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**Datasheet for the decision
of 17 April 2007**

Case Number: T 1155/03 - 3.3.05

Application Number: 99112549.3

Publication Number: 0968980

IPC: C05C 9/02

Language of the proceedings: EN

Title of invention:

Microgranular fertiliser composition for local application
during sowing or transplanting

Applicant:

Agroqualita S.r.l.

Opponent:

-

Headword:

-

Relevant legal provisions:

EPC Art. 84
EPC R. 67, 45

Keyword:

"Broad claims, lack of support (no)"

Decisions cited:

T 0939/92, T 0409/91, T 0367/91, T 0680/89, T 0332/94,
T 0659/93

Catchword:

-



Case Number: T 1155/03 - 3.3.05

D E C I S I O N
of the Technical Board of Appeal 3.3.05
of 17 April 2007

Appellant: Agroqualita S.r.l.
Via Sempione, 195
I-20016 Pero (MI) (IT)

Representative: Gislon, Gabriele
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Decision under appeal: Decision of the Examining Division of the
European Patent Office posted 31 March 2003
refusing European application No. 99112549.3
pursuant to Article 97(1) EPC.

Composition of the Board:

Chairman: M. Eberhard
Members: H. Engl
J. Willems

Summary of Facts and Submissions

- I. This appeal is directed against the decision of the examining division posted on 31 March 2003 refusing European patent application EP99112549.3. The decision was based on the objections that claim 1 of both the main request and the auxiliary request filed during the oral proceedings lacked support by the description, contrary to Article 84 EPC, and were not commensurate with the description and the contribution to the art it provided.
- II. The applicant (henceforth: the appellant) filed an appeal against this decision; the grounds of appeal, accompanied by amended claims in accordance with a main and an auxiliary request, were received on 5 August 2003.
- III. In a first communication issued by the board (in a different composition) on 8 October 2004, the objection under Article 84 EPC was maintained against said amended claims 1 (main and auxiliary requests) filed with the grounds of appeal. The claims were also considered to lack inventive step, having regard to documents D3: Derwent abstract AN 97-294755 & JP A 9 110 564 and D4: US A 5 021 247.
- IV. In reply thereto, the appellant filed with letter of 18 April 2005 two sets of amended claims in accordance with a main and an auxiliary request.
- V. A further communication was issued on 28 February 2006, wherein the board provisionally accepted that the new claims met the requirement of support by the

description set out in Article 84 EPC and announced its intention to remit the case to the department of the first instance for further search and examination.

VI. In response thereto, in the letter dated 13 June 2006, the appellant withdrew an earlier request for oral proceedings, but maintained his earlier request for reimbursement of the appeal fee on grounds of substantial procedural violations. The appellant additionally criticized that the examining division had not properly applied decision T 939/92, but had instead relied on the Guidelines for Examination.

VII. In reply to a third communication of the board the appellant submitted with its letter dated 26 March 2007 new sets of claims in accordance with a main and an auxiliary request, replacing the claims of the earlier requests.

Independent claims 1 and 15 of this main request read as follows:

"1. A fertilizer composition, in the form of granules for localized application during sowing or transplanting of agricultural crops, comprising an organic nitrogenous compound of natural origin and an inorganic phosphate or phospho - nitrogen compound, characterized in that said granules have a size between 0.1 and 1.5 mm and the granules average diameter is between 0.5 and 1.0 mm."

"15. Use of a composition according to any previous claim during sowing or transplanting of plant and tree

crops for localized application along sowing or transplanting rows."

VIII. The arguments of the appellant may be summarized as follows:

With respect to the objection under Article 84 EPC:

The appellant argued that the claimed invention related to a new physical form of known fertilizer compositions comprising an organic nitrogenous fertilizer of natural origin and a phosphate or phospho - nitrogen compound, which compositions were characterized by physical features of the granules, *i.e.* their minimum and maximum size and their average diameter. These essential features of the invention were clearly recited in the independent claims. In the appellant's submission, the claimed combination of features was responsible for the advantageous results obtained in accordance with the invention and illustrated in test reports 1 to 5 filed during appeal procedure.

Therefore, the claims would encompass no more than the effective contribution of the invention to the art. The examining division's objection was mainly that claim 1 was too broad in view of the examples provided in the description; however, such an objection should be raised and treated under Article 56 EPC rather than Article 84 EPC, in view of decision T 939/92 (point 2.2.2. of the reasons).

