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**D E C I S I O N**  
of 30 July 1996

**Case Number:** T 0169/96 - 3.3.1  
**Application Number:** 89109785.9  
**Publication Number:** 0344733  
**IPC:** C07C 409/16

**Language of the proceedings:** EN

**Title of invention:**  
Novel antioxiant-peroxides and their use

**Applicant:**  
ELF ATOCHEM NORTH AMERICA, INC.

**Opponent:**  
-

**Headword:**  
Main and auxiliary request/ELF ATOCHEM

**Relevant legal provisions:**  
EPC Art. 18(2), 111(1), 113(2), 82  
EPC R. 9(3), 51(4), 67, 68(2)

**Keyword:**  
"Refusal on basis of auxiliary request without decision on main request"  
"EPO bound to order of requests"  
"Reimbursement of the appeal fee (yes)"  
"Unity of invention (yes)"

**Decisions cited:**  
G 0002/88, G 0006/88, G 0010/93, T 0234/86, T 0484/88,  
T 0079/89, T 0999/93

**Catchword:**  
-



Case Number: T 0169/96 - 3.3.1

**D E C I S I O N**  
of the Technical Board of Appeal 3.3.1  
of 30 July 1996

**Appellant:** ELF ATOCHEM NORTH AMERICA, INC.  
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Philadelphia  
Pennsylvania 19102-3222 (US)

**Representative:** Abitz, Walter, Dr.-Ing.  
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**Decision under appeal:** Decision of the Examining Division of the European Patent Office posted 7 September 1995 refusing European patent application No. 89 109 785.9 pursuant to Article 97(1) EPC.

**Composition of the Board:**

**Chairman:** A. J. Nuss  
**Members:** R. K. Spangenberg  
R. E. Teschemacher

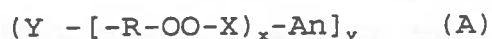
### Summary of Facts and Submissions

- I. European patent application No. 89 109 785.9 was filed on 31 May 1989, claiming a priority of 31 May 1988.
- II. In the course of substantive examination, the Examining Division raised several objections, inter alia it observed that Claim 1 as filed related to more than one invention, with respect to the state of the art represented by

D1: Hucek et al., J. Am. Chem. Soc., Vol. 95 (14), pages 4698 to 4705 (1973).

With letter dated 24 March 1994, the Applicants filed four sets of claims as main request and auxiliary requests I to III.

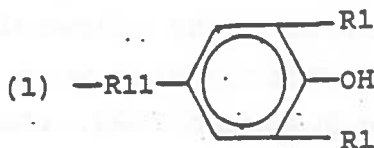
Claim 1 of the main request related to the use of an antioxidant-peroxide compound for producing polymeric compositions of enhanced oxidative stability, which compound had the structure A:

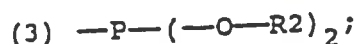
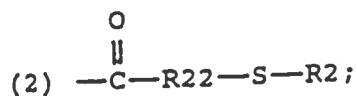


where x and y are 1 or 2, but when x is 2, y can only be 1, and when y is 2, x can only be 1 and with the following provisos (I), (II) and (III):

(I) when x is 1 and y is 1,

An is an antioxidant monoradical having a structure selected from the following structures (1), (2) and (3):

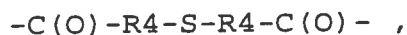




Y is nothing, X may also be nothing, R11 may be -C(O)- and R1 may be tert.butyl, the further meanings of these substituents as well as the meanings of the other substituents are not relevant to the questions at issue in this decision;

(II) when x is 1 and y is 2, An is the same as when x is 1 and y is 1, but Y is different from nothing, and the other substituents can have various meanings, which are not relevant to the questions at issue in this decision; and

(III) when x is 2 and y is 1, An is an antioxidant diradical having the structure



and Y is nothing, the other substituents having a number of meanings, not relevant to the questions at issue in this decision.

Claim 2 of the main request concerned the compounds of the above formula A; however, in proviso I the possibility of X being nothing had been deleted.

In a communication dated 16 May 1994, the Examining Division informed the Applicants that auxiliary request III was considered to be allowable, provided that certain formal deficiencies were remedied. In their response dated 2 August 1994, the Applicants complained that the communication did not deal with the preceding requests, i.e. the main request and auxiliary requests I

and II. The Examining Division, in its next communication dated 18 August 1994, replied that the reasons for the objections to the main request, in particular those concerning lack of unity of invention, had already been given in the previous communication and needed no further explanation. These objections applied also to the first and second auxiliary request. In a further letter dated 17 January 1995, the Applicants amended the claims of auxiliary request III and filed a new set of claims for Spain as well as a redrafted description.

III. In a communication under Rule 51(4) EPC, dated 30 March 1995 and based on auxiliary request III, the Examining Division informed the Applicants of the text in which it was intended to grant the patent. With letter dated 15 May 1995, the Applicants replied that they did not agree to the version communicated to them.

