

**Internal distribution code:**

- (A) [ ] Publication in OJ  
(B) [ ] To Chairmen and Members  
(C) [X] To Chairmen

**D E C I S I O N**  
of 10 January 1997

**Case Number:** T 0114/94 - 3.2.4

**Application Number:** 85902485.3

**Publication Number:** 0180630

**IPC:** B28B 7/38

**Language of the proceedings:** EN

**Title of invention:**

A method for improving the release of a moulded concrete body from the mould

**Patentee:**

CASTROL A/S

**Opponent:**

Karlshamns AB

**Headword:**

-

**Relevant legal provisions:**

EPC Art. 111(1)

**Keyword:**

"Remittal to opposition division"

**Decisions cited:**

T 0023/86, T 0222/87

**Catchword:**

-



Case Number: T 0114/94 - 3.2.4

**D E C I S I O N**  
of the Technical Board of Appeal 3.2.4  
of 10 January 1997

**Appellant:** CASTROL A/S  
(Proprietor of the patent) Esplanaden 7  
DK - 1263 Copenhagen K (DK)

**Representative:** Andersen, Henrik Rastrup  
c/o Plougmann & Vingtoft A/S  
Sankt Annae Plads 11  
P.O. Box 3007  
DK - 1021 Copenhagen K (DK)

**Respondent:** Karlshamns AB  
(Opponent) Västra kajen  
SE - 374 82 Karlshamn (SE)

**Representative:** Norin, Klas  
Kooperativa förbundet  
Patent Department  
P.O. Box 15200  
SE - 104 65 Stockholm (SE)

**Decision under appeal:** Decision of the Opposition Division of the  
European Patent Office posted 14 December 1993  
revoking European patent No. 0 180 630 pursuant  
to Article 102(1) EPC.

**Composition of the Board:**

**Chairman:** C. A. J. Andries  
**Members:** M. G. Hatherly  
J. -P. Seitz

## Summary of Facts and Submissions

- I. The decision of the opposition division to revoke European patent No. 0 180 630 (resulting from application No. 85 902 485.3) was dispatched on 14 December 1993. On 14 February 1994 the appellants (proprietors) filed an appeal against this decision and paid the appeal fee. The Statement of Grounds of Appeal was received on 14 March 1994.
- II. The version of the patent decided upon in the decision of the opposition division was the version as granted, having an independent method claim 1 (with claims 2 to 30 dependent thereon) and an independent claim 31 to an oil-in-water emulsion.

The opposition division stated in the decision that:

- "... the subject-matter of claim 31 of the patent-in-suit is thus not new over the content of D3" ie document US-A-4 237 021, see the Reasons for the Decision, the paragraph bridging pages 4 and 5;
- "As regards the subject-matter of process claims 1-30, this is clearly new over the prior art documents cited by the opponent (this has not been disputed by the Opponent)", see the Reasons for the Decision, section II, 2.2, the first complete paragraph on page 5;
- "Since none of the documents cited by the Opponent suggest using the composition as defined in present claim 1 to solve the above problem, an inventive step should be recognized to the

subject-matter of present claims 1-30", see the Additional Remarks, the last paragraph of section 1.3 on page 6; and

- "The composition defined in present claim 1 should be amended to meet the requirements of clarity, because the sum of the individual components of said composition is in certain cases greater than 100%, what is contrary to Article 84 EPC", see the Additional Remarks, section 2 on pages 6 and 7.

III. In the paragraph bridging pages 1 and 2 of the statement of grounds the appellants write that:

- "... we therefore request that the patent be maintained on the basis of claims 1-30. An amended claim set is enclosed in which claim 31 has been cancelled. Furthermore, while we believe it is obvious that the sum of the components defined in claim 1 cannot exceed 100%, we have chosen to amend claim 1 as granted along the lines suggested by the opposition division in its decision so that the sum of the individual components does not exceed 100%."

IV. The present version of claim 1 is as follows:

"A method for improving the release of a moulded concrete body from the mould by applying an effective amount of a concrete release composition to the mould, said composition being an oil-in-water emulsion containing water in an amount of 10-90% by weight of the total emulsion, an oily component in an amount of 10-90% by weight of the total emulsion, one or more non-ionic surfactants in an amount of 0.5-20% by weight of the total emulsion, and one or more anionic surfactants provided as a sodium, potassium, lithium,

ammonium or a lower alkylamine, lower alkyl-alkanolamine or lower alkanolamine salt of at the most 8 carbon atoms or a mixed salt, in which the amount of the anionic surfactant in relation to the non-ionic surfactant is 1-100% by weight and with the proviso that the sum of ingredients in the composition does not exceed 100%."

