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**Datasheet for the decision
of 19 December 2007**

Case Number: T 0316/05 - 3.3.10

Application Number: 00978793.8

Publication Number: 1240130

IPC: C07C 51/265

Language of the proceedings: EN

Title of invention:

Method for oxidation of xylene derivatives

Applicant:

GENERAL ELECTRIC COMPANY

Headword:

-

Relevant legal provisions (EPC 2000):

EPC Art. 123(2)
EPC R. 103, 111(2)

Relevant legal provisions (EPC 1973):

EPC R. 67, 68(2)

Keyword:

"Decision reasoned in the sense of Rule 111(2) [Rule 68(2)]
EPC (no) - fresh feature - no decision on original disclosure
- findings on substantive issues based on that feature -
deficient reasoning"
"Substantial procedural violation (yes)"
"Reimbursement of appeal fee (yes)"
"Remittal to the first instance for further prosecution"

Decisions cited:

T 0278/00

Catchword:

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Case Number: T 0316/05 - 3.3.10

D E C I S I O N
of the Technical Board of Appeal 3.3.10
of 19 December 2007

Appellant:

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Decision under appeal:

Decision of the Examining Division of the
European Patent Office posted 23 September 2004
refusing European application No. 00978793.8
pursuant to Article 97(1) EPC 1973.

Composition of the Board:

Chairman: R. Freimuth
Members: C. Komenda
D. S. Rogers

Summary of Facts and Submissions

I. The appeal lodged on 22 November 2004 lies from the decision of the Examining Division posted on 23 September 2004 refusing European patent application No. 00 978 793.8 published under the International publication No. WO 01/38280.

II. The decision under appeal was based on claims 1 to 10 submitted on 15 January 2004 according to the then pending request. Claim 1 read as follows:

"1. A method for oxidizing a substrate comprising at least one halo-ortho-xylene which comprises combining the substrate in the absence of solvent or promoter with at least one metal catalyst in the non-gaseous phase and heating in the presence of an oxygen source to produce a product mixture."

Further independent claims were claims 7 and 10. Claims 2 to 6 were dependent on claim 1 and claims 8 and 9 were dependent on claim 7.

III. In a communication dated 10 September 2003 the Examining Division objected to the feature "in the non-gaseous phase", which was introduced into original independent claims 1 and 7, as not having a basis in the application as filed thus contravening the requirements of Article 123(2) EPC. In the decision under appeal the Examining Division did not take a decision on this issue but nevertheless held that the subject-matter of claim 1 was novel over the cited prior art due to that particular feature, since the method according to claim 1 was delimited from two

prior art documents disclosing a gas-phase oxidation process for the reason of operating in the "non-gaseous phase". In the assessment of inventive step, the Examining Division found that in view of other documents, which related to methods for oxidizing xylenes in the liquid phase, the method according to claim 1 did not involve an inventive step, thus contravening Article 56 EPC.

- IV. With a Fax received on 17 December 2007 the Appellant submitted that there was a substantial procedural violation, since the Examining Division had failed to decide whether the amendment made to claim 1 satisfied the requirements of Article 123(2) EPC. He further informed the Board that he would not attend the oral proceedings.

- V. The Appellant requested that the decision under appeal be set aside, that the case be remitted to the department of the first instance for further prosecution and that the appeal fee be reimbursed.

- VI. At the end of the oral proceedings, which were held on 19 December 2007 in the absence of the Appellant, the decision of the Board was announced.

Reasons for the Decision

- 1. The appeal is admissible.

Procedural matters

2. The Appellant has objected to the decision under appeal as being insufficiently reasoned in violation of Rule 111(2) EPC 2000 (Rule 68(2) EPC 1973), since no decision as to whether the amendment made to claim 1 fulfils the requirements of Article 123(2) EPC has been taken.

It is established jurisprudence of the Boards of Appeal that the provision of Rule 111(2) EPC 2000 (Rule 68(2) EPC 1973) requires the decision to contain, in logical sequence, those arguments which justify the decision. Moreover, the conclusions drawn from the facts and evidence must be made clear. Therefore all the facts, evidence and arguments which are essential to the decision must be discussed in detail in the decision including all the decisive considerations in respect of the factual and legal aspects of the case (T 278/00, OJ EPO 2003, 546, points 2 to 5 of the reasons).

