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**Datasheet for the decision
of 8 July 2008**

Case Number: T 0645/07 - 3.3.06

Application Number: 98922833.3

Publication Number: 0985010

IPC: C10G 45/64

Language of the proceedings: EN

Title of invention:

Process for producing high grade diesel fuel

Patentee:

Neste Oil Oyj

Opponents:

- 01: ExxonMobil Research and Engineering Company
02: Sasol Chevron Consulting Limited

Headword:

Diesel fuel/NESTE

Relevant legal provisions:

RPBA Art. 10a(2)

Relevant legal provisions (EPC 1973):

EPC Art. 108, 84, 123(2), 111(1)

Keyword:

"Admissibility of appeal - yes (sufficiency of grounds)"
"Main request: clarity of claim (yes) - support of claim (yes)
(extracted feature, no functional or structural relationship
to other features)"

Decisions cited:

T 0922/05, T 1067/97

Catchword:

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Case Number: T 0645/07 - 3.3.06

D E C I S I O N
of the Technical Board of Appeal 3.3.06
of 8 July 2008

Appellant: Neste Oil Oyj
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Decision under appeal: Decision of the Opposition Division of the
European Patent Office posted 2 February 2007
revoking European patent No. 0985010 pursuant
to Article 102(1) EPC.

Composition of the Board:

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

Summary of Facts and Submissions

- I. This appeal is from the decision of the Opposition Division to revoke the European patent No. 0 985 010 entitled "process for producing high grade diesel fuel".
- II. Two notices of opposition had been filed against the granted patent, wherein the Opponents sought revocation of the patent on the grounds of *inter alia* Article 100(c) EPC due to extension beyond the content of the application as filed (Article 123(2) EPC)).
- III. The decision of the Opposition Division was based on amended sets of claims according to a main request and four auxiliary requests, Claim 1 of the main request reading:

"1. A process for producing a middle distillate suitable as a diesel fuel, with improved low temperature properties and a low content of aromatic compounds, from a hydrocarbon feed as the starting material, characterized in that the feed material is a mixture of hydrocarbons boiling in the range of 150 to 400°C and in that said feed is contacted in a single reaction step, in the presence of hydrogen, and at a temperature between 250-500°C and at a pressure being 50-80 bar with a bifunctional catalyst containing a hydrogenating metal component in addition to a zeolite or a silicoaluminophosphate molecular sieve and a carrier for the simultaneous removal of aromatics and isomerization of paraffins, and the bifunctional catalyst is obtained by impregnation of the catalyst with the metal component."

The claims of the auxiliary requests differ therefrom, *inter alia*, in that the impregnation method is defined as the pore filling method.

The Opposition Division held that the amended claims of none of the Proprietor's then pending requests fulfilled the requirements set out in Article 123(2) EPC. In particular, it was held that the amendments contained non-allowable generalisations of features disclosed in the original application only in combination with specific other features. Two such generalisations were made out in Claim 1 of the main request, namely the isolated insertion of the pressure and temperature condition from specific sets of process conditions and the insertion of the term "impregnation" instead of the specific "pore filling method" used in the examples of the application as filed for impregnating the catalyst.

Concerning the introduction of the pore filling method into Claim 1 of the auxiliary requests, the following can be inferred from the appealed decision:

The examples of the application as filed provided the only basis for this method, however, merely in relation with specific catalysts and a specific platinum salt solution. In contrast, in the claims of the auxiliary requests the impregnation method had been generalised for other zeolites and molecular sieves as well as for all possible carriers and aqueous platinum salt solutions. This generalisation was not admissible due to lack of support for it in the application as filed and since the Proprietor had not provided evidence for the absence of a functional or structural relationship between the respective features.

IV. This decision was appealed by the Patent Proprietor, now Appellant, who filed amended sets of claims in a new main and five auxiliary requests and an explanation of how the claims have been amended and where a basis for the amendment could be found in the original application.

