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D E C I S I O N
of 31 January 2005

Case Number: T 0023/03 - 3.3.6

Application Number: 95934164.5

Publication Number: 0786029

IPC: D21C 9/00

Language of the proceedings: EN

Title of invention:

Method for removal of hexenuronic acid groups in cellulose pulp by heat treatment

Patentee:

Andritz Oy

Opponents:

Kvaerner Pulping AB
Degussa Ag
Metso Paper Sundsvall AB

Headword:

Hexenuronic acid in pulp/ANDRITZ

Relevant legal provisions:

EPC Art. 108, 112

Keyword:

"Admissibility of appeal (no) - no reasoned statement of grounds"
"Remittal of questions to the Enlarged Board of Appeal (no) - no important point of law"

Decisions cited:

T 0145/88, J 0022/86, T 0162/97, T 0213/85, T 1158/98
T 0729/90, T 0563/91, J xxxx/87

Catchword:

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Case Number: T 0023/03 - 3.3.6

D E C I S I O N
of the Technical Board of Appeal 3.3.6
of 31 January 2005

Appellant: Andritz Oy
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Decision under appeal: Decision of the Opposition Division of the
European Patent Office posted 21 October 2002
revoking European patent No. 0786029 pursuant
to Article 102(1) EPC.

Composition of the Board:

Chairman: P. Krasa
Members: G. Dischinger-Höppler
J. H. Van Moer

Summary of Facts and Submissions

- I. European patent No. 0 786 029 relating to a method for removal of hexenuronic acid groups in cellulose pulp by heat treatment was granted on the basis of an amended set of 18 claims.

- II. Three oppositions were filed against the patent as granted, wherein the Opponents sought revocation of the patent on the grounds of Articles 100(a) EPC for lack of novelty and lack of inventive step (Articles 52(1), 54(2) and 56 EPC). During the oral proceedings held before the Opposition Division, the Patent Proprietor eventually filed further amended sets of claims in a new main request and two auxiliary requests.

- III. In its decision, the Opposition Division held that the main request was not allowable under Article 123(2) EPC since no basis could be found in the application as filed for the particular combination of features set out in dependent Claims 2 and 5 to 10, i.e. for a method of treating cellulose pulps in accordance with those dependent claims wherein the treatment is effected in a bleaching sequence prior to a chlorine dioxide, ozone or peracid stage as required according to the amended Claim 1. The auxiliary requests were rejected on the ground that the subject-matter claimed therein was not based on an inventive step. The patent was, thus, revoked.

- IV. This decision was appealed by the Patent Proprietor (hereinafter Appellant) who filed under cover of the letter dated 27 February 2003 a document headed "Written Statement setting out the Grounds of Appeal

dated December 23, 2002" and amended sets of claims in a new main and three auxiliary requests. In this document it was submitted that the subject-matter of Claim 1 of all requests was supported by Claim 1 as granted in combination with the description as originally filed and that the dependent claims corresponded to dependent claims as granted.

V. In reply to the Appellant's statement of grounds of appeal, Opponent I (hereinafter Respondent I) *inter alia* questioned the admissibility of the appeal for not being adequately substantiated. Opponents II and III (hereinafter Respondents II and III) *inter alia* questioned the admissibility of the claims of the Appellant's new requests under Article 123(2) EPC.

VI. Following the summons to oral proceedings on 31 January 2005, in an annex to which the Board informed the parties of the fact that the question of admissibility of appeal would be an issue to be discussed, the Appellant filed further amended sets of claims in a new main and seven auxiliary requests and *inter alia* refuted the arguments regarding admissibility of appeal.

VII. At the oral proceedings, the Appellant presented the following arguments:

- The ultimate reason for which the patent in suit had been revoked was lack of inventive step. The grounds of appeal were sufficiently substantiated since they provided detailed reasons why the decision under appeal was held to be incorrect.

- According to the EPC, it was not required that the grounds of appeal address each and every argument of the contested decision, if it was clear why the Appellant felt the decision to be wrong.
- Nevertheless, the grounds of appeal also indicated where in the Appellant's view support for the various features of the new claims could be found.
- Whether this view was correct was irrelevant as regards sufficiency of substantiation.
- In the present case, it was possible to refer to the claims as granted as basis of original support since those had not been attacked under Article 123(2) EPC.
- According to decision J 22/86 sufficiency of substantiation of an appeal depended on the decision under appeal. However, the decision under appeal was not clear and insufficiently reasoned since it ignored the Appellant's references to the original description in relation to the bleaching stages.
- It was sufficient as substantiation to file new claims together with the grounds of appeal, thereby removing the legal basis of the first instance decision. This was corroborated by decisions T 563/91, T 729/90 and T 1158/98 concerning cases where no reason at all was given in the statement of grounds of appeal as to why the contested decision should be set aside.

- Respondents II and III apparently had no problems to understand why the appellant considered the contested decision to be erroneous.

