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**D E C I S I O N**  
**of 9 January 2003**

**Case Number:** T 1142/00 - 3.3.4

**Application Number:** 93919966.7

**Publication Number:** 0654096

**IPC:** C13K 1/02

**Language of the proceedings:** EN

**Title of invention:**  
Methods of biomass pretreatment

**Applicant:**  
THE TEXAS A&M UNIVERSITY SYSTEM

**Opponent:**  
-

**Headword:**  
BIOMASS PRETREATMENT/Texas A&M

**Relevant legal provisions:**  
EPC Art. 123(2)

**Keyword:**  
"Allowability of amendments (yes)"

**Decisions cited:**  
-

**Catchword:**  
-



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Boards of Appeal

Chambres de recours

**Case Number:** T 1142/00 - 3.3.4

**D E C I S I O N**  
**of the Technical Board of Appeal 3.3.4**  
**of 9 January 2003**

**Appellant:** THE TEXAS A&M UNIVERSITY SYSTEM  
310 Wisenbaker  
College Station  
TX-77843-3369 (US)

**Representative:** Dean, John Paul  
Withers & Rogers  
Goldings House  
2 Hays Lane  
London SE1 2HW (GB)

**Decision under appeal:** Decision of the Examining Division of the  
European Patent Office posted 16 March 2000  
refusing European patent application  
No. 93 919 966.7 pursuant to Article 97(1) EPC.

**Composition of the Board:**

**Chairwoman:** U. M. Kinkeldey  
**Members:** M. R. J. Wieser  
V. Di Cerbo

## Summary of Facts and Submissions

- I. The appeal lies from the decision of the examining division to refuse the European Patent Application No. 93 919 966.7, publication number 0 654 096, with the title "Methods of Biomass Pretreatment", under Article 97(1) EPC, because it contained subject-matter which extended beyond the content of the application as filed, contrary to the requirements of Article 123(2) EPC.
- II. With the grounds for appeal the appellants filed a new main and auxiliary request. With a further submission, on 7 January 2003, these requests were replaced by an amended main request and two auxiliary requests.
- III. Oral proceedings took place on 9 January 2003. After the board, at the oral proceedings, had expressed its preliminary opinion, that none of the requests on file seemed to fulfil the requirements of Article 123(2) EPC, a new main request, consisting of claims 1 to 23, was filed. The following claims thereof contain amendments as compared to the claims as originally filed:

"1. A method for pretreating a lignocellulose-containing biomass, comprising adding calcium hydroxide and water and an oxidizing agent selected from oxygen and oxygen containing gases to the biomass to form a mixture, and pretreating the biomass for oxidizing without degrading the lignocellulose by maintaining the mixture at 40°C to 150°C for a period of between about 1 hour and about 36 hours.

3. The method of claim 1 or 2 wherein the oxidizing agent is added to the mixture under pressure.

9. The method of any one of the preceding claims wherein the period of time is between about 1 and about 20 hours.

13. A useful product made by a method according to claim 11 or claim 12, wherein the useful product comprises a feedstock, a fuel, an alcohol, an acid, a sugar, a ketone, starch, a fatty acid, or a combination thereof."

IV. The appellants argued that the claims of the requests were fully supported by the claims and the description as originally filed.

V. The appellants requested that the decision under appeal be set aside and that a patent be granted on the basis of the following points:

claims 1 to 23 as filed at the oral proceedings as main request, or

claims 1 to 23 as first auxiliary request filed on 7 January 2003, or

claims 1 to 22 as second auxiliary request filed on 7 January 2003.

## **Reasons for the Decision**

### *The main request*

#### *Article 123(2) EPC*

1. Claim 1 is supported by claims 1, 10 ("40 °C to 150 °C") and 13 ("between about 1 hour and about 36 hours"), and page 14, lines 19 to 20 of the description ("without degrading the lignocellulose") as originally filed.

2. Claim 3 is supported by page 1, line 9 of the description ("..may be added under pressure.."). Claim 9 is based on page 16, lines 12 to 13 ("..between about 1 to about 20 hours,.."). Claim 13 is supported by page 17, lines 7 to 11 ("a feedstock" and "an acid") of the description as originally filed.
3. Claims 1 to 23 meet the requirements of Article 123(2)EPC.
4. Given that no substantive examination as to the patentability of the application has been carried out by the examining division, the board, in the exercise of its power pursuant to Article 111(1) EPC, remits the case to the first instance for further prosecution.

## **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 on the basis of claims 1 to 23 of the main request filed at the oral proceedings.

The Registrar:

The Chairwoman:

P. Cremona

U. M. Kinkeldey