Claim 1 of the main request reads:

"1. A process for producing a middle distillate suitable as a diesel fuel, with improved low temperature properties and a low content of aromatic compounds, from a hydrocarbon feed as the starting material, characterized in that the feed material is a mixture of hydrocarbons boiling in the range of 150 to 400°C and in that said feed is contacted in a single reaction step, in the presence of hydrogen, and at a temperature between 300-400°C, at a pressure of 50-80 bar, hydrocarbon feed liquid hourly space velocity being between 0.5 and 3 h⁻¹ and hydrogen feed 200-500N l/l, with a bifunctional catalyst containing 0.01 - 10 wt-% of platinum in addition to a zeolite or a silicoaluminophosphate molecular sieve and a carrier for the simultaneous removal of aromatics and isomerization of paraffins, and the bifunctional catalyst is obtained by impregnation of the catalyst with platinum using the pore filling method."

V. The Opponents, now Respondents asserted that the appeal was inadmissible for being insufficiently substantiated and that the amendments made to the claims violated the provisions of Articles 123(2) and 84 EPC.

- VI. With its letter of response, the Appellant filed *inter alia* an expert opinion by Dr Narendra Kumar. Thereupon, the Respondents filed further documents.
- VII. In a communication annexed to the summons for oral proceedings on 8 July 2008, the Board informed the parties that the issues to be discussed would be limited to the admissibility of the Appellant's appeal and the admissibility of the amendments made to the claims.
- VIII. The Appellant, at the oral proceedings and in writing, submitted in essence the following arguments:
- The appeal was admissible since it was apparent from the statement of grounds of appeal that the amendments made in Claim 1 of the new main request addressed and overcame the two objections of the contested decision under Article 123(2) EPC against the then pending main request.
 - The feature concerning the impregnation method which was taken from the examples was not closely related to the other features of the examples. It was implicitly present in Claim 1 as filed where it was required that the catalyst contains the metal component in addition to the molecular sieve and carrier, not as part of the crystal lattice of the molecular sieve. Moreover, the pore filling method was the only method mentioned in the application as filed.

- The amendments did not create non-clarity of the claims since the terms "hydrogen feed" and "pore filling method" were perfectly clear to those skilled in the art.

IX. The Respondents submitted the following arguments:

- The appeal was insufficiently substantiated and, thus, inadmissible since it was not indicated in the Appellant's statement of grounds of appeal how the new requests might overcome the findings under Article 123(2) EPC in the contested decision. Reference was made in this respect to decision T 922/05. In addition, the statement of grounds of appeal did not contain a complete and unbroken line of reasoning contrary to Article 10a(2) of the Rules of Procedure of the Boards of Appeal (RPBA).
- The introduction of the pore filling method into Claim 1 of the new requests violated the provisions under Article 123(2) EPC since that feature was originally disclosed only in combination with specific other features. According to decision T 1067/97, the extraction of isolated features from a specific set of features was only allowable in the absence of a functional or structural relationship of those features. Such an absence was not demonstrated by the Appellant who carries the burden of proof. Further, it was apparent from the prior art that there existed different methods of impregnation. Thus, the particular pore filling method was not a feature implicitly present in the claims as filed.

Consequently, it was originally not clearly and unambiguously disclosed that, as now claimed, the catalyst is obtained by using the pore filling method to impregnate any molecular sieve and carrier with any compound of platinum in any concentration.

- The terms "hydrogen feed" and "pore filling method" newly introduced into the claims rendered the latter unclear due to a lacking definition.

- X. The Appellant requested that the decision under appeal be set aside and that the case be remitted to the first instance for further prosecution.

The Respondents requested that the appeal be dismissed or, in the alternative, that the case be remitted to the first instance for further prosecution concerning Article 100(a) and (b) EPC.

Reasons for the Decision

1. Admissibility of the Appellant's appeal

The Appellant's appeal, of which the admissibility under Article 108 EPC was disputed by the Respondents for lack of substantiation (point IX above), is admissible for the following reasons:

- 1.1 It is established case law (see Case Law of the Board of Appeal of the European Patent Office, 5th edition 2001, chapter VII.D.7.5.1) that an appeal is adequately substantiated, if the grounds of appeal specify the

legal or factual reasons why the impugned decision should be set aside. The arguments must be clearly and concisely presented to enable the Board and the other party or parties to understand immediately why the decision is alleged to be incorrect, and on what facts the Appellant bases its arguments, without first having to make investigations of their own.

