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**Datasheet for the decision
of 27 June 2008**

Case Number: T 1064/04 - 3.3.07

Application Number: 98912425.0

Publication Number: 0968055

IPC: B01J 27/26

Language of the proceedings: EN

Title of invention:

Process for making double metal cyanide catalysts

Applicant:

BAYER ANTWERPEN N.V.

Opponent:

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Headword:

-

Relevant legal provisions:

EPC R. 137(3)

Relevant legal provisions (EPC 1973):

EPC R. 51(4)-(6) (in force from 1 July 2002)

EPC R. 86(3)

Keyword:

"Correct exercise of discretion by the Examining Division
under Rule 86(3) EPC 1973"

Decisions cited:

G 0007/93, T 0166/86, T 0989/99

Headnote:

"Summary of principles derived from decision G 0007/93 on admission of amendments at late stage of proceedings (see point 4). In particular such admission is to be the exception not the rule."

"Requests for amendments after oral proceedings which resulted in a communication indicating grant possible on an auxiliary request, are made at a late stage of proceedings (see point 4.2)"



Case Number: T 1064/04 - 3.3.07

D E C I S I O N
of the Technical Board of Appeal 3.3.07
of 27 June 2008

Appellant:

BAYER ANTWERPEN N.V.
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Representative:

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Decision under appeal:

Decision of the Examining Division of the
European Patent Office posted 1 March 2004
refusing European application No. 98912425.0
pursuant to Article 97(1) EPC.

Composition of the Board:

Chairman: S. Perryman
Members: B. ter Laan
B. Struif

Summary of Facts and Submissions

- I. The appeal lies from the decision of the Examining Division issued on 1 March 2004 to refuse European patent application No. 98 912 425.0 (originating from international application PCT/EP98/01155 (published as WO-A-98/40162) and having the international filing date of 2 March 1998) in accordance with Article 97(1) EPC on the ground that no agreed text as required by Article 113(2) EPC existed.
- II. The prosecution history before the Examining Division can be summarized as follows:
- (a) A first communication dated 25 April 2001 was issued by the Examining Division maintaining that the deficiencies already mentioned in the international preliminary examination report gave rise to corresponding objections under the EPC. The applicants (hereinafter "appellants") responded by letter dated 6 June 2001 containing arguments why the existing claims were allowable.
- (b) A second communication dated 20 August 2001 was issued by the Examining Division raising objections under Articles 84, 54 and 56 EPC, in particular that since the method for measuring alkalinity given in the description was unclear and applied only to measuring the alkalinity of $ZnCl_2$ and not to other metals, it was not clear how the alkalinity of any other metal was to be determined. Since it was not clear how the alkalinity was to be determined said parameter could not be used as a distinguishing feature over

the prior art. The appellants responded by letter dated 27 February 2002 with an amended set of fourteen claims of which claims 1 and 2 read:

"1. A process which comprises producing an aqueous solution of a **metal salt** and controlling its alkalinity so that it comprises from 0.2 to 2.0 wt.% expressed as metal oxide and based on the amount of metal salt; and reacting the aqueous solution of the metal salt with an aqueous solution of a metal cyanide salt in the presence of an organic complexing agent in a manner effective to produce a substantially non-crystalline double metal cyanide (DMC) catalyst."

"2. The process of Claim 1 wherein the metal salt **is** zinc chloride."

(Emphasis added by the Board.)

Claims 3 to 12 were process claims directly or indirectly dependent on claim 1, and claims 13 and 14 were directed to a catalyst made according to the process of any preceding claim.

- (c) On 16 July 2002 the Examining Division issued a summons to oral proceedings accompanied by a third communication, maintaining the objection as to novelty in respect of the catalyst claims 13 and 14 and the objection as to lack of inventive step of all claims. The appellants responded by letter dated 9 December 2002 by filing a main request limited to claims 1-12 of the request filed by

letter dated 27 February 2002, as well as a further request as auxiliary request.

