

Internal distribution code:

- (A) Publication in OJ
(B) To Chairmen and Members
(C) To Chairmen
(D) No distribution

**Datasheet for the decision
of 3 August 2006**

Case Number: T 0781/03 - 3.3.09

Application Number: 97942502.2

Publication Number: 0927220

IPC: C08J 11/06

Language of the proceedings: EN

Title of invention:

Methods of recycling and compositions used therein

Applicant:

PPG INDUSTRIES OHIO, INC.

Opponent:

-

Headword:

-

Relevant legal provisions:

EPC Art. 84, 123(2), 111(1)

Keyword:

"Clarity (yes) - after amendments"
"Remittal for further prosecution"

Decisions cited:

-

Catchword:

-



Case Number: T 0781/03 - 3.3.09

D E C I S I O N
of the Technical Board of Appeal 3.3.09
of 3 August 2006

Appellant: PPG Industries Ohio, Inc.
3800 West 143rd Street
Cleveland, OH 44111 (US)

Representative: Sternagel, Fleischer, Godemeyer & Partner
Braunsberger Feld 29
D-51429 Bergisch Gladbach (DE)

Decision under appeal: Decision of the Examining Division of the
European Patent Office posted 7 February 2003
refusing European application No. 97942502.2
pursuant to Article 97(1) EPC.

Composition of the Board:

Chairman: P. Kitzmantel
Members: A. T. Liu
M. Tardo-Dino

Summary of Facts and Submissions

- I. The European patent application 97 942 502.2, published under the PCT with the International application number WO 98/12249, was refused on the ground of lack of clarity by the decision of the Examining Division, despatched on 7 February 2003.
- II. A notice of appeal was lodged by the applicant on 28 March 2003. With the Statement of grounds of appeal of 11 June 2003, the appellant submitted that the decision of the examining division had been taken in violation of the appellant's right to be heard. It was requested that the appeal fee be reimbursed accordingly (main request). In addition, it was requested that the decision under appeal be set aside and a patent be granted on the basis of the claims that were considered in the impugned decision (first auxiliary request) or on the basis of the set of Claims 1 to 15 newly filed with the Statement of the grounds of appeal (second auxiliary request).
- III. In an annex to the summons to oral proceedings, the board expressed its preliminary opinion in respect of the appellant's requests. In particular, it indicated that it was inclined to share the examining division's point of view that the appellant had been heard on the lack of clarity issue which formed the basis of the impugned decision. The board also observed that it would in all likelihood follow the examining division on the finding of lack of clarity.

Further, the board remarked that, should the main request and the first auxiliary request be refused, the

case should be remitted to the examining division for further prosecution on the basis of the claims according to the second auxiliary request.

IV. In the reply to the summons dated 4 July 2006, the appellant submitted, as its new main request, that the prosecution of the application be carried on with a set of Claims 1 to 15 attached to the letter, which claims essentially corresponded to Claims 1 to 15 of the previously termed second auxiliary request. This request was confirmed in a subsequent letter dated 24 July 2006. The previous main request for reimbursement of appeal fee was not mentioned in these submissions, nor in any other response of the appellant by way of reply to the annex to the summons to oral proceedings.

V. Claim 1 of the operative main request reads as follow:

"A composition comprising

- (i) greater than 60% by weight of water;
- (ii) at least one lifting agent selected from anionic, cationic, nonionic and amphoteric surfactants; and
- (iii) at least one accelerator selected from the group consisting of glycol ethers, glycol ether acetates, alkylene carbonates, glycerine, lactones and substituted lactones, pyrrolidones and substituted pyrrolidones, furan compounds and mixtures of two or more thereof,

characterized in that,

the composition comprises additionally (iv) at least one basic or acidic compound, wherein when the at least one basic compound is present, the composition has a pH greater than 7.5."

VI. In a communication dated 20 July 2006, the appellant was informed of the cancellation of the oral proceedings appointed for 6 September 2006.

