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Datasheet for the decision of 2 February 2023

Case Number: T 0643/20 - 3.3.06

Application Number: 14711966.3

Publication Number: 2981594

IPC: C10G3/00, C10L1/02, C11C3/12, C10L1/04, C10L1/08, C11B3/00

Language of the proceedings: EN

Title of invention:
RENEWABLE HYDROCARBON COMPOSITION

Patent Proprietor:
UPM-Kymmene Corporation

Opponents:
Neste Oyj
Polski Koncern Naftowy ORLEN S.A.

Headword:
RENEWABLE HYDROCARBON COMPOSITION / UPM-Kymmene Corporation

Relevant legal provisions:
EPC Art. 56
RPBA 2020 Art. 12(4), 12(6)

Keyword:
Inventive step - main request and auxiliary requests 1-17 (no)
Late-filed request - auxiliary request 18 should have been submitted in first-instance proceedings (yes)

Decisions cited:

Catchword:

Europäisches Patentamt
European Patent Office
Office européen des brevets

Beschwerdekammern

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Case Number: T 0643/20 - 3.3.06

D E C I S I O N
of Technical Board of Appeal 3.3.06
of 2 February 2023

Appellant: (Patent Proprietor)	UPM-Kymmene Corporation Alvar Aallon katu 1 00100 Helsinki (FI)
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Representative:	Lazewski, Marek LDS Lazewski Depo & Partners ul. Prosta 70 00-838 Warsaw (PL)
Decision under appeal:	**Decision of the Opposition Division of the European Patent Office posted on 3 January 2020 revoking European patent No. 2981594 pursuant to Article 101(3)(b) EPC.**

Composition of the Board:

Chairman	L. Li Voti
Members:	P. Ammendola
	C. Heath

Summary of Facts and Submissions

I. The appeal of the patent proprietor (**appellant**) lies from the decision of the opposition division to revoke the patent because none of the eighteen sets of amended claims according to the main request and auxiliary requests 1 to 17 then on file complied with the EPC.

II. With its statement of grounds of appeal the patent proprietor (**appellant**) submitted, *inter alia*, nineteen sets of amended claims labelled as **main request and auxiliary requests 1 to 18** and also presented arguments, *inter alia*, as to the compliance of each version of claim 1 according to the filed requests with Article 56 EPC in view of the prior art disclosed in **P10** (WO 2012/069706 A2).

III. In their replies to the appeal both opponent 1 and 2 (**respondents 1** and **2**) disputed the admittance into the appeal proceedings of the auxiliary request 18 and argued, *inter alia*, that none of the requests on file would involve an inventive step over the prior art disclosed in P10 or over that disclosed in **P7** (US 2012/0260565 Al). **P6** (*Tall Oil and Its Uses – II*, McSweeney *et al.*, Chapter 2, pages 12 to 18. 1987) was also cited.

IV. Following the communication of 2 December 2022 in which the board expressed its preliminary opinion on some of the pending issues, the board received one further submission on the substance of the case with a letter of respondent 1 dated 24 January 2023. Moreover, the appellant reiterated with letter dated 01 February 2023 its view that document P4, already not admitted into

the proceedings by the opposition division, should also not be admitted into the appeal proceedings.

V. Oral proceedings before the board were held by videoconference on 2 February 2023.

The parties' final requests were established to be as follows:

The proprietor and appellant requested that the decision under appeal be set aside and the patent be maintained in amended form on the basis of the claims of the main request or of one of auxiliary requests 1 to 18 all as enclosed to the statement of grounds of appeal.

Opponents and respondents 1 and 2 requested that the appeal be dismissed. Respondent 1 requested also that auxiliary request 18 not be admitted into the appeal proceedings. Respondent 2 requested that auxiliary requests 13 to 18 not be admitted.

VI. Claim 1 of the **main request** reads as follows:

"*1. A composition produced from a renewable biological feedstock, the composition comprising 10-40 mass% of C_{8-30} linear alkanes, up to 20 mass% of C_{7-20} aromatic hydrocarbons, at least 90 mass% of which are monoaromatic, and no more than 1 mass% in total of oxygen-containing compounds;*

wherein the total amount of C_{8-30} alkanes in the composition is 50-90 mass%, and the total amount of C_{8-30} alkanes, C_{7-20} aromatic hydrocarbons and C_{8-30} cycloalkanes is at least 95 mass%;

wherein the composition comprises 10-40 mass% of C_{8-30} cycloalkanes; and

wherein the amounts are based on the mass of the composition."

