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Datasheet for the decision of 20 February 2025

Case Number: T 2589/22 - 3.3.06

Application Number: 15168211.9

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Language of the proceedings: EN

Title of invention:
PROCESS AND APPARATUS FOR PURIFYING MATERIAL OF BIOLOGICAL ORIGIN

Patent Proprietor:
UPM-Kymmene Corporation

Opponent:
Neste Oyj

Headword:
PURIFYING BIOLOGICAL MATERIAL /UPM-Kymmene

Relevant legal provisions:
EPC Art. 56
RPBA 2020 Art. 12(4), 12(6), 12(3), 12(5)

Keyword:
Inventive step - (yes)

Decisions cited:

Catchword:

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Boards of Appeal

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Case Number: T 2589/22 - 3.3.06

D E C I S I O N
of Technical Board of Appeal 3.3.06
of 20 February 2025

Appellant: (Opponent)	Neste Oyj Keilaranta 21 02150 Espoo (FI)
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Respondent: (Patent Proprietor)	UPM-Kymmene Corporation Alvar Aallon katu 1 00100 Helsinki (FI)
Representative:	Hoffmann Eitle Patent- und Rechtsanwälte PartmbB Arabellastraße 30 81925 München (DE)
Decision under appeal:	**Interlocutory decision of the Opposition Division of the European Patent Office posted on 21 October 2022 concerning maintenance of the European Patent No. 2930231 in amended form.**

Composition of the Board:

Chairman	J.-M. Schwaller
Members:	P. Ammendola
	J. Hoppe

Summary of Facts and Submissions

I. The opponent appealed the interlocutory decision of the opposition division maintaining the patent in amended form with the claims of the current main request, of which claim 1 (hereinafter claim 1) reads as follows:

"*1. A process for purifying tall oil material, comprising the following steps*
(a) evaporating the tall oil material in a first evaporation step (E) to produce a first fraction comprising light hydrocarbons and water and a second fraction comprising fatty acids, resin acids, neutral substances and residue components,
(b) evaporating said second fraction in at least one further evaporation step (G; F,G) to produce a third fraction comprising fatty acids, resin acids and light neutral substances, and a residue fraction, and
(c) recovering said first fraction, third fraction and residue fraction,
(d) one or more hydroprocessing step(s) (C2) of converting the third fraction to one or more biofuels or components thereof selected from the group consisting of diesel, jet fuel, gasoline, naphta and fuel gases;
characterized in that the first evaporation step (E) is performed at a temperature of 50 to 250°C and at a pressure of 5 to 100 mbar."

II. According to the contested decision, claim 1 was not obvious when starting from the prior art disclosed in D4 (US 5,705,722 A), a more promising springboard for the assessment of inventive step than that disclosed in any of D1 (WO 2009/131510 A1), D16a (WO 2009/011639A2), D18(US 2009/0163744 A1) or D20 (EP 1 741 768 A1). Even

though D2 ("Tall Oil", Ullmann's Encyclopedia of industrial chemistry, 2005) and D8 (Zinkel et al, "Naval Stores", excerpt 1989) showed that dehydration and depitching of crude tall oil by distillation would be common general knowledge, a skilled person starting from D4 would not be incited to adapt the temperature of the depitching process to the range of the first evaporation step "*(a)*" of claim 1 to reduce "carry over" in the evaporation and hence improve the purification process.

III. With its grounds of appeal, the appellant filed D2a (https://onlinelibrary.wiley.com/doi/book/10.1002/14356007), D34 (US 2004/0230085 A1) and D35 (Perry's Chemical Engineers' Handbook, 7th Ed., 1997, pp. 2-306, 2-307), and requested the revocation of the patent based on Article 83, 54 (based on D28) and 56 EPC (based on D1, D4, D16a, D18, D20, D28 and D34).

IV. The patent proprietor and respondent replied with letter of 4 July 2023, enclosed with eleven sets of amended claims labelled as auxiliary requests 1 to 11. Further it disputed the admittance of D2a, D34 and D35.

V. At the oral proceedings, held on 20 February 2025, the final parties' requests were as follows:

The appellant requested that the decision under appeal be set aside and the patent be revoked.

