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**Datasheet for the decision
of 16 January 2008**

Case Number: T 1629/06 - 3.3.06

Application Number: 00911691.4

Publication Number: 1177269

IPC: C10G 75/00

Language of the proceedings: EN

Title of invention:

Method of removing contaminants from petroleum distillates

Applicant:

MIAMI UNIVERSITY

Opponent:

-

Headword:

PAH-contaminants/MIAMI UNIVERSITY

Relevant legal provisions:

EPC Art. 123(2)
RPBA Art. 15(3), 15(6)

Relevant legal provisions (EPC 1973):

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Keyword:

"Request to continue the proceedings in writing: dismissed"
"Extension beyond the content of the application as originally
filed: yes"

Decisions cited:

-

Catchword:

-



Case Number: T 1629/06 - 3.3.06

D E C I S I O N
of the Technical Board of Appeal 3.3.06
of 16 January 2008

Appellant:
(Applicant)

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Representative:

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Decision under appeal:

Decision of the Examining Division of the
European Patent Office posted 2 June 2006
refusing European application No. 00911691.4
pursuant to Article 97(1) EPC.

Composition of the Board:

Chairman: P. Ammendola
Members: L. Li Voti
U. Tronser

Summary of Facts and Submissions

I. This appeal lies from the decision of the Examining Division to refuse European patent application no. 00 911 691.4, relating to a method of removing contaminants from petroleum distillates.

II. In its decision, the Examining Division found *inter alia* that

- the claims according to the then pending requests complied with the requirements of Article 123(2) EPC;

- the subject-matter of each claim 1 according to any of the then pending requests lacked novelty and/or inventive step in the light of the cited prior art.

III. An appeal was filed against this decision by the Applicant (Appellant).

The Appellant submitted with the statement of the grounds of appeal a set of claims according to the main request and two further sets of claims according to the first and second auxiliary requests.

With the communication under Article 110(2) EPC of 22 December 2006 the Board informed the Appellant of its provisional opinion upon the compliance of such claims with the requirements of Articles 84 and 123(2) EPC and upon the novelty and inventive step of the claimed subject-matter.

With the letter of 30 April 2007 the Appellant submitted an amended set of claims according to the

main request and two further amended sets of claims according to the first and second auxiliary requests.

The Appellant submitted that the newly amended claims complied with the requirements of Article 123(2) EPC since

- the feature that the contaminants removed by means of the claimed method were PAH-contaminants was supported by claims 1 and 6 as originally filed and

- the use of a solvent immiscible with the used oil distillate and selective toward PAH-contaminants contained therein was supported by claim 3 and page 15, final paragraph, of the original description.

Moreover, the Appellant requested to be heard in oral proceedings should the Board not be in the position to allow the main request.

IV. The independent claim 1 and 6 of the set of 14 claims according to the main request reads as follows:

"1. A method of removing polynuclear aromatic hydrocarbons (PAH) contaminants from used oil distillates comprising the steps of:

- a) mixing an used oil distillate having PAH-contaminants contained therein with a solvent immiscible with the oil distillate and selective toward the PAH-contaminants contained therein thereby dissolving the PAH-contaminants from the used oil distillate into the solvent;
- b) separating the solvent having the PAH-contaminants dissolved therein from the used oil distillate;

c) separating the PAH-contaminants from the solvent and recovering the solvent;
d) separating any remaining solvent from the used oil distillate; and
e) reusing the recovered solvent to extract PAH-contaminants from subsequent quantities of used oil distillate."

Claim 1 according to the first auxiliary request differs from that according to the main request only insofar it includes an additional process step reading: **"f) obtaining a treated used oil distillate having a concentration of PAH-contaminants of 1 ppm or less."**

Claim 1 according to the second auxiliary request differs from that according to the first auxiliary request only insofar as it requires that the used oil distillate of step (a) **has more than 200 ppm PAH-contaminants** contained therein.

V. In the communication pursuant to Article 11(1) RPBA (OJ 2004, 541), sent as an annex to the summons to oral proceedings of 6 September 2007, the Board informed the Appellant *inter alia* that

- the claims according to the main request and to the first and second auxiliary requests submitted with the letter of 30 April 2007 related to the removal of PAH-contaminants only by means of a solvent selective toward such contaminants;

- the original documents of the application appeared to describe a method for removing at once PAH and other contaminants by means of a solvent which did not appear

to be selective toward PAH-contaminants but, on the contrary, had to be able to remove other contaminants also;

- therefore, the admissibility of these claims under Article 123(2) EPC had to be discussed at the forthcoming oral proceedings.

VI. The Appellant informed the Board with a fax dated 10 January 2008 that it did not intend to attend the oral proceedings scheduled on 16 January 2008 and requested that the prosecution of the application be continued in writing. No further arguments were submitted with regard to the deficiencies indicated in said Board's communication under Article 11(1) RPBA (OJ 2004, 541).

With a fax dated 11 January 2008 the Board informed the Appellant that the oral proceedings will take place as scheduled on 16 January 2008.

Oral proceedings before the Board were held on 16 January 2008 in the absence of the Appellant.

VII. The Appellant requests that the decision under appeal be set aside and that a patent be granted on the basis of claims 1 to 14 according to the main request submitted with letter of 30 April 2007, or in the alternative on the basis of any of the sets of claims according to the first or second auxiliary requests, submitted with the same letter.

Reasons for the Decision

1. *Formal issues*

- 1.1 Following the Appellant's request to be summoned to oral proceedings should the Board not be in the position to allow the claims according to the main request submitted with letter of 30 April 2007, the Board summoned the Appellant to oral proceedings.