- (d) Oral proceedings were held on 9 January 2003 by video conference, at which two requests were considered. The main request corresponded to claims 1 to 12 of the set filed on 9 December 2002. An auxiliary request, newly filed during the oral proceedings had a claim 1 in which the wording "aqueous solution of a **metal salt**" of the main request had been replaced by "an aqueous solution of **zinc chloride**" and the references to the salt and the oxide had been restricted to "**zinc chloride**" and "**zinc oxide**", respectively (emphasis added by the Board). The main request was considered not to comply with the provisions of the EPC, but the Examining Division indicated that the application could proceed to grant on the basis of the auxiliary request.
- (e) On 31 January 2003 a communication under Rule 51(4) EPC 1973 (version in force from 1 July 2002) was issued in relation to the auxiliary request, accompanied by a communication of the same date stating that the main request did not comply with Article 56 EPC because the examples in the description only showed that a technical effect was obtained with the metal salt being zinc chloride. Further the term "alkalinity" used in claim 1 was not clear since it had only been defined in respect of zinc chloride and zinc oxide in the description, so claim 1 lacked clarity within the meaning of Article 84 EPC.

- (f) By a letter dated 14 August 2003, the appellants requested further processing and filed two new requests as well as an experimental report. The main request ("First Revised Specification") contained 17 pages of description and 13 claims, the second request ("Second Revised Specification") contained 17 pages of description and 11 claims.

The first four claims of the "First Revised Specification" read:

"1. A process which comprises producing an aqueous solution of a **metal halide** and controlling its alkalinity so that it comprises from 0.2 to 2.0 wt.% expressed as metal oxide and based on the amount of metal salt; and reacting the aqueous solution of the metal salt with an aqueous solution of a metal cyanide salt in the presence of an organic complexing agent in a manner effective to produce a substantially non-crystalline double metal cyanide (DMC) catalyst."

"2. **A process according to Claim 1 wherein the metal is selected from the group consisting of Zn(II), Fe(II), Co(II) and Ni(II).**"

"3. A process according to Claim 1 or 2 wherein the metal salt **comprises** zinc halide."

"4. A process according to Claim 3 wherein the metal salt **comprises** zinc chloride."

(Emphasis added by the Board to indicate the differences with the main and auxiliary requests cited above.)

The first two claims of the "Second Revised Specification" read:

"1. A process which comprises producing an aqueous solution of a **zinc halide** and controlling its alkalinity so that it comprises from 0.2 to 2.0 wt.% expressed as **zinc oxide** and based on the amount of **zinc halide**; and reacting the aqueous solution of the **zinc halide** with an aqueous solution of a metal cyanide salt in the presence of an organic complexing agent in a manner effective to produce a substantially non-crystalline double metal cyanide (DMC) catalyst."

"2. A process according to Claim 1 wherein the metal salt **comprises** zinc chloride."

(Emphasis added by the Board to indicate the differences with the main and auxiliary requests and the "First Revised Specification" cited above.)

- (g) In a communication of 26 September 2003, the examining division stated that the nature of the amendments according to the "First Revised

Specification" and the necessity to study the experimental report would require the reopening of the examination procedure which, in view of the advanced stage of the procedure, was refused. Decision G 7/93 (OJ EPO 1994, 775) was cited.

(h) In a telephone conversation on 9 October 2003, the examiner indicated that the "Second Revised Specification" was also not accepted since its allowance into the proceedings would necessitate the reopening of the substantive examination. The appellants' attention was drawn to the opportunity to lodge an appeal against the refusal of the main request.

(i) By letter dated 26 November 2003 the applicants maintained the "First Revised Specification" as the main request and the "Second Revised Specification" as an auxiliary request and argued that the examining division had exercised its discretion under Rule 86(3) EPC 1973 in error, in that "all relevant factors" mentioned in G 7/93 (*supra*) included the applicant's interest in obtaining the extent of protection that is appropriate.

III. In its decision dated 1 March 2004, the examining division refused the above European patent application pursuant to Article 97(1) EPC as there was no agreed text as required by Article 113(2) EPC. It stated that in refusing to allow into the proceedings the additional requests (first and second revised specifications) submitted after the communication under Rule 51(4) EPC 1973 (version in force from 1 July 2002)

it had properly exercised its discretion under Rule 86(3) EPC, since it considered that the conditions for accepting amendments at this stage of procedure defined in G 7/93 (*supra*) had not been met. The amendments were not minor, and new comparative data had been submitted which did not *prima facie* support inventive step over the whole range claimed. The applicant had already been informed before the oral proceedings that the problem had not been regarded as solved for any metal salt and any cyanide salt and thus had had an opportunity to provide required information. Re-opening the examination proceedings would involve an appreciable delay and was not justified.

