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**Datasheet for the decision  
of 25 April 2018**

**Case Number:** T 2061/16 - 3.3.05

**Application Number:** 05723641.6

**Publication Number:** 1720802

**IPC:** C02F1/78, C02F1/72, B09C1/00,  
C02F11/06

**Language of the proceedings:** EN

**Title of invention:**

OXIDATION OF ORGANIC COMPOUNDS AT HIGH PH

**Patent Proprietor:**

PeroxyChem LLC

**Opponent:**

United Initiators GmbH

**Headword:**

Soil decontamination/PEROXYCHEM

**Relevant legal provisions:**

EPC Art. 123(2)

**Keyword:**

Amendments - extension beyond the content of the application  
as filed (no) - broadening of claim (no)

**Decisions cited:**

**Catchword:**



**Beschwerdekammern**  
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Case Number: T 2061/16 - 3.3.05

**D E C I S I O N**  
**of Technical Board of Appeal 3.3.05**  
**of 25 April 2018**

**Appellant:** PeroxyChem LLC  
(Patent Proprietor) 1735 Market Street, 16th Floor  
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**Respondent:** United Initiators GmbH  
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**Decision under appeal:** **Decision of the Opposition Division of the  
European Patent Office posted on 20 June 2016  
revoking European patent No. 1720802 pursuant to  
Article 101(3) (b) EPC.**

**Composition of the Board:**

**Chairman** E. Bendl  
**Members:** J.-M. Schwaller  
P. Guntz

## Summary of Facts and Submissions

- I. The present appeal lies from the decision of the opposition division to revoke European patent No. 1 720 802 on the grounds that the main and auxiliary request then on file did not meet the requirements of Article 123(2) EPC.
- II. With the grounds of appeal, the appellant contested the decision and filed four additional auxiliary requests.
- III. With its response to the grounds of appeal, the respondent requested *inter alia* that these new requests not be admitted into the appeal proceedings.
- IV. The board expressed its preliminary opinion that the new requests appeared to be admissible but their subject-matter appeared to infringe the requirements of Article 123(2) EPC.
- V. With letter of 19 January 2018, the appellant filed four additional auxiliary requests.
- VI. The respondent requested that they not be admitted because they were late-filed.
- VII. At the oral proceedings, the debate focused on the allowability under Article 123(2) EPC of the different sets of claims at issue. The appellant submitted *inter alia* an eighth auxiliary request labelled "made at 12.12, 25/4/18" and withdrew all the requests previously on file, except auxiliary request 9, thus making the two remaining requests the main and auxiliary request, respectively.

Claim 1 of the main request reads as follows:

*"A method for oxidising an organic compound comprising contacting the organic compound with a composition being sodium persulfate and a pH modifier, the pH modifier being sodium hydroxide, potassium hydroxide or calcium hydroxide, wherein the pH modifier is capable of maintaining a pH of at least 10 in the environment being treated, and wherein the organic compound is present in soil."*

Claims 2 to 5 are dependent on claim 1 and describe preferred embodiments thereof.

VIII. The final requests of the parties were as follows:

The appellant requested that the decision under appeal be set aside and that the patent be maintained in amended form on the basis of the claims according to the main request submitted as eighth auxiliary request labelled "made at 12.12, 25/4/18" during oral proceedings before the board, or according to the auxiliary request submitted as ninth auxiliary request with the letter of 19 January 2018.

The respondent requested that the appeal be dismissed.

## **Reasons for the Decision**

1. Admissibility of the amendments

The eighth auxiliary request filed on 19 January 2018 was held admissible because the board saw it as an attempt to overcome the objections raised in its preliminary opinion. This request was moreover filed more than three months before the oral proceedings so

the appellant had sufficient time to study and comment on it.

The amendment to the eighth auxiliary request was filed during the oral proceedings before the board and it came in direct response to an objection raised by the appellant. The appellant and the board had sufficient time to study this amendment - a break of more than one hour was made - and its extent was such that it could be easily understood by the parties without having to postpone the proceedings, so the board exercised its discretion and admitted the amended request into the appeal proceedings.

## 2. Allowability of the amendments

For the board, the claims of the main request at issue meet the requirements of Article 123(2) EPC for the following reasons.

- 2.1 Claim 1 at issue is based on the general concept of the invention disclosed at page 6, lines 3 to 7, as filed, reading: "*In accordance with the process of the present invention, organic compounds are oxidized by contacting the organic compound with a composition comprising (a) a water soluble peroxygen compound and (b) a pH modifier - i.e., any compound which is capable of maintaining the pH greater than about 10 in its intended environment.*", **in combination** with the specific embodiment disclosed at page 5, lines 6 to 8, reading: "*In a preferred form of the invention, a composition comprising sodium persulfate ( $\text{Na}_2\text{S}_2\text{O}_8$ ) and a metal hydroxide (potassium hydroxide, sodium hydroxide, calcium hydroxide) is introduced into contaminated soil.*"

The subject-matter of current claim 1 thus corresponds in essence to the general concept of the invention applied specifically to the treatment of soil contaminated with organic compounds.

- 2.2 The appellant argued that claim 1 cited above infringed the requirements of Article 123(2) EPC because the present wording of claim 1 was broader - in the sense that it allowed the separate transport of the individual components below the ground level and their combination into the bi-component composition within the contaminated area - than the disclosure of the specific embodiment at page 5, lines 6 to 8, which required that the composition be introduced into contaminated soil.

The board does not accept this conclusion because the specific embodiment at page 5, lines 6 to 8, does not exclude either that the two components be transported separately below the ground level and combined into a bi-component composition before being introduced into the contaminated soil.

- 2.3 The further limitation in claim 1 to the bi-component composition of a sodium persulfate and a pH modifier selected from potassium hydroxide, sodium hydroxide and calcium hydroxide is a restriction of the open composition disclosed at page 5, lines 6 to 8 ("a composition comprising sodium persulfate and a metal hydroxide (potassium hydroxide, sodium hydroxide, calcium hydroxide)").

This restriction is plainly allowable as it derives directly and unambiguously from the application as filed, in particular the examples, which exclusively

describe bi-component compositions in the treatment of contaminated soils.

2.4 Claims 2 to 5 of the current request have their basis in claims 3, 11 and 12 as originally filed.

2.5 Thus, the requirements of Article 123(2) EPC are fulfilled.

3. Since the contested decision concerned only the question of whether or not the claimed subject-matter had a basis in the application as filed, the board exercises its discretion under Article 111(1) EPC and remits the case to the opposition division for further consideration of the relevant grounds of opposition in regard of this request, as requested by both parties.



## 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 on the basis of the main request labelled "made at 12.12, 25/4/18" submitted during oral proceedings before the board or, alternatively, on the basis of the auxiliary request submitted as "Ninth Auxiliary Request" with the letter of 19 January 2018.

The Registrar:

The Chairman:



I. Aperribay

E. Bendl

Decision electronically authenticated