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**Datasheet for the decision  
of 9 January 2024**

**Case Number:** T 0437/22 - 3.3.02

**Application Number:** 15774332.9

**Publication Number:** 3127904

**IPC:** C07D301/10, C07D303/04,  
C07B61/00

**Language of the proceedings:** EN

**Title of invention:**  
PROCESS FOR PRODUCING ETHYLENE OXIDE

**Patent Proprietor:**  
Nippon Shokubai Co., Ltd.

**Opponent:**  
BASF SE

**Headword:**

**Relevant legal provisions:**  
EPC Art. 56, 83

**Keyword:**  
Inventive step  
Sufficiency of disclosure

**Decisions cited:**

**Catchword:**



**Beschwerdekammern**

**Boards of Appeal**

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Case Number: T 0437/22 - 3.3.02

**D E C I S I O N**  
**of Technical Board of Appeal 3.3.02**  
**of 9 January 2024**

**Appellant:**

(Opponent)

BASF SE  
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**Representative:**

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**Respondent:**

(Patent Proprietor)

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**Representative:**

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**Decision under appeal:**

**Decision of the Opposition Division of the  
European Patent Office posted on 9 December 2021  
rejecting the opposition filed against European  
patent No. 3127904 pursuant to Article 101(2)  
EPC.**

**Composition of the Board:**

**Chairman** M. O. Müller  
**Members:** S. Bertrand  
R. Romandini

## **Summary of Facts and Submissions**

- I. The appeal by the opponent lies from the opposition division's decision to reject the opposition against European patent No. 3 127 904.
- II. The following documents are referred to in the present decision:
- |      |   |
|------|---|
| D1   | EP 0 893 443 A2                                     |
| D13  | Excerpt of Ullmann's Encyclopedia on ethylene oxide |
| A014 | Annex filed with the statement of grounds of appeal |
- III. In the impugned decision, the opposition division's conclusions included the following:
- The invention as defined in the main request was sufficiently disclosed within the meaning of Article 83 EPC.
  - The subject-matter of the claims according to the main request involved an inventive step in view of D1 as the closest prior art (Article 56 EPC).
- IV. In its statement of grounds of appeal, the opponent ("appellant") contested the opposition division's reasoning. It submitted in particular that the invention defined in the claims according to the main request was not sufficiently disclosed and that the subject-matter of the claims of this request did not involve an inventive step.

- V. In the reply to the grounds of appeal (letter of 2 September 2022), the patent proprietor ("respondent") provided counter-arguments regarding sufficiency of disclosure and inventive step. It submitted auxiliary requests 1 and 2. As a main request, it requested that the appeal be dismissed, implying maintenance of the patent on the basis of the claims as granted (hereinafter "*previous main request*").
- VI. In a further letter, the appellant submitted further arguments on insufficiency of disclosure and inventive step of the claims according to the previous main request. It also objected to the findings of sufficiency of disclosure and inventive step of the claims according to auxiliary requests 1 and 2.
- VII. The board summoned the parties to oral proceedings, as requested by the parties, and issued a communication under Article 15(1) RPBA 2020. In the communication, the board gave its preliminary view that the claims of the original main request met the requirements of sufficiency of disclosure and the subject-matter of these claims involved an inventive step.
- VIII. In a second further letter dated 18 December 2023, the appellant submitted further arguments on sufficiency of disclosure and inventive step of the previous main request. It withdrew its objections to the claims according to auxiliary requests 1 and 2.
- IX. In a subsequent letter, the respondent reiterated its previous requests.
- X. Oral proceedings before the board were held by videoconference on 14 November 2023. During the oral proceedings, the respondent withdrew its previous main request and made auxiliary request 1 as filed with the reply to the grounds of appeal its main request. The

appellant explained that it no longer opposed maintenance of the patent on the basis of either of auxiliary requests 1 or 2 as filed on 2 September 2022.

XI. The parties' requests, where relevant to the decision, were as follows:

The appellant requested:

- that the decision under appeal be set aside and that the previous main request be rejected,
- that the opposition division's decision not to admit D13 into the proceedings be overruled, and
- that A014 be admitted into the proceedings.

The respondent requested:

- that the patent be maintained in amended form on the basis of the set of claims of the main request filed as auxiliary request 1 with the reply to the grounds of appeal (letter of 2 September 2022) or on the basis of the set of claims of auxiliary request 2, also filed with the reply to the grounds of appeal (letter of 2 September 2022),
- that the opposition division's decision not to admit D13 be maintained, and
- that A014 not be admitted into the proceedings.

## Reasons for the Decision

Main request filed as auxiliary request 1

1. During the oral proceedings, the chairman stated that the board was of the view that the claims according to the main request met the requirements of the EPC including Articles 56 and 83 EPC. The reasons were that, in its communication pursuant to Article 15(1) RPBA 2020, the board concluded as a preliminary view that the claims according to the previous main request were inventive and sufficiently disclosed. This conclusion applied to the claims of the main request which were filed as auxiliary request 1.
2. The appellant did not dispute this conclusion at the hearing. Furthermore, as announced in its letter of 18 December 2023, it did not raise any objection to the claims according to the main request which were filed as auxiliary request 1.
3. For its part, the board found no reason to depart from its preliminary view on sufficiency and inventive step. Nor did it see any reason to doubt the compliance of the claims as formulated in the new main request with the other requirements of the EPC which any board should examine *ex officio* in respect of any amended version of a granted patent (see Article 101(3)(a) EPC). The board therefore concluded that the main request was allowable.

## Order

### For these reasons it is decided that:

1. The decision under appeal is set aside.
2. The case is remitted to the opposition division with the order to maintain the patent on the basis of the claims of the main request filed as auxiliary request 1 with the reply to the statement of grounds of appeal of 2 September 2022 and a description and drawings possibly to be adapted thereto.

The Registrar:

The Chairman:



M. Schalow

M. O. Müller

Decision electronically authenticated