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

Case Number: T 0853/10 - 3.3.06
Application Number: 00937223.6
Publication Number: 1104803
IPC: C11D 11/00, C11D 3/02,
C11D 3/10, C11D 3/37,
C11D 11/02, C11D 17/06,
C11D 3/12

Language of the proceedings: EN

Title of invention:

Granules for carrying surfactant and method for producing the same

Patentee:

KAO CORPORATION

Opponents:

UNILEVER PLC / UNILEVER NV
The Procter & Gamble Company

Headword:

Particles for supporting surfactant/KAO CORPORATION

Relevant legal provisions:

EPC R. 103(1)(a)

Relevant legal provisions (EPC 1973):

EPC Art. 111(1)

Keyword:

"Substantial procedural violation (no)"
"Reimbursement of the appeal fee (no)"
"Remittal (yes)"

Decisions cited:

T 0642/97

Catchword:

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Case Number: T 0853/10 - 3.3.06

D E C I S I O N
of the Technical Board of Appeal 3.3.06
of 10 July 2012

Appellant: KAO CORPORATION
(Patent Proprietor) 14-10, Nihonbashi Kayaba-cho 1-chome,
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Respondent I: UNILEVER PLC / UNILEVER NV
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Respondent II: The Procter & Gamble Company
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Representative: Howard, Phillip Jan
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Decision under appeal: Decision of the Opposition Division of the
European Patent Office posted 17 February 2010
revoking European patent No. 1104803 pursuant
to Article 101(3)(b) EPC.

Composition of the Board:

Chairman: P.-P. Bracke
Members: L. Li Voti
U. Tronser

Summary of Facts and Submissions

- I. The present appeal is from the decision of the Opposition Division to revoke the European patent no. 1 104 803, concerning a process for preparing particles.
- II. In their notices of opposition the two Opponents sought the revocation of the patent on the grounds of Articles 100(a), (b) and (c) EPC (1973).
- III. The Opposition Division found in its decision that claim 1 according to then pending main and first auxiliary requests lacked clarity and that the subject-matter of independent claim 12 according to the then pending second auxiliary request lacked novelty, *inter alia*, over document (3).

As regards novelty the Opposition Division found, in particular, that the subject-matter of claim 12 encompassed particles having specific characteristics known from document (3) and obtainable by the process of claim 2, which did not lead necessarily to a reduced mode diameter of microporous capacity distribution.

The novelty of the other claims was not decided upon.

- IV. An appeal was filed against this decision by the Patent Proprietor (Appellant).

The set of claims according to the main request submitted in writing by the Appellant differed mainly from the set of claims according to the second auxiliary request before the Opposition Division

insofar as it did not contain any longer claims 2 and 12.

V. The Appellant submitted in writing and orally *inter alia* the following:

- after that the amended claims according to the main request and the first auxiliary request submitted during the oral proceedings of 4 February 2010 had been found to lack clarity, the Opposition Division gave the Patent Proprietor a last opportunity to file a new request;

- the claims of the then filed second auxiliary request were found to comply with the requirements of Articles 84, 123 and 83 EPC; however, the Opponents raised novelty objections against claim 12, which corresponded to claim 17 as granted;

- the novelty objections raised by the Opponents had not been submitted previously in writing and, in fact, the Opposition Division had communicated in the summons to oral proceedings its provisional opinion that the claimed subject-matter was novel over the cited prior art;

- after an interruption for deliberation, the Chairman of the Opposition Division informed the parties that further amendments would not be accepted, that claim 12 lacked novelty and that therefore the patent was revoked;

- the Opposition Division thus did not give the Patent Proprietor a further opportunity to file a new request

not containing any longer the objected claim 12, which request had been already prepared during the interruption; this represented a violation of the right to be heard and a substantial procedural violation;

- moreover, since the Patent Proprietor had to file an appeal because of the Opposition Division's decision not to give a further opportunity to amend the claims, it was equitable to reimburse the appeal fee in accordance with Rule 103(1)(a) EPC (Rule 67 EPC (1973));

- as the set of claims according to the main request submitted with the grounds of appeal did not contain any longer the objected claim 12, the case should be remitted to the department of first instance in order to allow a discussion in two instances of novelty and inventive step of the remaining claims.

VI. The Respondents (Opponents) submitted in writing that

- the Patent Proprietor was allowed to submit three new requests during the oral proceedings before the Opposition Division;

- after the discussion of the first auxiliary request the chairman gave the Patent Proprietor a last opportunity to file a new request but stated that no further amendments would be allowed;

- the novelty objections against claim 12 of the second auxiliary request were based on documents already cited in the notices of opposition;

- therefore, the right to be heard had not been denied to the Patent Proprietor;

- since the Opposition Division had not committed any substantial procedural violation, the case should not be remitted to the first instance.

