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**Datasheet for the decision
of 30 April 2009**

Case Number: T 1538/08 - 3.3.06

Application Number: 99935224.8

Publication Number: 1115943

IPC: D21C 3/02

Language of the proceedings: EN

Title of invention:

Method for precipitating hemicellulose onto fibres for improved yield and beatability

Patentee:

Metso Fiber Karlstad AB

Opponent:

Andritz Inc.

Headword:

Cellulose cooking/KVAERNER

Relevant legal provisions:

EPC Art. 111(1)

Relevant legal provisions (EPC 1973):

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Keyword:

"Remittal - yes (requested by both parties; reason for which the patent has been revoked no longer applies"

Decisions cited:

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Catchword:

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Case Number: T 1538/08 - 3.3.06

D E C I S I O N
of the Technical Board of Appeal 3.3.06
of 30 April 2009

Appellant: Metso Fiber Karlstad AB
(Patent Proprietor) Box 1033
SE-651 15 Karlstad (SE)

Representative: Andréasson, Ivar
Hynell Patenttjänst AB
Patron Carls väg 2
SE-683 40 Hagfors/Uddeholm (SE)

Respondents: Andritz Inc.
(Opponent) 13 Pruy'n's Island Drive
Glens Falls
New York 12801 (US)

Representative: Görg, Klaus
Hoffmann Eitle
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Decision under appeal: Decision of the Opposition Division of the
European Patent Office posted 12 June 2008
revoking European patent No. 1115943 pursuant
to Article 102(1) EPC 1973.

Composition of the Board:

Chairman: P.-P. Bracke
Members: G. Dischinger-Höppler
U. Tronser

Summary of Facts and Submissions

I. European patent No. 1 115 943 (international publication No. WO-A-00/11261) entitled "Method for precipitating hemicellulose onto fibres for improved yield and beatability" was granted on the basis of a set of 13 claims.

A notice of opposition was filed against the granted patent wherein the Opponent sought revocation of the patent solely on the ground of lack of inventive step (Articles 100(a) and 56 EPC).

The decision under appeal was based on amended sets of claims according to a main and three auxiliary requests filed during oral proceedings before the Opposition Division.

II. In its decision, the Opposition Division revoked the patent for the reason that the amendments made to the claims of all requests did not meet the requirements of Article 123(2) EPC. In addition, it was held that the amendments brought about in Claim 1 of the first and third auxiliary requests introduced non-clarity contrary to the proviso of Article 84 EPC.

III. With its statement of grounds of appeal dated 17 October 2008, the Patent proprietor, now Appellant, filed amended sets of claims in six new auxiliary requests and requested that the decision under appeal be set aside and that the patent be maintained as granted (main request) or according to one of the six auxiliary requests. Oral proceedings were requested in

case the Appellant's main request would not be accepted by the Board.

The Appellant provided arguments as to why the new main request was allowable, why the new auxiliary requests met the requirements of Article 123(2) EPC, why the Opposition Division's reasoning with respect to Article 84 EPC was wrong and why the claimed subject-matter of all requests was based on an inventive step.

However, the Appellant declared not to object to a remittal of the case to the first instance if so desired by the Respondent, even though in its opinion the issue of inventive step also could be decided directly by the Board of Appeal.

IV. The Opponent, now Respondent, requested that the appeal be "rejected" and the case be remitted to the first instance. Oral proceedings were requested in case the Board would consider any decision adverse to the Respondent.

The Respondent argued that inventive step of the subject-matter claimed in the patent as granted was not discussed at all at the oral proceedings before the Opposition Division since at that time the Appellant chose to rely on amended sets of claims. Hence, the case should be remitted to allow the parties to be heard by two instances on each opposition ground.

In addition, the Respondent maintained its arguments presented at first instance in regard of inventive step of the subject-matter of Claim 1 as granted, hence of

the main request, and raised objections under Article 123(2) EPC against all auxiliary requests.

- V. In response to the Respondents submissions, the Appellant indicated in a letter dated 8 April 2009 to join the Respondent's request for remittal and requested oral proceedings only if the Board should not be willing to remit the case back to the first instance.

Reasons for the Decision

1. *Admissibility of the main request*

The opposition against the claims as granted was based on the ground of lack of inventive step (Article 100(a) EPC and Article 56 EPC) only.

At the hearing before the Opposition Division, the Appellant relied, however, exclusively on amended sets of claims and the patent was revoked by the Opposition for the reason that the amendments brought about in all requests of the Appellant were not allowable in view of Article 123(2) EPC.

The Appellant is thus adversely affected by the decision under appeal and entitled to return to the claims as granted in order to overcome the objection of added subject-matter, unless this appears to constitute an abuse of procedure (see Case Law of the Boards of Appeal of the European Patent Office (5th edition 2006), chapter VI.J.3.2.2 b) i)).

The Respondent did not argue against the admissibility of the new main request and the Board does not see any abuse of procedure in the Appellant's behaviour, the more so as the request has been filed at the earliest moment possible, with the statement of grounds of appeal.

The Board concludes therefore that the new main request is admissible.

2. *Respondent's requests*

The Board interprets the Respondent's requests to "reject" the appeal and remit the case to the first instance as a request for either dismiss the appeal or remit the case for further prosecution by the first instance.

3. *Remittal*

However, as the Respondent argued that the case should be remitted for the reason that inventive step of the subject-matter claimed in the main request (as granted) was never discussed at first instance oral proceedings and since the ground under Article 100(c) EPC for which the patent was revoked is not an issue as far as the main request is concerned (point 1), the Board concludes that a final decision by the Board at that stage is not justified for the following reasons:

The Opposition Division has not yet had the opportunity of considering the issue of inventive step of the claims as granted (main request) and both parties

agreed that the case should be remitted for that purpose.

It is accordingly considered appropriate, in accordance with Article 111(1) EPC, to remit the case to the department of first instance to ensure that the parties have the opportunity to be heard by two instances on each opposition ground.

As a consequence, there was no need in the present case to have oral proceedings which were requested by both parties if the case was not remitted.

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 on the basis of the claims as granted (main request).

The Registrar:

The Chairman:

G. Rauh

P.-P. Bracke