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D E C I S I O N
of 9 May 1996

Case Number: T 0740/94 - 3.2.3

Application Number: 88906164.4

Publication Number: 0365584

IPC: B05D 5/00

Language of the proceedings: EN

Title of invention:
Contamination removal process

Patentee:
Polysaccharide Industries

Opponent:
I. P. de Smit
II. Kaul GmbH
III. Fina Research

Headword:
-

Relevant legal provisions:
EPC Art. 100(b)
EPC R. 67

Keyword:
"Remittal to the Opposition Division (full examination)"
"Reimbursement of the appeal fee (substantial procedural violation)"

Decisions cited:
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Catchword:
-



Case Number: T 0740/94 - 3.2.3

D E C I S I O N
of the Technical Board of Appeal 3.2.3
of 9 May 1996

Appellant:
(Opponent II)

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Representative:

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Party as of right:
(Opponent I)

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Representative:

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Party as of right:
(Opponent III)

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Representative:

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Respondent:
(Proprietor of the patent)

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Representative:

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Decision under appeal:

Interlocutory decision of the Opposition Division
of the European Patent Office dated 19 May 1994,
posted on 12 July 1994 concerning maintenance of
European patent No. 0 365 584 in amended form.

Composition of the Board:

Chairman: C. T. Wilson
Members: F. Brösamle
L. C. Mancini

Summary of Facts and Submissions

I. In the oral proceedings of 18 May 1994 the Opposition Division upheld European patent No. 0 365 584 in amended form; the written decision within the meaning of Article 106(3) EPC was posted on 12 July 1994.

II. The independent claim upheld with the above decision reads as follows:

"1. A process for facilitating the removal of undesired graffiti type contamination from a surface, comprising the steps:

- (a) applying a solution containing a polysaccharide and a solvent therefor onto said surface before it is subjected to contamination, said polysaccharide being capable of forming a redissolvable or swelling solid film upon drying;
- (b) allowing the applied solution to dry to form a solid film on said surface;
- (c) treating the coated surface with a liquid capable of redissolving the film or providing swelling thereof; and
- (d) removing the undesired contamination by removing only the dissolved or swelled surface layer of the film."

III. Opponent II Kaul GmbH - appellant in the following - lodged an appeal against the above decision on 9 September 1994 paying the appeal fee on the same day. The statement of grounds of appeal was filed on 9 November 1994.

He requests to set aside the impugned decision and to revoke European patent No. 0 365 584 since "the process as claimed is not practicable" and "the patent does not disclose the invention in a manner sufficiently clear and complete for it to be carried out by a person skilled in the art (Article 100(b) EPC)".

In this connection an opinion of the "Institut für Bautenschutz und Bausanierung GmbH" - "Gutachten IBB" in the following - dated 30 October 1994 is filed as evidence "that the process according to claim 1 is not practicable" since it was not possible to remove only a portion of the film, namely the dissolved or swelled layer of the film containing the contamination.

- IV. Opponent III in his capacity as a non-appealing party as of right, Article 117 EPC, supported the findings of the appellant and also requests the revocation of the patent.

- V. The proprietor - respondent in the following - requests to dismiss the appeal (and to maintain the patent).

- VI. Following the communication dated 27 October 1995, in which the Board commented on an apparently new ground of opposition, with reference to Enlarged Board of Appeal's decision G 10/91, OJ 93, 420, the respondent withheld his approval to discuss any objection under Article 100(b) EPC and maintained the request to dismiss the appeal, (see letter of 1 February 1996), whereas the appellant pointed to the minutes of the oral proceedings held on 18 May 1994, page 3 first paragraph which reads:

"The **opponent 2** argued that it is technically impossible to remove only the surface layer of a very thin polysaccharide film. Any treatment with water would inevitably remove the film as a whole, as in the normal practice with coatings."

and follows therefrom that "an objection under Article 100(b) EPC was already raised before the Opposition Division". He contends that this situation was created by the respondent by modifying Claim 1 i.e. claiming an embodiment "which - as shown by Test Reports - does not work." so that the Board should consider the objection under Article 100(b) EPC and "Gutachten IBB" and revoke the patent.

The party as of right also argued that Article 100(b) EPC is not a fresh ground of opposition and that the objection "was actually raised **before the Opposition Division**, although Article 100(b) was not cited expressis verbis." The patent should accordingly be revoked.

Reasons for the Decision

1. The appeal of opponent II is admissible.
2. *Amendments to claim 1*
 - 2.1 With respect to granted claim 1 the "undesired contamination" was changed into "undesired graffiti type contamination". This modification of Claim 1 is clearly allowable since in EP-B1-0 365 584, see column 1 line 22 or column 5 lines 9 to 11, this type of contamination is clearly mentioned, Article 123(2) EPC.

With respect to the requirements of Article 123(3) EPC it is obvious that the extent of protection is narrowed by inserting "graffiti type" so that the requirements of Article 123(3) EPC are met.

- 2.2. The second modification of granted Claim 1 concerns its characterizing feature "d" in which the word "only" has been inserted. This refers merely to removing the film not in its totality but only its dissolved or swelled surface layer.

This feature is supported by the reference in the original application documents, (e.g. page 2, lines 7, 8) to the removal of at least the surface layer.

3. *Objection under Article 100(b) EPC*

- 3.1 In the light of the reference on page 3, first paragraph of the minutes dated 12 July 1994 of the oral proceedings held before the Opposition Division, which reads:

"The opponent 2 argued that it is technically impossible to remove only the surface layer of a very thin polysaccharide film. Any treatment with water would inevitably remove the film as a whole, as it is the usual practice with sacrificial coatings."

it is clear that an objection under Article 100(b) EPC had already been raised before the Opposition Division.

- 3.2 The failure of the Opposition Division to deal with this objection against an amended claim in its decision to maintain the patent in amended form, clearly constitutes a substantial procedural violation, (see G 10/91, paragraph 19).

3.3 The Board therefore considers that it would be more appropriate now to set aside the decision under appeal and avail itself of its powers under Article 111(1) EPC in order to remit the case to the Opposition Division for further prosecution.

3.4 It is obvious that newly filed evidence "Gutachten IBB" has to be allowed in to the proceedings under Article 114(1) EPC since it is directly linked to the issue of the further examination.

4. *Reimbursement of the appeal fee*

In the present case, the requirements of Rule 67 EPC are fulfilled: the Board deems the appeal allowable and the reimbursement of the appeal fee is ordered since such reimbursement is clearly equitable by reason of the substantial procedural violation.

Order

For these reasons it is decided that:

1. The impugned decision is set aside.
2. The case is remitted to the Opposition Division in order to carry out a full examination of the issue of Article 100(b) EPC including the evidence filed by the appellant in this respect.
3. The reimbursement of the appeal fee is ordered.

The Registrar:



N. Maslin

The Chairman:



C. T. Wilson