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**Datasheet for the decision
of 23 January 2012**

Case Number: T 1033/07 - 3.3.05

Application Number: 04012169.1

Publication Number: 1454669

IPC: B01D 53/86, B01J 29/068,
B01J 21/06

Language of the proceedings: EN

Title of invention:
Combustion catalysts and processes for removing organic
compounds

Applicant:
TOSOH CORPORATION

Opponent:
-

Headword:
Appeal fee/TOSOH

Relevant legal provisions:
EPC R. 103(1)(a)

Keyword:
"Procedural violation (no)"
"Reimbursement of the appeal fee (no)"

Decisions cited:
G 0001/05, G 0001/06, G 0003/06, T 0114/86, T 0012/81,
T 0198/94, T 0248/85

Catchword:
-



Case Number: T 1033/07 - 3.3.05

D E C I S I O N
of the Technical Board of Appeal 3.3.05
of 23 January 2012

Appellant: TOSOH CORPORATION
(Applicant) 4560, Kaisei-cho
Syunan-shi
Yamaguchi 746-8501 (JP)

Representative: Pautex Schneider, Nicole Véronique
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Decision under appeal: Decision of the Examining Division of the
European Patent Office posted 2 February 2007
refusing European patent application
No. 04012169.1 pursuant to Article 97(2) EPC.

Composition of the Board:

Chairman: G. Raths
Members: E. Waeckerlin
S. Hoffmann

Summary of Facts and Submissions

I. This appeal lies against the decision of the examining division dated 2 February 2007, refusing European patent application No. 04 012 169.1 (EP 1 454 669 A1) relating to "*Combustion catalysts and processes for removing organic compounds*". Notice of appeal was filed by the appellant with letter dated 27 March 2007. The appeal fee was paid, and the statement setting out the grounds of appeal was received on 18 May 2007 with letter dated 15 May 2007.

II. The application as filed included claims 1 to 4, the independent claims being claim 1 directed to a combustion catalyst and claim 4 directed to a process for removing organic compounds by catalytic combustion.

In a communication dated 2 March 2005, the examining division stated the claimed subject-matter lacked novelty having regard to the disclosure of documents D1 and D2, respectively.

D1: EP 0 800 856 A;

D2: US 5 849 255 A.

III. With letter of reply dated 24 May 2005, the appellant submitted a set of amended claims 1 to 4. All claims were now directed to a process for removing organic compounds by catalytic combustion.

The appellant argued, in essence, that D1 related to a process for purifying exhaust gases from diesel engines, not to a process for removing organic

compounds by catalytic combustion. The catalyst used in the process according to D1 was a "*post-combustion catalyst*", as opposed to the "*combustion catalyst*" used in the claimed process. Likewise, document D2 related also to a process for treating exhaust gases from diesel engines. The appellant concluded that the process according to the amended set of claims was novel and inventive over the disclosure of D1 and D2.

IV. Subsequently, the examining division refused the application on the ground of lack of novelty. The examining division held that there was no technical difference between the subject-matter disclosed in D1 and the process according to amended claims 1 to 3. The process of D1 could also be termed as catalytic combustion. Referring to decisions T 114/86, T 12/81, T 198/94 and T 248/85, the examining division stated that the difference in wording was not sufficient to establish novelty.

V. With the statement setting out the grounds of appeal the applicant submitted a new set of claims 1 to 3 and requested that the decision under appeal be set aside and that the appeal fee be reimbursed. As a precautionary measure, oral proceedings were requested.

Regarding the request for reimbursement of the appeal fee, the appellant argued as follows:

The present application (called "*divisional 2*") was a divisional application of European patent application No. 02 014 905 (called "*divisional 1*"), which was in turn a divisional application of European patent application No. 99 125 620. In the case of

"*divisional 1*", the examining division had issued a communication dated 30 January 2006, indicating that the examination proceedings were adjourned until the Enlarged Board of Appeal had given its decision in case G 1/05 concerning the validity of a divisional application. At the material time, there existed a possibility that "*divisional 1*" had to be considered as never filed and, thus, non-existing. In this case, "*divisional 2*", *i.e. the present application*, could also be considered as never filed and non-existing. The existence of the present application depended also on the decision in case G 1/06. Therefore, the validity of the present application was uncertain.

By refusing the present application instead of adjourning the examining proceedings until the Enlarged Board of Appeal had taken its decision in consolidated proceedings G 1/05, G 1/06 and G 3/06, the examining division had made a substantial procedural violation. Any discussion of the present application in appeal proceedings, so the appellant argued, was premature, since it could not be established with certainty at this stage, whether or not the present application was validly filed.

- VI. Following the appeal by the appellant, the examining division rectified its decision to refuse the application pursuant to Article 109(1) EPC. The examining division did not allow, however, the appellant's request for reimbursement of the appeal fee, this request being forwarded to the board of appeal for a decision.