Claim 1 of the **auxiliary request 1** only differs from that of the main request in that the claimed composition is specified to be a **fuel** composition.

Claim 1 of the **auxiliary request 2** only differs from that of the auxiliary request 1 in that it additionally requires that the composition comprises **10-40 mass% of C_{12-18} linear alkanes.**

Claim 1 of the **auxiliary request 3** only differs from that of the auxiliary request 2 in that the composition comprises **10-~~40~~30 mass% of C_{8-30} cycloalkanes.**

Claim 1 of the **auxiliary request 4** and that of the **auxiliary request 5** only differ from respectively claim 1 of the auxiliary request 2 and that of the auxiliary request 3 in that the composition comprises **10-40 mass% of $C_{~~12~~15-18}$ linear alkanes.**

Claim 1 of the **auxiliary request 6** and that of the **auxiliary request 7** only differ from respectively claim 1 of the auxiliary request 3 and that of the auxiliary request 5 in that the wording "***produced from a renewable biological feedstock, the composition comprising***" is **deleted.**

Claim 1 of the **auxiliary request 8** reads as follows:

"*1. A method for producing a fuel composition comprising the steps of:*
(i) hydroprocessing a biological feedstock using one or more catalysts; and
(ii) fractionating the product of step (i);

wherein the composition comprises 10-40 mass% of C_{8-30} linear alkanes, up to 20 mass% of C_{7-20} aromatic hydrocarbons, at least 90 mass% of which are monoaromatic, and no more than 1 mass% in total of oxygen-containing compounds;

wherein the total amount of C_{8-30} alkanes in the composition is 50-90 mass%, and the total amount of C_{8-30} alkanes, C_{7-20} aromatic hydrocarbons and C_{8-30} cycloalkanes is at least 95 mass%;

wherein the composition comprises 10-40 mass% of C_{8-30} cycloalkanes; and

wherein the amounts are based on the mass of the composition."

Claim 1 of the **auxiliary request 9** only differs from that of the auxiliary request 8 in that it additionally requires that the composition comprises **10-40 mass% of C_{12-18} linear alkanes**.

Claim 1 of the **auxiliary request 10** only differs from that of the auxiliary request 9 in that the composition comprises **10-~~40~~30 mass% of C_{8-30} cycloalkanes**.

Claim 1 of the **auxiliary request 11** only differs from that of the auxiliary request 9 in that the composition comprises **10-40 mass% of $C_{~~12~~15-18}$ linear alkanes.**

Claim 1 of the **auxiliary request 12** only differs from that of the auxiliary request 11 in that the composition comprises **10-~~40~~30 mass% of C_{8-30} cycloalkanes**.

Claim 1 of the **auxiliary request 13** only differs from that of the auxiliary request 8 in that the biological feedstock comprises **at least 45 mass% of C_{12-18} fatty acids, at least 25 mass% of resin acids and at least 20**

mass% of neutral compounds based on the mass of the feedstock.

Claim 1 of the **auxiliary request 14** only differs from that of the auxiliary request 13 in that it additionally requires that the **composition comprises 10-40 mass% of C_{12-18} linear alkanes.**

Claim 1 of the **auxiliary request 15** only differs from that of the auxiliary request 14 in that the composition **comprises 10-~~40~~30 mass% of C_{8-30} cycloalkanes.**

Claim 1 of the **auxiliary request 16** and that of the **auxiliary request 17** only differ from respectively claim 1 of the auxiliary request 14 and that of the auxiliary request 15 in that the composition comprises **10-40 mass% of $C_{~~12~~15-18}$ linear alkanes.**

