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**Datasheet for the decision  
of 28 August 2009**

**Case Number:** T 0937/07 - 3.3.05

**Application Number:** 00954093.1

**Publication Number:** 1204587

**IPC:** C01B 3/38

**Language of the proceedings:** EN

**Title of invention:**

A method and catalyst structure for steam reforming of a hydrocarbon

**Applicant:**

BATTELLE MEMORIAL INSTITUTE

**Opponent:**

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**Headword:**

STEAM REFORMING/BATTELLE MEMORIAL INSTITUTE

**Relevant legal provisions:**

EPC Art. 103(1)(a), 111(1), 123(2)  
EPC R. 116(1), 137(3)

**Relevant legal provisions (EPC 1973):**

EPC R. 67, 71a(1), 86(3)

**Keyword:**

"Procedural violation (no) - Reimbursement of the appeal fee (no)"  
"Amendments allowable"  
"Remittal for further prosecution"

**Decisions cited:**

G 0007/93, T 0132/92, T 0755/96, T 0951/97, T 0529/94

**Catchword:**

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Case Number: T 0937/07 - 3.3.05

**D E C I S I O N**  
**of the Technical Board of Appeal 3.3.05**  
**of 28 August 2009**

**Appellant:**

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**Representative:**

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**Decision under appeal:**

**Decision of the Examining Division of the  
European Patent Office posted 22 November 2006  
refusing European patent application  
No. 00954093.1 pursuant to Article 97(1) EPC.**

**Composition of the Board:**

**Chairman:** G. Rath  
**Members:** H. Engl  
H. Preglau

## **Summary of Facts and Submissions**

- I. This appeal lies from the decision of the examining division posted on 22 November 2006 to refuse the European application nr. 00 954 093.1. The decision was based on the ground that claims 1 and 12 of the main request, filed during oral proceedings contravened Article 123(2) EPC.
- II. The notice of appeal was filed with a letter dated 17 January 2007. The grounds of appeal were filed with a letter dated 2 April 2007 and were accompanied by amended claims in accordance with a main and an auxiliary request. The appellant furthermore requested the reimbursement of the appeal fee because a substantial procedural violation had occurred during first instance proceedings.
- III. The board issued a communication under Article 15(1) RPBA, dated 7 May 2009, as an Annex to the summons for oral proceedings, in which the board raised objections under Articles 84 and 123(2) EPC against the claims as amended.

Regarding the request to reimburse the appeal fee, in the board's provisional opinion there was no substantial procedural violation making a reimbursement equitable.

The board also indicated its intention to exercise its discretion under Article 111 (1) EPC to remit the case to the department of first instance for further prosecution in case the appellant was able to overcome the objections raised.

- IV. Subsequently, the appellant filed new claims in accordance with a main and four auxiliary requests.
- V. The board issued a second communication under Article 15(1) RPBA, dated 20 July 2009, as an Annex to the summons for oral proceedings. The board maintained its objections against the claims of the main request and first and second auxiliary requests, but indicated that the claims of the third auxiliary request appeared to meet the requirements of Article 123 (2) EPC.
- VI. On 27 July 2009 the appellant filed an amended set of claims 1 to 11 as a new main request and claims 1 to 5 as an auxiliary request. It also submitted further arguments regarding the substantial procedural error.

Independent claims 1 and 9 of the main request read as follows:

"1. A method for steam reforming of a hydrocarbon having the steps of flowing a mixture of steam and said hydrocarbon past a supported catalyst having a support and a catalyst metal thereon, and reacting said mixture at a temperature from 600°C to 1000°C thereby forming at least one product; wherein said support is a spinel support and said flowing is at a rate providing a residence time of less than 0.1 seconds."

"9. A steam reforming catalyst structure for steam reforming of a hydrocarbon, comprising:

a first porous structure comprising a first pore surface area and a first pore size of at least 0.1 µm;

a porous interfacial layer that is a spinel with a second pore surface area and a second pore size less than the first pore size, the porous interfacial layer having a thickness less than 4 mm placed upon the first pore surface area; and

a steam reforming catalyst selected from the group consisting of rhodium, iridium, nickel, palladium, carbide of group VIB, and combinations thereof, placed upon the second pore surface area."

The appellant withdrew its request for oral proceedings provided the board allowed the main request and decided to remit the case to the examining division for further prosecution.