The Appellant further submitted that in the event that the Board should consider that the appeal was not admissible, the following two questions should be referred to the Enlarged Board of Appeal prior to taking a decision on admissibility:

- (a) Does the filing of new claims with the grounds of appeal always satisfy the requirement of sufficient substantiation? If not, what are the requirements that the filing of new claims is deemed sufficient?
- (b) Is the requirement of sufficient substantiation of the grounds of appeal fulfilled if the grounds of appeal address the findings in the first instance only relating to the ultimate request considered in the decision under appeal, or is it a requirement that the findings relating to all requests considered in the decision under appeal be addressed?

VIII. The Respondents refuted the Appellant's arguments and were of the opinion that there was no reason to submit questions (a) and (b) to the Enlarged Board of Appeal since the case law of the European Patent Office was clear with regard to the requirements for a sufficiently substantiated appeal.

IX. The Appellant requested that the decision under appeal be set aside and that the patent be maintained on the basis of the main request or in the alternative, of the auxiliary requests 1 to 7, all filed under cover of the letter dated 29 September 2005.

He also requested referral of two questions (a) and (b) to the Enlarged Board of Appeal.

The Respondents requested that the appeal be dismissed.

Reasons for the Decision

Admissibility of Appeal

1. The only question with regard to admissibility to be decided here is whether the document filed under cover of the letter dated 27 February 2003 complies with the requirement addressed in the third sentence of Article 108 EPC according to which a written statement setting out the grounds of appeal must be filed.
2. Whether or not the requirement of Article 108 is met depends upon the substance of the document presented as the statement of grounds of appeal and not upon its title (see e.g. T 145/88, OJ EPO, 1991, 251, reasons No. 1). It is, therefore, not essential if, as in the present case, the document bears a title in accordance with the third sentence of Article 108 EPC (see IV above).

It is rather the established Case Law of the Boards of Appeal (see 4th edition 2001, chapter VII.D.7.5.1) that the grounds of appeal have to specify the legal and factual reasons why the contested decision should be set aside and the appeal allowed. In particular, the arguments must be clearly presented to enable the Board and the other party or parties immediately to understand why the decision is alleged to be incorrect, and on what facts the Appellant bases its arguments, without having to make investigations of their own.

Further, the examination of whether the requirements of Article 108 EPC, third sentence, are met has to be made on the basis of the contents of the statement of grounds of appeal in the light of the main reasons given in the contested decision (see e.g. J 22/86, OJ EPO, 1987, 280, reasons No. 2, T 162/97, not published in the OJ EPO, reasons No. 1.1.2 and T 213/85, OJ EPO 1987, 482, reasons No. 3).

3. In the present case, it is clear from the contested decision that the amendments made to Claim 1 as granted were found to result in an extension beyond the content of the application as filed of the subject-matter of dependent Claims 2 and 5 to 10 of the main request which did, therefore, not meet the requirements of Article 123(2) EPC (see point III above). It is also clear that this deficiency was not present in the claim sets of the auxiliary requests which were rejected for lack of inventive step since they did not contain corresponding dependent claims.

However, the claim sets filed with the statement of grounds of appeal in a new main and three auxiliary

requests contained dependent claims of the same wording as the above dependent Claims 2 and 5 to 10 of the main request rejected by the Opposition Division under Article 123(2) EPC.

In accordance with the above cited Case Law, it is therefore necessary that the statement of grounds of appeal not only address the issue of inventive step but also the issue of Article 123(2) EPC, i.e. the legal basis on which the Appellant's main request has been rejected. In other words, it must be clear from the statement of grounds of appeal why in the Appellant's opinion the contested decision is either incorrect or no longer applies to the amended claim sets filed with the grounds of appeal.

4. The Appellant's statement of grounds of appeal contains two references to Article 123(2) EPC by indicating a support in the application as filed for the amendments made to Claim 1 of the various requests, namely a support for the restriction of the kappa number decrease to 3 to 6 units (all requests) and a support for the feature relating to an oxygen stage (second and third auxiliary requests). Concerning the dependent claims of the main request, it is stated that "dependent claims 2 to 10 of the main request correspond to claims 2, 5, 7 and 10 to 15 as granted". Concerning the dependent claims of the auxiliary requests, reference is only made to the dependent claims of the main request.
5. The Appellant's opinion according to which it was possible in the present case to refer for the purposes of Article 123(2) EPC to the granted claims since those

have not been attacked under the aspects of this Article, was not contained in the statement of grounds of appeal. Nor could this opinion implicitly be deduced from it when considering the decision under appeal rejecting the then pending main request for not complying with the requirements of Article 123(2) EPC.

The same applies to the Appellant's allegation that the decision under appeal was not clear and insufficiently reasoned. The Appellant's complaint that the Opposition Division in its decision ignored the Appellant's references to the original description as regards the bleaching stages, does not address the factual reasons of the contested decision, since the bleaching stages were features of Claim 1, not of the dependent claims. On the contrary, it is clear from the contested decision that the Appellant had been asked in vain during the oral proceedings to identify any part of the application as filed in support of the new combination of features in the dependent claims.