- 2.1 The purpose of the requirement to provide a reasoned decision is of course to enable the party or parties and, in case of an appeal, also the Board of Appeal to examine whether the decision could be considered to be justified or not. Thus, when deciding upon novelty and inventive step, as in the present case, the logical chain of reasoning must be given, comprising identifying the feature(s) characterising the claimed invention, i.e. that feature, which delimits and distinguishes the subject-matter claimed from the (closest) state of the art. In the case that this feature results from an amendment made to the independent claim the logical chain of reasoning should

start, as a prerequisite, with determining whether this amendment fulfils the requirements of Article 123(2) EPC in that the fresh feature does not extend the subject-matter claimed beyond the content of the application as filed. This is because it would be futile to acknowledge or deny novelty due to the presence of a feature, which has not been originally disclosed and, hence, does not form part of the invention. The same considerations apply with respect to the assessment of inventive step, since it would be pointless to acknowledge or deny inventive ingenuity on the basis of a feature not being part of the invention.

- 2.2 In the present case the feature "in the non-gaseous phase" has been incorporated into claim 1. The Examining Division objected in the communication dated 10 September 2003 to this feature as not having support in the application as filed. However, the decision under appeal neither considered, nor decided as to whether this feature satisfied the requirements of Article 123(2) EPC. Thus, in being simply silent on the issue of Article 123(2) EPC which had been raised in examination proceedings, the decision under appeal did not establish whether this feature "in the non-gaseous phase" is a technical feature disclosed in the application as filed, or added subject-matter. This exercise is a necessary prerequisite for deciding on novelty and inventive step, since a decision on these substantive issues being based only on this particular feature becomes futile once the feature "in the non-gaseous phase" would not have been originally disclosed and, hence, would not be part of the invention.

- 2.3 In the absence of a decision on the issue of Article 123(2) EPC a proper basis for deciding on novelty is missing. In the decision under appeal novelty was acknowledged due to the feature "in the non-gaseous phase", which was found to distinguish the subject-matter claimed from the prior art. Since this finding on novelty is based exclusively on that particular feature which has not been decided if it extends beyond the content of the application as filed, the decision under appeal is flawed.
- 2.4 As a further consequence of accepting the feature "in the non-gaseous phase" as distinguishing feature the decision under appeal relied in the assessment of inventive step only upon documents relating to the liquid phase and disregarded other prior art documents. In the absence of a decision as to whether this feature fulfils the requirements of Article 123(2) EPC, and thus forms part of the invention, this feature cannot be the basis for considering or disregarding documents in the assessment of inventive step.
- 2.5 Therefore, the Board concludes that in the absence of the prerequisite finding as to whether the fresh feature "in the non-gaseous phase" fulfils the requirements of Article 123(2) EPC, the first step of the logical chain of reasoning is missing and the decision under appeal thereby deficient.
3. For these reasons, in the Board's judgment, the decision under appeal which is based on such a deficient reasoning is not 'reasoned' in the sense of Rule 111(2) EPC 2000 (Rule 68(2) EPC 1973). This failure amounts to a substantial procedural violation

requiring the decision under appeal to be set aside and the case to be remitted to the first instance. The appeal is thus deemed to be allowable and the Board considers it to be equitable by reason of that substantial procedural violation to reimburse the appeal fee in the present case according to Rule 103 EPC 2000 (Rule 67 EPC 1973).

4. The Board also considers the following issues outlined below as meriting consideration when resuming examination proceedings:

The application contains a plurality of independent claims of the same category, an examination of whether or not the claims fulfil all the requirements of the EPC, e.g. of Rule 43(2) EPC 2000 (Rule 29(2) EPC 1973) is thus needed.

The deletion of the term "added" from the claims needs to be examined as to whether or not it complies with Article 123(2) EPC.

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.
3. The appeal fee is to be reimbursed.

The Registrar

The Chairman

P. Cremona

R. Freimuth