Claim 1 of the **auxiliary request 18** differs from that of the auxiliary request 13 in that it relates to a method for producing a **diesel** fuel composition and it additionally requires that **the hydroprocessing step is performed using a reactor comprising catalysts (i) and (ii) and comprising two or three catalysts beds in which the proportion of catalyst (ii) increases on moving between the catalyst beds in the flow direction, the first bed containing only catalyst (i) or a mixture of catalysts (i) and (ii) in a first mass ratio, the second bed containing a mixture of catalysts (i) and (ii) in a second mass ratio, and the third bed containing a mixture of catalysts (i) and (ii) in a third mass ratio or containing only catalyst (ii); wherein the second mass ratio is less than the first mass ratio, and the third mass ratio is less than the second mass ratio; catalyst (i) comprises MoO_3, one or**

both of CoO and NiO, and one or more support materials; catalyst (ii) comprises NiW and one or more support materials; and the support materials are selected from zeolite, alumina, zeolite-alumina, alumina-silica, alumina-silica-zeolite and activated carbon.

Reasons for the Decision

Auxiliary request 8

1. Inventive step (Article 56 EPC): claim 1

This claim defines a method for producing a fuel composition by hydroprocessing a biological feedstock (see VI above).

1.1 The closest prior art

It is undisputed among the parties that the prior art disclosed in P10 represents a suitable starting point for the assessment of inventive step. All parties referred in particular to Example 3 of this prior art, wherein the hydroprocessing of a biological feedstock (crude tall oil = **CTO**, which can be the feedstock also in the present patent) and the subsequent fractionation of the resulting product results in the fuel compositions labelled as "CTO HW+HDO Mid cut" and "CTO HW Mid cut", whose properties are described in Table 3 (see in particular in the first two columns). It is also evident from Tables 3 and 4 that these mid cut fuels have properties similar to the standard for a diesel according to EN590. Therefore, in the board's view they represent a diesel fuel.

It is undisputed that the subject-matter of claim 1 under consideration differs from this prior art in that the former specifies the chemical composition of the fuel composition resulting from the claimed method (see in claim 1 of the auxiliary request 8, from "*wherein the composition comprises 10-40 mass% of C_{8-30} linear alkanes*" to the end of the claim).
Indeed, the chemical compositions of the fuels produced in Example 3 of P10 are undisclosed.

1.2 Technical problem solved according to the appellant

The appellant saw the technical problem solved in the provision of (a method for producing) a renewable hydrocarbon composition suitable as stand alone diesel fuel and having high compatibility with ordinary (petroleum) diesel fuels. In particular, in the appellant's view the "high" compatibility achieved would be that apparent from the distillations profiles (of two examples) of the fuels produced according to the invention depicted in Figure 2 of the patent in suit.

1.2.1 However, for the board this definition of the technical problem solved appears manifestly incommensurate with the breadth of the definition of the claimed method.

As correctly stressed by the respondents and undisputed by the appellant, the chemical composition of the final product described in claim 1 under consideration is not expressly limited to diesel fuels and is so broad as to also embrace, for instance, fuel compositions made mostly of C_8 (or e.g. C_{8-10}) linear and branched alkanes whose distillation and combustion properties may undisputedly be predicted to be much closer to those of naphtha than to those of diesel. In other words, the

definition of the produced composition manifestly encompasses very diverse sorts of fuels, ranging from naphtha to diesel or kerosene.

Accordingly, claim 1 under consideration neither describes compositional features of the final product that necessarily imply its suitability as stand alone diesel fuel (not to mention the specific distillation profiles of the diesel fuels exemplified in the patent in suit), nor directly specifies the process conditions and the starting biological feedstock in any way (and, thus, also to the extent possibly justifying a conclusion that the claimed method would necessarily result in fuels suitable for diesel engines).

Therefore, the claimed method is found also to possibly result in the production of e.g. naphtha or other mixtures of hydrocarbons manifestly unsuitable as diesel stand alone fuel, which necessarily also show distillation profiles substantially different from those of the diesel fuels exemplified in the patent in suit.

The board remarks also that the diesel fuels of the closest prior art (see Table 3) may be mixed with conventional diesel and the resulting fuels have boiling points and other properties very similar to a standard diesel. Thus, it is not perceivable that they are inferior to the fuel compositions tested in the patent.
Accordingly, the technical problem identified by the appellant is found not plausibly solved across the whole scope of claim 1 of the auxiliary request 8 and has anyway already been solved by the closest prior art.