Thus, the statement of grounds of appeal does not contain any indication in relation of Article 123(2) EPC as concerns the original disclosure of the particular combination of features defining the subject-matter of the dependent claims of the then pending main request.

6. The Board agrees with the Appellant insofar as in certain instances it may be sufficient as substantiation to file new claims with the grounds of appeal which might remove the legal basis of the first instance decision. Actually, this holds true of the three decisions of the Boards of Appeal cited by the

Appellant, which all relate to cases where the first instance decision was based on lack of inventive step and new claims filed with the grounds of appeal constituted a new fact in relation to that decision.

In particular, T 1158/98 concerned a case where an auxiliary request was filed with the statement of grounds of appeal based on amended claims, the subject-matter of which had not been addressed in the first instance decision (reasons No. 1).

T 729/90 concerned an *ex-parte* case, but was otherwise similar to T 1158/98, namely in that an auxiliary request was filed with the statement of grounds of appeal, the claims of which had not been subject of the decision of the Examining Division to reject the application. In this case, it was even evident that the Examining Division in its decision had already acknowledged that the subject-matter of the new Claim 1 was based on an inventive step (see, in particular, reasons Nos. 1.3 and 1.3.1).

Also in the case of T 563/91 new claims were filed with the grounds of appeal which form a new factual basis in relation to the contested decision under consideration. In this respect, T 563/91 refers to J xx/87 (OJ EPO, 1988, 323), in particular reason No. 1.4, where it is held that the contested decision would no longer have a legal basis if there was a chance that a new fact on which the Appellant's grounds are based might be confirmed.

In other words all these decisions confirm the respective Case Law of the Boards of Appeal (see 4th

edition 2001, chapter VII.D.7.5.2 and 3) according to which a change of the factual situation as compared with that underlying the appealed decision may be sufficient as substantiation of the grounds of appeal provided that it was evident that, depending on the merits of the case, the legal basis of the contested decision might no longer apply.

7. However, the above does not apply in the present case for the following reasons:

In the decision under appeal, the Appellant's main request has been rejected since "no basis can be found in the application as filed for a method of treating cellulose pulps wherein the pulp is treated according to the features disclosed in dependent claims 2, 5 to 10 of said main request and in which treatment is effected prior to a chlorine dioxide stage or an ozone stage or a peracid stage", i.e. irrespective of any other features of Claim 1.

The claim sets of all requests filed with the statement of grounds of appeal still contain claims which have the same features as the above Claims 2 and 5 to 10, and are dependent on Claim 1 containing the feature of effecting the treatment in a bleaching sequence prior to a chlorine dioxide, ozone or peracid stage. These claims, therefore, contain the same combination of features for which the Appellant's main request has been rejected under Article 123(2) EPC. The amendments made to Claim 1 of the requests filed with the grounds of appeal, which consist in a restriction of the kappa number decrease to "3 - 6" units and, concerning the second and third auxiliary requests, the incorporation

- of the features of the dependent Claim 8 (original Claim 9) into Claim 1, do not change this fact.
8. Therefore, the factual basis of the contested decision remained unchanged in the present case and the amendments made to the claims filed with the statement of grounds of appeal did not add anything which implicitly could clarify as to why the Appellant might be of the opinion that the contested decision no longer applies to the new dependent claims.
 9. This is corroborated by the fact that Respondents II and III, insofar as the factual situation was the same as in the first instance, simply repeated their arguments presented there. Doing so rather implies that there was nothing to add since the situation has not changed, but cannot be interpreted as an answer to grounds of appeal indicating why the first instance decision should be held to be incorrect or no longer apply.
 10. Therefore, the Appellant's document headed "written statement of grounds of appeal ..." does not deal with the reasons given in the decision under appeal and, thus, does not comply with the requirements according to the third sentence of Article 108 EPC. Consequently, the appeal has to be rejected as inadmissible in accordance with the provisions of Rule 65(1) EPC.

Referral of questions to the Enlarged Board of Appeal

11. According to Article 112(1)(a) EPC, a Board shall refer questions to the Enlarged Board of Appeal if it considers that a decision is required in order to

ensure uniform application of the law or if an important point of law arises.

As explained above under points 3 and 6 to 8, there is no contradiction between the present case and the case law with regard to the two questions posed by the Appellant. Therefore, the Board does not consider that a decision of the Enlarged Board of Appeal is required with respect to this point of law.

Having regard to the above considerations, the Appellant's request for two questions to be referred to the Enlarged Board of Appeal is, therefore refused.

Order

For these reasons it is decided that:

1. The request to refer two questions ((a) and (b)) to the Enlarged Board of Appeal is refused.
2. The appeal is dismissed.

The Registrar:

The Chairman:

G. Rauh

P. Krasa