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**Datasheet for the decision
of 10 September 2012**

Case Number: T 0435/07 - 3.3.07

Application Number: 01203415.3

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Language of the proceedings: EN

Title of invention:
Catalyst carrier comprising a fibre paper impregnated with
micro fibres, process for its production and its uses

Applicant:
Akzo Nobel N.V.
Eka Chemicals AB

Headword:
-

Relevant legal provisions:
EPC Art. 113(1)

Keyword:
"Basis of the decision - right to be heard (no)"

Decisions cited:
G 0004/92, T 0162/82, T 0300/89

Catchword:

The grounds on which a decision is based must be communicated to the applicants in such a way that they are put in the position to defend their rights. It is not sufficient to raise an objection without giving the factual details on which this objection is based and then leave it to the applicants to formulate the counterarguments. An objection against the grant of a patent must be raised in such a way that the applicants are able to understand its factual basis and to react accordingly without having to guess first what the examining division might have had in mind.



Case Number: T 0435/07 - 3.3.07

D E C I S I O N
of the Technical Board of Appeal 3.3.07
of 10 September 2012

Appellants:
(Applicants)

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Decision under appeal:

**Decision of the Examining Division of the
European Patent Office posted 27 October 2006
refusing European application No. 01203415.3
pursuant to Article 97(1) EPC 1973.**

Composition of the Board:

Chairman: J. Riolo
Members: D. Semino
P. Schmitz

Summary of Facts and Submissions

I. The appeal lies from the decision of the examining division dated 27 October 2006 refusing European patent application No. 01 203 415.3. The application as filed comprised 17 claims, claims 1, 12 and 13 reading as follows:

"1. A catalyst carrier comprising a fibre paper impregnated with a slurry comprising silica sol, micro fibres and a filler, wherein said micro fibres have an equivalent average particle size, measured with sedigraph method, from about 200 nm to about 30000 nm and said filler has an average equivalent particle size, measured with sedigraph method, from about 300 to about 10000 nm."

"12. An aqueous slurry useful for preparing a catalyst carrier according to any of the claims 1-10, comprising a silica sol, micro fibres and a filler, wherein said micro fibres have an equivalent average particle size, measured with sedigraph method, from about 200 nm to about 30000 nm, and said filler has an average equivalent particle size, measured with sedigraph method, from about 300 to about 10000 nm."

"13. A catalyst comprising a catalyst carrier according to any one of the claims 1-10 on which at least one catalytically active material is deposited."

II. The search division considered that the application did not comply with the requirement of unity of invention and related to three inventions, namely the carrier (ii) of claim 1 (claims 1-11), the slurry (i) of claim 12

and the catalyst (iii) of claim 13 (claims 13-17), since it found that there was no common concept linking (i)-(iii), which provided a contribution over the prior art. It issued therefore a partial search report for the invention first mentioned in the claims (the carrier). After payment of a further search fee for the third invention a European search report was issued for claims 1-11 and 13-17. In that search report the following documents were cited *inter alia*:

- D1: WO-A-97/31710
- D2: Ullmann's Encyclopedia of Industrial Chemistry, 1993, VCH Verlagsgesellschaft mbH, Weinheim, 5th edition, volume A23:"Silicates", pages 672 and 702-706
- D3: Ullmann's Encyclopedia of Industrial Chemistry, 1986, VCH Verlagsgesellschaft mbH, Weinheim, 5th edition, volume A7:"Clays", pages 126-136
- D4: Ullmann's Encyclopedia of Industrial Chemistry, 1991, VCH Verlagsgesellschaft mbH, Weinheim, 5th edition, volume A18:"Paints and coatings", pages 462-463
- D8: JP-A-10 015396
- D10: EP-A-0 398 766

III. The examining division issued a communication under Article 96(2) EPC 1973, in which the objection of lack of unity raised by the search division was maintained and it was argued as follows (paragraph 2.1 of that communication):

"The common concept linking the intermediate products (i), (ii) and catalyst product (iii) is the slurry (i) defined in claim 12. The common concept linking the intermediate product (ii) and catalyst

product (iii) is defined by the features of the support (ii), stated in claim 1.

The slurries (i) are, however, known from D8 for the same purpose, additionally relying on the computer translation of this document provided by the JPO (cf. http://dossier1.ipdl.ncip.go.jp/AIPN/aipn_call_transl.ipdl?N0000=7413&N0120=01&N2001=2&N3001=H10-015396). Furthermore, it was found in the further search of invention group 3 (see below) that these slurries are also known for the same purpose from D10.

