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Aktenzeichen / Case Number / N° du recours : T 347/86

Anmeldenummer / Filing No / N° de la demande : 81 305 479.8

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Bezeichnung der Erfindung: Method for the modification of fats and oils
Title of invention:
Titre de l'invention :

Klassifikation / Classification / Classement : C11C 3/08

ENTSCHEIDUNG / DECISION

vom / of / du 28 January 1988

Anmelder / Applicant / Demandeur : Fuji Oil Company, Limited

Patentinhaber / Proprietor of the patent /
Titulaire du brevet :

Einsprechender / Opponent / Opposant :

Stichwort / Headword / Référence : Modification of fats and oils/Fuji Oil

EPÜ/EPC/CBE Article 111(1), Rule 86(3)

Kennwort / Keyword / Mot clé : "Substantially amended claims filed at the
appeal stage" - "Remittal to the Examining
Division"

Leitsatz / Headnote / Sommaire

Europäisches
Patentamt

Beschwerdekammern

European Patent
Office

Boards of Appeal

Office européen
des brevets

Chambres de recours



Case Number : T 347/86

D E C I S I O N
of the Technical Board of Appeal 3.3.2
of 28 January 1988

Appellant : FUJI OIL COMPANY, LIMITED
No. 6-1, Hachiman-cho Minami-ku
Osaka-fu/JP
Japan

Representative : Allard, Susan Joyce
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Decision under appeal : Decision of Examining Division 023 of the European Patent Office dated 23 May 1986 refusing European patent application No. 81 305 479.8 pursuant to Article 97(1) EPC

Composition of the Board :

Chairman : P. Lançon

Members : A. Nuss

G.D. Paterson

Summary of Facts and Submissions

- I. European patent application No. 81 305 479.8 was filed on 19 November 1981.

On 10 December 1984, the Examining Division issued a first Communication indicating that in view of the four prior art documents cited, no inventive step could be seen in the features of (original) Claim 1. In addition, it was stated that Claims 2 to 11 related to features that were either known from three of these citations or could be found by a skilled man by routine research procedures and that, therefore, none of the dependent claims could be combined with Claim 1 to afford a patentable main claim.

In reply, a letter from the Appellant was filed on 12 April 1985 in which reasons were submitted why the invention as claimed involved an inventive step over the cited prior art. Apart from the correction of a clerical error in Claim 9, the original claims were left unchanged.

On 16 August 1985, the Examining Division issued a second Communication which indicated that the objection of lack of inventive step as raised in the previous official Communication was maintained. It was further pointed out that the Appellant had not proved any unexpected effect of the claimed process. The Communication ended with the remark that a refusal of the application should be expected.

In reply, the Appellant filed a slightly modified Claim 1 on 18 December 1985, together with additional arguments and evidence in support of an inventive step thereof.

On 23 May 1986, the Examining Division issued a Decision refusing the application on grounds as set out in the preceding Communications, however, in more detailed form.

- II. On 27 June 1986, a notice of appeal was filed together with a debit order for payment of the appeal fee. On 22 September 1986, a written statement setting out the grounds of appeal was filed at the same time as a revised set of Claims 1 to 13 comprising now two independent (method) claims, viz. an amended main claim corresponding to Claim 1 as filed on 18 December 1985 in which the features of original Claims 2, 4 and 5 had been included and a second independent claim, i.e. Claim 8 which was described as comprising "a combination of the features of Claims 1, 2, 5 and 6" of the claims as filed on 18 December 1985.

In response to a communication of the Board, which had only been made in order to clarify matters, the Appellant filed on 12 December 1987 a letter together with another set of claims, which differed mainly from the preceding one in that Claim 8 had been amended by including a certain number of features based on the description and Figure 1. The claims now submitted were presented in the Appellant's reply as a first group of claims (Claims 1 to 7) which are concerned with the modification of one group of fats or oils and a second group of claims (Claims 8 to 13) which are concerned with the modification of a second group of fats or oils. In addition, the Appellant pointed out that Examples 1 and 2 contained in the present application illustrate the invention as now claimed in Claim 8, whilst Examples 5 and 6 illustrate the invention claimed in Claim 1 and that Examples 3 and 4 do not illustrate either the invention claimed in Claim 1 or the invention claimed in Claim 8 (should be deleted).

The statement of grounds of appeal and the reply to the Communication of the Board contain detailed arguments in support of an inventive step of the invention as claimed. In the latter, the Appellant declares, in addition, that he would be willing to file a Divisional Application directed to the invention as claimed in Claims 8 to 13, if necessary.

Reasons for the Decision

1. The appeal complies with Articles 106 to 108 and Rule 64 EPC and is, therefore, admissible.
2. The Applicant's submissions before the Board leave no doubt that he no longer wishes to apply for a patent on the basis of claims as examined and refused by the first instance. In any case, the mere fact that he filed an extensively revised set of claims comprising in particular a new series of claims, i.e. Claims 8 to 13 containing features which obviously had not been examined before, makes it clear that he now applies for a patent on a quite different basis. This may explain his readiness to file a divisional application if need be.

Therefore, the principles established by another Board of Appeal in case T 63/86 dated 10 August 1987 (to be reported) should also be applied in the present case. Thus, for the reasons set out in detail in that decision (see in particular point 2 of the Reasons for the Decision), the Board will not in the present case exercise the discretionary power under Rule 86(3) EPC in relation to the substantial amendments submitted by the Appellant. Where substantial amendments have been proposed which require a substantial further examination in relation to both the formal and substantial requirements of the EPC, such further

examination should be carried out, if at all, only after the Examining Division has itself exercised its discretion under Rule 86(3) EPC. In this way, the Appellant's right to appeal to a second instance is maintained, both in relation to the exercise of discretion under Rule 86(3) EPC, and (if such discretion is favourably exercised) in relation to the formal and substantive allowability of the amended claims. The same applies to the Appellant's request for oral proceedings.

3. In view of the above, the Board has decided to exercise its power under Article 111(1) EPC to remit this case to the Examining Division, in order that it should examine and decide:
 - (a) whether the further amendments to the claims, filed on 12 December 1987, together with Applicant's letter dated 10 December 1987, can be made under Rule 86(3) EPC;
 - (b) if such amendments can be made, whether such claims are allowable.

Order

For these reasons, it is decided that:

The case is remitted to the Examining Division for further prosecution in relation to the proposed amendments filed on 12 December 1987.

The Registrar:



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The Chairman:

