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D E C I S I O N
of 22 May 1995

Case Number: T 0105/93 - 3.3.1

Application Number: 89312902.3

Publication Number: 0432323

IPC: C07C 1/26

Language of the proceedings: EN

Title of invention:

Simultaneous Hydrodehalogenation of two streams containing halogenated organic compounds

Applicant:

UOP

Opponent:

-

Headword:

Hydrodehalogenation/UOP

Relevant legal provisions:

EPC Art. 56, 100, 113(1)

EPC R. 67

Keyword:

"Inventive step (yes; second auxiliary request)"

"Substantial procedural violation (no) - meaning of the term 'grounds' in Article 113(1) - reimbursement of appeal fee refused"

Decisions cited:

G 0010/93

Catchword:

The term 'grounds' in Article 113(1) EPC means the reasoning upon which the EPO has based its decision.



Case Number: T 0105/93 - 3.3.1

D E C I S I O N
of the Technical Board of Appeal 3.3.1
of 22 May 1995

Appellant:

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Representative:

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Decision under appeal:

**Decision of the Examining Division of the European
Patent Office dated 24 August 1992 refusing
European patent application No. 89 312 902.3
pursuant to Article 97(1) EPC.**

Composition of the Board:

Chairman: A. J. Nuss
Members: J. M. Jonk
J. A. Stephens-Ofner

Summary of Facts and Submissions

I. The Appellant (Applicant) lodged an appeal against the decision of the Examining Division on the refusal of the application No. 89 312 902.3. The decision was based on Claims 1 to 10 filed on 30 July 1992, the only independent Claim 1 reading as follows:

"A process for the simultaneous hydrodehalogenation of a first feedstock (1) containing unsaturated, halogenated organic compounds and a second feedstock (4) containing saturated, halogenated organic compounds which process comprises:

(a) reacting said first feedstock (1) with hydrogen in a first reaction zone (2) operated at hydrogenation conditions selected to minimize the polymerization of unsaturated organic compounds and to produce a first effluent stream (3) comprising saturated hydrocarbonaceous compounds;

(b) reacting at least a portion of said first effluent stream (3) and said second feedstock (4) with hydrogen in a second reaction zone (5) operated at hydrogenation conditions selected to dehalogenate said feedstocks (1,4) and to produce a second effluent stream (6) comprising saturated hydrocarbonaceous compounds, unreacted hydrogen and a water-soluble inorganic halide compound; and

(c) recovering a hydrogen-rich gaseous stream (18), a hydrogenated stream (21) comprising hydrocarbonaceous compounds and said water-soluble inorganic halide compound (10) from the second effluent stream."

The Examining Division held that the patent application did not meet the requirements of Article 56 EPC, having regard to the following documents:

- (1) US-A-3 133 013 and
- (2) DD-A-105 194.

They considered that the closest state of the art with respect to the process of Claim 1 was the disclosure of document (2) and that the technical problem to be solved was to avoid polymerisation of unsaturated halogenated compounds occurring under the reaction conditions necessary for the hydrogenative removal of the halogen atoms. Furthermore, they held that the solution of this problem was obvious to the skilled person in the light of the disclosure of document (1), particularly the indication therein that the polymerisation of the unsaturated starting compounds subjected to hydrogenative purification could be overcome by initially saturating the unsaturated compounds under conditions sufficiently mild to avoid polymerisation and then performing a hydrodehalogenation step under more severe reaction conditions. Furthermore, they held that the addition of a second feed of saturated halogenated compounds prior to the hydrodehalogenative reaction did not add anything inventive to the present process. They also noted that the step of dividing the unsaturated feed into a high and a low boiling fraction disclosed in document (1) was not excluded from the present process.