- VII. Summons to oral proceedings pursuant to Rule 115(1) EPC were issued by the board of appeal on 7 November 2011.
- VIII. In a communication dated 18/24 November 2011 the board of appeal informed the appellant of its provisional, non-binding opinion concerning the issue of reimbursement of the appeal fee.
- IX. Oral proceedings were held on 23 January 2012 in the absence of the appellant. The latter had informed the board with letter dated 28 November 2011, that he would not attend the oral proceedings.

Reasons for the Decision

1. The examining division rectified its decision to refuse the application pursuant to Article 109(1) EPC (see decision dated 28 June 2007). Therefore, the examination of the application is pursued by the examining division under Article 94 EPC.
2. The only issue to be decided by the board of appeal is, whether the appeal fee has to be reimbursed under Rule 103 EPC, or not (see grounds of appeal dated 15 May 2007, main request and first to second auxiliary requests).
3. According to Rule 103(1)(a) EPC, the appeal fee is reimbursed in the event of interlocutory revision, if such reimbursement is equitable by reason of a substantial procedural violation.

- 3.1 It has to be investigated, therefore, whether a substantial procedural violation occurred in the present case during the examination proceedings.
- 3.2 The examining division refused the present application under Article 97(2) EPC on grounds of lack of novelty of the process according to claims 1 to 3 in respect of the disclosure of D1. The examining division held that, although the wording of claim 1 of the present application was different from the wording used in D1, there existed no technical difference between the process set out in claim 1 of the present application and the process disclosed in D1. In the decision under appeal, the significance of the disclosure of D1 was discussed in detail (see points 4.1 to 4.2 of the decision to refuse the application).
- 3.3 The board is satisfied that the reasons which led to the refusal of the application were both understandable and adequate, so that the decision was sufficiently reasoned in accordance with Rule 111(2) EPC. In this respect, there is no evidence that the decision under appeal is tainted with any flaws.
- 3.4 In the appellant's view, the examining division committed a substantial procedural violation by refusing the application, instead of adjourning the examining proceedings until such time when the Enlarged Board of Appeal had given in consolidated proceedings G 1/05, G 1/06 and G 3/06 its *"decision concerning the validity of the present divisional application as for the parent application"*, (see statement setting out the grounds of appeal, page 4, paragraphs 3 to 5).

- 3.5 The board notes that the alleged procedural violation is completely unrelated to the ground of lack of novelty of the process of claims 1 to 3, which was decisive for the refusal of the application. Consequently the outcome of case G 1/05 was not "*of the highest importance*" for the present application, as the appellant erroneously believed (see statement setting out the grounds of appeal, page 3, last paragraph, lines 1 - 5). For this reason, the board cannot subscribe to the notion, that the examining division committed objectively a substantial procedural violation by not adjourning the examination of the application until such time, when the Enlarged Board of Appeal gave its decision in consolidated cases G 1/05 and G 1/06 and G 3/07 (see OJ EPO 2008, 271 and 307).
4. Regarding the conditions for staying proceedings before the EPO first-instance departments (here: examining division) in connection with consolidated cases G 1/05, G 1/06 and G 3/06, the board refers to the Notice from the European Patent Office dated 1 September 2006 (see OJ 2006, p. 538 - 539).
- 4.1 According to said notice, examination proceedings were stayed until issuance of the decision of the Enlarged Board of Appeal only where the two following conditions are met:
- (i) the **stay of proceedings** has **explicitly** been **requested by the party** to the proceedings, i.e. the applicant; and
 - (ii) the **outcome of examination proceedings depends** in the opinion of the examining division **entirely on the decision of the Enlarged Board of Appeal**.

Furthermore, the notice contained the following statement: "*All cases affected by decision T 39/03 will henceforth be stayed only where the two abovementioned conditions are fulfilled.*" (see Notice from the EPO, OJ 2006, p. 539, paragraphs 3 to 6; emphasis added by the board).

- 4.2 The board notes that in the present case, the applicant (now appellant) did not make an explicit request for staying the examination proceedings. The examining division on its part did not consider, that the outcome of the examination proceedings depended entirely on the decision in consolidated cases G 1/05, G 1/06 and G 3/06. Therefore, neither the first nor the second condition for staying the examination proceedings set out in the Notice from the EPO dated 1 September 2006 was met.
- 4.3 Under these circumstances, there existed no legal basis for the adjournment of the examination proceedings in the case of the present application. Since the course of action adopted by the examining division was in full conformity with the Notice from the European Patent Office dated 1 September 2006, there can be no question of a procedural violation.
5. In the absence of a substantial procedural violation, no reimbursement of the appeal fee is possible under Rule 103(1)(a) EPC.

Order

For these reasons it is decided that:

The request for reimbursement of the appeal fee is refused.

Registrar:

Chairman:

C. Vodz

G. Rath