

Veröffentlichung im Amtsblatt Ja / Nein
Publication in the Official Journal Yes / No
Publication au Journal Officiel Oui / Non



Aktenzeichen / Case Number / N° du recours : T 9/87 - 3.3.1

Anmeldenummer / Filing No / N° de la demande : 82 300 770.3

Veröffentlichungs-Nr. / Publication No / N° de la publication : 0 059 059

Bezeichnung der Erfindung: Zeolites

Title of invention:

Titre de l'invention :

Klassifikation / Classification / Classement : C01B 33/28

ENTSCHEIDUNG / DECISION

vom / of / du 18 August 1988

Anmelder / Applicant / Demandeur :

Patentinhaber / Proprietor of the patent /
Titulaire du brevet :

Imperial Chemical Industries PLC

Einsprechender / Opponent / Opposant :

Mobil Oil Corporation

Stichwort / Headword / Référence : Zeolites/ICI

EPO/EPC/CBE Articles 54(1), 99(1), ¹⁰¹and 114(1), Rule 55(c)

Schlagwort / Keyword / Mot clé :

"Extent of opposition limited to three claims"
- "deletion of the three opposed claims" -
"limited power of Opposition Division and Board
of Appeal"

Leitsatz / Headnote / Sommaire

The examination of an opposition under Article 101 EPC is limited by the statement in the Notice of Opposition of the extent to which the patent is opposed. Article 114(1) EPC should be interpreted as subject to Article 101 EPC in this respect. Neither the Opposition Division nor a Board of Appeal has the obligation or the power to examine and decide on the maintenance of the European patent except to the extent to which it is opposed. (see Reasons 3).

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Boards of Appeal

Chambres de recours

Case Number : T 9/87 - 3.3.1



D E C I S I O N
of the Technical Board of Appeal 3.3.1
of 18 August 1988

Appellant :
(Opponent)

Mobil Oil Corporation
150 East 42nd Street
New York, N.Y. 10017 (USA)

Representative :

Cooper John A.
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43 Bloomsbury Square
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Respondent :
(Proprietor of the patent)

Imperial Chemical Industries PLC
Imperial Chemical House
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London SW1P 3JF (GB)

Representative :

Martin, David Lincoln et al.
Imperial Chemical Industries PLC
Legal Department: Patents
PO Box 6, Bessemer Road
Welwyn Garden City, Herts AL7 1HD (GB)

Decision under appeal :

Decision of the Opposition Division of the European
Patent Office dated 31 October 1986 rejecting
the opposition filed against European patent
No. 0 059 059 pursuant to Article 102(2) EPC.

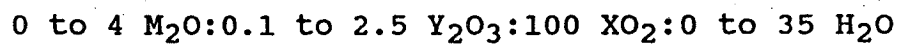
Composition of the Board :

Chairman : K.J.A. Jahn
Members : R.W. Andrews
G.D. Paterson

Summary of Facts and Submissions

- I. The mention of the grant of patent No. 0 059 059 in respect of European patent application No. 82 300 770.3, filed on 16 February 1982 and claiming priority of 23 February 1981 from a prior application in the United Kingdom, was announced on 14 November 1984 (cf. Bulletin 84/46) on the basis of eleven claims. The independent Claims 1, 3 and 11 read as follows:-

"1. A synthetic zeolite material having a molar composition expressed by the formula:



wherein M is sodium, ammonium or hydrogen, Y is one or more of aluminium, gallium, boron, iron, chromium, vanadium, molybdenum, arsenic, antimony and manganese, X is silicon and/or germanium and H₂O is water of hydration additional to water notionally present when M is hydrogen and having the following X-ray diffraction pattern:

| dÅ | 100I/I ₀ |
|-------|---------------------|
| 11.8 | 19 |
| 10.05 | 9 |
| 4.79 | 16 |
| 4.26 | 100 |
| 4.08 | 46 |
| 3.834 | 23 |
| 3.648 | 3 |
| 3.541 | 10 |
| 3.395 | 11 |
| 3.320 | 12 |
| 3.198 | 6 |
| 3.143 | 6 |

| dA | 100I/I ₀ |
|-------|---------------------|
| 3.043 | 5 |
| 2.894 | 8 |
| 2.515 | 12 |
| 2.495 | 13 |

3. A method of making a synthetic zeolite material as defined in Claim 1 which comprises reacting an aqueous mixture comprising at least one oxide XO_2 , at least one oxide Y_2O_3 and at least one piperazine compound.