- II. Oral proceedings were held on 22 May 1995.
- III. The Appellant requested that the decision under appeal be set aside and a patent granted on the basis of the following claims:

(i) **main request:**

Claims 1 to 5 filed on 30 July 1992 and original
Claims 6 to 10;

(ii) **first auxiliary request:**

Claims 1 to 6 filed on 29 December 1992;

(iii) **second auxiliary request:**

Claims 1 to 8 submitted during the oral proceedings; and

(iv) **third auxiliary request:**

Claims 1 to 4 also submitted during the oral
proceedings.

In addition, he requested the reimbursement of the
appeal fee on the ground of an alleged substantial
procedural violation.

IV. The wording of the independent Claims 1 according to the
requests on file at the time of the present decision
read as follows:

(i) Claim 1 according to the **main request:**

This Claim, filed on 30 July 1992, is specified above in
Section I.

(ii) Claim 1 according to the **first auxiliary request:**

This Claim corresponds to that of the main request,
except that the first feedstock (1) is defined as:

"selected from fractionation column bottoms formed
in the production of allyl chloride, fractionation

bottoms formed in the production of ethylene dichloride, fractionation bottoms formed in the production of trichloroethylene and perchloroethylene, used dielectric fluid containing polychlorinated biphenyls (PCB) and chlorinated benzene, used chlorinated solvents and mixtures thereof",

and the second feedstock (4) is defined as:

"selected from fractionation bottoms from the purification column in epichlorhydrin production, carbon tetrachloride, 1,1,1 trichloroethane, chlorinated alcohols, chlorinated ethers, chlorofluorocarbons and mixtures thereof";

(iii) Claim 1 according to the **second auxiliary request**:

"A process for the simultaneous hydrodehalogenation of a first feedstock (1) containing unsaturated, halogenated organic compounds and a second feedstock (4) containing saturated, halogenated organic compounds which process comprises:

(a) reacting said first feedstock (1) with hydrogen in a first reaction zone (2) operated at a pressure from atmospheric (0 kPa gauge) to 2000 psig (13790 kPa gauge), a maximum catalyst temperature from 122°F (50°C) to 650°F (343°C) and a hydrogen circulation from 200 SCFB (33.7 normal m³/m³) to 100,000 SCFB (16851 normal m³/m³), said hydrogenation conditions being selected to minimize the polymerization of unsaturated organic compounds and to produce a first effluent stream (3) of saturated hydrocarbonaceous compounds;

(b) reacting said first effluent stream (3) and said second feedstock (4) with hydrogen in a second reaction zone (5) operated at a pressure from atmospheric (0 kPa gauge) to 2000 psig (13790 kPa gauge), a maximum catalyst temperature from 122°F (50°C) to 850°F (454°C) and a hydrogen circulation rate from 200 SCFB (33.7 normal m³/m³) to 50,000 SCFB (8427 normal

m³/m³), at hydrogenation conditions which are more severe than those in step (a) selected to dehalogenate said feedstocks (1,4) and to produce a second effluent stream (6) of saturated hydrocarbonaceous compounds, unreacted hydrogen and a water-soluble inorganic halide compound; and

(c) recovering a hydrogen-rich gaseous stream (18), a hydrogenated stream (21) comprising hydrocarbonaceous compounds and said water-soluble hydrogen halide compound (10) from the second effluent stream."; and

(iv) Claim 1 according to the **third auxiliary request**:

This Claim corresponds essentially to that of the main request, except that the feedstocks (1 and 4) are defined according to the first auxiliary request and the hydrogenation conditions in steps (a) and (b) are specified according to the second auxiliary request.

V. The Appellant disputed that the claimed process was obvious in the light of documents (1) and (2). Neither document related to a treatment of two separate and different feedstocks. Moreover document (1) related to the hydrogenative removal of sulphur, nitrogen and oxygen containing impurities, involving the saturation of unsaturated hydrocarbons being present in the starting material inhibiting the forming of coke and high-molecular weight polymerisation products, and did not suggest any hydrogenation of the saturated materials, originated from the saturation of the starting material, let alone a hydrodehalogenation step. In addition, this document, as a whole, disclosed as essential features the initial fractionation of the feedstock to provide a light and a heavier fraction, the hydrogenation of these fractions in two separate reaction zones, and a further hydrogenative treatment of the combined effluents in a third reaction zone at

higher temperatures, as well as the controlling of the hydrogenation of the light and heavier fractions by recycling a portion of the hydrorefined product effluent obtained in the third reaction zone.