With respect to the alleged occurrence of a substantial procedural violation:

The appellant firstly argued that the examining division refused to discuss novelty and inventive step at the oral proceedings. The examining division did not avail itself of the possibility of hearing the two inventors and a technical expert present at the oral proceedings on the questions of novelty and inventive step. For reasons of equity, the appeal fee should therefore be reimbursed. Secondly, the appellant complained that issues of Article 83 EPC were discussed at the oral proceedings, although not announced in the summons. The examining division refused to hear and consider declarations offered by the appellant in this regard. In the letter dated 13 June 2006, the appellant thirdly criticized that the examining division did not properly apply the relevant case law, namely decision T 939/92, but instead appeared to have relied on the Guidelines for Examination, allegedly saying that Article 83 EPC and Article 84 EPC were interchangeable. In rejecting the reasoning of a board of appeal decision, the examining division had committed a substantial procedural violation.

- IX. The appellant requests that the decision of the first instance be set aside and a patent be granted on the basis of claims 1 - 15 of the main request or alternatively on the basis of the claims 1 - 15 according to the auxiliary request, both filed with letter of 26 March 2007; the appellant furthermore requests reimbursement of the appeal fee.

Reasons for the Decision

1. *Amendments (main request)*
 - 1.1 Amended claim 1 is based on claims 1 and 2 of the originally filed version. Additionally, the feature concerning the presence of a slow - release organic nitrogenous substance produced by synthesis (present in original claim 1) has been omitted from the current claim. A basis for this is provided at page 3, second sentence, of the description as originally filed, where it is made clear that the organic nitrogenous substance of natural origin and the slow - release organic nitrogenous substance produced by synthesis can be used **individually** or in combination. The broadening of claim 1, compared with its originally filed version, does not, therefore, contravene Article 123(2) EPC.
 - 1.2 The average diameter of the granules of between 0.5 and 1.0 mm is disclosed on page 3, lines 11 - 12 of the description as originally filed. The feature "*phosphate and phospho - nitrogen compounds of inorganic origin*" is disclosed on page 2, lines 23 - 30, in combination with page 4, lines 27, 28. The additional presence in claim 2 of a slow - release organic nitrogenous compound produced by synthesis finds a basis in claim 1 as originally filed. Dependent claims 3 - 9 correspond to claims 3 - 9 as originally filed. Claim 10 is based on the description, page 5, lines 19 - 24. Claim 11 is based on the description, page 5, line 25 to page 6, line 14. Claims 12 and 13 are derived from the description, page 6, lines 15 - 18, and from original claim 12. The specific "*microorganisms*" and "*mixtures thereof*" recited in claim 13 are based on the original

disclosure of claims 11 and 12. Claim 14 is based on the description, page 6, lines 19 - 25. Amended claim 15 is based on original claim 19 and the description, page 9, lines 21 - 23.

2. *Objections under Article 84 EPC (main request)*

2.1 The contested decision invokes Article 84 EPC, namely lack of support of the claims by the description, mainly on the ground that the claims are not commensurate with the description and the contribution to the art it provides (see decision, page 5, third paragraph; page 6, second paragraph).

In the contested decision, it is observed that "*claim 1 is directed to **all** organic nitrogenous fertiliser compounds of natural origin and **all** phosphates or phospho - nitrogen compounds that are suitable for use in a fertiliser composition*". The examining division therefore recognized an "*unlimited number of possibilities that are covered by the claim*". It was further noted that in the description only one combination of organic nitrogenous fertilizer compound of natural origin and phosphate or phospho - nitrogen fertiliser compound was exemplified, namely the combination of dried blood as organic nitrogenous fertilizer compound and ammonium hydrogen phosphate as phospho - nitrogen fertilizer compound. However, the examining division acknowledged that the description provided lists of preferred organic fertilizer compounds (page 3, lines 27 - 30) and of the phosphate and phospho - nitrogen compounds (page 4, line 27 - page 5, line 5).

2.2 The board is satisfied that the description does not present any essential features which are not adequately reflected in the independent claims. *Vice versa*, the independent claims contain all the features presented as essential in the description. In fact, the description, page 2, last paragraph, defines the invention in general terms by its essential characteristics, *i.e.* the synergistic association of a selected organic fraction with an inorganic fraction, and the formulation of the fertilizer in the form of granules having smaller dimensions than in the prior art, namely dimensions ranging between 0.1 and 1.5 mm. The nature of the organic fraction is explained in more detail at page 3, first paragraph, disclosing that it can be either an organic nitrogenous substance of natural origin and/or a slow - release organic nitrogenous substance. The inorganic fraction is defined in the fourth paragraph of page 1 as being a phosphate or phospho - nitrogen compound. These features are accordingly stated in amended claim 1 which furthermore indicates the granule average diameter in addition to their dimensions (0.1 to 0.5 mm).