VII. The appellant's arguments may be summarized as follows:

i Regarding the substance of the appeal

Claim 1 of the main request closely corresponded to claim 1 as originally filed. In claim 2 the group VIB carbides had been deleted to counter any argument to the effect that claims 1 and 2 were inconsistent (which was denied because the skilled person would understand that it was the metal of the carbide compound which was the element essential for the catalytic activity).

Claim 9 was based on the description, page 2, lines 10 to 20, in the version as originally filed. It was evident from the application as a whole that the claimed catalyst structure was intended for a method of steam reforming of a hydrocarbon.

- ii Regarding the request for reimbursement of the appeal fee

The appellant contended that the conduct of the oral proceedings by the examining division constituted a substantial procedural violation in accordance with Rule 103 (1)a EPC (Rule 67 EPC 1973). In particular, a "*harsh approach*" and "*Draconian action*" was seen in the fact that the chairman of the hearing announced that only one final opportunity for amendment was to be allowed. The basis for this was that during the written procedure the appellant had already filed five sets of amended claims. Consequently, the appellant had prepared in a break during the hearing a substantially revised set of claims to overcome the previously expressed objections. However, the examining division, after having deliberated on said amended claims, had denied any opportunity to remove the two remaining, final objections concerning claim 1 and claim 12 which ultimately led to the refusal, for instance by amending claim 1 and deleting claim 12, as offered by the appellant.

It appeared to the appellant that this harsh approach had been made so as to penalise the applicant for the alleged failures in the previous amendments during the written procedure (see Minutes of the oral proceedings, page 1, paragraph 4). This was, of course, not a proper reason to limit the appellant to one final amendment during the oral proceedings before the examining division. Hence the examining division

did not exercise its discretion afforded by Rule 86(3) EPC [1973] in the way directed by G 0007/93 and thus committed a substantial procedural violation.

The appellant also referred to T 0132/92 (of 6 August 1996), stating that to refuse further amendment in oral proceedings in opposition proceedings would only be appropriate if it was evident after various unsuccessful amendments that the patentee was only delaying the procedure. In the present case, the examining division had reasons to be more flexible than an opposition division, yet acted more harshly by allowing only one amendment, rather than first and second amendments. In the present case, the amendment was made in a genuine attempt to overcome the objections. The examining division did not balance the interests of the appellant and the EPO and failed to properly exercise its discretion by refusing to consider claims irrespective of their merit and thus bringing the hearing to an early close.

Decision T 0755/96 (OJ EPO 2000, 174) concerned the examining division's discretion to allow amendments after the period set out in Rule 71a EPC [1973]. It was established that for an examining division simply to refer to Rule 86(3) EPC was not in itself an adequate reason for not admitting amended claims. Furthermore, *"[t]he task of the European Patent Office is to grant European patents which comply with the European Patent Convention. On the other hand, it is also*

*desirable that the procedure before the EPO be as efficient as possible. It would not be conducive to this end if the discretionary power conferred by Rule 71a EPC was exercised in a purely formalistic way so that the European Patent Office refused to consider new claims on the sole ground that they had not been filed by a final date stated in a summons to oral proceedings, even though the request in fact complied with all requirements of the EPC and raised no new issues. The result would be that an appeal would be necessary, in which the request would then be allowed into the proceedings and the matter would be referred back to the first instance, causing expense and delay."*

All of the reasons for allowing further amendments as set out under point 4.5 of the Reasons of T 0755/96 were apparently ignored by the examining division in the hearing of 24 October 2006.

In summary, the appellant's conduct in filing amended claims in response to previous written official communications should not be used to curtail the appellant's right to be heard during oral proceedings, or the examining division's discretion to admit, or even consider whether to admit, further requests.

VIII. Requests:

The appellant requested that the contested decision be set aside and the case be remitted to the examining division for further prosecution on the basis of the



claims of the main request or the auxiliary request, both filed with letter dated 27 July 2009.

The appellant furthermore requested the reimbursement of the appeal fee because of a substantial procedural violation.

## **Reasons for the Decision**

### 1. Amendments (main request)

1.1 Claim 1 essentially corresponds to claim 1 of the application as filed (*i.e.* published as WO-A-01/12 540). Some linguistic peculiarities and unclarities have been removed which resulted in the deletion of the last two lines of the said original claim. Said deletion does not remove any features which could be considered essential to the invention.