With respect to the request for the reimbursement of the appeal fee, he argued that the decision to refuse the present patent application was based upon grounds different from those set out in the only communication submitted by the Examining Division. Therefore, the Applicant was not afforded the opportunity to reply to these allegedly new grounds.

VI. At the conclusion of the oral proceedings, the Board's decision to allow the Appellant's second auxiliary request was pronounced.

Reasons for the Decision

1. The appeal is admissible.

2. *Main request*

2.1 The subject-matter of present Claim 1 is based on Claim 1, page 7, lines 7 to 11, page 8, lines 5 to 11, and - with respect to the reference signs - page 14, line 29 to page 16, line 19, of the patent application as filed.

The reference signs in present Claims 2 to 4 are also based on page 14, line 29 to page 16, line 19, of the original patent application.

Present Claims 5 to 10 are identical with the respective Claims 5 to 10 of the originally filed patent application.

Thus, all claims of the new set of claims according to the main request comply with the requirement of Article 123(2) EPC.

- 2.2 Pursuant to its powers under Article 114 EPC in appeals from the Examining Division, as explained in G 10/93, paragraphs 3 and 4 of the reasons, the Board has reached the conclusion that the subject-matter as defined in all the claims is novel. As this point was never at issue before the Examining Division, it is not necessary to give reasons for this finding.
- 2.3 This leaves the issue of whether the subject-matter of Claim 1 involves an inventive step.
- 2.4 The Board considers document (2) as the closest state of the art. This document relates to a process for the hydrogenative conversion of saturated and/or unsaturated chlorinated hydrocarbons to dechlorinated hydrocarbons by reacting the chlorinated hydrocarbons with hydrogen in the gasphase at temperatures of 50 to 500°C in the presence of a rhodium catalyst (cf. Claims 1 to 4 and page 7, third paragraph).

However, it was submitted by the Appellant that the dehalogenative treatment of feedstocks comprising unsaturated organic compounds induced polymerisation which lead to undesirable coke-forming. Moreover, there was - as indicated in the description of the original patent application (cf. page 1, lines 13 to 17) - an increasing demand for technology capable of a

simultaneous hydroconversion of a first feedstock comprising unsaturated halogenated organic compounds and a second feedstock comprising saturated halogenated organic compounds.

- 2.5 Therefore, in the light of this closest prior art, the Board sees the technical problem underlying the present patent application as being the provision of a process for the simultaneous hydrodehalogenation of a first feedstock containing unsaturated halogenated organic compounds and a second feedstock containing saturated halogenated organic compounds whilst minimising the polymerisation of the unsaturated compounds giving rise to the forming of undesirable carbonaceous deposits in the processing equipment and in the catalyst (cf. also page 2, lines 28 to 36, of the patent application as filed).

The present patent application suggest, as the solution of this problem, a process according to Claim 1, in which the essential features are (a) the reaction of the first feedstock in a first reaction zone at hydrogenation conditions selected to minimise the polymerisation of unsaturated organic compounds and to produce an effluent stream comprising saturated hydrocarbonaceous compounds and (b) reacting at least a portion of this effluent stream and the second feedstock in a second reaction zone at hydrogenation conditions selected to dehalogenate said feedstocks and to produce a second effluent stream comprising saturated hydrocarbonaceous compounds, unreacted hydrogen and a water-soluble inorganic halide compound.

It follows from the Example of the present patent application that an essentially halogen-free hydrocarbonaceous product, consisting of saturated hydrocarbons, can be obtained without any indication of

undesirable polymerisation (cf. particularly page 19, last paragraph, and Table 3 of the original patent application). Therefore, the Board finds it credible that the technical problem as defined above has been solved.