The respondent requested that the appeal be rejected (main request) or, as an auxiliary measure, that the patent be maintained in amended form based on one of auxiliary requests 1 to 11, as filed with the reply to the appeal.

Reasons for the Decision

1. Main request - Inventive step starting from D4

The finding of the opposition division that D4 represents a suitable starting point for the assessment of inventive step of claim 1 at issue is undisputed, and the board sees no reason to take a different view.

1.1 D4 discloses a process for purifying crude tall oil and converting the purified tall oil into additives for diesel fuels. This prior art process combines the following evaporation and hydroprocessing steps:

- depitching the crude tall oil on a thin film evaporator at 5 to 10 mmHg vacuum (= 6.7 to 13 mbar) and at a temperature of 300 to 320°C (column 3, lines 26-32),
- processing the (intermediate) depitched tall oil through further distillation stages to obtain a finished depitched tall oil (column 3, lines 32-36), and
- hydroprocessing the finished depitched tall oil (column 3, line 3-8).

As also finally undisputed by the appellant, it is apparent that the process of claim 1 for purifying and hydroprocessing a (necessarily impure) tall oil material differs from this prior art in that in the former the tall oil material is subject to a "*first evaporation step (E) at a temperature of 50 to 250°C and at a pressure of 5 to 100 mbar*" to produce and recover from the crude tall oil a "*first fraction comprising light hydrocarbons and water*" (see steps *(a)* and *c)* of claim 1).

1.2 Technical problem solved

1.2.1 In the board's view, several passages of the patent in suit need to be considered to identify the technical advantages deriving from the "*first evaporation step (E)*" and the "*recovering*" of the "*first fraction*" and thus, from the feature that distinguishes the claimed process from the prior art of departure.

In particular, the patent explains:

- in paragraph [0006] that the prior art disclosed in D4 provides a "*poor*" yield in a component of diesel biofuels, because "*a huge amount of valuable raw material for hydrogenation is lost as residue, i.e. pitch*";
- in paragraph [0016] that the initial evaporation of "*water and light components*" from the tall oil material makes the "*further evaporation steps more efficient*" in that it ensures that "*low boiling light components, i.e. components having boiling point of 150-210°C, preferably 150-170°C, at a normal pressure, do not cause so much "carry over", i.e. migrating of the compounds having a boiling point range at the higher end of the above boiling point ranges as well as impurities to the vapour in the subsequent evaporation steps*";
- still in paragraph [0016] that "[t]*he light components can be, if desired, returned back to the material of biological origin or refined further in another process or sold further as such*";
- in paragraph [0037] that the "*light hydrocarbons*" are "*recovered from the first evaporation step E*";
- in paragraph [0044] that the "*first fraction*" may be subjected to separation into water the "*light hydrocarbon fraction*", and
- in paragraph [0082] that from the examples (described in preceding paragraphs [0078] to [0081]) it is obvious that the process of the

invention is "*a very efficient method for removing impurities*" from the tall oil material, since "*the amount of the residue fraction, pitch, is minimized*" and that "[i]*t is also obvious that by using the process according to the invention, light neutral components can be separated to be processed to raw materials for valuable transportation fuel products*".

The board finds that all these teachings allow to identify two distinct technical advantages arising from the initial separation and recovery from the tall oil material of the "*first fraction*". These two technical advantages are namely:
(a) to reduce "*carry over*" and the amount of residue in the "*second evaporation*" (i.e. the depitching step),
(b) rendering easily available other valuable low-boiling derivatives of the tall oil material.

1.2.2 The appellant has disputed the plausible occurrence across the broad scope of claim 1 of the technical advantages over the prior art alleged in the patent in suit, and concluded that these technical advantages could not be used to identify the technical problem solved by the claimed subject matter.

It is instead apparent to the board that, for the reasons given below, at least the above-identified technical advantage (b) plausibly occurs across the scope of claim 1 and thus allows for the identification of the technical problem solved.

Hence, hereinafter the board assumes in favour of the appellant that technical advantage (a) identified above does not plausibly occur across the breadth of claim 1.

