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D E C I S I O N
of 16 August 2001

Case Number: T 0876/98 - 3.2.3

Application Number: 93870232.1

Publication Number: 0614709

IPC: B09B 3/00, E21B 43/26, E21B 43/00

Language of the proceedings: EN

Title of invention:
In-situ remediation of contaminated soils

Applicant:
Monsanto Company

Opponent:
-

Headword:
-

Relevant legal provisions:
EPC Art. 84, 111(1)

Keyword:
"Claims - clarity (yes, after amendment)"
"Decision re appeal - remittal (yes)"

Decisions cited:
-

Catchword:
-



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Boards of Appeal

Chambres de recours

Case Number: T 0876/98 - 3.2.3

D E C I S I O N
of the Technical Board of Appeal 3.2.3
of 16 August 2001

Appellant: Monsanto Company
800 North Lindbergh Boulevard
St. Louis Missouri 63167 (US)

Representative: Ernst, Hubert
Monsanto Services Internationl S.A./N.V.
Patent Department
Avenue de Tervuren 270-272
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Decision under appeal: Decision of the Examining Division 2.3.09.113 of
the European Patent Office dated 3 April 1998
refusing European patent application
No. 93 870 232.1 pursuant to Article 97(1) EPC.

Composition of the Board:

Chairman: C. T. Wilson
Members: F. Brösamle
J. P. Seitz

Summary of Facts and Submissions

- I. With decision of 3 April 1998 the examining division refused European patent application No. 93 870 232.1 for reasons of lacking clarity within the meaning of Article 84 EPC.
- II. The applicant - appellant in the following - lodged an appeal on 18 May 1998 against the above decision of the examining division paying the appeal fee on the same day and filing the statement of grounds of appeal on 6 August 1998.
- III. Following the Board's Communication pursuant to Article 11(2) RPBA in which the board informed the appellant that his requests and claim 1 needed reconsideration and amendment with respect to clarity the appellant filed new claims 1 to 15 with letter of 22 January 2001, received on 26 January 2001.
- IV. Claim 1 thereof has the following wording:
- "1. A process for the in-situ remediation of soil from a liquid permeable region within a contaminated soil region comprising:
- (a) introducing material for treating contaminants in said contaminated soil region selected from the group consisting of microorganisms, nutrients, electron acceptors, catalysts, adsorbents, surfactants, electron donors, co-metabolites, chelating agents, ion exchange resins, buffers, salts and combinations thereof, into said liquid permeable regions to form at least one treating zone within said contaminated soil region, and

- (b) transmitting direct electric current through said contaminated soil region between a first electrode and a second electrode having opposite charge, wherein said first electrode is located at a first end of said contaminated soil region and said second electrode is located at the opposite end of said contaminated soil region (1) to cause an electroosmotic flow from said second electrode to said first electrode and (2) to cause an electromigratory movement of ionic contaminants in a direction toward the electrode of opposite charge."

V. The appellant requested:

- (a) to set aside the impugned decision and
- (b) to remit the case to the first instance for further prosecution on the basis of claims 1 to 15 filed with letter of 22 January 2001.

VI. The arguments of the appellant can be summarised as follows:

- by deleting the former feature (3) namely "to cause an electroosmotic flow...and an electromigratory movement of ionic contaminants..." from claim 1 underlying the impugned decision (and from claim 1 filed with the statement of grounds of appeal) the clarity objection of the board raised in its Communication pursuant to Article 11(2) RPBA has been overcome;
- claim 1 now being clear the reason for refusal of the patent application in suit does no longer

exist so that the case should be remitted to the examining division for further prosecution.

Reasons for the Decision

1. The appeal is admissible.
2. *Amendments*
 - 2.1 Claim 1 in its feature (b) is based on two effects, namely
 - (1) to cause an electroosmotic flow and
 - (2) to cause an electromigratory movement of ionic contaminants.
 - 2.2 While the electroosmotic flow for a person skilled in the art relates to the movement of liquids, the electromigratory movement relates to ionic contaminants, see documents cited in the Search Report, namely
 - (D1) DE-A-4 112 893, in particular column 4, lines 10 to 13, and
 - (D2) "Chemistry & Industry", 18 September 1989, pages 585 to 590, in particular page 585, left column where definitions of the above technical expressions are given.
 - 2.4 It has to be added that the technical expression "electromigratory movement" falls under the general term "elektrokinetics" dealt with in particular in

(D2).

- 2.5 With respect to claim 1 the requirements of Article 84 EPC are met so that the reason for refusal of the application no longer exists and there is a basis for assessing the issues of novelty and possibly inventive step of the claimed invention.
- 2.6 The Board therefore follows the appellant's request to remit the case to the first instance for further prosecution, Article 111(1) EPC.
3. Summarizing the above considerations the impugned decision cannot be upheld.

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 for further prosecution.

The Registrar:

The Chairman:

A. Counillon

C. T. Wilson