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**Datasheet for the decision
of 3 November 2020**

Case Number: T 0545/18 - 3.3.05

Application Number: 11766567.9

Publication Number: 2556032

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C02F103/18, C02F103/36

Language of the proceedings: EN

Title of invention:
METAL SCAVENGING POLYMERS AND USES THEREOF

Applicant:
Nalco Company

Headword:
Metal scavenging polymers/NALCO

Relevant legal provisions:
EPC Art. 111(1), 113(1), 123(2)
EPC R. 103(1)(a)
RPBA 2020 Art. 11, 13(1), 13(2)

Keyword:

Amendment after summons - exceptional circumstances (yes)
Right to be heard - opportunity to comment (no) - examination
procedure - substantial procedural violation (yes)
Remittal - (yes)
Reimbursement of appeal fee - (no)

Decisions cited:

T 0951/92, T 0041/97, T 0133/02, T 1599/06, T 0677/08,
T 1034/11, T 1817/16, T 2538/18

Catchword:



Beschwerdekammern
Boards of Appeal
Chambres de recours

Boards of Appeal of the
European Patent Office
Richard-Reitzner-Allee 8
85540 Haar
GERMANY
Tel. +49 (0)89 2399-0
Fax +49 (0)89 2399-4465

Case Number: T 0545/18 - 3.3.05

D E C I S I O N
of Technical Board of Appeal 3.3.05
of 3 November 2020

Appellant: Nalco Company
(Applicant) 1601 West Diehl Road
Naperville, IL 60563-1198 (US)

Representative: Godemeyer Blum Lenze Patentanwälte
Partnerschaft mbB - werkpatent
An den Gärten 7
51491 Overath (DE)

Decision under appeal: **Decision of the Examining Division of the
European Patent Office posted on 11 September
2017 refusing European patent application No.
11766567.9 pursuant to Article 97(2) EPC.**

Composition of the Board:

Chairman E. Bendl
Members: T. Burkhardt
S. Fernández de Córdoba

Summary of Facts and Submissions

I. The appeal lies from the examining division's decision to refuse European patent application No. 11 766 567.9.

II. In the decision under appeal, the examining division held that:

- the then main request did not meet the requirements of Article 84 EPC, Rule 43(1) and (2) and Article 56 EPC (Point II. "Main request"), and
- the then auxiliary request did not meet the requirements of Article 123(2) EPC (Point II. "Auxiliary request").

The decision under appeal moreover comprised an *obiter dictum* (Point IV.), which indicated that claim 1 of the then main request lacked inventive step "[e]ven though it was not a subject of the discussion of the oral proceedings".

III. With its statement setting out the grounds of appeal, the applicant (appellant) submitted a main request and seven auxiliary requests as well as arguments, among other things with regard to the course of events during the examination procedure and the requirements of Articles 123(2), 84 and 56 EPC.

IV. In a communication under Article 15(1) RPBA 2020, the board expressed its preliminary opinion that:

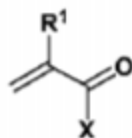
- the main request and auxiliary requests 1 to 4 and 6 would probably not be considered,

- auxiliary request 5 (which corresponds to the main request in the appealed decision) did not appear to meet the requirements of Article 84 EPC, and
- auxiliary request 7 (which corresponds to the auxiliary request in the appealed decision) did not appear to meet the requirements of Articles 56 and 123(2) EPC.

V. In response, the appellant submitted an eighth auxiliary request and provided further arguments with regard to added subject-matter, novelty and inventive step.