IV. In a decision dated 7 September 1995, the application was refused pursuant to Article 97(1) and Rule 51(5) EPC for the reason that in reply to the communication under Rule 51(4) EPC neither an approval nor any amendments had been received. There was thus no text to serve as a basis for the grant of a patent. The decision had been signed by a person whose function was not indicated. From a previous communication it becomes clear that she was a formalities examiner.

V. The Applicants filed a notice of Appeal on 8 November 1995, paying the appeal fee the same day. A statement of grounds of appeal was submitted on 9 January 1996.

VI. The Appellants submitted that the only reason for refusal related to the missing approval of the text based on auxiliary request III. Since the other requests were still pending, the decision contained no reasons

concerning the main request and auxiliary requests I and II. Furthermore, they dealt in substance with the objection of lack of unity of invention raised by the Examining Division, elaborating why, in their opinion, the application in the version of the main request met the requirement of the Article 82 EPC.

- VII. The Appellants requested that the decision under appeal be set aside, the patent be granted on the basis of the main request and the appeal fee be refunded because of a substantial procedural violation.

#### Reasons for the Decision

1. The appeal is admissible.
2. In the proceedings before the EPO main and auxiliary requests are allowed (Legal Advice 15/84, OJ EPO 1984, 491; Guidelines for Examination in the EPO E-X, 5; for grant proceedings see e.g. T 79/89, OJ EPO 1992, 283; for opposition proceedings see e.g. T 234/86, OJ EPO 1989, 79). An auxiliary request is a request which is contingent on the main request or any preceding auxiliary request being held to be unallowable (T 79/89, supra, point. 2.1 of the reasons, with reference to T 153/85, OJ EPO 1988, 1).
3. According to Article 113(2) EPC, the EPO is bound to the requests of the applicant or proprietor. In case of main and auxiliary requests, this means that the EPO is also bound to the order of the requests. Before a decision can be taken on the basis of an auxiliary request, the main request has to be examined and decided upon (T 484/88, dated 1 February 1989, cited in "Case Law of the Boards of Appeal of the EPO", Munich 1996,

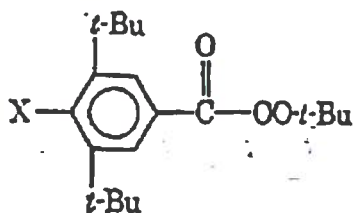
page 257). This principle has been violated by the Examining Division. The Applicants were only invited to indicate their approval of the text according to auxiliary request III. Therefore, their express disapproval related necessarily only to this version of the application. There is nothing in the file which could be interpreted as a withdrawal of the main request and the auxiliary requests I and II. Hence, these requests were pending when the decision under appeal was taken and the failure to give a decision on these requests was a violation of Article 113(2) EPC.

4. The failure to deal with the requests preceding auxiliary request III violates also Rule 68(2) EPC. If a decision relates to several requests, it must give reasons for the rejection of each one (T 234/86, supra, point. 5.10 of the reasons). The fact that the first examiner had expressed a preliminary view in a previous communication which may be applicable to these requests cannot replace reasons in the decision itself. Whereas the reasons of a decision may, in the interest of procedural economy, refer in appropriate cases to previous communications, it must be clear from the decision which considerations led the Division to its conclusions (T 234/86, supra).
5. From the considerations in paragraphs 2 and 3 it becomes clear that a decision had to be taken on the substance of the requests preceding auxiliary request III. If an applicant states disapproval of a proposed text based on an auxiliary request while insisting on his main request, this is not a case of lack of a text agreed by the applicant (T 999/93, dated 9 March 1995, cited in "Case Law of the Boards of Appeal of the EPO", Munich 1996, page 275). Nevertheless, a decision on the formal ground of lacking approval was given. A substantive decision could only be taken by the Examining Division

in its composition according to Article 18(2), first sentence, EPC. A responsibility of the Formalities Examiner was not given since the technical examination of applications cannot be entrusted to employees without technical or legal qualification under Rule 9(3) EPC.

6. Proceedings before the Boards of Appeal in ex parte cases are primarily concerned with examining the contested decision (G 10/93, OJ EPO, 1995, 172). In the present case, however, although the decision under appeal did not contain proper reasons which can be examined, the Appellant, in his letter dated 29 March 1996, expressly asked the Board to take a decision in respect of unity of invention, submitting that this question was the only point of dispute in the examining proceedings. The Board has therefore decided, with a view to streamline the proceedings before the EPO as much as possible, to examine that question under its competence pursuant to Article 111(1) EPC, second sentence.
7. In its communication dated 27 April 1993, the Examining Division found that, having regard to document D1, the present patent application concerned three different inventions, relating essentially to the use of compounds wherein the residue "An" corresponded to one of the three formulas mentioned in point II above.

D1 is a scientific paper concerning the radical and base-induced decomposition of the phenolic perester 1a having the following formula



wherein X is OH.



This compound corresponds to a compound according to formula A of the present Claim 1 (see point II above) wherein x and y are 1; An is of formula (1), R11 being -C(O)-; and X and Y are nothing. Since in Claim 2 X cannot in this context mean nothing, the above compound does not fall within the ambit of that claim.