1.3 The objective technical problem

Hence, the board, also considering that the process in P10 already hydroprocesses a biological feedstock (CTO) and fractions the resulting product to generate renewable fuel compositions, finds that the technical problem solved by the subject-matter of claim 1 of the auxiliary request 8, can only be seen in the provision of a further (method for hydroprocessing and fractionating a biological feedstock that results in a) renewable fuel, i.e. in the provision of an alternative to the prior art of departure.

1.4 The solution

According to claim 1 under consideration the posed technical problem is solved by a method for hydroprocessing and fractionating a biological feedstock that results in a fuel product having the chemical composition specified in the claim.

1.5 Obviousness of the solution

1.5.1 The appellant submitted that fuels having the chemical composition described in claim 1 under consideration would be obtainable by hydroprocessing and fractionating specific biological feedstocks under specific processing conditions, including the use of multiple beds of catalyst, as those used in the examples of the patent in suit.

However, in both samples of the prior art disclosed in Example 3 of P10 the used feedstock was a CTO of unspecified chemical composition and even the two catalysts used in the "HDO+HW" sample were not arranged in multiple catalysts beds.

Nor would a CTO similar to the one used in the examples of the patent in suit be suggested in the other available prior art.

1.5.2 The board notes however that the patent in suit provides no evidence or explanation suggesting that the chemical composition of the final renewable fuel produced in accordance with claim 1 necessarily implies the use of specific feedstocks and processing conditions, similar to the specific CTO and assembly of catalysts used in the patent examples, which are in fact not features of claim 1 at issue.

In particular, paragraph [0043] of the patent description only gives many general examples of biological feedstock, among which tall oil is listed, and paragraph [0044] mentions that "*In one embodiment the feedstock comprises or consists of one or more of tall oil, tall oil components (e.g. tall oil fatty acids) and tall oil derivatives (e.g. tall oil resin acid and tall oil pitch)*". Thus, the description does not limit the feedstock to specific tall oils. Even the tall oils defined as preferred in paragraph [0046] are described by a plurality of alternative and significantly different values for the minimum amounts of the three components of these well-known biological feedstocks.

Similarly, the patent itself, in paragraphs [0046] to [0058] of the description, generically refers to conventional hydroprocessing catalysts in any conceivable assembly.

Nor are other specific processing conditions described as essential in paragraphs [0058] to [0077] of the

description: the patent discloses in general the hydroprocessing conditions for obtaining the composition defined as final product of the method of claim 1 under consideration, thereby apparently embracing many conventional settings of these conditions.

1.5.3 On the other hand, as also stressed by the respondents (see for instance Table 1 on pages 10 to 11 of the reply to appeal of respondent 2), P10 itself teaches to its skilled reader the production of renewable fuels from CTO via hydroprocessing and fractionation by providing a general description largely overlapping if not coincident with that provided in the patent in suit for the process features and for the tall oil useful as feedstock.

The board stresses, in particular, that P10 (see page 11, lines 15-18) already teaches arrangements including the catalyst system comprising several beds. Furthermore, even the distillation ranges disclosed for the specific prior art examples in Table 3 of P10 are in accordance with the fractionation temperatures described in paragraph [0038] of the patent in suit for the method of the invention.

The board considers it appropriate to also underline that the generic character of most teachings in both documents (the patent in suit and P10) relating to the nature of the suitable biological feedstocks and to the hydroprocessing and fractionation steps further corroborates the existence of abundant common general knowledge in the relevant technical field.

1.6 Hence, all that is needed for the skilled reader of P10 in order to solve the objective technical problem so as

to arrive at a modification of the method of the prior art resulting in a renewable fuel having compositional features in accordance with the definition of the final product of the method described in claim 1 in dispute, is an arbitrary selection among the conventional (e.g. commercially available) alternatives in terms of tall oil and catalyst and the conventional alternative settings for hydroprocessing and fractionation. This applies all the more in the present case as P10 itself reminds its reader of the existence of these alternatives. Such an arbitrary selection is within the routine abilities of the skilled person, and for this reason alone it cannot contribute to inventive step.