- 2.6 It remains to be decided whether, in view of the technical problem to be solved, the requirement of inventive step is met by the claimed process.
- 2.7 As indicated above, document (2) relates to a process for the hydrogenative conversion of saturated and/or unsaturated chlorinated hydrocarbons to dechlorinated hydrocarbons by reacting the chlorinated hydrocarbons with hydrogen in the gasphase at temperatures of 50 to 500°C in the presence of a rhodium catalyst. The dechlorinated hydrocarbonaceous product obtained according to this process can also comprise unsaturated hydrocarbons (cf. page 6, last paragraph to page 7, line 9). However, as indicated in the present patent application, it has been discovered that such a process using a feedstock comprising unsaturated organic compounds, is disadvantaged by undesirable polymerisation (cf. page 2, lines 28 to 36, of the application as filed). Thus, document (2) being silent on this deficiency does not give any pointer to the solution of the technical problem as defined above.
- 2.8 Document (1) concerns a process for the hydrorefining of unsaturated hydrocarbons containing feedstocks, such as hydrocarbon distillates, for the purpose of removing contaminants thereof, including sulphurous, nitrogenous and oxygenated compounds, and the production of saturated hydrocarbons, whereby the formation of coke

and other heavy carbonaceous material in the processing equipment and in the catalyst is inhibited (cf. column 1, lines 10 to 21 and 36 to 46; column 1, line 71 to column 2, line 14; and column 2, lines 60 to 65).

The process comprises initially fractionating the feedstock to provide a light fraction having an end boiling point of from about 250°F (121°C) to about 280°F (138°C) and a heavy fraction having an initial boiling point of from about 250°F (121°C) to about 280°F (138°C), separately hydrogenating the light fraction in a first reaction zone and the heavy fraction in a second reaction zone at a temperature less than about 500°F (260°C) in order to effect at least a partial saturation of the highly unsaturated components, combining at least a portion of the effluent from the first reaction zone with at least a portion of the effluent of the second reaction zone, raising the temperature of the resultant mixture and passing the heated mixture into a third reaction zone, effecting further hydrogenation of the mixture at a temperature in excess of about 500°F (260°C) for the purpose of the hydrogenative conversion and removal of the various contaminants and to complete the saturation of the mixture, and recycling at least a portion of the effluent from the third reaction zone to combine with the light and heavy fractions prior to reacting the same in the first and second reaction zones respectively (cf. Claim 1, and column 4, lines 25 to 43).

The document explicitly states that the fractionation and separate hydrogenation of the resulting light and the heavy fractions, as well as the recycling of a portion of the effluent of the third reaction zone to combine with the light and heavy fractions, are essential steps to avoid the problem of the formation of

coke and other heavy carbonaceous materials (cf. column 3, lines 2 to 15; column 4, lines 58 to 63; column 5, lines 62 to 65; and column 6, lines 2 to 6).

Thus, in the Board's judgment, a skilled person faced with the problem of the formation of coke or other heavy carbonaceous materials in a process for the hydrorefining of feedstocks containing unsaturated organic compounds in order to hydroconvert halogenated contaminants and, optionally, sulphurous compounds, nitrogenous compounds and oxygenated compounds (cf. page 7, lines 21 to 27, of the original patent application) to provide a hydrocarbonaceous product, would have taken the technical teaching of document (1), involving the specific initial saturation of the highly unsaturated components of the feedstock, as a promising mean for its solution.

It is true that document (1) does not relate to a simultaneous hydrogenative purification of a first feedstock containing unsaturated organic impurities and a second feedstock containing saturated organic impurities according to process of present Claim 1, but the claimed steps of combining such a second feedstock with the first feedstock after its initial saturation under conditions to avoid the polymerisation problem and further hydrogenating the resulting mixture of saturated organic substances, in the Board's judgment, does not involve any inventive activity because a skilled person would not expect further polymerisation problems nor does the Board see any other foreseeable difficulty that could result from the combination step in question.