Dependent claim 2 is based on the description, page 2, lines 10 to 20, as originally filed. The term "*carbides of group VIB*" has been deleted from the list of catalysts, thereby removing any discrepancy with the expression "*catalyst metal*" in claim 1. Platinum has been deleted from the list of catalysts. It is evident from the application as a whole and in particular from the description, page 2, lines 1 to 9, and 21 to 24, and page 3, lines 7 to 15, that the catalyst structure for steam reforming of a hydrocarbon as described on page 2 is suitable and intended for use in the method of claim 1.

Dependent claim 3 finds its basis in original claim 6 of the application as filed (and published as WO-A-01/12540).

Claim 4 is based on the original disclosure of page 3, line 23; claim 5 on original claim 8 and on Example 1 (pages 3 and 4); claim 6 is based on the description, page 3, lines 26 to 28; claim 7 on page 3, line 28; and claims 8 and 11 are based on original claim 8 and on Example 1.

Independent product claim 9 is properly based on the description, page 2, lines 10 to 20, as originally filed.

Dependent claim 10 finds its support in claim 9 as originally filed.

1.2 The claims of the main request are therefore considered to meet the requirements of Article 123(2) EPC.

1.3 In view of the above finding on the main request, there is no need to examine the claims of the auxiliary request.

2. Reimbursement of the appeal fee

2.1 Pursuant to Rule 103 (1)a EPC, the appeal fee shall be reimbursed, if the Board of Appeal deems an appeal to be allowable, if such reimbursement is equitable by reasons of a substantial procedural violation.

In the instant case, the board is not convinced that a

substantial procedural violation has occurred making a reimbursement equitable, for the following reasons.

- 2.1.1 The appellant essentially complains that at the oral proceedings before the examining division it was refused an opportunity to amend the claims more than once irrespective of their merit. According to the appellant, the examining division thus did not properly exercise its discretionary power in admitting new requests.
- 2.1.2 According to the file, the appellant was informed with the summons to attend oral proceedings dated 21 February 2006 that the final date for making written submissions and/or amendments (Rule 71a EPC 1973) was 28 June 2006. The examining division also relied on Rule 86(3) EPC 1973 (Rule 137 (3) EPC) stipulating that no further amendment may be made without the consent of the Examining Division, if the applicant, after receipt of the first communication from the Examining Division, has amended, in reply to said communication, the description, claims and drawings of his own volition. Allowing such amendments is therefore a matter of discretion for the examining division.
- 2.1.3 The established case law of the EPO demands that the examining division, in exercising its discretion, takes into consideration all relevant circumstances of the case. In decision T 951/97 (of 5 September 1997; see Reasons, point 2) the board stated: *"Whether or not that consent is given is at the discretion of the examining division and depends on the facts of the individual case, on the nature of the grounds for seeking an amendment, and equally on the stage of the*

*procedure. It is easier to secure an amendment at an earlier rather than at a later stage (cf. Singer, Lunzer edition, 123.05". In T 0529/94 (of 9 October 1997; see Reasons, point 4), the board observed that "[t]he way in which the examining division should exercise its discretion under Rule 86(3) to allow or to refuse an amendment depends on the circumstances of each individual case, and e.g. on the stage of the pre-grant procedure."*

It is undisputed that the appellant had at least five opportunities to present amended claims in the written examination procedure. While it is true that this does not generally preclude the filing of further requests (amendments), the board nevertheless considers that under these circumstances any further requests for amendments may be accepted only under certain conditions. Therefore, it cannot be considered an abuse of the examining division's discretion afforded under Rule 116 (1) EPC, second sentence, to limit the opportunity for further amendments during oral proceedings. Moreover, pursuant to Rule 71a EPC 1973, any amendments should have been filed before the time limit set out in the summons for oral proceedings. The board observes that appellant did not avail itself, in good time, of the possibility of filing one or more auxiliary requests.

- 2.1.4 In fact, notwithstanding the expiry of the time limit set out in the communication dated 21 February 2006, the appellant was given a further opportunity to file during oral proceedings a new main request (see Minutes of oral proceedings, page 2, paragraph 7). Said new

main request was then the subject of discussion and deliberation by the examining division.

- 2.1.5 The appellant now asserts that at a later stage - after discussion of the said new main request and after the interruption of the proceedings from 10:50 till 11:05 hrs - it had proposed to delete claim 12 in order to remove an outstanding objection concerning said claim and that said request was rejected by the examining division under Rules 137(3) and 116 EPC (Rules 86(3) and 71a (1) EPC 1973).

The board notes, however, that the Minutes of the oral proceedings do not record a further request proposed by the appellant and rejected by the examining division. The filing of such an additional request is not mentioned in the decision under appeal, either.