1.2.3 The appellant implicitly disputed the occurrence of technical advantage (b) across the scope of claim 1, by stressing that the "*light hydrocarbons*" were not necessarily selectively separated by the claimed process (since the further separation from water of the "*light hydrocarbons*" contained in the "*first fraction*" was not mandatory in the process of claim 1, but rather just a possible embodiment thereof, defined in claim 13 of the patent in suit).

1.2.4 This argument manifestly assumes that only the "*light hydrocarbons*" *per se* (i.e. only after their separation from water) can be regarded as a valuable product of the claimed process for valorising the tall oil material.

However in the board's opinion, a skilled person merely by examining claim 1 itself would already regard the "*first fraction*" as a valuable product. Indeed, the explicit mention of specifically "*light hydrocarbons*" — rather than a more generic term such as "light components" — in said fraction is meaningful only if interpreted as an indication of its substantial value for further uses, as already set out in point 12.3.2 of the board' preliminary opinion.

The value of the "*first fraction*" produced by the claimed process and apparent already from the wording of claim 1 is of course further confirmed by the explanations offered in the patent regarding the separation from such fraction of the "*light hydrocarbons*" and the uses of the latter, including their potential for sale (see 1.2.1 above).

In conclusion, the skilled reader of the patent in suit as a whole understands that, despite its water content,

the combination of "*light hydrocarbons and water*" of the "*first fraction*" has added value compared to the starting tall oil material, because it allows for the selective separation of "*light hydrocarbons*" therefrom.

The board considers it appropriate to emphasise that the indication in claim 1 of the value of the "*first fraction*" also has implications for the technically sound interpretation of the expression "*recovering said first fraction*" in step *c)* of claim 1. Specifically, it necessitates carrying out this "*recovering*" in a manner that facilitates, rather than hinders, its subsequent use for separating therefrom the "*light hydrocarbons*". Accordingly, in the context of claim 1 as maintained, the "*recovering*" of the "*first fraction*" excludes for instance its treatment as waste for disposal, or for any other reason the allocation of pipelines or containers for the recovery of such fraction where large amounts of water and/or other substances different from light hydrocarbons are simultaneously introduced or already present. This technically sound construction of the wording "*recovering said first fraction*" in claim 1 at issue is hereinafter referred to as the recovery for further use of such fraction.

1.2.5 The board also finds that the appellant's submissions that the conditions of the "*first evaporation (E)*" in claim 1 overlap with those specified in claim 3 for the "*second evaporation*" (depitching) step(s) "*(G; F,G)*", are insufficient at rendering plausible that the skilled person willing to effect the "*first evaporation step (E)*" set forth in claim 1, would use conditions for separating and recovering the "*light hydrocarbons and water*" from the tall oil material in e.g. a certain specific evaporation apparatus, that are comparable to, let alone harsher than those that would be used in the

same evaporation apparatus for separating instead higher-boiling components of the tall oil material.

The board incidentally emphasises that none of the other appellant's submissions appear to even just allege, let alone make it plausible that a skilled person would encounter substantial difficulties in adapting the conditions used in step "*(E)*" to any specific tall oil material of departure in such a way to ensure that the "*light hydrocarbons and water*" initially present in the tall oil material are recovered in the "*first fraction*".

Finally, it is apparent to the board that already the variability in terms of composition of the starting tall oil materials and evaporation techniques/ apparatuses might justify the breadth of the ranges in claim 1. Hence, in the absence of evidence to the contrary, the board sees no compelling reason to presume that such ranges are unreasonably broad.

1.2.6 The above considerations are thus sufficient to conclude that the "*first fraction*" that the claimed process aims to recover is in itself a product of the claimed process that is more useful than (the corresponding chemical compounds as initially present in the tall oil material of departure. Therefore, it is apparent that the production and recovery of the "*first fraction*" (at least) ensures across the ambit of claim 1 the technical advantage "(b)" identified in 1.2.1 above (also over the prior art disclosed in D4).

Accordingly, the subject matter of claim 1 at issue is found to plausibly solve vis-à-vis the prior art the technical problem of providing a further process for valorising an impure tall oil material into products

useful for fuel production by combining evaporation and hydroprocessing steps, while also making additional valuable products available.

