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**Datasheet for the decision
of 30 June 2010**

Case Number: T 0879/07 - 3.3.06

Application Number: 96935878.7

Publication Number: 0861311

IPC: C10L 1/02

Language of the proceedings: EN

Title of invention:

Process for producing synthetic diesel fuel

Patentee:

ExxonMobil Research and Engineering Company

Opponent:

Shell Internationale Research Maatschappij B.V.

Headword:

Synthetic Diesel Fuel/EXXON

Relevant legal provisions:

EPC Art. 123(2)(3), 84, 54, 111(1)

Relevant legal provisions (EPC 1973):

-

Keyword:

"Admissibility of amendments (yes)"

"Novelty (yes)"

"Remittal (yes)"

Decisions cited:

-

Catchword:

-



Case Number: T 0879/07 - 3.3.06

D E C I S I O N
of the Technical Board of Appeal 3.3.06
of 30 June 2010

Appellant: ExxonMobil Research and Engineering Company
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Decision under appeal: Interlocutory decision of the Opposition
Division of the European Patent Office posted
21 March 2007 concerning maintenance of
European patent No. 0861311 in amended form.

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 European patent No. 0 861 311 relating to a process for producing synthetic diesel fuel.
- II. Two notices of opposition had been filed against the granted patent, wherein the Opponents sought revocation of the patent inter alia on the grounds of Article 100(a) EPC for lack of novelty in view of document

D1 DE88014638 (US Dept. of Commerce, National Technical Information Service) "Fischer-Tropsch wax characterization and Upgrading: Final Report 06.06.88.

- III. In its decision, the Opposition Division held that the patent as granted (main request) did not meet the requirements of Article 100(a) EPC in view of figure 6.1 of document D1.

In particular, the Opposition Division was of the opinion that the wording of Claim 1 covered the presence of primary C₁₂+ alcohols in the (ii) fraction(s) of step (b) since the phrase "one or more other fractions" did not exclude such materials. Therefore, it was held that fraction(s) (b)(ii) of present Claim 1 corresponded to the heaviest fraction obtained from the F-T condensate (fraction 650-OP 601.9) in Figure 6.1. Therefore, the process disclosed in that figure comprised the hydroisomerisation of at least a portion of the heavier fraction of step (a) and at least a

portion of the (b)(ii) fraction(s) according to step (c) of Claim 1.

- IV. The Proprietor (hereinafter Appellant) appealed this decision. Opponent I responded to the Appellant's statement of grounds of appeal but withdrew its opposition under cover of a letter dated 8 September 2008. Opponent II did not make any comments during appeal proceedings.
- V. In a communication annexed to the summons of 11 February 2010 to oral proceedings, the Board indicated that the questions of novelty and inventive step of the claimed subject-matter in view of document D1 might be an issue at the oral proceeding. Concerning inventive step, documents D2 to D6 were mentioned as relevant common general knowledge.
- VI. In the course of the oral proceedings before the Board of Appeal, held on 30 June 2010 in the absence of Opponent II as announced by letter dated 22 March 2010, the Appellant filed amended claims in a new main request containing two independent claims reading:
- "1. A process for producing a distillate fuel or distillate fuel blending stock heavier than gasoline comprising:
- (a) separating the product of a Fischer-Tropsch process into a heavier 700°F+ (371.1°C+) fraction and a lighter 700°F- (371.1°C-) fraction;
 - (b) further separating the lighter fraction into at least two fractions, (i) one of which contains

primary C₁₂+ alcohols and is a 500°F-700°F (260°C-371.1°C) fraction and (ii) one of which is a C₅-500°F (C₅-260°C) fraction;

- (c) hydroisomerizing at least a portion of the heavier fraction of step (a) together with at least a portion of the (b)(ii) fraction at hydroisomerization conditions and recovering a 700°F- (371.1°C-) fraction from hydroisomerization;
- (d) blending at least a portion of the fraction (b)(i) with at least a portion of the 700°F- (371.1°C-) fractions of step (c),

wherein the fraction (b)(i) is characterized by the absence of hydrotreating.

6. The use as a fuel for a Diesel engine or as a blending component in or for such a fuel of a distillate fuel produced by a process in accordance with any one of claims 1 to 5."