VI. Claim 1 of auxiliary request 8 reads as follows:

"1. A method of removing one or more monovalent or multivalent metals selected from the group consisting of copper, nickel, zinc, lead, mercury, cadmium, silver, iron, manganese, palladium, platinum, strontium, selenium, arsenic, cobalt and gold from a wastewater stream containing these metals which comprises the steps of: (a) treating said wastewater stream containing these metals with a composition comprising a polymer derived from a condensation polymerization reaction of at least two monomers: acrylic-X and an alkylamine, and wherein said acrylic-X has the following formula:



wherein acrylic-X is at least one of the following: methyl (meth)acrylate, ethyl (meth)acrylate, propyl (meth)acrylate, (meth)acrylic acid and (meth)acrylamide, wherein the molecular weight of said polymer is between 1,500 to 8,000, wherein the

alkylamine is PEHA or TEPA or DETA or TETA or EDA, wherein the molar ratio between acrylic-X and alkylamine is from 0.85 to 1.5, and wherein said polymer is modified to contain 55 to 80 mole percent dithiocarbamate salt group per total amines capable of binding one or more of said metals; (b) allowing the metal polymer complexes to self-flocculate and settle; and (c) collecting said treated metals by filtration, wherein the dosage is 1 to 2 moles of dithiocarbamate per mole of metal contained in the water."

VII. Oral proceedings took place on 3 November 2020.

During the oral proceedings, the appellant raised an objection that the examining division had not respected the appellant's right to be heard with regard to the ground of refusal in relation to the then main request under Article 56 EPC.

The appellant moreover, in the course of the oral proceedings, withdrew the main request and auxiliary requests 1 to 7.

VIII. The appellant requested that the decision under appeal be set aside and that the case be remitted to the examining division for further prosecution.

Reasons for the Decision

1. Consideration of auxiliary request 8

In the present case, the appellant was summoned to oral proceedings after RPBA 2020 had entered into force.

Thus Article 13(2) RPBA 2020 applies (see Article 25(3) RPBA 2020).

Auxiliary request 8 was filed with the submission dated 17 September 2020, i.e. after the summons and a communication under Article 15(1) RPBA 2020 had been issued.

As compared to auxiliary request 7, claim 1 of auxiliary request 8 additionally requires an *upper* limit of the dithiocarbamate salt concentration of 80 mole percent.

The addition of this feature is an appropriate reaction to the objection under Article 123(2) EPC against auxiliary request 7 raised for the first time in point 9 of the communication under Article 15(1) RPBA 2020, and overcomes this objection. Thus, in view of the convincing reasons given by the appellant for the late filing of the request, the board considers this reaction to constitute exceptional circumstances within the meaning of Article 13(2) RPBA 2020.

The board consequently exercises its discretion under Article 13(1) and (2) RPBA 2020 and admits auxiliary request 8.

2. Right to be heard

2.1 At the oral proceedings before the board, the appellant criticised the fact that, while Article 56 EPC was one of the grounds for refusing the application, this ground had not been discussed at the examination-stage oral proceedings.

The appellant referred to the first paragraphs on page 5 of the decision under appeal, to the "Obiter Dictum" on page 7 and to point 7 of the minutes of the oral proceedings in this regard.

In the appellant's view, its right to be heard under Article 113(1) EPC had consequently not been respected.

2.2 This argument was submitted for the first time at a very late stage: while the appellant noted in its statement setting out the grounds of appeal that "inventive step was not discussed during oral proceedings" (page 14, paragraph 8.3), a violation of the right to be heard had not been argued until the appeal-stage oral proceedings.

Any criticism expressed on pages 1 and 2 of the statement setting out the grounds of appeal as to the course of events during the examination procedure related rather to the late point at which objections under Article 84 EPC were raised for the first time and to the fact that the oral proceedings were maintained nonetheless.

However, given the great importance of the right to be heard in the EPC and in the case law, and the facts that no other party is affected by the lateness of raising the objection and that the board is in a position to take a decision on this issue without needing to postpone the oral proceedings, "exceptional circumstances" within the meaning of Article 13(2) RPBA 2020 exist.

The board consequently exercises its discretion under Article 13(1) and (2) RPBA 2020 and takes this amendment of the appellant's case into account.

2.3 Article 113(1) EPC requires that "[t]he decisions by the European Patent Office may *only* be based on grounds or evidence on which the parties concerned have had an opportunity to present their comments" (emphasis added by the board).

A ground in this respect is the essential legal and factual reasoning which leads to the refusal of the application (see T 951/92, headnote I).