1.3 Obviousness

1.3.1 According to the appellant the subject-matter of claim 1 would be obvious in view of the combination of the prior art disclosed in D4 with the common general knowledge resumed in D2 and/or D8 (see also D5 and D26). In particular, paragraph 3.2.1 of D2 would render apparent that the fraction collected in the "dehydration" step, that would necessarily precede the conventional dry depitching of crude tall oil contained "turpentine", i.e. light hydrocarbons acknowledged in D2 itself, in the sentence bridging pages 1 and 2, to be (with rosin gum) products obtained "by distillation of exuded oleoresin from wounded living trees" still of high volume and importance.

1.3.2 The board notes that in the process disclosed in D4 the valorisation of components of crude tall oils into products for fuel production occurs exclusively by hydroprocessing depitched tall oil. Moreover, in the prior art of departure a specific depitching step is used (that for instance allows for substantial amounts of unsaponifiables to be present in the depitched product; compare in D4, column 1, lines 58 to end, with the composition fo the "Depitched Tall Oil" in Table A) for which there is no implicit or explicit acknowledgement in D4 that the conditions used for depitching are "conventional".

Finally, the skilled reader of D4 finds in this citation not even an indirect pointer to the presence of light hydrocarbons (or turpentine) in the crude tall

oil of departure and thus, also no disclosure whether these components of crude tall oil might be present in any of the products that are recovered during depitching or the further distillation stages (used in this prior art to produce the "finished" depitched tall oil) or e.g. simply disposed of as waste. Nor is in D4 any other teaching present reminding that "*light hydrocarbons*" (not to mention their mixtures with water) also are of value *per se*.

1.3.3 Hence, the board is not convinced that a skilled person starting from the process of D4 for valorising crude tall oil into fuel additives also by means of hydroprocessing, and searching for the possibility to obtain from crude tall oil further valuable products, could consider immediately relevant the common general knowledge resumed in D2 and/or D8 on the valorisation of crude tall oil by mere fractionation into products that are not meant to be used for fuel production or for hydroprocessing. Hence, it is only with hindsight from the patent that a skilled reader of D4, aiming at obtaining from a tall oil material more sorts of useful products in the context of a process of valorisation of crude tall oil into products for fuel production, would recognise relevant what the skilled person already knows in the context of substantially different processes for the valorisation of crude tall oil. Hence, the board finds that the combination of the process of D4 with the common general knowledge on the fractionation of crude tall oil, as proposed by the appellant, is not apt to call into question inventive step.

1.3.4 In any case, the board additionally stresses that only paragraph 3.2.1 of D2 - among all the documents cited as evidence of common general knowledge by the

appellant - describes a preliminary dehydration of crude tall oil followed by depitching, whereby such dehydration is carried out under conditions encompassed by the ranges recited in claim 1 at issue for the "*first evaporation step (E)*" and is acknowledged to also evaporate turpentine (i.e. light hydrocarbons). Instead, the information provided for instance on pages 356 and 357 of D8, as to the composition of the "Tall Oil Heads" appears not to relate exclusively to the fraction vaporised during the dehydration of crude tall oil preceding depitching.

The board notes further that in said paragraph 3.2.1 of D2, it is merely stated that "[i]*nert combustible gases, water (≈1%), low-boiling compounds such as organic heads (H_1) and turpentine (≈1%) are distilled during the first passage through the evaporator*" (emphasis added).

It is self-evident that this limited disclosure does not even allow for the conclusion as to whether e.g. the distilled compounds including *inter alia* water and turpentine, have all or in part been recovered in a fraction for further use, or for example treated as waste for disposal. Nor is the acknowledgment in the sentence bridging pages 1 and 2 of D2 of the high volume and importance of the production of turpentine "by distillation of exuded oleoresin from wounded living trees" sufficient at rendering plausible that in the conventional dehydration in accordance with D2 the distilled fraction would be recovered for further use.

Thus, even if hypothetically assuming that the skilled person starting from D4 and searching for a solution to the posed problem would consider relevant the common general knowledge resumed in D2 and D8, still the

modification of the process of D4 required to arrive at the subject-matter of claim 1 at issue - namely the recovery for further use of the "*first fraction*" (see 1.2.4 above) - is not derivable at all from said paragraph 3.2.1 of D2.

1.4 Accordingly, the objection of lack of inventive step under Article 56 EPC starting from the prior art disclosed in D4 is found unconvincing.

