. The appellant lodged an appeal against this decision. In the letter setting out the grounds of the appeal the appellant indicated that attached to this letter there were three copies of new application documents, namely new description pages 1 to 21 and a new set of claims 1 to 45. No such copies were, however, received, or anyhow were not present in the file. After a telephone conversation with the registrar the missing copies were filed with the letter dated 12 November 2002 and received on the same day.

V. In a communication of the Board it was indicated that the Board intended to remit the case to the Examining Division for further prosecution and the appellant was asked whether in the given situation the conditional request for oral proceedings if a patent could not be granted in the written proceedings, was maintained. With the letter dated 9 October 2003 the appellant replied that the request for oral proceedings was not

maintained if the case was to be remitted to the Examining Division.

- VI. The appellant requested that the decision to refuse the application be revoked and a European patent be granted on the basis of the amended application documents as filed with the letter dated 12 November 2002.

Reasons for the Decision

1. The appeal is admissible.

2. It follows from point II above that the claims on file when the contested decision was issued were claim 1, filed with the letter dated 22 June 1998, claims 2 to 15, 17 to 28 and 30 to 45 as originally filed, and claims 16 and 29 filed with the letter dated 8 May 1996. In the decision under appeal no reference is made to amended claim 1 filed with the letter dated 22 June 1998. The decision under appeal, therefore, was not based on the text submitted by the appellant and thus violates the requirements of Article 113(2) EPC. The decision is also factually incorrect in that it indicates that the applicant filed no comments or amendments in reply to the communication dated 22 December 1997, whereas with the letter dated 22 June 1998 the applicant did file comments and amendments in reply to the communication dated 22 December 1997. The said violation of Article 113(2) EPC is a substantial procedural violation within the meaning of Rule 67 EPC. Although reimbursement of appeal fee has not been requested the Board deems a reimbursement of the appeal fee equitable in this case.

3. The Board has noticed that the essential amendment in present claim 1 is the same as in claim 1 submitted with the letter dated 22 June 1998, ie that in process step (e) ambient pressure feed gas is used for repressurizing the regenerated adsorption bed. Said feature, which was present in original claim 3, was not discussed in the communications of the Examining Division. Repressurization by ambient pressure feed gas seems to be a feature which is relevant for the issue of inventive step. Since this feature was present in the claims on file before the Examining Division but not taken into consideration in the contested decision, the Board holds that the examination by the first instance was incomplete and deems it appropriate to exercise its power under Article 111(1) EPC to remit the case to the Examining 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 Examining Division for further prosecution.
3. The appeal fee is reimbursed.

The Registrar:

The Chairman:

U. Bultmann

R. Spangenberg