- VII. The Appellant submitted in essence that the amendments made to the claims were allowable under the provisions of Articles 123(2)(3) and 84 EPC and that the subject-matter claimed according to the new single request differed from the disclosure of document D1 with respect to the cut point in step (a), the boiling ranges of fractions (b)(i) and (b)(ii) in step (b), and the hydroisomerisation of the heavier fraction together with at least a portion of fraction (b)(ii) in step (c).

VIII. The Appellant requested that the decision of the Opposition Division be set aside and that the case be remitted to the first instance for further prosecution on the basis of the main request filed during the oral proceedings.

Reasons for the Decision

1. *Amendments (Article 123(2)(3) and 84 EPC)*

The amendments made to Claim 1 are based on original Claims 5 and 10 in combination with the disclosure on page 3, lines 5 to 17, of the application as filed.

Dependent Claims 2, 3 and 5 are derived from original Claims 6, 7 and 12 and dependent Claim 4 is based on original Claims 9 and 11 in combination with the disclosure on page 8, lines 12 to 17 and 31 to 32. Claim 6 for the use of the product of Claims 1 to 5 is based on the disclosure on page 7, third paragraph of the application as filed (all references relate to the International Application No. WO-A-97/14768).

The amendments further limit the extent of protection conferred by the patent as granted and do not give rise to objections under Article 84 EPC.

The Board is, therefore, satisfied that the claims of the new main request meet the requirements of Articles 123(2)(3) and 84 EPC.

2. *Novelty*

2.1 In the decision under appeal, the Opposition Division rejected the Appellant's main request for lack novelty of the claimed subject-matter in view of Figure 6.1 of document D1 for the reasons set out in point III above.

However, with the amendments made to Claim 1, the Appellant introduced limitations of the claimed subject-matter which are not present in that prior art.

2.2 In particular, by defining in step (b) fraction (ii) as one which is a C₅-500°F (C₅-260°C) fraction, the argument of the Opposition Division that this fraction might correspond to the heaviest fraction obtained from the F-T condensate no longer applies since this fraction boils at 650°F and higher (see in Figure 6.1 of document D1 fraction 650-OP 601.8).

The claimed process is further distinguished from that illustrated in Figure 6.1 of document D1 by the following features:

- The cut point in step (a) is at 700°F (371.1°C).

In document D1, this point is not defined and may be above or below that temperature.

- Fraction (i) in step (b) which is not hydrotreated in the claimed process is defined to contain primary C₁₂+ alcohols and to boil within the temperature range of 500-700°F (260-371.1°C).

The corresponding fraction in document D1 boils between 350 and 650°F (see in Figure 6.1 the stream having a flow rate of 685.8 metric tons per day and being composed of fractions 2 to 5 derived from the F-T condensate).

- At least a portion of the heavier fraction of step (a) and a portion of fraction (ii) of step (b) are hydroisomerised together.

According to document D1 two fractions are hydroisomerised together with the heavier fraction of step (a), i.e. the F-T wax fraction in Figure 6.1, namely the heaviest fraction of the F-T condensate (fraction 650-OP 601.8) and a fraction obtained from oligomerised F-T C3 to C6 material (fraction HVY POLYMER 3.5). However, none of those fractions boils directly and unambiguously in a temperature range of C₅-500°F (C₅-260°C) as does fraction (b)(ii) of Claim 1.

- 2.3 The Board is, therefore, satisfied that the subject-matter of Claim 1 is novel in view of document D1 (Article 54 EPC).

The same applies *mutatis mutandis* to Claim 6 for the use of the distillate fuel of Claim 1.

3. *Remittal*

As the Appellant has argued that the case should be remitted for the reason that inventive step of the subject-matter claimed in the main request had not yet been assessed by the Opposition Division, and

considering further that the only remaining other party, Opponent II, has never advanced any opinion with respect to the Appellant's appeal, the Board deems it inappropriate to deny the Appellant the opportunity to be heard on each opposition ground by two instances Article 111(1) EPC).

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 main request.

The Registrar:

The Chairman:

G. Rauh

P.-P. Bracke