The supports (ii), as well as the slurries (i) are foreshadowed by D1 in combination with technical encyclopedia excerpts D2-D4. D1 clearly teaches that adding either a gelation agent or the fibres defined in present claim 4-5, dependent upon claim 1, to an impregnation slurry for fibre papers comprising silica sol will lead to a strong and durable carrier as presently sought (cf. application page 1, lines 21-23), the carrier (ii) claimed in present claim 1 thus being an obvious alternative to that of D1. Particularly attapulgite (identical with palygorskite, cf. present claim 5) and sepiolite, referred to in D1, are known from D2 as typically falling within the particle size range claimed in present claim 1. The explicitly mentioned fillers in D1 (e.g. kaolin, mica and talc) are known from D3 and D4 to prescribe to the presently defined particle sizes in claim 1. Therefore there is no common concept linking (i)-(iii), which provides a contribution over the prior art, hence unity of invention is lacking."

In the first paragraph of that communication it was specified that:

"Unless indicated otherwise, the respective passages cited with the individual documents in the search report apply in assessing these documents in the following items."

IV. The applicants timely filed a letter of reply in which documents D1-D4, D8 and D10 were discussed, reasons were given why in their view the slurry of claim 12 was both novel and inventive over the prior art cited and constituted the common inventive concept linking all claims of the application and grant of a patent based

on the claims as originally filed as well as refund of the extra search fee were requested.

V. The examining division directly issued the decision under appeal thereafter, where it argued as follows:

(a) A decision appeared appropriate in view of procedural economy. Since no auxiliary requests of any form, including of oral proceedings, had been filed by the applicants, their standpoint appeared to be final. The issue of a decision was permissible under Article 113(1) EPC, since it was based on grounds which were previously communicated to the applicants and on which they had the opportunity to comment. The principles in T 162/82 (OJ EPO 1987, 533, points 10, 12 and 13 of the reasons), T 300/89 (OJ EPO 1991, 480, points 9.1 and 9.2 of the reasons) and G 4/92 (OJ EPO 1994, 149, point 2 of the conclusions) had been followed.

(b) The common concept linking the intermediate products (the slurry (i) and the carrier (ii)) and the catalyst product (iii) was the slurry (i) of claim 12. The common concept linking the carrier (ii) and the catalyst product (iii) was defined by the features of the support (ii) of claim 1. The slurries (i) were, however, known from D8 for the same purpose. The supports (ii), as well as the slurries (i) were foreshadowed by D1 in combination with technical encyclopedia excerpts D2 - D4. Therefore there was no common concept linking (i)-(iii), which provided a contribution over the prior art, hence unity of invention was lacking.

Pages 3 to 7 of the decision dealt with the objection of lack of unity. Therein the examining division took position over the points raised by the applicant, by indicating *inter alia* where in documents D8 and D1 the disputed features of claims 12 and 1 were to be found.

VI. The applicants (appellants) filed a notice of appeal against the above decision. With the statement setting out the grounds of appeal, the appellants requested that the decision under appeal be set aside and submitted three sets of claims as main, first and second auxiliary requests and requested grant of a patent on this basis. They requested oral proceedings in case the Board were not willing to accept the claims of the main request. In addition, they requested reimbursement of the extra search fee paid and of the appeal fee.

VII. As far as relevant to the present decision, the appellants argued as follows:

The application was refused on the grounds of lack of unity after only one examination report. The reason set out for lack of unity was that claim 12 was said to lack novelty or inventive step. However, in the communication, the grounds for lack of novelty and inventive step were only set out very briefly and it was not possible to foresee therefrom that the examining division would maintain its view when considering the counterarguments submitted in the response to the examination report.

Under those circumstances, refusing the application after only one examination report was a substantial procedural violation and for that reason reimbursement of the appeal fee was justified.

VIII. In a communication sent in preparation of oral proceedings, the Board expressed the provisional opinion that a substantial procedural violation took place, envisaged the remittal of the case to the examining division as well as the reimbursement of the appeal fee and informed the appellants that the scheduled oral proceedings would be limited to the discussion of that point.

IX. Following withdrawal of the request for oral proceedings with letter of 14 November 2011, the scheduled oral proceedings were cancelled.

Reasons for the Decision

1. The appeal is admissible.

2. *Procedural violation*

2.1 According to Article 113(1) EPC, the decisions of the EPO may only be based on grounds or evidence on which the parties concerned have had an opportunity to present their comments. The grounds are to be understood as meaning the essential legal and factual reasoning on which the decision is based (Case Law of the Boards of Appeal, 6th edition 2010, VI.B.1.1). The grounds must be communicated to the applicants in such a way that they are put in the position to defend their

rights. It is not sufficient to raise an objection without giving the factual details on which this objection is based and then leave it to the applicants to formulate the counterarguments. An objection against the grant of a patent must be raised in such a way that the applicants are able to understand its factual basis and to react accordingly without having to guess first what the examining division might have had in mind.

2.2 In the present case, the application was refused based on a single ground, namely lack of unity. Thus it needs to be decided whether or not that ground had been properly communicated to the applicants in advance and whether the applicants were given an opportunity to overcome it.

2.3 Lack of unity was based on the fact that the common concept linking the intermediate products (i), (ii) and catalyst product (iii), namely the slurry (i) defined in claim 12, is known from D8 and the common concept linking the intermediate product (ii) and catalyst product (iii), namely the support (ii) of claim 1, is foreshadowed by D1 in combination with technical encyclopedia excerpts D2-D4. The basis for lack of unity was therefore lack of novelty of the slurry of claim 12 over D8 and lack of inventive step of the support of claim 1 over D1 in combination with D2-D4.