In the opinion of the board, upon receipt of the said Minutes, the appellant should have insisted that the alleged procedural act of filing a new request and its alleged refusal by the examining division were properly recorded in the Minutes, for instance by way of requesting a correction of the Minutes. The appellant did, however, not request such a correction. The board must therefore assume that the Minutes record the course of the oral proceedings correctly, so that the appellant's complaint must fail in this regard.

- 2.1.6 But even assuming, in favour of the appellant, that such additional request(s) was (were) indeed filed, it is apparent that the mere deletion of claim 12 would not have led to a set of allowable claims, in view of the objections still pending against claim 1.

The later proposal to reinstate the term "*metal*" in line 3 of claim 1 (main request filed 24 October 2006) would, in the examining division's and the board's views, also not have served to overcome the pending objections, because of the obvious discrepancy between the expression "*catalyst **metal***" in line 3 and the claim feature "*said catalyst [is] selected from the group consisting of rhodium, iridium, nickel, palladium, **carbide** of group VIb*" (emphasis added).

- 2.1.7 According to the minutes of the oral proceedings, the reasons which finally led to the refusal of the application had been discussed with respect to the claims presented at the outset of the oral proceedings. Nevertheless, the appellant filed a new set of claims (filed with letter dated 24 October 2009) including features which evidently would give rise to the same or similar objections. A refusal could thus not have been unexpected.

As regards the filing of further amended claims proposed at a very late stage of the proceedings, the allegations of the appellant are not supported by the Minutes of the oral proceedings. In any event, the further amendments allegedly proposed were not *a priori* sufficient to overcome the objections pending.

- 2.1.8 Pursuant to G 0007/93 (OJ EPO 1994, 775; Reasons 2.5), an examining division exercising its discretion under Rule 86(3) EPC [1973] is required to consider all relevant factors and to balance the interests of the EPO and the applicant against one another. The appellant also referred to decision T 0132/92 (of

6 August 1996; Reasons, point 2.2) stating that in opposition proceedings "*[t]o refuse any further amendment would only be appropriate if it is evident after various unsuccessful amendments that the Proprietor is not seriously trying to overcome the objections but is only delaying the proceedings.*" In the appellant's view, there was no evidence for such behaviour in this case and the examining division should have even been more flexible than an opposition division in allowing first and second amendments.

In this respect, however, the board notes that the examining division had already shown flexibility in allowing, without discussion and in spite of the expiry of the time limit set out in the communication dated 21 February 2006, the amendments filed during oral proceedings. As regards further amendments, the fact that neither the five sets of amended claims filed in the written procedure nor the one filed during oral proceedings met the requirements of Article 123(2) EPC, may well have been taken as an indication that a serious attempt to overcome the objections pending was lacking. In the instant case, the examining division concluding that the interest of the EPO in efficient proceedings should prevail may have had good reason not to accept said further amendments.

- 2.1.9 The board is therefore of the opinion that the principles for exercising discretion under Rule 86(3) EPC [1973] set out in G 0007/93 have not been violated. It should also be borne in mind that, according to G 0007/93 (Reasons, point 2.6), "*...it is not the function of a Board of Appeal to review all the facts and circumstances 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 such discretion in the same way as the first instance department.[] ... a Board of Appeal should only overrule the way in which a first instance department has exercised its discretion if it comes to the conclusion either that the first instance department in its decision has not exercised its discretion in accordance with the right principles as set out in paragraph 2.5 above, or that it has exercised its discretion in an unreasonable way, and has thus exceeded the proper limits of its discretion."*

2.2 Therefore, the request for reimbursement of the appeal fee is refused.

3. Oral proceedings

The appellant requested oral proceedings only in case the board refuses the claims of the main request. As regards the reimbursement of the appeal fee, the appellant has informed the board in its letter dated 27 July 2009 that it wished to rely on the written submissions *in lieu* of attending oral proceedings and that the hearing scheduled for 31 July 2009 be cancelled.

Accordingly, the board has cancelled the oral proceedings without affecting the appellant's rights under Article 116 EPC.



4. Remittal

The contested decision was solely based on objections under Article 123(2) EPC which have been overcome by the amended claims in accordance with the main request. Under these circumstances, and in view of the appellant's request, the board exercises its discretion under Article 111 (1) EPC to remit the case to the department of first instance 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.
3. The request for reimbursement of the appeal fee is refused.

The Registrar

The Chairman

C. Vodz

G. Rath