- V. In the letter of 25 February 1994 to the representatives of the respondents, the Registry of the Boards of Appeal stated that an appeal had been filed by the proprietors and enclosed a copy of the appeal.

In the letter of 22 March 1994 to the representatives of the respondents, the Registry enclosed a copy of the grounds of appeal and stated that "Any submissions in answer hereupon must be filed within four months."

No reply to either letter has been received from the respondents or their representatives.

- VI. The appellants request that the decision be set aside and the patent maintained amended in the following version:

Claims: 1 to 30 filed with the statement of grounds of appeal

Description: page 2 to page 32, line 32 of the patent as granted

### Reasons for the Decision

1. The appeal is admissible.

2. The reason for revoking the patent given by the opposition division in the Reasons for the Decision (see the paragraph bridging pages 4 and 5) is that the subject-matter of claim 31 of the patent-in-suit is not new.

The appellants have responded in the statement of grounds of appeal by deleting claim 31.

Thus the sole cause for the revocation given in the Reasons for the Decision has been removed.

3. The opposition division adds in the Reasons for the Decision that the subject-matter of claims 1 to 30 is new (see the first complete paragraph on page 5) and in the Additional Remarks that the subject-matter of the claims 1 to 30 (as granted) is inventive (see the last paragraph of section 1.3 on page 6).

It is perfectly clear from the statement of grounds of appeal that the appellants are making a bona fide attempt to meet the points made by the opposition division in its decision. However the respondents (opponents) have not reacted in the appeal proceedings. Since they were informed by letter of 25 February 1994 of the existence of the appeal and were given the opportunity by letter of 22 March 1994 to comment on the grounds of appeal, the board concludes that the respondents at present have no objection to maintenance of the patent in the form proposed by the appellants, the most important amendment being the deletion of claim 31.

The board has been given in the appeal proceedings no reason by the respondents and itself sees no reason to disagree with the opposition division's view of the novelty and inventivity of the subject-matter of claims 1 to 30 as granted.

4. The opposition division's sole comment against a future maintenance of the patent in amended form on the basis of claims 1 to 30 as granted is the comment that claim 1 as granted needs amendment because it is unclear.

The board notes that, if one has the commonplace claim to a mixture with proportions given for its constituents, then one could postulate a mixture with the maximum proportion of each constituent but then the proportions would add up to more than the requisite total (100% in the case of percentages). However it is self evident to the skilled person that if he is to take the maximum proportion of one constituent then he needs to take a smaller than the maximum proportion of one or more of the other constituents so that the requisite total is not exceeded. This situation is inherent in this type of claim and does not render it unclear.

However the opposition division, while appearing to summarise the above situation by stating concerning claim 1 as granted that "the sum of the individual components of said composition is in certain cases greater than 100%", without further comment finds claim 1 as granted unclear.

This clarity objection seems to be - according to the opposition division - the only objection standing between the appellants and the maintenance of the patent but it is an objection which, on the face of it, is itself not clear.

5. The opposition division's comment is made in section 2 on pages 6 and 7 in the Additional Remarks instead of in the Reasons for the Decision presumably because it is the first time in the opposition proceedings that the question of the clarity of claim 1 has arisen.

Accordingly the proprietors (now the appellants) had no opportunity in the opposition proceedings to reply to the comment made against their patent that claim 1 as granted is unclear.

The board therefore wishes to exercise its power under Article 111(1) EPC to remit the case to the opposition division for further prosecution on the basis of the claims 1 to 30 filed with the statement of grounds of appeal and the description page 2 to page 32, line 32 of the patent as granted.

However the board wishes to emphasise that clarity is not a ground for opposition so that in normal cases a granted, unamended independent claim should be understood as it stands, having regard if necessary to the description and drawings, see decision T 0023/86(OJ EPO 1987, 316).

6. While remittal means that the board is not granting the appellants' main request for maintenance of the patent, it does mean that the decision is being set aside and the appeal is not being dismissed. Accordingly there is no need to appoint the oral proceedings requested auxiliarily by the appellants, see decision T 0222/87, section 5, not published.

It is pointed out that this auxiliary request for oral proceedings is a request in the present appeal proceedings and will have no effect in the further proceedings before the opposition division.



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 that the further prosecution be based on the following documents:

Claims: 1 to 30 filed with the statement of grounds of appeal

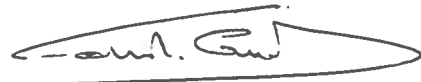
Description: page 2 to page 32, line 32 of the patent as granted.

The Registrar:



N. Maslin

The Chairman:



C. Andries