1.7 In view of the above, the board concludes that the subject-matter of claim 1 of auxiliary request 8 does not involve an inventive step.

1.8 The auxiliary request 8 is thus not allowable.

Main request and auxiliary requests 1 to 7 and 9 to 12

2. Inventive step (Article 56 EPC): claim 1 of the main request and of auxiliary request 1

The composition of claim 1 of the main request (see VI above) differs from the composition obtained according to the method of the already considered auxiliary request 8 only in that the former is explicitly required to be produced from a renewable biological feedstock.

The composition of claim 1 of the auxiliary request 1 (see VI above) only differs from that of claim 1 of the main request in that the former is explicitly qualified as fuel composition.

Since the compositions described in claim 1 of the already considered auxiliary request 8 are the product of a method for producing a fuel composition comprising the hydroprocessing of a biological feedstock, it is apparent that the subject-matter of claim 1 of the main request as well as that of claim 1 of the auxiliary request 1 encompass the final product of the method according to claim 1 of the already considered auxiliary request 8.

Hence, the same reasoning for lack of inventive step as made above for claim 1 of the auxiliary request 8 applies to both these versions of claim 1.

The subject-matter of claim 1 of the main request and that of the auxiliary request 1 therefore lack an inventive step, and these requests are thus not allowable.

3. Inventive step (Article 56 EPC): claim 1 of the auxiliary requests 2 to 7 and 9 to 12

3.1 Claim 1 of these requests (see VI above) differ from the previously discussed requests only in that they contain further limitations as regards the chemical composition of the fuel.

It is undisputed that none of the above modifications of the chemical composition of the claimed fuel or of the fuel produced by the claimed method results in the exclusion of e.g. naphtha compositions or other fuels not suitable as diesel stand alone fuel.

Nor is any of these modifications of the claimed subject-matter (in terms of the chemical composition of

the fuel produced by the method of the invention) even just alleged - not to mention proven - in the patent in suit to be surprising or to correspond to a particular advantage over a diesel fuel as disclosed in P10.

The board stresses that during the oral proceedings, the board informed the appellant that the same reasons that had brought the board to the conclusion that claim 1 of the auxiliary request 8 lacked an inventive step, appeared to justify the same conclusion for each of the compositions claimed in the version of claim 1 according to all higher ranking requests, as well as for each of the methods of claim 1 of the auxiliary requests 9 to 12. This was not disputed by the appellant, and no further comments were made in this regard.

Hence, even though these requests require further restrictions of the chemical composition of the claimed fuels or of the product obtained by the claimed methods the same reasons given above for the conclusion that claim 1 of the auxiliary request 8 as well as that of the main request and of auxiliary requests 1 lacked an inventive step still apply.

3.2 The subject-matter of claim 1 of the auxiliary requests 2 to 7 and that of the auxiliary requests 9 to 12 are therefore also found to lack an inventive step, and these requests are thus not allowable.

4. Admittance into the appeal proceedings of the auxiliary requests 13 to 17

Since these requests have been found to lack inventive step for the reasons exposed below, the request for

their not admittance into the appeal proceedings does not need to be addressed.

Auxiliary request 13

5. Inventive step (Article 56 EPC): claim 1

Claim 1 of auxiliary request 13 (see VI above) differs from claim 1 of auxiliary request 8 in that it characterises the biological feedstock as comprising at least 45 mass% of C_{12-18} fatty acids, at least 25 mass% of resin acids and at least 20 mass% of neutral compounds based on the mass of the feedstock.

5.1 The appellant submitted that the reasons for finding claim 1 of the auxiliary request 8 lacking of an inventive step over P10 would not apply to the subject-matter of claim 1 of the auxiliary request 13, because the latter was limited to a specific biological feedstock, also used in the patent examples for arriving at a fuel composition as claimed. Neither P10 nor any of the other documents on file provided a disclosure of such a feedstock.
Hence, even if the technical problem solved had to be seen in the provision of a further renewable fuel, the skilled person would not simply arrive at using the specified feedstock by an arbitrary choice among the conventional CTOs.