However, there exist cases where substantiation of an appeal is sufficient even if the grounds do not contain detailed reasons why the decision is contested (see Case Law chapter VII.D.7.5.2). This is especially true if amended claims are filed which deprive the contested decision of its basis. Hence, an appeal is considered to be sufficiently substantiated even though it is not specified in the statement of grounds of appeal that and why the contested decision is deemed to be wrong, provided that the subject of the proceedings has changed and the reasons for the decision are no longer relevant in view of that change.

1.2 In the present case, the contested decision contains two different lines of argument in relation to the requirement under Article 123(2) EPC, one dealing with the then pending main request, the other dealing with the auxiliary requests (point III above).

1.2.1 Concerning the main request, the Opposition Division found that the requirements of Article 123(2) EPC were not met for two reasons:

Firstly, the contact temperature and pressure introduced into Claim 1 were originally disclosed only

in combination with specific other process conditions and could not, therefore, be selected in isolation.

Secondly, concerning the introduced feature that the catalyst is obtained by impregnation, the examples as the only source of disclosure stipulated that "the catalyst was impregnated (was added) using the pore filling method". Therefore, the generalization of the specific impregnation method to "impregnation" in general was not supported by the description as filed.

These arguments suggest that introducing, firstly, an originally disclosed complete set of process conditions and, secondly, the specific pore filling method would overcome the objections under Article 123(2) EPC against the main request.

- 1.2.2 However, concerning the auxiliary requests, the contested decision states that the pore filling method was disclosed in the examples only in connection with other features, such as a specific catalyst (point III above), and could not, therefore, be generalised for other catalysts, unless there was evidence for the absence of any functional and structural relationship.

Hence, the reasoning with respect to the auxiliary requests suggests in contradiction to that concerning the main request that the introduction of the pore filling method into Claim 1 produces subject-matter which extends beyond the application as filed.

- 1.3 The Appellant filed with the statement of the grounds of appeal amended claims in a new main request and five auxiliary requests and an explanation of how Claim 1 of

the new main and auxiliary requests have been amended in relation to the main request which was before the Opposition Division and where in the application as filed support for the amended features is to be found.

It is immediately apparent (cf. points III and IV) that the amendments made to Claim 1 of the main request are a reaction to the above suggestion in the contested decision (point 1.2.1) of how to overcome the deficiencies under Article 123(2) EPC of Claim 1 of the main request, since the new main request contains in Claim 1 the complete set of process conditions disclosed on page 6 of the application as filed (lines 10 to 11) and the specification that the catalyst is obtained by impregnation using the pore filling method.

1.4 The Board is, therefore, of the opinion that decision T 922/05 cited by the Respondents is not applicable here. Contrary to the case underlying that decision, the present statement of grounds of appeal clearly contains a connection to the appealed decision and it is immediately apparent from the amendments made to the claims of the main request why and how the new claims are deemed to avoid the findings by the Opposition Division in relation to the then pending main request. In the present case, further reasoning is, thus, dispensable.

1.5 The Board also notes that the Respondent's quotation of Article 10a(2) RPBA as requiring that "the statement of grounds of appeal should be the party's complete case" is incomplete. The first two sentences of this Article read:

"The statement of grounds of appeal **and the reply** shall contain **a party's** complete case. **They** shall set out clearly and concisely the reasons why it is requested that the decision under appeal be reversed, amended or upheld, and should specify expressly all the facts, arguments and evidence relied on".

Hence, it is clear that according to the RPBA the Appellant has the possibility to complete its case in reply to submissions made in answer to the statement of grounds of appeal by a Respondent or Board of Appeal.

The Respondents, however, did not allege that the Appellant's case was incomplete, if the Appellant's reply to the Respondents' submissions is taken into account.

- 1.6 The Respondents further argued that the new main request was de facto an amendment of the first auxiliary request so that the statement of grounds of appeal should have addressed the corresponding reasoning in the appealed decision.

It is true that Claim 1 of the main request has been limited further to platinum as the hydrogenating metal and to the amount of platinum present in the catalyst as is disclosed in a preferred embodiment on page 6 of the application as filed (lines 28 to 31).