The fact that according to the process of present Claim 1 the hydrodehalogenation step is carried out after the saturation of the feedstock, whereas - according to the Appellant's submissions - document (1)

does not suggest a hydrogenation step after the saturation of the unsaturated substances since it indicates (column 6, lines 46 to 57) that the hydrogenative removal of the contaminants already essentially occurs in the first two reactors, wherein the mild hydrogenation conditions are applied, and that the third reactor, wherein higher temperatures are used, only serves to complete the saturation, in the Board's judgment, also does not involve an inventive step. In this context it is observed by the Board that the teaching of document (1) does not exclude that the contaminants such as nitrogenous and sulphurous compounds are partly hydroconverted in the final (third) reaction zone and even after completion of the saturation of the unsaturated substances, because it also teaches that the elevated temperature in reactor 12 (the third reaction zone) is necessary to complete the saturation and to convert any **remaining** nitrogenous and sulphurous compounds into ammonia, hydrogen sulphide and the hydrocarbon counterpart thereof (cf. column 6, lines 37 to 42). In addition, the Board observes that the claimed hydrogenative treatment in the first reaction zone (2) not only provides saturation but also includes dehalogenation (cf. page 7, lines 7 to 27). Furthermore, in the Board's view, a skilled person, having regard to the teaching of document (1), would have understood that, after an appropriate saturation step, no further polymerisation problems could be expected at the hydrogenation conditions to accomplish the desired hydrodehalogenation.

The Board does not accept the Appellant's submission that a skilled person, having regard to the disclosure of document (1) teaching - as indicated above - that the fractionation step, the separate hydrogenation of the resulting light and the heavy fractions, and the recycling of a portion of the effluent of the third

reaction zone to combine with the light and heavy fractions, are essential steps to avoid the problem of the formation of coke and other heavy carbonaceous materials, would not have arrived to the solution of the polymerisation as claimed, either, because the broad formulation of present Claim 1 does not exclude these steps. In this context, it is observed by the Board that according to Claim 1 (cf. under point (a)) the first feedstock (1), containing the unsaturated substances, is reacted with hydrogen **at hydrogenation conditions selected to minimise the polymerisation of unsaturated organic compounds**, which conditions, in the Board's judgment, do not exclude a fractionation step and a separate hydrogenation of the resulting light and heavy fractions. Furthermore, present Claim 1 (cf. under point (b)) also claims that at least **a portion** of the effluent of the first reaction zone is combined with the second feedstock, so that, in the Board's view, the recirculation of the rest of said effluent to the first feedstock prior to its reaction in the first reaction zone is not excluded too.

2.9 It follows, that the subject-matter of Claim 1 according to the main request lacks inventive step and, thus, does not comply with Article 56 EPC.

3. *First auxiliary request*

3.1 Claim 1 of this request differs from that of the main request only in that the feedstocks (1 and 4) are defined as indicated above under point IV, item (ii).

The subject-matter of these additional features is based on page 6, lines 19 to 31, of the original patent application.

Claims 2 to 6 according to this request are identical with the Claims 2, 3, 4, 7 and 8 of the main request.

Therefore, the claims of this auxiliary request also comply with the requirements of Article 123(2) EPC.

3.2 Since the subject-matter of present Claim 1 according to this request only differs from that of Claim 1 of the main request in that the first feedstock (1) containing unsaturated halogenated organic compounds and the second feedstock (4) containing saturated halogenated organic compounds are limited and more specified, whereas the process features for their simultaneous hydrodehalogenation are identical to those of Claim 1 of the main request, in the Board's judgment, the considerations indicated above with respect to the subject-matter of Claim 1 according to the main request, particularly regarding the closest prior art, the definition of the technical problem to be solved, the solution of this technical problem and the teaching of document (1) in relation to the required inventive step, also apply to the subject-matter of Claim 1 of this request.