The appellant stressed in particular that the conventional nature of the biological feedstock now described in claim 1 was also not apparent from the common general knowledge as represented by P6, since also the latter document disclosed no CTO with at least 25 mass% of resin acids and at least 20 mass% of neutral compounds. On the contrary, this document

stressed the variability in terms of chemical composition of the conventional CTO.

5.2 The board finds however the fact that no CTO complying with the definition of claim 1 under consideration is disclosed in the cited documents to be insufficient for concluding that no such CTOs would be conventional.

It is relevant in this respect that, as already stressed in point 1.5.2 above, the patent in dispute only describes the preferred tall oils in paragraph [0046] by offering a plurality of alternative and significantly different values for the minimum amounts of the three components of these well-known biological feedstocks. Thus, even if the definition of the feedstock now introduced in claim 1 corresponds to the combination for the most preferred among these minimum amounts, it remains a fact that the patent contains no (even indirect) teachings possibly suggestive that these preferred CTOs were new or at least uncommon feedstocks for producing fuels or that they provided an unexpected advantage.

To the contrary, conventional CTOs very close to the one now defined in claim 1 of auxiliary request 13 are explicitly disclosed in P6, wherein Table 1 shows that Scandinavia CTO comprises 23% resin acids and 20% unsaponifiable compounds ("Unsaps" in Table 1). The last sentence of the first paragraph on page 12 of P6 mentions that "... the neutrals are always slighty higher than the so called 'unsaps'", meaning that the amount of neutral compounds in the Scandinavia CTO is at least 20 mass% as required by claim 1 of auxiliary request 13.
With regard to the resin acid content, the amount disclosed in P6 for the typical Scandinavia CTO (i.e.

23%) is very close to the amount required by claim 1 of auxiliary request 13 (25 mass%) and is within the minor variation that a skilled person would, on the basis of common general knowledge, consider inevitably occurring in many real products of this sort of CTO. Indeed, P6 itself acknowledges on page 12, in the paragraph below the headings "Crude Tall Oil", the common general knowledge relating to the typical CTO compositions given in Table 1, that "[i]ndividual samples may vary considerably from these "typicals"" and depend on the amount of types of woods pulped on any time.

The board hence concludes that it can reasonably be expected that CTOs varying slightly from that identified in P6 certainly existed and were available to the skilled person. Therefore, a feedstock in accordance with the definition of claim 1 of auxiliary request 13 was among the conventional alternatives for CTO also apparent to the skilled reader of P10 who is aiming at the provision of further renewable fuels.

5.3 Accordingly, the selection of a particular conventional feedstock in accordance with the definition thereof specified in claim 1 of auxiliary request 13, remains an arbitrary selection.

Hence, the same reasoning for lack of inventive step as made above for claim 1 of the auxiliary request 8 applies to this version of claim 1 as well.

The subject-matter of claim 1 of the auxiliary request 13 therefore lacks an inventive step, and this request is not allowable, either.

Auxiliary requests 14 to 17

6. Inventive step (Article 56 EPC): claim 1

Claim 1 of these requests (see VI above) differ from the previously discussed auxiliary request 13 only in that they contain further limitations as regards the chemical composition of the fuel.

6.1 As already indicated above in point 3.1, it is undisputed that none of the above modifications of the chemical composition of the fuel produced by the claimed method results in the exclusion of e.g. naphtha compositions or other fuels not suitable as diesel stand alone fuel.

Nor is any of these modifications of the claimed subject-matter (in terms of the chemical composition of the fuel produced by the method of the invention) even just alleged - not to mention proven - in the patent in suit to be surprising or to correspond to a particular advantage.

Hence, even though these requests require further restrictions of the chemical composition of the product obtained by the claimed method the same reasons given above for the conclusion that claim 1 of the auxiliary request 13 (and that of the auxiliary request 8) lacked an inventive step still apply.

The subject-matter of claim 1 of auxiliary requests 14 to 17 are therefore also found to lack an inventive step, and these requests are thus not allowable.