2. The appellant has submitted further objections of lack of inventive step starting from D1, D16a, D18, D20 and D34.

2.1 Inventive step objection starting from D1 - admissibility

2.1.1 In points 13.1.1 to 13.1.5 of its preliminary opinion, the board found that this objection was *inter alia* insufficiently substantiated according to Article 12(3) RPBA.

2.1.2 As the appellant has not objected to this preliminary conclusion either in writing or during the oral proceedings, the board concludes that this objection has not been substantiated in sufficient details in the statement of grounds of appeal and thus, does not meet the requirements in Article 12(3) RPBA. In this respect it is noted that the whole section 5.1.1 of the statement of grounds of appeal where this objection was presented is essentially devoted to compare the disclosure of D1 with the subject-matter of claim 1, and only gives in paragraph 31 the vague indication that the teachings of D2 are applicable to those of D1. The board therefore exercised its discretion under

Article 12(5) RPBA not to admit this objection into the appeal proceedings

2.2 Inventive step objection starting from the D16a (already raised in opposition)

2.2.1 In point 13.2 of its preliminary opinion, the board indicated that this objection was found unconvincing for the same reason given by the opposition division, namely that the prior art disclosed in D16a was not suitable as starting point for the assessment of inventive step.

2.2.2 The appellant has not objected to this preliminary conclusion either in writing or during the oral proceedings.

2.2.3 The board stresses that (as already indicated in point 13.2 of its preliminary opinion) the appellant's submissions in point 5.1.2.2 of the statement of grounds of appeal appear to imply that, since the decarboxylation step described on page 8 of D16a may also use some hydrogen, the latter could also be considered a step of "hydroprocessing". Further, in the board's knowledge this is however not the case, as also confirmed by the fact that D16a itself uses the term "hydroprocessing" exclusively on page 10, lines 24 to 27, to describe that the product of the decarboxylation step may be subject to a "treatment with hydrogen in one or more hydroprocessing reactors". Finally, the appellant failed to provide any evidence that biofeed decarboxylation methods are conventionally considered to represent a sub-class of the biofeed "hydroprocessing" methods. Hence, the board concludes that the appellant failed to demonstrate erroneous the conclusion of the opposition division that the prior

art disclosed in D16a is far removed from the subject-matter of claim 1 at issue, and as such does not represent a suitable springboard for the assessment of inventive step.

2.2.4 Accordingly, already for these reasons the objection of lack of inventive step (Article 56 EPC) starting from D16a is found unconvincing.

2.3 New inventive step objection starting from D16a: admissibility

2.3.1 In point 8 of its preliminary opinion, the board found that this new objection was belated and manifestly unconvincing and should therefore not be admitted.

2.3.2 The appellant has not objected to this preliminary opinion, either in writing or during the oral proceedings.

2.3.3 The board stresses that (as already indicated in point 8 of its preliminary opinion) this objection - vaguely described in paragraphs 33 to 35 of the grounds of appeal - identifies apparently for the first time the disclosure on page 4, lines 11 to 13 of D16a as a suitable starting point for the assessment of inventive step. Further, the appellant has not demonstrated that this objection was admissibly raised during opposition proceedings and therefore, this objection is deemed to be an amendment according to Article 12(4) RPBA. Finally, the appellant has failed to indicate any reason as to why such new objection has only been submitted at the appeal stage. The board therefore concludes that the filing of this objection has occurred late, without any justification.

2.3.4 Hence the board, exercised its discretion under Article 12(4),(6) RPBA not to admit this new objection taking the disclosure on page 4, lines 11 to 13 of D16a as closest prior art.

2.4 Inventive step starting from D18

2.4.1 The board notes the undisputed fact that the prior art disclosed in D18 does not describe any evaporation step for purifying or fractionating the biomass that is hydroprocessed into hydrocarbons. The absence of such disclosure was the reason for the finding of the opposition division (second paragraph on page 18 of the decision) that also this prior art was not suitable as starting point for the assessment of inventive step.

2.4.2 The appellant has disputed this finding by presenting two lines of reasoning that would instead show that the prior art disclosed in D18 rendered obvious the process of claim 1.