2.4 Lack of novelty of the slurry over D8 was communicated to the applicants in the single communication of the examining division by a single sentence, stating only that the slurries are "known from D8 for the same purpose, additionally relying on the computer translation of this document".

- 2.4.1 Such a statement without any indication of where in the document the features of the slurry are to be found individually and in combination results in simply raising the objection without communicating to the applicants the reasoning on which that objection is based, since there is no correlation between specific passages of the document and corresponding features of the claim and there are no arguments to support the objection. It is left to the applicants to find out about the relevant features in D8 themselves.
- 2.4.2 A generic statement at the beginning of the communication that "the respective passages cited with the individual documents in the search report apply in assessing these documents" cannot support a different conclusion, since it only restricts somewhat the parts of the documents which may be relevant, but does not put the applicants in the position of understanding where each feature is to be found according to the examining division and which reasoning of the division stays at the basis of the raised objection.
- 2.5 The lack of inventive step objection for the support of claim 1 is developed in the single communication by the examining division in a few more sentences in which it is said that the support is "foreshadowed by D1 in combination with technical encyclopedia excerpts D2-D4. D1 clearly teaches that adding either a gelation agent or the fibres defined in present claim 4-5, dependent upon claim 1, to an impregnation slurry for fibre papers comprising silica sol will lead to a strong and durable carrier as presently sought (cf. application page 1, lines 21-23), the carrier (ii) claimed in

present claim 1 thus being an obvious alternative to that of D1. Particularly attapulgitite (identical with palygorskite, cf. present claim 5) and sepiolite, referred to in D1, are known from D2 as typically falling within the particle size range claimed in present claim 1. The explicitly mentioned fillers in D1 (e.g. kaolin, mica and talc) are known from D3 and D4 to prescribe to the presently defined particle sizes in claim 1."

2.5.1 Here again no single citation of specific passages of any of D1 or D2-D4 is given, let alone in combination with specific features of the claims. In particular, no indication is to be found of where in the document apparently considered as the closest state of the art (D1) the features of the support are to be found individually and in combination. Moreover, no clear indication is given of which are the distinguishing features with respect to D1 and where these features are to be found in the cited prior art together with a hint that they are meant to solve the posed problem. Without these pieces of information the applicants are not put in the position of understanding the objection of lack of inventive step raised by the examining division and reacting appropriately in order to overcome it.

2.5.2 Also in this case the generic reference at the beginning of the communication to all passages cited in the search report is of no help, for the same reasons as outlined above (point 2.4.2).

2.6 For these reasons, it is concluded that, while the ground of lack of unity was formally communicated to

the applicants in the single communication of the examining division, its factual basis was not sufficiently given therein, so that the appellants had to speculate about the examining division's assessment and thus were not put in the position to properly defend their rights. Under such circumstances the requirements of Article 113(1) EPC cannot be considered to be met.

- 2.7 Coming to a final decision after such a single deficient communication with the result that the application is refused results therefore in a substantial procedural violation.
- 2.8 Moreover, the decisions cited in the decision under appeal to support the fact that the issue of a decision was permissible under Article 113(1) EPC are not pertinent, since they refer to different factual situations. In the case dealt with in T 162/82 (*supra*) the primary examiner took a reasoned stand concerning the patentability of the application in his first communication (point 10 of the reasons, first sentence) and in the case underlying T 300/89 (*supra*) the relevant objection (lack of novelty) was clearly raised and explained in the first communication (point 9.1, last paragraph). The conclusion of the Boards in those cases that no procedural violation took place when a decision was directly taken after the first communication in the absence of a request for oral proceedings was based on the presence of a properly raised objection in the first communication which is not the case here. Decision G 4/92 (*supra*) deals with a decision taken against a duly summoned party who fails

to appear at oral proceedings and is not relevant for that reason only.

3. *Remittal*

3.1 Since a substantial procedural violation took place, the case is remitted to the first instance for further prosecution without an analysis of the appealed decision in its substantive aspects, nor a decision on the claim requests of the applicants on file (Article 11 of the Rules of Procedure of the Boards of Appeal).

3.2 Since the Board did not decide whether the non-unity objection was well founded, it cannot decide on the request for a refund of the extra search fee. This will be the task of the examining division.

4. *Reimbursement of the appeal fee*

4.1 In view of the foregoing, the appeal is successful to the extent that the decision under appeal is set aside. Moreover, as a consequence of the substantial procedural violation the applicants were only able to have their right to be heard restored by filing the appeal. In view of this the Board considers the reimbursement of the appeal fee as equitable (Rule 67 EPC 1973).

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 first instance for further prosecution.
3. The appeal fee shall be reimbursed.

The Registrar

The Chairman

S. Fabiani

J. Riolo