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**Datasheet for the decision  
of 17 October 2019**

**Case Number:** T 0574/18 - 3.3.06  
**Application Number:** 06792834.1  
**Publication Number:** 1917102  
**IPC:** B01J27/122, C07C17/156,  
B01J27/138, C07C19/045  
**Language of the proceedings:** EN

**Title of invention:**  
CATALYTIC OXYCHLORINATION

**Applicant:**  
Albemarle Netherlands B.V.

**Headword:**  
Catalytic oxychlorination/Albemarle

**Relevant legal provisions:**  
EPC Art. 84, 123(2), 111(1)  
RPBA Art. 13(1)

**Keyword:**  
Late-filed new main request - admissible - yes - filed in  
reaction to the Board's communication  
Amendments - added subject-matter (no)  
Claims - clarity (yes)  
Remittal to the department of first instance - (yes)

**Decisions cited:**

**Catchword:**



**Beschwerdekammern**  
**Boards of Appeal**  
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Case Number: T 0574/18 - 3.3.06

**D E C I S I O N**  
**of Technical Board of Appeal 3.3.06**  
**of 17 October 2019**

**Appellant:** Albemarle Netherlands B.V.  
(Applicant) Stationsplein 4  
1838 LH Amersfoort (NL)

**Representative:** Uexküll & Stolberg  
Partnerschaft von  
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**Decision under appeal:** **Decision of the Examining Division of the  
European Patent Office posted on 4 October 2017  
refusing European patent application No.  
06792834.1 pursuant to Article 97(2) EPC.**

**Composition of the Board:**

**Chairman** J.-M. Schwaller  
**Members:** G. Santavicca  
C. Brandt

## Summary of Facts and Submissions

- I. The appeal lies from the decision of the Examining Division to reject European patent application No. 06792834.1 because the subject-matter of claim 1 of the then pending main request lacked clarity and inventive step, whilst the subject-matter of claim 1 of the then pending auxiliary request was not clear and contravened the requirements of Article 123(2) EPC.
- II. With its statement setting out the grounds of appeal dated 4 February 2018, the appellant maintained the main request underlying the contested decision and submitted new 1st and 2nd auxiliary requests.
- III. In its preliminary opinion, the Board held *inter alia* the subject-matter of claim 1 according to each of the main and 1<sup>st</sup> auxiliary requests to lack clarity under Article 84 EPC, whilst the claims of the 2<sup>nd</sup> auxiliary request were held to be clear and based on the application as originally filed, so that a remittal on that basis could be envisaged, in so far as inventive step of its claimed subject-matter had not been dealt with.
- IV. With its response dated 26 September 2019, the appellant withdrew its main and 1<sup>st</sup> auxiliary requests and maintained as the new main request the claims of the 2<sup>nd</sup> auxiliary request. It argued that the claims were clear and based on the original application and requested that the case be remitted to the Examining Division for further prosecution.
- V. The new main request comprises 9 claims, with its sole independent claim 1 reading as follows:

"1. A catalytic oxychlorination process comprising the step of contacting a feed containing an olefin, oxygen, and hydrogen chloride with an oxychlorination catalyst comprising from 5.5 wt% to 14 wt% copper, from 0.2 wt% to 5 wt% of a rare earth metal or a mixture of rare earth metals, and not higher than 0.6 wt% alkali metal, with no sodium being added to the catalyst composition, in a baffled fluid bed reactor, whereby the O<sub>2</sub>/2HCl ratio in the feed is in the range of from 0.50 to 0.58."

## Reasons for the Decision

1. New Main request

1.1 Admissibility

This request having been filed in reaction to the communication expressing the Board's preliminary opinion, its admissibility is not at stake (Article 13(1) RPBA).

1.2 Amendments

1.2.1 Compared to claim 1 as originally filed, claim 1 of the new main request comprises the following amendments (made apparent by the Board):

"1. A ~~process for the~~ catalytic oxychlorination **process** ~~of an olefin~~ comprising the step of contacting a feed containing ~~the~~ an olefin, O<sub>2</sub> **oxygen**, and HCl **hydrogen chloride** with an oxychlorination catalyst **comprising from 5.5 wt% to 14 wt% copper, from 0.2 wt% to 5 wt% of rare earth metal or a mixture of rare earth metals, and not higher than 0.6 wt% alkali metal, with no sodium being added to the catalyst composition, in a baffled**

*fluid bed reactor, whereby the O<sub>2</sub>/2HCl ratio in the feed is in the range of from 0.50 to 0.58."*

- 1.2.2 Apart from the replacement of some symbols with their corresponding names, the above amendments find their basis in original claims 1, 5, 7, 10 and 13 and in the passages on page 4, line 29, and page 8, line 11, of the application as originally filed.
- 1.2.3 The amendment "**above 0,52 to below 0,56**" in claim 9 has its basis in the passages on page 6, lines 7 (see "0,52 or greater") and 11 (see "below 0,56") of the original application.
- 1.2.4 Therefore, the amended claims of the new main request comply with the requirements of Article 123(2) EPC.

### 1.3 Clarity

Claim 1 at issue no longer contains the feature "*sodium being too small to have an effect on the performance of the catalyst*", objected to under Article 84 EPC by the Examining Division. Instead, claim 1 now clearly defines that "*no sodium being added to the catalyst composition*".

Consequently, the Board is satisfied that also the requirements of clarity under Article 84 EPC are fulfilled by amended claim 1 at issue.

## 2. Remittal

- 2.1 The new main request was not dealt with in the decision under appeal, so that there is no decision to review, let alone in respect of substantive issues such as inventive step. In fact, the Examining Division decided

on the issue of inventive step only in respect of the then pending main request, which did not include the present amendments, and it cannot be inferred from the decision under appeal (reasons, 14) whether the now claimed subject-matter is still objectionable e.g. under Article 56 EPC.

2.2 The Board therefore considers it appropriate to remit the case to the Examining Division pursuant to Article 111(1) EPC for further prosecution, in particular as regards inventive step of its claimed subject-matter.

## Order

### **For these reasons it is decided that:**

1. The decision under appeal is set aside.
2. The case is remitted to the Examining Division for further prosecution of the application on the basis of the claims according to the main request filed with the letter dated 26 September 2019.

The Registrar:

The Chairman:



A. Pinna

J.-M. Schwaller

Decision electronically authenticated