In the first line, the appellant maintained that the "tall oil fatty acids" (TOFA) mentioned in claim 2 of D18 (dependent on claim 1) among the possible starting materials for the hydroprocessing process of this prior art were commercial products typically produced through conventional upgrading by fractionation of crude tall oil, i.e. produced in accordance with the common general knowledge disclosed in D2 and also reflected in D8 and in D5 and D26 cited by the appellant. Hence, by simply carrying out the process of D18 using a commercial TOFA prepared in accordance with D2, a skilled person would have arrived without any inventive step to the subject-matter of claim 1 at issue.

In a second line of reasoning, it submitted that a skilled person who would seek to put into practice the prior art disclosed in D18 must find a method for producing TOFA. Also in that case, the combination D18 with the common general knowledge about conventional upgrading of crude tall oil to TOFA proved by D2 would have brought to the subject-matter of claim 1 at issue without requiring an inventive step.

2.4.3 As to the first line of reasoning, the board is of the opinion that a skilled person would not interpret the wording of steps *a)* to *c)* of claim 1 as encompassing a distinct process possibly ending with commercialising the "*third fraction*" so that this latter may, before undergoing hydroprocessing in step "*d)*", for instance, possibly have been stored for an indefinite time in a depot while awaiting sale, then sold and transported to another firm, potentially anywhere in the world and possibly even multiple times. Hence, already for this reasons it is apparent that carrying out the process of D18 using any specific commercial TOFA cannot lead to an embodiment of claim 1 at issue (regardless as to how the purchased TOFA has been produced).

2.4.4 As to the second line of reasoning, the board notes that in order to put D18 into practice there is no need to prepare TOFA, as these are indisputably commercial products.

2.4.5 Already these consideration are sufficient for the board to conclude that both lines of reasoning starting from D18 are manifestly implausible. The board also finds that the implausibility of the appellant's submissions starting from D18 confirm that the opposition division was right in concluding that this prior art is far removed from the subject-matter of

claim 1 at issue and as such is not apt to call inventive step into question.

2.4.6 The board however considers appropriate to stress that — even in the hypothetical case where it could be deemed obvious for a skilled person, in order to carry out further embodiments of D18, to purchase a TOFA prepared in accordance with the conventional fractionation by evaporation of crude tall oil as disclosed in D2, or to prepare such a TOFA — the disclosure in D2 (or the corresponding general knowledge) cannot, for the reasons already provided in 1.3.4 above, render obvious the recovery for further use of the "*first fraction*", which is a feature of claim 1 at issue. Hence, also on this ground, both lines of reasoning starting from D18 are manifestly not apt to demonstrate a lack of inventive step.

2.4.7 Accordingly, also this objection under Article 56 EPC starting from D18 is found unconvincing.

2.5 New inventive step objection starting from D20: admissibility

2.5.1 In point 9 of its preliminary opinion, the board found that this objection was belated and should not be admitted.

2.5.2 The appellant has not objected thereto either in writing or during the oral proceedings.

2.5.3 The board notes in this respect (as indicated in the preliminary opinion) that the objections of lack of inventive step vaguely described in paragraphs 50, 137 to 144 of the grounds of appeal start either from comparative examples 1 and 2 of D20. As the appellant

has not demonstrated that the objection starting from D20 was admissibly raised during opposition proceedings (Article 12(4) RPBA), this objection is deemed to be an amendment according to Article 12(4) RPBA. Further, the vague statement in paragraph 50 of the grounds of appeal, where the appellant states that the "*same reasoning*" of the objection of lack of inventive step previously presented starting from D18 "*applies similarly to D20*", the same appears (vaguely) repeated in the subsequent paragraphs 137, 141 and 142 of the grounds of appeal.

Hence, the board concludes that this new objection has not been proved to be *prima facie* relevant for the same reasons as found for D18, and could and should have been filed already in the opposition proceedings.

2.5.4 Thus the board exercised its discretion under Article 12(4),(6) RPBA not to admit this new inventive step objection starting from comparative examples 1 and 2 of D20.

2.6 New inventive step objection starting from newly filed D34: admissibility

2.6.1 The filing with the statement of grounds of appeal of D34 and of a (necessarily new) objection of lack of inventive step starting from this document is undisputedly an amendment according to Article 12(4) RPBA.

