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**Datasheet for the decision
of 25 April 2012**

Case Number: T 0306/09 - 3.3.10

Application Number: 03707697.3

Publication Number: 1471950

IPC: A61L9/14, B01D1/16, A61L9/00

Language of the proceedings: EN

Title of invention:
METHOD AND APPARATUS FOR EVAPORATING MULTI-COMPONENT LIQUIDS

Patentee:
S. C. Johnson & Son, Inc.

Opponent:
The Procter & Gamble Company

Headword:

Relevant legal provisions:
EPC Art. 56
EPC R. 111(2)

Keyword:
Procedural violation (yes): decision not reasoned
Remittal (yes): reimbursement of appeal fees (yes)

Decisions cited:
T 0278/00, T 1366/05, T 0087/08, T 2375/10

Catchword:



Case Number: T0306/09 - 3.3.10

D E C I S I O N
of the Technical Board of Appeal 3.3.10
of 25 April 2012

Appellant:
(Patent Proprietor)

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Appellant:
(Opponent)

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Representative:

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Decision under appeal:

**Interlocutory decision of the Opposition
Division of the European Patent Office posted 21
November 2008 concerning maintenance of the
European Patent No. 1471950 in amended form.**

Composition of the Board:

Chairman: P. Gryczka
Members: R. Pérez Carlón
D. Rogers

Summary of Facts and Submissions

- I. The present appeal lies from the interlocutory decision of the opposition division to maintain European patent EP B 1 471 950 in amended form.
- II. Notice of opposition had been filed on the grounds of lack of novelty and inventive step (Art. 100(a) EPC). After the opposition period, the opponent raised insufficiency of disclosure (Art. 100(b) EPC) as a further ground of opposition.
- III. The opposition division decided not to admit the fresh ground for opposition under Art. 100(b) EPC into the proceedings, held that the claimed subject-matter according to the main request (patent as granted) was novel but did not involve an inventive step, the first auxiliary request was not admissible in view of Art. 84 EPC, and the subject-matter according to the second auxiliary request fulfilled the requirements of Art. 123, 84, 54 and 56 EPC.
- IV. A first notice of appeal was filed by the patent proprietor (appellant 1). It requested that the decision be set aside and the patent maintained as granted or in the form of one of the first or second auxiliary requests, which were those upon which the appealed decision was based.
- V. A second notice of appeal was filed by the opponent (appellant 2), requesting that the decision of the opposition division be set aside, that the patent be revoked in its entirety.
- VI. In a communication, the board indicated that the contested decision appeared to lack reasoning and that,

on account of this procedural violation, it intended to remit the case to the first instance for further prosecution and to order the reimbursement of the appeal fees.

- VII. Both parties withdrew their requests for oral proceedings provided the board remitted the case to the first instance and refunded the appeal fees.

Reasons for the Decision

1. The appeal is admissible.
2. According to established jurisprudence of the boards of appeal, to satisfy the requirement of Rule 111(2) EPC, a decision should contain, in logical sequence, those arguments which support it. The conclusions drawn by the deciding body 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. The purpose of the requirement to reason the decision is to enable the 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 (see T 278/00, OJ EPO, 2003, 546; T 1366/05, not published in OJ EPO).
3. In the present case, the opposition division decided that the subject-matter of claims 1 and 16 of the main request did not involve an inventive step, with the consequence that this request was rejected.
4. Art. 56 EPC requires that the assessment of inventive step is made **having regard to the state of the art.**

Accordingly, the logical chain of reasoning of the decision under appeal to justify the conclusion under Art. 56 EPC has to contain a proper assessment of the question of obviousness in the light of the prior art.

However, point 3.2 of the decision under appeal, which is the portion of said decision which may reveal the reasoning of the opposition division on the issue of inventive step, does not contain any reference to any prior art; said paragraph only states that the claimed subject-matter did not comply with the requirements of Art. 56 EPC since the subject-matter claimed "encompasses embodiments which do not solve the problem forming the basis of the patent and which do not achieve the intended effect".

The opposition division thus arrived at the conclusion that the claimed subject-matter lacked an inventive step by finding that a purported effect had not been achieved over the whole breadth of the subject-matter claimed, without assessing obviousness in the light of the prior art.

Since the requirement of inventive step as defined in Art. 56 EPC is based on the state of the art, the decision under appeal, by arriving at its conclusion of lack of inventive step without reference to prior art, is insufficiently reasoned in the sense of Rule 111(2) EPC (see T 87/08 and T 2375/10).

5. This failure amounts to a substantial procedural violation requiring that the decision under appeal is set aside and the case is remitted to the first instance (see T 278/00, loc. cit. point 5). The appeals are thus deemed to be allowable and the board considers it to be equitable by reason of the substantial

procedural violation to reimburse the appeal fees of both parties pursuant to Rule 103(1)(a) 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.
3. The appeal fees are reimbursed.

The Registrar:

The Chairman:



C. Rodríguez Rodríguez

P. Gryczka

Decision electronically authenticated