In accordance with Article 11(1) RPBA (OJ 2004, 541) the Board sent a communication as annex to the summons of 6 September 2007, drawing the Appellant's attention to some deficiencies that had to be discussed at the forthcoming oral proceedings.

With a fax dated 10 January 2008, 6 days before the scheduled oral proceedings, the Appellant informed the Board that it did not intend to attend the oral proceedings; moreover it did not submit further arguments with regard to the deficiencies indicated in the Board's communication under Article 11(1) RPBA (OJ 2004, 541) and requested that the proceedings be continued in writing.

This request amounts in the Board's view to a request that no final decision be taken by the Board during oral proceedings and that it is decided instead to continue the proceedings in writing.

- 1.2 In accordance with Article 15(3) RPBA (OJ 2007, 536) the Board considered during the oral proceedings held on 16 January 2008 in the absence of the duly summoned

Appellant that the Appellant may be treated as relying only on its written case.

Moreover, Article 15(6) RPBA (OJ 2007, 536) requires that the Board shall ensure that the case is ready for decision at the conclusion of the oral proceedings, unless there are special reasons to the contrary.

In the present case the Appellant did not submit in writing any reason for its request that a final decision not be taken by the Board during oral proceedings.

Therefore, the Appellant's request that the proceedings be continued in writing has to be dismissed.

2. *Main request*

2.1 Article 123(2) EPC

2.1.1 Claim 1 according to the main request relates to a method of **removing polynuclear aromatic hydrocarbons (PAH) from used oil distillates** comprising the steps of mixing an used oil distillate **having PAH-contaminants contained therein** with a solvent immiscible with the oil distillate and **selective toward the PAH-contaminants** contained therein thereby **dissolving the PAH-contaminants** from the used oil distillate into the solvent, separating the solvent **having the PAH-contaminants dissolved therein** from the used oil distillate, **separating the PAH-contaminants** from the solvent and recovering the solvent, separating any remaining solvent from the used oil distillate and

reusing the recovered solvent **to extract PAH-contaminants** from subsequent quantities of used oil distillate.

This process thus encompasses the treatment of a used oil distillate with a solvent which is **selective toward PAH-contaminants only** and, consequently, **not selective toward other contaminants** present in the used oil distillate, in which process **the PAH-contaminants only** are removed from the used oil distillate whilst **the other contaminants are not removed therefrom**.

2.1.2 The originally filed documents of the application (reference being made hereinafter to the published WO application 00/56842) disclose throughout the description and the claims a method **for removing PAH and other contaminants** from petroleum distillates such as used motor oil distillates, all the described process steps regarding the **removal of PAH and other contaminants** (see page 1, lines 1 to 5; page 14, lines 3 to 14; page 15, lines 14 to 24; page 16, lines 6 to 16; page 17, lines 3 to 6; page 21, lines 15 to 17; page 23, lines 1 to 10; claims 1 to 12 on pages 26 to 30).

In particular, also claims 1, 3 and 6, expressly referred to by the Appellant, relate to a method for removing **PAH and other contaminants** contained in a petroleum distillate by means of a solvent able to dissolve all such contaminants and claims 3 and 6 specifically define the used solvent as being **selective toward all the contaminants** contained in the petroleum distillate.

Moreover, even though the description teaches in one passage that a solvent such as N,N-dimethylformamide (DMF) is **especially selective** (but not exclusively selective) toward PAH-contaminants, it teaches in the following passage that the solvent system is **selective toward various sulphur-containing molecules** (page 14, line 20 to page 15, lines 1 to 5). In fact, the solvent DMF is used in the examples of the present application (see page 17, lines 18 to 21), according to which **not only PAH-contaminants but substantially all PAH, sulphur and nitrogen-containing substances and other contaminants are removed from** the treated petroleum distillate (page 21, lines 7 to 10).

Therefore, in the Board's view, the originally filed documents of the application do not contain any support for a process including the treatment of a used oil distillate with a solvent which is **selective toward PAH-contaminants only** and, consequently, **not selective toward other contaminants** present in the used oil distillate, in which process **the PAH-contaminants only** are removed from the used oil distillate whilst **the other contaminants are not removed therefrom**.

The Board concludes that claim 1 according to the main request contains subject-matter which extends beyond the content of the application as originally filed and that therefore it contravenes the requirements of Article 123(2) EPC.

3. *First auxiliary request*

Claim 1 according to the first auxiliary request differs from that according to the main request only

insofar as it includes an additional process step reading: "**f) obtaining a treated used oil distillate having a concentration of PAH-contaminants of 1 ppm or less.**"

Since the wording of this claim encompasses a treatment of a used oil distillate with a solvent which is **selective toward PAH-contaminants only** and, consequently, **not selective toward other contaminants** present in the used oil distillate, and wherein **the PAH-contaminants only** are removed from the used oil distillate whilst **the other contaminants are not removed therefrom**, claim 1 according to the first auxiliary request contravenes the requirements of Article 123(2) EPC for the reasons put forward in point 2.1.2 above.

4. *Second auxiliary request*

Since claim 1 according to the second auxiliary request differs from that according to the first auxiliary request only insofar as it requires that the used oil distillate of step (a) **has more than 200 ppm PAH-contaminants** contained therein, this claim contravenes *mutatis mutandis* the requirements of Article 123(2) EPC.

5. Since the appeal fails already on these grounds there is no need to discuss the novelty and inventive step of the claimed subject-matter.

Order

For these reasons it is decided that:

The appeal is dismissed.

The Registrar:

The Chairman:

G. Rauh

P. Ammendola