11. A catalyst comprising a synthetic zeolite material as claimed in Claim 1 or Claim 2."

II. On 2 August 1985 the Appellant filed a notice of opposition on the ground that the subject-matter of the patent was not patentable within the terms of Articles 52 to 57 EPC. The opposition was only brought against Claims 1, 2 and 11 of the patent. The opposition was supported by

(1) US-A-3 832 449 and

(2) GB-A-2 079 735.

III. By a decision dated 31 October 1986 the Opposition Division rejected the opposition on the basis that the subject-matter of the independent Claims 1, 3 and 11 was novel and involved an inventive step.

IV. An appeal was lodged by the Appellant by a duly confirmed telex on 24 December 1986 with payment of the prescribed fee. In the statement of grounds of appeal filed on 2 March 1987 the Appellant reiterated that only Claims 1, 2 and 11 were opposed since the subject-matter of these claims lacked novelty and inventive step in the light of the disclosure in documents (1) and (2). Claims 3 to 10 had deliberately not been opposed.

With his reply to the Respondent's letter of 21 July 1987, in which it was contended that the subject-matter of the opposed claims was novel and inventive in view of the difference, in X-ray patterns and sorption properties of the claimed zeolite and ZSM-12 of document (1), the Appellant submitted affidavits from Dr. M.E. Leonowicz and Dr. G.H. Kuehl. In the light of the evidence in these affidavits it was argued that the product of Example 1 of the disputed patent is clearly a mixture of ZSM-12, α -cristobolite and ferrierite and the presence of such impurities would account for the differences in X-ray patterns and sorption properties of the claimed zeolite.

- V. In a communication of the Board dated 4 May 1988, the preliminary opinion was expressed that the subject-matter of Claims 1, 2 and 11 of the disputed patent lacked novelty. In his reply filed on 8 July 1988 the Respondent filed an amended set of claims in which the opposed claims had been deleted.
- VI. The Appellant requested that the decision under appeal be set aside and that the patent be revoked if any one of Claims 1, 2 and 11 are maintained. The Respondent requested that the patent be maintained in amended form on the basis of Claims 1 to 8 filed on 8 July 1988.

Reasons for the Decision

1. The appeal complies with the requirements of Articles 106 to 108 and Rule 64 EPC and is, therefore, admissible.
2. There are no formal objections under Article 123 EPC to the present set of claims. Present Claims 1 to 8 correspond to Claims 3 to 10 as originally filed and granted.

3. By the deletion of original Claims 1, 2 and 11 the only issue which was raised in the opposition has been overcome.

Article 99(1) EPC provides inter alia that "notice of opposition shall be filed in a written reasoned statement". Rule 55(c) EPC requires that the notice of opposition shall contain "a statement of the extent to which the European patent is opposed" (and of the grounds on which the opposition is based). Opposition proceedings constitute an exception to the general rule under the EPC that a European patent after grant is no longer within the competence of the EPO but becomes a bundle of national patents within the jurisdiction of the designated Contracting States. Opposition proceedings are an exceptional procedure whereby, during a limited period of time, a centralised action for revocation of a European patent may be brought before and decided by the EPO. With this background in mind, in the Board's view, an opponent's statement pursuant to Rule 55(c) EPC of "the extent to which the European patent is opposed", in combination with the grounds of opposition, provides a definition of the issues raised by the opposition and, therefore, of the extent of competence of the EPO in relation to the examination of the opposed European patent under Article 101 EPC. Article 114(1) EPC should be interpreted as subject to Article 101 EPC in this respect.

Applying this principle to the present case, the notice of opposition clearly defined the extent of the opposition as limited to the subject-matter of Claims 1, 2 and 11. The power of the Opposition Division and the Board of Appeal was thereby limited to a consideration of these three claims. Neither the Opposition Division nor the Board of Appeal, therefore, has either the obligation or the power to examine and decide whether the maintenance of the patent

is prejudiced after it has been amended to exclude Claims 1, 2 and 11.

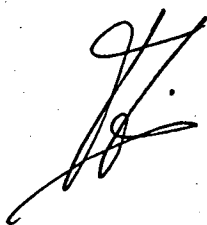
It follows that the patent must be maintained with Claims 1 to 8 as requested by the Respondent (subject to any appropriate amendment of the description). The subject-matter of these claims was not the subject of the opposition proceedings.

Order

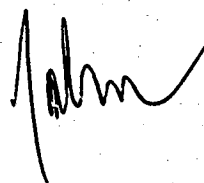
For these reasons, it is decided that:

1. The decision under appeal is set aside.
2. The case is remitted to the first instance with the order to maintain the patent in amended form on the basis of Claims 1 to 8 as filed on 8 July 1988 and a description in a form to be decided by the first instance.

The Registrar:



The Chairman:



LJA

02723

MP