VII. The Appellant requests that the decision under appeal be set aside and the case be remitted to the department of first instance for further prosecution.

The Appellant requests also the refund of the appeal fee.

VIII. The Respondents requested in writing that the appeal be dismissed.

Reasons for the Decision

1. *Substantial procedural violation and refund of the appeal fee*

1.1 It is not disputed and it results from the minutes of the oral proceedings of 4 February 2010 before the Opposition Division that

- the Patent Proprietor was allowed to submit three new requests;

- after the discussion on the clarity of the first auxiliary request the Opposition Division gave the Patent Proprietor a last opportunity to file a new request;

- the claims of the then filed second auxiliary request were found to comply with the requirements of Articles 84 EPC (1973), 123 EPC and 83 EPC (1973); however, the Opponents raised new novelty objections, which had not been submitted previously in writing, against claim 12, corresponding to claim 17 as granted;

- the Patent Proprietor had ample time to discuss these new facts and had no difficulty in discussing the objections raised;

- the Patent Proprietor did not ask for the possibility of submitting further requests and did not inform the Opposition Division that it intended to prepare an amended request in order to overcome the raised novelty objections before the proceedings were interrupted by the chairman for deliberating on the novelty of the second auxiliary request;

- after an interruption for deliberation, the Chairman of the Opposition Division informed the parties that claim 12 lacked novelty and that therefore the patent was revoked.

1.2 The admissibility of the new novelty objections has not been challenged by the Patent Proprietor. Moreover, as already explained above, the Patent Proprietor had sufficient time for considering the new objections raised against its amended claims and had no difficulty in dealing with them.

As regards the fact that the Opposition Division had communicated in the summons to oral proceedings its

provisional opinion that the product claims were novel over the cited prior art, the Board remarks that the opinion expressed in the summons was provisional and, consequently, subject to revision on the basis of the arguments submitted by the parties at the oral proceedings. In fact, such a communication sent to the parties with the summons serves only as orientation for the discussion that has to take place during oral proceedings but it has no limitative effect on the arguments which can be then presented by the parties.

Under these circumstances the Board cannot recognise any procedural violation in the admission of the new novelty objections.

- 1.3 The Appellant submitted during the oral proceedings before the Board that, in its recollection, the chairman, after reopening the proceedings, stated that further amendments would not be allowed, *de facto* depriving the Patent Proprietor of the possibility of filing a further amended request as a reaction to the new novelty objections raised.
A confirmation of this fact cannot be found in the minutes.

The Respondents submitted in writing that, after the discussion on the clarity of the first auxiliary request, the chairman gave the Patent Proprietor a last opportunity to file a new request, as reported in the minutes, and stated also that no further amendments would be allowed.

Therefore, the chairman's statement concerned exclusively the attempt of the Patent Proprietor of overcoming the clarity objections discussed so far.

Hence, it cannot be assumed that this statement had still to be considered applicable in the light of the new facts introduced into the proceedings with the novelty objections raised for the first time by the Opponents against claim 12 of the second auxiliary request.

- 1.4 Even though the Board is convinced that it would have been a substantial procedural violation to refuse a request by the Patent Proprietor to submit amended claims in an attempt to overcome the new novelty objections which could not have been foreseen before oral proceedings, the Board can rely in its judgement only on the minutes of oral proceedings, which were not disputed by the Patent Proprietor (see also T 642/97, point 9.3 of the reasons), and on the facts agreed upon by all parties.

On the basis of these undisputed facts, it does not result that the chairman stated, after reopening the oral proceedings, that further amendments would not be allowed.

Therefore, the Board can only conclude that the Opposition Division, in deciding after deliberation to revoke the patent, did not commit any substantial procedural violation.

- 1.5 Since the Opposition division did not commit a substantial procedural violation, the request for the reimbursement of the appeal fee cannot succeed.

2. *Remittal*

- 2.1 In the present case the grounds for revocation in the decision under appeal were only based on the fact that claim 12 lacked novelty.

Even though it results from the minutes that the parties discussed also at least the novelty of claims 8 and 13, the decision does not contain any consideration of the novelty of the independent claims 1, 8, 13 and 15.

The Board finds then that it would have been certainly more efficient and more helpful to the parties if the Opposition Division would have decided on the novelty of all claims instead of basing its decision on the lack of novelty of a single claim.

- 2.2 Since neither the novelty of the other claims nor the inventive step of the claimed subject-matter were decided upon and the main request submitted by the Appellant does not contain any longer the contested claim 12, the Board finds that it is appropriate, under the circumstances of the present case, to exercise its powers under Article 111(1) EPC (1973) and to remit the case to the department of first instance for further prosecution in order not to deprive the parties of the opportunity to argue the remaining issues at two instances.

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 request for the reimbursement of the appeal fee is refused.

The Registrar:

The Chairman:

D. Magliano

P.-P. Bracke