The description discloses a list of organic nitrogenous compounds of natural origin and a list of inorganic phosphate and phospho - nitrogen compounds. In particular, the organic nitrogenous compounds of natural origin listed at page 3, lines 27 - 30 are clearly indicated as being "*particularly suitable*". Therefore, said list is not presented as exhaustive. Regarding the phosphate and phospho - nitrogen compounds recited at page 4, line 27, to page 5, line 5, it can be inferred from the use of the words

"may" and "such as" that other compounds may also be suitable.

The specific organic nitrogen substances of natural origin and the specific phosphate or phospho - nitrogen compounds are also listed in the dependent claims 3, 7 and 8 of the application as filed, thus confirming what can be unambiguously derived from the description, *i.e.* that they are preferred embodiments.

Thus contrary to the statement in point 6, third paragraph, of the contested decision, it cannot be inferred from the description that only "*dried blood and similar substances*" would - in combination with the granule size and suitable inorganic phosphate or phospho - nitrogen compounds - correspond to the technical contribution to the art.

It was criticized in the contested decision that the independent claims do not define the amounts of the two components of the fertilizer composition. However, the application as filed does not present this feature as an essential characteristic since the suitable amounts of the components are not mentioned at all in the claims as filed, contrary to the granule size which is recited in claim 1 and, according to the description, page 5, second paragraph, the total nitrogen and the phosphoric anhydride "*may vary*" within certain ranges, this wording suggesting that these features are not compulsory.

- 2.3 It is true that one can have doubts as to whether all embodiments of the broad claims solve the problems of the prior art set out in the description, page 1,

line 21 - page 2, line 18). In particular, it appears that the application seeks to address the problem of localized application of fertilizer in reduced quantities (*cf.* page 10, lines 5 - 15). However, the question of whether or not this problem is indeed solved by all embodiments of the claimed composition or, in other words, whether or not the corresponding technical effect is achieved by all embodiments of claim 1, may be dealt with when assessing inventive step. As the said technical effect is not part of the fertilizer definition given in claim 1, an objection of lack of support by the description cannot properly be raised for this sole reason (see T 939/92, OJ EPO, 1996, 309, Headnote I and Reasons, points 2.2.2 and 2.2.3).

2.4 The present case differs from the situation in T 409/91 (cited in the contested decision). In the said case, it was precisely the essential feature of the presence of an additive that was missing in the independent claims (see Reasons, points 3.2 to 3.4). In T 409/91, the description disclosed the use of additives for obtaining the desired size of wax crystals which was stated in claim 1. Since said additives were not recited in claim 1, the requirements of Article 84 EPC were not met. In contrast, in amended claim 1 of the present application all of the essential elements, including the desired particle size, are present.

2.5 The examining division has argued that claim 1 lacked support under Article 84 EPC because it did not define the effective contribution of the invention over the art (*cf.* decision under appeal, Reasons, point 7, third paragraph). In this context, the examining division referred to decisions T 332/94 and T 659/93 and

concluded that not only claim 1 lacked support, but also that the invention could not be performed over the whole range claimed, an objection which could be seen as an objection under Article 83 EPC (contested decision, page 8, third paragraph).

In the contested decision, page 7, last paragraph, the examining division defined the technical contribution to the art of the invention as "*the provision of granules having a size between 0.1 and 1.5 mm and the granules having an average diameter of 0.5 to 1.0 mm of dried blood and similar substances in combination with suitable inorganic phosphate or phospho - nitrogen compounds*". The board notes that the granule size and the granule average diameter are correctly recited in amended claim 1, as well as the presence of inorganic phosphate or phospho - nitrogen compounds. Furthermore, as already pointed out above (see point 2.2.), it cannot be derived from the application as filed that "*dried blood and similar substances*" are mandatory components of the fertiliser composition. The board observes in this context that the decision gives no clear reasons as to why the said specific substances were considered "*to correspond to the technical contribution to the art*" in combination with the features already stated in claim 1, *i.e.*, the inorganic phosphate or phospho - nitrogen compounds and the granule size and average diameter.

