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D E C I S I O N
of 11 January 2006

Case Number: T 0527/04 - 3.3.10

Application Number: 99305682.9

Publication Number: 0974570

IPC: C07C 2/68

Language of the proceedings: EN

Title of invention:

Method for the preparation of arylated poly alpha-olefins

Patentee:

EXXONMOBIL OIL CORPORATION

Opponent:

-

Headword:

Method for the preparation of arylated poly alpha-olefins/EXXONMOBIL OIL CORPORATION

Relevant legal provisions:

EPC Art. 111(1), 123(2)

Keyword:

"Claims substantially amended on appeal - fresh case - remittal"

Decisions cited:

G 0010/93, T 0063/86, T 0139/87, T 0047/90

Catchword:

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Case Number: T 0527/04 - 3.3.10

D E C I S I O N
of the Technical Board of Appeal 3.3.10
of 11 January 2006

Appellant:

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Decision under appeal:

Decision of the Examining Division of the
European Patent Office posted 17 November 2003
refusing European application No. 99305682.9
pursuant to Article 97(1) EPC.

Composition of the Board:

Chairman: R. Freimuth
Members: J. Schmid
J. Seitz

Summary of Facts and Submissions

- I. The appeal lodged on 19 January 2004 lies from the decision of the Examining Division posted on 17 November 2003 refusing European patent application No. 99305682.9 (European publication No. 0 974 570).
- II. The decision under appeal was based on the claims according to the then pending main and auxiliary requests submitted on 22 October 2003. Both requests comprised an independent claim which was directed to a process for the preparation of arylated poly α -olefins comprising two distinct alternatives, that is, a two step process catalysed either by BF_3 or AlCl_3 .
- III. The Examining Division found that the subject-matter claimed lacked inventive step (Article 56 EPC) in view of documents
- (1) WO-A-91/11411,
 - (3) EP-A-0 377 305 and
 - (4) GB-A-2 078 776.

The Examining Division held that the subject-matter of the independent claim 1, insofar as it was directed to the use of BF_3 as catalyst, was obvious in view of document (4), which was regarded as the closest prior art, in combination with document (1) or document (3). The Examining Division recognised that document (4) aimed at avoiding the use of AlCl_3 in the oligomerisation step which was the reason not to object

to the inventive step of the process using AlCl_3 as catalyst.

The Examining Division therefore based the decision under appeal solely on that embodiment of the claimed subject-matter relating to the process catalysed by BF_3 , since it was of the opinion that the deterrent teaching of document (4) relating specifically to the use of AlCl_3 could not be extrapolated to the use of any other Lewis acid catalyst, in particular not to BF_3 .

IV. At the oral proceedings before the Board held on 11 January 2006 the Appellant (Applicant) no longer maintained the former requests. He submitted a fresh request of five claims superseding any previous request. The sole independent claim of that request read as follows:

"1. A method for the preparation of arylated poly α -olefins comprising the steps of:

- (a) oligomerizing one or more α -olefins in the presence of an acid catalyst to form predominantly olefin dimer and higher oligomers; and once the reaction has gone to completion
- (b) arylating the olefin oligomers with an aromatic compound in the presence of the same catalyst as used in step (a) to form the arylated poly α -olefin, wherein the acid catalyst is promoted AlCl_3 ."

Claims 2 to 5 of that fresh request were dependent on claim 1.

- V. The Appellant argued in respect of inventive step that the objections raised in the decision under appeal were met since independent claim 1 was now restricted to a process using AlCl_3 as catalyst, i.e. no longer comprised the alternative using BF_3 objected to by the first instance.
- VI. The Appellant requested that the decision under appeal be set aside and that the case be remitted to the Examining Division for further prosecution on the basis of the claims 1 to 5 filed during the oral proceedings.
- VII. At the end of the oral proceedings the decision of the Board was announced.

Reasons for the Decision

1. The appeal is admissible.
2. *Scope of examination on appeal*

While Article 111(1) EPC gives the Boards of Appeal the power to raise new grounds in ex-parte proceedings where the application has been refused on other grounds, proceedings before the Boards of Appeal in ex-parte cases are primarily concerned with examining the contested decision (see decision G 10/93, OJ EPO 1995, 172, points 4 and 5 of the reasons), other objections normally being left to the Examining Division to consider after a referral back, so that the Appellant has the opportunity for these to be considered without loss of an instance.

In the present case the Board, thus, restricts itself to examining whether the amended claims meet the requirements of Article 123(2) EPC and whether the objection as to lack of inventive step pursuant to Article 56 EPC as formulated in the decision under appeal and forming the sole ground for refusal of the application, can still be considered as applying to the amended claims.

3. *Amendments (Article 123(2) EPC)*

The subject-matter of claim 1 is based on original claim 1 in combination with page 5, lines 17 to 23 of the application as filed. Claims 2 to 5 are backed up by original claims 7 to 9.

For these reasons, the Board concludes that that the present claims as amended comply with the requirements of Article 123(2) EPC.

4. *Ground for refusal*

The decision under appeal exclusively dealt with lack of inventive step of the independent claim 1 of the then pending requests to the extend that it was directed to a process for the preparation of arylated poly α -olefins catalysed by BF_3 . The amendments made to the claimed subject-matter in the fresh request, in particular by dropping the embodiment that the Examining Division considered to be obvious in the light of the prior art and on which the decision under appeal was based, while presenting a sole fresh independent process claim which was substantially restricted in scope by specifying AlCl_3 to be used as

the only catalyst, have the effect that the reasons given in the contested decision for refusing the present application no longer apply, since the present process claim 1 has never been challenged under Article 56 EPC.

Thus, the Board considers that the amendments made by the Appellant avoids the inventive step objection as formulated in the decision under appeal and are substantial in the sense that in the present case the examination has to be done on a new basis, with the consequence that the appeal is well founded.

This finding is in line with established jurisprudence of the Boards of Appeal that an appeal is to be considered well founded if the Appellant no longer seeks grant of the patent with a text as refused by the Examining Division and if substantial amendments are proposed which clearly meet the objections on which the decision relies (see decisions T 63/86, OJ EPO 1988, 224; T 139/87, OJ EPO 1990, 68 and T 47/90, OJ EPO 1991, 486).

5. *Remittal*

Having so decided, the Board has not, however, taken a decision on the whole matter, since as set out above substantial amendments to the subject-matter claimed have been made by submitting fresh process claim 1 which was only presented at the oral proceedings before the Board. The decision under appeal did not consider fresh process claim 1 in the form of the present request, as such request was never submitted to the first instance. It is only before the Board that the

Appellant has dropped the alternative embodiment that the Examining Division considered to be obvious, in order to overcome the objections raised. Thus, fresh process claim 1 generates a fresh case not yet addressed in examination proceedings.

Under these circumstances, the examination not having been concluded, the Board considers it appropriate to exercise its power conferred on it by Article 111(1), second sentence, second alternative, EPC to remit the case to the Examining Division 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 department of first instance for further prosecution on the basis of claims 1 to 5 of the sole request filed during the oral proceedings.

The Registrar:

The Chairman:

C. Moser

R. Freimuth