8. The Examining Division did not dispute that the use claimed in the present Claim 1 is not disclosed in D1. However, in its communication dated 18 August 1994 the Examining Division held, referring inter alia to the Guidelines for Examination in the EPO, C-III, 7.4a, that a common new use of known and novel chemical compounds was not in itself sufficient to establish a common inventive concept within the meaning of Article 82 EPC.

9. This Guideline refers to the text of Rule 30 EPC as applicable to European patent applications filed after 1 June 1991 (see the transitorial provision in Article 3 of the Decision of the Administrative Council of 7 December 1990 amending the Implementing Regulations, OJ EPO 1991, page 4), which is not applicable to the present patent application (see point I above). According to Rule 30(b) in the text applicable in respect of the present patent application Article 82 shall be construed as permitting in particular that one and the same European patent application may include in addition to an independent claim for a process, an independent claim for an apparatus or means specifically designed for carrying out the process. The present Claim 1 is a use claim, which belongs to the category of claims directed to an activity, i.e. to the same category as process claims (see G 2/88, OJ EPO 1990, 93, reasons No. 2.2 and G 6/88, OJ EPO 1990, 114 reasons No. 2.2). The Examining Division did not dispute that all the compounds covered by the present Claim 2 are suitable for producing polymeric compositions of

enhanced oxidative stability. It did also not dispute that these compounds were "specifically designed" for this purpose. Consequently, the requirement of Rule 30(b) is met by all compounds covered by Claim 2. The fact that Claim 1 also comprises a known compound, not covered by Claim 2, is of no relevance to the question of unity, because that rule does not require that there must be a common concept unifying different "means" according to it. In other words, it is not relevant in the present circumstances that the three different classes of chemical compounds identified by the Examining Division comprise completely different chemical structures of the residue "An".

10. In addition, since the Examining Division had relied upon the Guidelines for Examination presently in force, the Board observes that the new Rule 30 is to be construed in such a manner that claims relating to different patent categories which were considered under the old Rule 30 to satisfy the requirement of Article 82 EPC continue to relate to one single general inventive concept in view of the new text of this Rule. Such interpretation seems to be in agreement with the legislative purpose of the revision of Rule 30 EPC (see Notice dated 3 June 1991 concerning amendment of the EPC Implementing Regulations and the Rules relating to Fees, published in OJ EPO 1991, 300, in particular page 303).

Moreover, in the Board's judgment the said Guideline provides a reasonable construction of the expression "single general inventive concept", contained in Article 82 EPC, in respect of Markush-type claims, which construction is therefore applicable to the examination of the requirement of unity of invention in respect of such claims, regardless whether they were filed before or after 1 June 1991.

11. It seems to follow from the official communication dated 18 August 1994 that the Examining Division was of the opinion that in the present case such a single general inventive concept was not present, since the structural alternatives comprised by formula A, which have a common property, did not share a common significant structural element. The Board therefore deems it appropriate to observe that the above-mentioned chapter of the Guidelines as well as the corresponding Part 1(f) of Annex B of the Administrative Instructions under the PCT, concerning the examination of unity of invention of so-called Markush-type claims, rightly state that the said significant structural element may consist of a combination of individual components linked together. It is not stated there that the combination of individual structural elements must be novel *per se*, nor does such a requirement follow from Article 82 EPC. Rather it follows from that guideline that this expression means that **in relation to the said common property or activity** there must be a common part of the chemical structure which distinguishes the claimed compounds from known compounds having the same property or activity. In the present case no state of the art was cited which relates to chemical compounds which were known to be useful for the production of polymeric compositions of enhanced oxidative stability. The combination of the peroxide group and the residue "An" which is responsible for conferring the oxidative stability, however, distinguishes the compounds of Claim 2 from all chemical compounds conventionally used as antioxidants in polymeric compositions, on the one hand, and from all compounds conventionally used as polymerisation initiators, on the other hand.
12. On the basis of the above considerations the Board holds that unity of invention pursuant to Article 82 EPC cannot be denied for the set of claims of the main

request, having regard to the state of the art represented by D1.

13. Since, however, the Examining Division had not taken the opportunity to proceed further with the examination, the Board considers the remittal of the case appropriate (Article 111(1) EPC).
  
14. The course of action taken by the Examining Division violates several procedural principles well established in the practice of the first instance and in the jurisprudence of the Board of Appeals. In the absence of any substantive reason for the refusal of the application, there was no proper factual basis for these appeal proceedings. Therefore, the Board considers the reimbursement of the appeal fee to be equitable under Rule 67 EPC.

Order

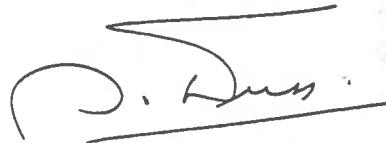
For these reasons it is decided that:

1. The decision under appeal is set aside.
2. The case is remitted to the Examining Division for further prosecution.
3. The appeal fee is to be reimbursed.

The Registrar:

  
E. Gorgmaier

The Chairman

  
A. Nuss

Te 30.7.96  
K. sp. 30.7.96