3.3 Thus, the Board concludes that the claimed solution of the technical problem to minimise the polymerisation problems owing to the unsaturated compounds in the first feedstock as defined in present Claim 1 would also have been obvious to the skilled person. Therefore, the subject-matter of Claim 1 according to the first auxiliary request does not involve the required inventive step either.

4. *Second auxiliary request*

- 4.1 Claim 1 of this request (see point IV, item (iii) above) differs from that of the main request in that
- the hydrogenation conditions in the first reaction zone (2) and in the second reaction zone (5) are limited and specified as indicated under points (a) and (b) of the Claim,
 - the composition of the first effluent stream (3) is precised by indicating that it consists of (instead of "comprises") saturated hydrocarbonaceous compounds,
 - it indicates that the first effluent stream (3) as such (instead of "at least a portion") is combined with the second feedstock (4) and further treated as claimed under point (b), and in that
 - a water-soluble hydrogen halide compound (instead of "a water-soluble inorganic halide compound") is recovered as indicated under point (c).

The subject-matter of these additional features is based on page 7, line 1 to page 8, line 29 and page 10, lines 6 to 30, particularly lines 23 to 30, of the original patent application.

Claims 2 to 8 according to this request are based on the Claims 2 to 6, 9 and 10 of the main request.

Therefore, the claims of this auxiliary request also meet the requirements of Article 123(2) EPC.

- 4.2 Again the issue to be dealt with is whether the subject-matter of the present Claim 1 according to this request involves an inventive step.

- 4.3 As has already been stated in relation to the main request, the closest state of the art is considered by the Board to be document (2). Furthermore, in the light

of this closest prior art, the Board sees the technical problem underlying the present patent application according to this request as being, again, the provision of a process for the simultaneous hydrodehalogenation of a first feedstock containing unsaturated halogenated organic compounds and a second feedstock containing saturated halogenated organic compounds whilst minimising the polymerisation problems of the unsaturated compounds giving rise to the forming of undesirable carbonaceous deposits in the processing equipment and in the catalyst.

4.4 According to the present Claim 1, this technical problem is essentially solved by hydrogenating the first feedstock under hydrogenation conditions specified under (a) to provide an effluent stream (3) of saturated hydrocarbonaceous compounds and by hydrogenating a mixture of this effluent stream and the second feedstock (4) under hydrodehalogenation conditions indicated under (b), which are more severe than the hydrogenation conditions specified under (a), to produce an effluent stream (6) of saturated hydrocarbonaceous compounds, unreacted hydrogen and a water-soluble hydrogen halide.

4.5 In view of the Example in the present patent application showing that after the first hydrogenation step, which is carried out under the now claimed hydrogenation conditions (temperature, pressure and hydrogen feed) and without an initial fractionation step and/or recirculation step of produced saturated hydrocarbonaceous products, the resulting effluent only comprises saturated organic compounds (cf. the composition indicated in Table 1 compared with that of Table 2), that after the second step carried out under the specified hydrodehalogenation conditions the resulting effluent only contains traces of halogenated organic compounds which can be practically completely

removed in an additional hydrodehalogenation step (cf. the first paragraph under Table 2 and the second paragraph on page 19 of the originally filed patent application), the Board is satisfied that this technical problem is credibly solved.

- 4.6 In the Board's judgment, the proposed solution of the above-defined technical problem involves an inventive step, because the cited prior art documents (1) and (2) do not give any suggestion to the skilled person that this problem could be solved by the process as claimed.

Document (2) relating to the hydrodehalogenation of unsaturated hydrocarbonaceous material - as set out above under point 2.7 - being silent on the polymerisation problem does not give any pointer to the solution of the technical problem as defined above.