It is further true, as pointed out by the Respondents, that Claim 1 of the new main request differs from that of the first auxiliary request which was before the

Opposition Division essentially only with respect to the amount of platinum in the catalyst.

Nevertheless, the Respondents' line of argument is not convincing since, as already outlined above, the deficiencies criticised in the main request before the Opposition Division are overcome in the new main request.

It should be born in mind in this respect that the contested decision is contradictory concerning the issue of added matter by the introduction of the pore filling method into Claim 1 of the then pending main request on the one hand and of the auxiliary requests on the other hand (point 1.2.2 above). As correctly observed by the Appellant, it is not its own duty to improve the appealed decision.

1.7 As a consequence of the above contradiction in the contested decision, the Board finally finds it difficult in the present case, if not impossible, that the statement of grounds of appeal addresses the contested decision as a whole as was demanded by the Respondents.

2. *Amendments (Articles 84 and 123 EPC) (main request)*

2.1 Article 84 EPC

The Respondents objection under Article 84 EPC to the terms "pore filling method" and "hydrogen feed" is not convincing for the following reasons:

2.1.1 At the oral proceedings, Dr Miller as the Respondents' technical expert declared in conformity with the expert opinion by Dr Narendra Kumar filed by the Appellant that the term "pore filling method" was perfectly clear to those skilled in the art.

2.1.2 Concerning the "hydrogen feed", the Respondents correctly observed that the unit of that parameter is given as Nl/l (normalized litre/litre) which represents a ratio of gaseous volume to liquid volume. Hence, it is clear from the context of Claim 1 that the term indicates the feed ratio in litres of gaseous hydrogen to liquid hydrocarbons.

2.2 Article 123(2) EPC

2.2.1 Both Respondents objected under Article 123(2) EPC to the introduction of the pore filling method into Claim 1 since this method was disclosed only in examples in combination with specific other features which were absent in Claim 1, namely in combination with a specific platinum salt solution of a specific concentration and with a specific molecular sieve and carrier.

The Respondents produced the argument (point IX above) that in accordance with decision T 1067/97, the extraction of the feature concerning the pore filling method from the specific examples is not allowable since the Appellant had not demonstrated that there existed no functional or structural interaction between those features.

2.2.2 However, the Respondents never have given any reason why a skilled person would assume such a relationship. It is observed that the decision under appeal is also silent on that issue. Nor does the Board see how the pore filling method should have an influence on the outcome of process dependent on the kind and concentration of the platinum salt solution and on the particular molecular sieve and carrier.

In the case underlying the decision T 1067/97, it was apparent that the molar ratio $[\text{SiO}_2]:[\text{M}_2\text{O}]$ and the SiO_2 concentration of the developer were interrelated via the alkali strength.

In contrast, in the present case, the existence of such a functional or structural relationship is not per se evident.

2.2.3 Hence, the Respondents' objection to the introduction of the pore filling method into Claim 1 is based on mere allegation, which in the Board's opinion, is not sufficient to shift the burden of proof to the Appellant.

2.2.4 In addition, as pointed out by the Appellant, the application as filed mentions only one method, namely the pore filling method.

Whether there exist different methods of impregnation in the art is, in the Boards opinion, irrelevant since, the skilled reader of the application as filed had no choice to select from a variety of methods. Instead he would clearly and unambiguously derive from the application as filed that the pore filling method was

the method to be used for adding platinum to the catalyst.

- 2.2.5 The Board, therefore, concludes that the amendments made in Claim 1 of the main request are allowable under Article 123(2) EPC.

3. *Remittal*

The patent was revoked solely on the grounds of Article 123(2) EPC. Whether the patent with the amended claims according to the new main request meets the other requirements of the EPC, in particular those of Articles 83, 54 and 56 EPC, has not yet been established.

Since it is the function of appeal proceedings to give a judicial decision upon the correctness of a separate earlier decision taken by a first-instance department (Case Law of the Boards of Appeal, 5th ed. 2006, VII.D.1), the Board finds it appropriate to make use of its power under Article 111(1) EPC and remits the case to the first instance for further prosecution.

Order

For these reasons it is decided that:

The decision under appeal is set aside.

The case is remitted to the first instance for further prosecution.

The Registrar:

The Chairman:

G. Rauh

P.-P. Bracke