7. Non-admittance into the appeal proceedings of auxiliary request 18

7.1 Auxiliary request 18 is a new request filed with the statement of grounds of appeal and its admittance into the proceedings is subjected to the discretionary power of the board to be exercised in view of Article 12(4) and (6) RPBA 2020.

7.2 The appellant argued that this request had been filed in reaction to the reasons in the decision under appeal relating to the lack of inventive step of auxiliary request 8, in particular in order to address the lack of process features and the absence of a definition of the feedstock (in claim 1 of auxiliary request 8) considered relevant by the opposition division. The appellant also stressed that the main amendments in claim 1 of auxiliary request 18 with respect to that of auxiliary request 8 were taken from granted claims or were amendments implemented in auxiliary requests which had been filed, admitted and discussed during the first instance, and that auxiliary request 18 had been filed at the beginning of the appeal procedure.

7.3 The board notes that on 26 September 2019, i.e. two months before the oral proceedings ending the opposition, the appellant filed fourteen auxiliary requests to address the concerns in the preliminary opinion of the opposition division (dated 7 May 2019) that the sole set of claims then on file (the main request filed on 3 January 2019) lacked an inventive step. Moreover, it is noted that the appellant has even been allowed to file two further requests during the oral proceedings before the opposition division.

Hence, in the board's view, the fact that the decision under appeal also gives (necessarily for the first time in writing) detailed reasons, *inter alia*, for the conclusion of the opposition division that one of the

fifteen auxiliary requests filed just before the final hearing (i.e. auxiliary request 6, renumbered during the hearing as auxiliary request 8) still contravened Article 56 EPC, is no justification for filing a further set of claims at the beginning of the appeal stage in order to address such detailed reasons.

7.4 The board further stresses that the limitation of the claim to "*diesel*" (added at the beginning of claim 1 of the auxiliary request 18) represents a new modification not present in any of the preceding versions of claim 1 on file, in spite of the fact that most of the objections (of lack of novelty and inventive step) raised in the notices of opposition already manifestly related to the fact that patented subject-matter was not limited to diesel fuels or to methods for the productions of diesel fuels.
Also the opposition division's preliminary opinion issued with the summons to oral proceedings (dated 7 May 2019) referred to "fuels" in general when presenting in points 25.7 and 25.8 the reasons for the conclusion that also the then pending (process) claim 6 contravened Article 56 EPC.

Hence, the fact that the decision under appeal (in addressing the objection of lack of inventive step of claim 1 of the auxiliary request 8) states in point 55:

"[t]he opposition division notes that claim 1 does not disclose any feature that refers to a diesel component. Rather, a general process to produce a product of a determined chemical composition, for whichever purpose, is disclosed",

cannot possibly be considered as the first indication in the opposition proceedings of the relevance of the

fact that the claims are not limited to diesel fuels or to methods for the production of diesel fuels.

Thus, there is no new reason in the decision under appeal that could justify the limitation to "*diesel*" fuel for the first time in claim 1 of the auxiliary request 18.

7.5 Accordingly, in the board's view, the appellant could and should have filed requests encompassing such amendment at least during the oral proceedings before the opposition division, if not already with the submissions of 26 September 2019.

7.6 Finally, the board stresses that auxiliary request 18 also does not appear immediately allowable, either. Indeed, a number of issues to be debated have been raised by the respondents, including that the additional indication of the use of multiple catalyst beds and their advantage (manifestly aiming at introducing a further feature distinguishing the claimed subject-matter from the prior art disclosed in the examples of P10) would be already known from P7 (e.g. Figure 1 and example 9 thereof), which had also been cited in writing as an alternative starting point for the evaluation of inventive step. For this reason, this amendment appears *prima facie* not to overcome the objection for lack of an inventive step.

7.7 The board found therefore the filing of the auxiliary request 18 with the statement of grounds of appeal to be belated and detrimental to procedural economy. Thus, the board, using the discretion under Article 12(4) and (6) RPBA 2020 decided not to admit this auxiliary request.

8. As there were no further requests on file, and none of the requests as filed and discussed were considered allowable or admissible, the appeal had to be dismissed.

Order

For these reasons it is decided that:

The appeal is dismissed.

The Registrar: The Chairman:

A. Pinna L. Li Voti

Decision electronically authenticated