2.4 In the present case, the examining division held the then main request unallowable on two grounds, namely lack of clarity (pages 3 and 4 of the decision under appeal in the section "II. Grounds for the Decision") and lack of inventive step (first four paragraphs on page 5, also in the section "II. Grounds for the Decision").

While Article 56 EPC is not mentioned again under point "III. Decision", the chapter corresponding to Article 56 EPC in the section "II. Grounds for the Decision" makes it clear that Article 56 EPC is exactly that, a ground for the decision.

2.5 However, the compliance of the main request with Article 56 EPC had not been discussed at the examination-stage oral proceedings, as expressly indicated in the section "IV. Obiter Dictum" on page 7 of the decision under appeal, which states that "[e]ven though it was not a subject of the discussion of the oral proceedings, ... no inventive step as required by Article 56 EPC may be acknowledged, because claim 1 of the main request does not solve, over its whole scope, any technical problem".

Consistently, while point 7 of the minutes of the examination-stage oral proceedings at the examining stage indicates that Articles 84 and 123(2) EPC were discussed during the oral proceedings and that the main request contravened Article 84 EPC, the minutes do not mention any discussion of inventive step.

- 2.6 Since the appellant in the case at hand was unable to present arguments in relation to the objection under Article 56 EPC during the examination-stage oral proceedings, its right to be heard in this regard has not been respected (Article 113(1) EPC).

This amounts to a substantial procedural violation.

- 2.7 These conclusions are in line with established case law:

- In T133/02, the board held that "[i]f a decision is based on plural grounds (as opposed to one ground followed by obiter dicta), then Article 113(1) EPC requires that the parties concerned must have had an opportunity to comment on all of the grounds" (reasons 3). Since this was not the case, the board considered this a substantial procedural violation (reasons 6).

- Similarly, T 1034/11 (reasons 5.3) states that "when a decision is based on several grounds supported by respective arguments and evidence, it is of fundamental importance that the decision as a whole meets the requirements of Article 113(1) EPC. The fact that the appellant had no opportunity to comment on all the grounds on which the decision appears to have been based constituted a substantial procedural violation within the meaning of Article 113(1) and Rule 103 EPC".

3. Remittal to the department of first instance

"Fundamental deficiencies" in the proceedings before the department of first instance are "special reasons" under Article 11 RPBA 2020 that justify the remittal of the case to said department.

Since the infringement of the right to be heard constitutes one such fundamental deficiency, the board remits the case to the department of first instance for further prosecution (Article 111(1) EPC; see also T 1817/16, reasons 3; T 2538/18, reasons 2.3, last paragraph, and reasons 3). The board takes this decision bearing in particular in mind that any conclusions drawn by the examining division with regard to inventive step are also of relevance for the present main request.

4. Reimbursement of the appeal fee

No request for reimbursement of the appeal fee has been submitted in the case at hand, and the board does not order such on its own motion either, for the following reasons:

According to Rule 103(1)(a) EPC, the appeal fee shall be reimbursed if the appeal is allowable and if such a reimbursement is equitable by reason of a substantial procedural violation.

The present appeal is allowable due to a substantial procedural violation.

However, reimbursement of the appeal fee would not be equitable, for the following reasons:

- As explained above (point 2.2), while the appellant's objection with regard to the right to be heard in relation to the ground of refusal under Article 56 EPC could have been raised at an earlier date with the statement setting out the grounds of appeal, this objection was only raised at the latest possible moment, i.e. during the appeal-stage oral proceedings.

- Because of the presence of another ground for refusal, i.e. Article 84 EPC, an appeal had to be filed anyway, regardless of the procedural violation. There is hence no causal link between the procedural violation and the necessity of filing an appeal against the examining division's decision (T 41/97, reasons 4 and 7, T 1599/06, reasons 22.3, or T 677/08, reasons 5.4).

Order

For these reasons it is decided that:

- The decision under appeal is set aside.
- The case is remitted to the examining division for further prosecution.

The Registrar:

The Chairman:



A. Voyé

E. Bendl

Decision electronically authenticated