Furthermore, document (2), which involves - as set out under point 2.8 above - the fractionation and separate hydrogenation of the resulting light and the heavy fractions, as well as the recycling of a portion of the effluent of the third reaction zone to combine with the light and heavy fractions, as essential steps to avoid the problem of the formation of coke and other heavy carbonaceous materials, clearly leads away from the now claimed solution which - as indicated above - does not comprise these steps.

- 4.7 Dependent Claims 2 to 8, which relate to the preferred embodiments of the process claimed in Claim 1, are also allowable for the reasons stated above.

5. Since the claims according to the second auxiliary request are allowable, there is no need to consider the third auxiliary request.

6. *Request for the refund of the appeal fee*

In his Statement of Grounds of Appeal, the Appellant alleged, in support of his request for the refund of the appeal fee under Rule 67 EPC by reason of a substantial procedural violation, that the decision to refuse the present patent application was taken on the basis of assertions which were different from those set out in the Examining Division's communication dated 3 April 1992. In particular, he submitted that rather than repeating or amplifying the arguments contained in the said communication, the decision of the Examining Division had approached the reasoning on lack of inventive step from a different angle by starting with document (2) instead of document (1) and then arguing that the problem of polymerisation would have been solved by the disclosure of the other document, thus amounting, in effect, to a decision given on a wholly different basis. Indeed, in his notice of appeal, the Appellant went so far as to state that the decision had been rendered upon "grounds" entirely different from those set out in the above communication.

In the course of the oral proceedings in the appeal, he again argued that the "basis" or "ground" upon which the Examining Division's decision had been rendered was entirely different from the one set out in the above communication.

In the Board's view, whilst the term "grounds" does have a strict legal meaning under Article 100 EPC, in the present context the term "grounds" and the term "basis" amount to the same thing, namely the **reasoning** upon which the first instance based its decision. Thus, in Article 113(1) EPC providing that decisions of the EPO (including its judicial organ the Boards of Appeal) may only be based on "grounds or evidence on which the

parties concerned have had an opportunity to present their comments", the term "grounds" has the same meaning as "basis" or "reasons". What is essential is for a party affected by a decision, either of the first instance or of the Board of Appeal, to have had an **opportunity** to present its comments upon the basis upon which such a decision has been rendered. In the present case, the communication of April 3, 1992, in addition to elaborating on an express objection, more than merely foreshadowed, without however explicitly spelling it out, an alternative ground or basis (in the above sense) of objection which turned out to be the same one upon which the decision under appeal was rendered. In particular, it indicated that the objection of lack of novelty was based on documents (1) and (2), and that the polymerisation problem was solved according to document (1) by hydrogenating the unsaturated compounds to saturated compounds under mild conditions and by treating the saturated compounds to the more severe hydrodehalogenation conditions known from document (2).

It is accordingly quite clear to the Board that the required degree of an **opportunity** to present comments on such an, admittedly, implicit "ground" or "basis" had been afforded at all relevant times. Whilst the Board does have some sympathy with the Appellant's submission that where a communication from the EPO contains implicit as well as explicit objections, attention and response is routinely confined by his representatives only to the express ones in order to save time and effort, such a failure to take advantage of the opportunity afforded to respond, in compliance with Article 113(1) EPC, cannot in itself negate the presence of that opportunity. Accordingly, the Board finds that

the Appellant had indeed been afforded the legally required degree of opportunity to respond to the case that was put against him, and therefore rejects his request for the refund of the appeal fee.

Order

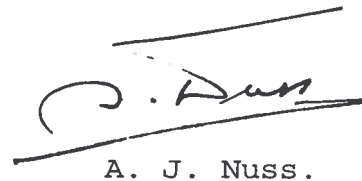
For these reasons it is decided that:

1. The Examining Division's decision is set aside.
2. The case is remitted to the Examining Division with the order to grant a patent on the basis of the second auxiliary request after appropriate amendment of the description.
3. The request for reimbursement of the appeal fee is refused.

The Registrar:


E. Gorgmaier

The Chairman:


A. J. Nuss.