VII. The appellant final requests were thus as follows:

- that the decision under appeal be set aside and a patent be granted on the basis of Claims 1 to 15 as filed by letter dated 4 July 2006 (main request), or alternatively
- that oral proceedings be arranged (auxiliary request).

Reasons for the Decision

1. *Amendments, Article 123(2) EPC*

Claim 1 as amended is essentially based on Claim 20 as originally filed, with the difference that it contains the additional features regarding:

- (i) the water concentration ("greater than 60% by weight"),

- (ii) the lifting agents ("to be selected from ... surfactants"),
- (iii) the accelerators ("selected from the group consisting of ... furan compounds and mixtures of two or more thereof"), and
- (iv) the pH of the composition ("when the at least one basic compound is present, the composition has a pH greater than 7.5").

These additional features are taken from the following statements in the application as originally filed:

(i) page 11, lines 5 to 7; (ii) page 14, lines 24 to 26; (iii) Claim 25, and (iv) page 11, lines 19 to 20. Since these features were originally disclosed in the general context of the application, their incorporation into the subject-matter of original Claim 20 is allowable under the terms of Article 123(2) EPC.

2. *Clarity, Article 84 EPC.*

2.1 Claim 1, on which the decision under appeal is based, only refers to "a major amount" of water comprised in the composition (see decision, item II-1). In contrast, this amount is now clearly defined as being "greater than 60 % by weight".

2.2 Likewise, the expressions "lifting agents" and "accelerators", which were found not to have an accepted meaning in the art (see decision, item II-2), are now defined in Claim 1 by the corresponding list of compounds to choose from (see item V above).

As a result of the amendments, the objections of lack of clarity previously raised against the wording of Claim 1 no longer apply to present Claim 1.

3. *Remittal to the first instance, Article 111(1) EPC.*

As already observed in the communication annexed to the summons to oral proceedings, the present set of claims was presented for the first time at the appeal stage. In order to safeguard the applicant's right to appeal to a department of second instance, the board, exercising its discretion under Article 111(1) EPC, decides to remit the case to the examining division for further prosecution.

The board is well aware of the appellant's auxiliary request for oral proceedings. As clearly indicated in the letter dated 24 July 2006, however, this request would only come into effect if the board were not prepared to grant a patent on the basis of present claims. As the Board does not intend to deal with the main request any further on this appeal, it is to the examining division that the appellant will have to put its case. In consequence, the holding of oral proceedings at the present stage would not be useful. Since the appellant still has the opportunity to present its comments to the examining division, the remittal to that department of the first instance without the appellant having been heard by the board does not contravene the requirements of Article 113(1) EPC. This is in fact in agreement with the appellant's reply to the board's communication (see letter of 4 July 2006: page 1, last paragraph to page 2, first paragraph).

To avoid any misunderstanding, the board wishes to point out that, unless the auxiliary request for oral proceedings is expressly withdrawn by the appellant, it remains pending and applicable to the prosecution of the application before the examining division.

4. *Reimbursement of appeal fee*

In the Statement of the grounds of appeal, the appellant requested, as the main request, that the appeal fee be reimbursed, the reason given being that the decision of the examining division was allegedly taken in violation of the appellant's right to be heard. However, in the communication annexed to the summons to oral proceedings, the board pointed out that in the process leading up to the impugned decision the appellant had been duly heard on the question of lack of clarity (see annex, item 2 and decision under appeal, item 2). This was not contested by the appellant in its later submissions. Instead, the appellant, without commenting further on this issue, submitted a new main request in reply to the communication (see items IV and VII above). Thus, the position has moved on since the request for reimbursement of the appeal fee was originally made. The board therefore concludes that this request is no longer pending.

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 on the basis of Claims 1 to 15 filed by letter of 4 July 2006.

The Registrar

The Chairman

G. Röhn

P. Kitzmantel