As regards Article 83 EPC, no proper reasons are given for this objection, and the contested decision goes immediately on in repeating the Article 84 EPC objections (lack of support). It seems from page 9, first paragraph, of the contested decision that the

examining division merely wished to make the point that the issues of Articles 84 and 83 EPC can often both be raised, as stated in the Guidelines (C-III 4.6., erroneously cited as C-IV 6.4. in the decision). In substance, however, the examining division did not base its decision on Article 83 EPC, but on the requirement of support by the description pursuant to Article 84 EPC.

2.6 In conclusion from the above, the board considers that the claims cannot be said to be broader than justified by the description and hence not adequately supported. The claims of the main request therefore meet the requirements of Article 84 EPC.

2.7 In view of this there is no need to consider the claims of the auxiliary request.

3. *Incomplete search*

The board notes that only an incomplete search under Rule 45 EPC has been carried out by the search department. In view of the fact that the claims now on file in accordance with the main request deviate in scope from the partially searched ones, in particular in that the presence of a slow release organic nitrogenous substance is not mandatory, the board cannot examine these claims as to their substance. It is thus necessary to remit the case to the department of the first instance for a further (supplementary) search.

4. *Reimbursement of the appeal fee*

The appellant has requested a refund of the appeal fee because of alleged substantial procedural violations in the proceedings before the first instance.

- 4.1 The appellant firstly argued that the examining division refused to discuss novelty and inventive step at the oral proceedings. However, the examining division had no such obligation in view of its finding that the application did not comply with the requirements of Article 84 EPC, even if it was announced in the summons that issues of novelty and inventive step would be discussed. The board points to the fact that an objection under Article 84 EPC was already raised in the examining division's communications dated 26 June 2001 and 27 May 2002 and maintained in the summons for oral proceedings. It could not have come as a surprise to the appellant that this question would be a decisive issue at the oral proceedings. The fact that the appellant's representative was accompanied at the oral proceedings by two inventors and a technical expert does not *per se* warrant that all of these persons must be heard on all questions.

A second point of the appellant's complaint was that issues of Article 83 EPC were discussed at the oral proceedings, although not announced in the summons. The examining division allegedly refused to hear and consider declarations offered by the appellant in this regard. However, the sole ground for refusal of the application was Article 84 EPC (lack of support). According to the Minutes of the oral proceedings, which

were not contested by the appellant, it was the appellant and not the examining division who briefly touched the issue of Article 83 EPC (see Minutes, page 2, paragraph 4). In any event, the appellant did not request a postponement of the hearing in order to prepare himself for a debate of Article 83 EPC, nor did he submit other requests which were unduly rejected by the examining division.

In the letter dated 13 June 2006, the appellant furthermore criticised that the examining division did not take into account decision T 939/92 cited by the appellant, but instead relied on the Guidelines for Examination allegedly saying that Article 83 EPC and Article 84 EPC are interchangeable. The appellant saw a substantial procedural violation in rejecting the reasoning of a decision by the board of appeal on the basis of the Guidelines.

The board observes that the examining division did not take its decision only on the basis of the Guidelines but also considered the case law. It can be derived from the appealed decision that it took into consideration the following decisions: T 409/91, T 939/92, T 332/94 and T 659/93, which were expressly cited in points 6 and 7 of the decision, as well as the Guidelines (point 8). The fact that, on the basis of the Guidelines and of this case law, the examining division came to a conclusion different from that of the present board or of the board in case T 939/92 does not mean that a substantial procedural violation had occurred. It is noted in this respect that the examining division was not bound by the *ratio decidendi* of the said decisions and that the circumstances of the

present case are not identical to those of case T 939/92, an effect of the composition (fertilizer) being stated in claim 1. Even if the assessment of the claimed invention by the examining division was wrong, a decision based on a wrong assessment must be regarded as a substantive mistake, but not as a substantial procedural violation (see T 367/91 of 14 December 1992, Reasons, point 7; and T 680/89 of 8 May 1990, Reasons, point 6).

The board therefore cannot recognize a procedural violation in the instant case at all, and is by no means convinced that a **substantial** procedural violation has occurred.

- 4.2 In accordance with Rule 67 EPC, the board shall order a reimbursement of appeal fees, if the appeal is allowed **and** if such reimbursement is equitable by reason of a substantial procedural violation. For the reasons given above, a substantial procedural violation which would call for a reimbursement for reasons of equity, has not taken place.

Order

For these reasons it is decided that:

1. The decision under appeal is set aside.
2. The case is remitted to the department of the first instance for further prosecution.
3. The request for reimbursement of the appeal fee is refused.

The Registrar:

The Chairman:

C. Vodz

M. Eberhard