- IV. On 19 March 2004 a Notice of Appeal was filed, together with an order for payment of the prescribed fee. The statement setting out the grounds of the appeal was filed on 2 July 2004, together with a "First Revised Specification" and a "Second Revised Specification" corresponding to the requests not allowed into the proceedings by the Examining Division.

- V. Oral proceedings before the Board were held on 27 June 2008.

- VI. The Appellant's arguments can be summarised as follows:
 - (a) The examining Division applied Decision G 7/93 (*supra*) incorrectly since that decision dealt with a situation regarding the old-style Rule 51(6) EPC 1973, which was a stage of the proceedings at which the text had already been approved, hence more advanced than in the present situation. According to Reasons 2.3 of G 7/93, amendments

after Rule 51(4) EPC 1973 should be treated more liberally than changes at a later stage. Reasons 2.5 stated that the Examining Division should consider all relevant points. This would include the interest of the appellant not only to obtain a valid patent, but also to obtain one with as broad claims as validly possible. T 989/99 (of 14 December 2000, not published in OJ EPO) and T 166/86 (OJ 1987, 372) were also cited in support of the argument that the examining division had not sufficiently considered the appellants' interests when it refused to accept the amended claims.

- (b) The appellants had not requested an appealable decision or filed an appeal when they received the communication under Rule 51(4) EPC 1973, since those possibilities had not been indicated, nor had they been mentioned in the minutes of the oral proceedings.

VII. 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 "First revised specification" and the "Second revised specification" filed with letter dated 14 August 2003, and that the appeal fee be reimbursed, or as second auxiliary request that a patent be granted on the basis of the text that accompanied the communication under Rule 51(4) EPC 1973 dated 31 January 2003.

Reasons for the Decision

1. The appeal is admissible.
2. The decision under appeal deals solely with the refusal under Rule 86(3) EPC 1973 to admit the requests filed after issuance of the communication under Rule 51(4) EPC 1973 (version in force from 1 July 2002) into the proceedings. The main question to be decided on appeal is thus whether this refusal is an appropriate exercise of the discretion given to the Examination Division under Rule 86(3) EPC.
3. Guidance on the principles to be applied can be derived from Enlarged Board of Appeal decision G 7/93 (*supra*). The particular case to which that decision relates arose when the Rules were slightly differently formulated, and in a case where the applicant had already given his consent to the version proposed by the Examining Division. But what was said by the Enlarged Board in that case can be considered generally applicable to new requests put forward at a late stage of the proceedings, that is one where the applicant has already had at least one opportunity to amend the application and the Examining Division has already completed substantive examination of the application.
4. The principles that can be derived from decision G 7/93 are:
 - (a) Until the issue of a decision to grant the patent, the Examining Division does have a discretion under Rule 86(3) (now 137(3)) EPC second sentence whether or not to allow the amendment of the

application at a late stage, irrespective of whether the applicant has already agreed to a text (G 7/93, point 2.1).

(b) The Examining Division is required to exercise its discretion considering all relevant factors, in particular the applicant's interest in obtaining a patent which is valid in all designated states, and the EPO's interest in bringing examination to a close, and must balance these against one another (G 7/93, points 2.2 and 2.3).

(c) Allowing a request for amendment at a late stage of the examination proceedings, that is against the background that the applicant has already had at least one opportunity to amend the application and that the Examining Division has already completed substantive examination of the application, will be an exception and not the rule (G 7/93, point 2.3).

(d) It is not the function of a Board of Appeal to review all the facts of the case as if it were in the place of the first instance department, in order to decide whether or not it would have exercised the discretion in the same way as the first instance department. Rather a Board of Appeal should only overrule the way in which the first instance department exercised its discretion if it comes to the conclusion either that the first instance department has not exercised its discretion in the right way as set out in (b) above or has exercised its discretion in an unreasonable way, and thus exceeded the proper limits of its discretion (G 7/93, point 2.6).