2.6.2 In point 9 of its preliminary opinion, the board found that this objection was belated and should not be admitted.

2.6.3 At the oral proceedings the appellant submitted that the filing of D34 was in reaction to the error of the opposition division in not recognising that the TOFA used in D18 was a fraction normally obtained by the upgrading of crude tall oil in accordance with the common general knowledge apparent from D2. In D34 it was explicitly indicated that TOFA is a "fraction".

2.6.4 The board notes that the appellant failed to point to any reasons for expecting e.g. that the same TOFA must have been used in both D18 and D34. Nor can the board see how the prior art patent D34 in which TOFA is hydroprocessed according to such invention, can possibly change the evaluation of the disclosure in a different patent (D18) simply because also the latter relates to an invention in which TOFA is listed among the biomasses that may be hydroprocessed. Therefore, as convincingly stressed by the respondent, the information contained in D34 cannot render the disclosure in D18 less remote from the subject-matter of claim 1 at issue.

2.6.5 Accordingly, the board finds unconvincing the appellant's justification for filing D34 at the appeal stage only, and thus exercised its discretion under Article 12(4),(6) RPBA not to admit D34 into the appeal proceedings.

3. Further issues

3.1 As indicated in point 7 of the board's preliminary opinion, there appears to be no point disputed in opposition in view of which D2a could be relevant. As the appellant has thereafter not mentioned D2a, either in writing or during the oral proceedings, the board

had no reason to decide on the admittance of this document.

3.2 Admissibility of D35 and the new argument based thereupon

3.2.1 In point 10 of its preliminary opinion, the board noted that the appellant failed to justify the filing only at the appeal stage of the manifestly new argument (as to an alleged implication of the disclosure in D4) presented in paragraph 148 of the grounds of appeal. The board preliminarily concluded that this argument could and should have been filed already in opposition, and that it appeared based on unsupported allegations and hypothesis, disputed by the respondent. Correspondingly, there also appeared to be no reason to consider D35 that had only been filed to prove the common general knowledge invoked for this new argument.

3.2.2 As the appellant has not objected to this preliminary opinion, either in writing or during the oral proceedings, the board sees no reason to reach a different conclusion.

3.2.3 Hence the board exercised its discretion under Article 12(4),(6) RPBA not to admit the new argument presented in paragraph 148 of the statement of grounds of appeal and D35 into the appeal proceedings.

3.3 Insufficiently substantiated further objections

3.3.1 Lack of sufficient disclosure (Article 83 EPC)

In point 14.1 of its preliminary opinion, the board expressed the opinion that the reasons in point 7.1 of the grounds of appeal failed to identify any error in

the opposition division's reasoning in the second paragraph on page 11 of the contested decision, according to which it would be irrelevant whether or not there existed catalysts capable of hydroprocessing heavy components. Thus the appellant's submissions were insufficient for disputing the finding in the decision under appeal that the subject-matter of claim 1 was sufficiently disclosed.

As the appellant has not objected to this preliminary opinion, either in writing or during the oral proceedings, the board sees no reason to reach a different conclusion and thus, exercised its discretion not to admit this objection in view of Article 12(3), (5) RPBA.

3.3.2 Lack of novelty (Article 54 EPC)

In point 14.2 of its preliminary opinion, the board held that the reasons in point 7.2 of the statement of grounds of appeal failed to identify any error in the opposition division's reasoning in the paragraph bridging pages 14 and 15 of the decision, as to the entitlement to priority of claim 1 at issue. Therefore the appellant also failed to provide reasons for disputing the consequent finding in the decision under appeal that a certain document did not disclose prior art and thus, could not anticipate the subject-matter of claim 1.

As the appellant has not objected to this preliminary opinion, either in writing or during the oral proceedings, the board sees no reason to reach a different conclusion, and exercised its discretion not to admit this objection into the proceedings pursuant to Article 12(3),(5) RPBA.

4. As none of the appellant's objections that were considered in the appeal proceedings was successful, the Board could not accede to its requests.

Order

For these reasons it is decided that:

The appeal is dismissed.

The Registrar: The Chairman:

A. Wille J.-M. Schwaller

Decision electronically authenticated