- 4.1 In the present case the proceedings before the Examining Division (see point II above) involved three communications from the Examining Division, followed by oral proceedings on 9 January 2003 at which the chairman indicated that the main request did not comply with the EPC but that the Examining Division intended to grant a patent on the basis of the new auxiliary request and amended description filed during the oral proceedings. This was confirmed in a communication under Rule 51(4) EPC 1973 (version in force from 1 July 2002) sent 31 January 2003 accompanied by a communication of the same date stating reasons why claim 1 of the main request lacked inventive step (Article 56 EPC) and clarity within Article 84 EPC.
- 4.2 The purpose of oral proceedings should be to settle as far as possible all outstanding questions relevant to the decision (compare Guidelines for Examination in the European Patent Office (December 2007 edition) Part E Chapter III.5). A late stage of the examination proceedings in the sense of point 4(c) above had thus been reached at the end of the oral proceedings, and any amendments thereafter therefore fell to be considered under the principles derivable from decision G 7/93, as set out in point 4 above.
- 4.3 On receipt of the communication under Rule 51(4) EPC 1973 (version in force from 1 July 2002) on the text of the auxiliary request and the accompanying communication giving the reasons for refusal of the main request, both of 31 January 2003, the appellants had two courses open to them. They could either accept grant of a patent on the basis of the communication under Rule 51(4) EPC 1973 (version in force from 1 July

2002) relating to the text of the auxiliary request submitted at the oral proceedings, or ask for a written decision giving the reasons for refusing the main request and then appeal this. These possibilities have now been spelled out in Legal Advice No. 15/05 (rev. 2) (OJ 2005, 357) in particular point 1.5. That this possibility of appeal was not stated explicitly during the oral proceedings or in the communication giving the reasons for the refusal of the main request is not regarded by the Board as relevant. The appellants were represented by a qualified representative and this possibility of appeal concerning the refusal of a request and appealing this decision is part of the basic knowledge of EPO procedure with which a qualified representative can be expected to be familiar. In any event the representative's attention was explicitly drawn to this possibility in the telephone conversation of 9 October 2003 (see point II(h) above). No procedural violation can be seen here.

- 4.4 As stated in the decision under appeal, the Examination Division exercised its discretion under Rule 86(3) EPC 1973 to refuse to allow into the proceedings the two further requests submitted because this would have required re-opening of the examination proceedings in relation to matters in relation to which the Examining Division had indicated in various communications that for such broader claims the requirements of the EPC were not fulfilled. It appears to the Board that the Examining Division exercised its discretion in a perfectly proper and reasonable way in accordance with the applicable principles.

4.5 From the two other decisions cited by the appellants, the Board can derive nothing that assists their case. Decision T 166/86 only concerned allowing the applicant to file at a late stage a claim request that would be valid under the legal provisions of a particular designated state that had made a reservation as to patentable subject matter under Article 167 EPC 1973. It provides no more support for the appellants' case than the later decision G 7/93 already discussed above. Decision T 989/99 turns on the fact that the Examination Division had given no reasons (see point 2.3) so that the Board of Appeal considered it necessary to set the decision under appeal aside and exercise the discretion itself (point 2.4). This is not the situation in this appeal.

4.6 The Board concludes that that the main request and the auxiliary request, which relate to the requests which the Examining Division did not allow into the proceedings, must be refused.

4.7 The Board would comment that it appreciates the importance to applicants of having the broadest valid claims possible. But ensuring that the right information and claims are before the Examining Division is something that applicants should bear in mind when filing, or at the latest when it comes to oral proceedings before the Examining Division.

5. Allowing into the appeal proceedings the second auxiliary request for grant of a patent on the basis of the text on which the Examining Division sent the Rule 51(4) EPC 1973 communication and remitting the application on this basis is justified since this does

not necessitate re-opening of the examination proceedings.

Reimbursement of the appeal fee

6. According to Rule 103(1)(a) EPC (substantially equivalent to former Rule 67 EPC 1973) the appeal fee shall be reimbursed where the Board of Appeal deems an appeal to be allowable, if such reimbursement is equitable by reason of a substantial procedural violation. Here the decision under appeal is considered correct, and is set aside only because of a request not before the Examining Division at the time it took its decision. Further the Board sees no procedural violation. Accordingly the request for reimbursement of the appeal fee must be refused.

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 the text that accompanied the communication under Rule 51(4) EPC dated 31 January 2003.
3. The request for reimbursement of the appeal fee is refused.

Registrar

Chairman

C. Eickhoff

S. Perryman