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**Datasheet for the decision
of 29 August 2012**

Case Number: T 2154/10 - 3.3.06
Application Number: 99962151.9
Publication Number: 1137741
IPC: C10G 45/64, B01J 29/06
Language of the proceedings: EN

Title of invention:
Catalytic dewaxing process

Patentee:
Shell Internationale Research Maatschappij B.V.

Opponent:
CHEVRON USA, Inc.

Headword:
Dewaxing process with dealuminated zeolites/SHELL

Relevant legal provisions:
EPC Art. 83, 84, 123(2)
RPBA Art. 13(1)(3)

Keyword:
"Admissibility of late filed requests (no)"
"Amendments going beyond original disclosure - second
auxiliary request (yes)"
"Clarity, sufficiency, 123(2) met - third auxiliary request
(yes)"
"Remittal to the departments of first instance"

Decisions cited:
-

Catchword:
-



Case Number: T 2154/10 - 3.3.06

D E C I S I O N
of the Technical Board of Appeal 3.3.06
of 29 August 2012

Appellant: Shell Internationale Research Maatschappij
(Patent Proprietor) B.V.
Carel van Bylandtlaan 30
NL-2596 HR Den Haag (NL)

Representative: Shell Internationale Research Maatschappij
B.V.
Intellectual Property Division
P.O. Box 302
NL-2501 CH Den Haag (NL)

Respondent: CHEVRON USA, Inc.
(Opponent) P.O. Box 6006
San Ramon, California 95583-4289 (US)

Representative: Brown, David Leslie
Haseltine Lake LLP
Redcliff Quay
120 Redcliff Street
Bristol BS1 6HU (GB)

Decision under appeal: **Decision of the Opposition Division of the
European Patent Office posted 2 September 2010
revoking European patent No. 1137741 pursuant
to Article 101(3)(b) EPC.**

Composition of the Board:

Chairman: P.-P. Bracke
Members: E. Bendl
J. Geschwind

Summary of Facts and Submissions

- I. The appeal lies from the decision of the Opposition Division to revoke the European patent no. 1 137 741.
- II. The Appellant/Proprietor filed an appeal against this decision and submitted with the grounds of appeal three sets of claims, which were already presented in the oral proceedings before the Opposition Division.

With the letter of 27 July 2012, i.e. about one month prior to the oral proceedings before the Board, the Appellant **additionally** submitted the claims as granted as the main request in addition to an amended first auxiliary request. The three sets of claims already on file were renumbered accordingly.

All requests were considered by the Appellant to meet the requirements of the EPC.

- III. Claims 1 of the requests relevant to the present decision, i.e. the main request and auxiliary requests I-III, read as follows:

Main request

"1. Process for the catalytic dewaxing of a hydrocarbon feed comprising waxy molecules by contacting the hydrocarbon feed under catalytic dewaxing conditions with a catalyst composition comprising metallosilicate crystallites having a Constraint Index of between 2 and 12, a low acidity refractory oxide binder, which binder is essentially free of aluminium and a hydrogenation component, wherein the weight ratio of the

metallo silicate crystallites and the binder is between 5:95 and 35:65 and the size of the metallo silicate crystallites are between 0.05 and 0.2 μm ."

First auxiliary request

Claim 1 of the first auxiliary request is identical to Claim 1 of the main request apart from the passage "and which crystallites have been subjected to a dealumination treatment" being appended at the end of the claim.

Second auxiliary request

"1. Process for the catalytic dewaxing of a hydrocarbon feed comprising waxy molecules by contacting the hydrocarbon feed under catalytic dewaxing conditions with a catalyst composition comprising metallo silicate crystallites, a binder and a hydrogenation component in which the metallo silicate crystallites have a Constraint Index of between 2 and 12 and are chosen from the group consisting of ZSM-5, ZSM-11, ZSM-12, ZSM-22, ZSM-23, ZSM-35, ZSM-38, ZSM-48, ZSM-50, TMA Offretite and Clinoptilolite, and the binder is a low acidity refractory oxide binder which binder is essentially free of aluminium, wherein the weight ratio of the metallo silicate crystallites and the binder is between 5:95 and 35:65 and the size of the metallo silicate crystallites are between 0.05 and 0.2 μm ."

Third auxiliary request

Claim 1 of the third auxiliary request is identical to Claim 1 of the second auxiliary request apart from the passage "and of which crystallites the number of alumina moieties has been reduced" being appended at the end of the claim.

Claims 2 to 15 of the third auxiliary request are dependent on Claim 1.

- IV. The Respondent/Opponent objected to the late filing of the main request and the first auxiliary request and regarded the remaining requests on file as not meeting the requirements of Articles 123(2) and 83 EPC.
- V. Both parties argued, that the case should be remitted to the department of first instance in the case novelty and inventive step were to be discussed. In addition the Respondent requested remittal also in case topics concerning sufficiency of disclosure other than the crystallite size had to be decided.
- VI. The main arguments of the **Appellant** were as follows:

Admissibility of the main request and the first auxiliary request

- The judicial practice of the Boards of Appeal changed very recently, because in the most recent decisions a clear distinction between the requirements of Articles 83 and 84 EPC was made. The amended claims have been adapted to reflect those changes.

Second auxiliary request - Article 123(2) EPC

- Small crystallite sizes and dealumination treatment are both described as being preferred and should be seen as two separate embodiments of the patent-in-suit. Example 2c on file shows that small crystallites may also be used without dealumination treatment. The requirement of Article 123(2) EPC is therefore met.

Third auxiliary request - clarity

- The wording of the claims is clear.

Third auxiliary request - Article 123(2) EPC

- Support for the feature "reduction of alumina moieties" can be found on page 10, lines 17-20 of the application as originally filed.

Third auxiliary request - Article 83 EPC

- The invention can be carried out, as is shown by the examples on file.

The main arguments of the **Respondent** were as follows:

Admissibility of the main request and the first auxiliary request

- No justification for the late-filing of the main request and the first auxiliary request has been given prior to the oral proceedings. The Appellant's explanation concerning an alleged change in legal practice of the Boards of Appeal is not correct.

Second auxiliary request - Article 123(2) EPC

- The crystallite size of between 0.05-0.2 μm is only disclosed on page 12, lines 8-10 and in Claim 20 of the application as originally filed. Both passages refer to **dealuminated** zeolite crystallites, whereas this feature is not mentioned in Claim 1. The requirement of Article 123(2) EPC is consequently not met.

Third auxiliary request - clarity

- The use of the term "crystallite" (singular form), the lack of a detailed description of the dealumination process and the contradiction between Claim 1 and Claims 4/5, which were considered to be broader in scope than Claim 1, renders the wording of Claim 1 unclear.

Third auxiliary request - Article 123(2) EPC

- Since no method for the dealumination step is defined in Claim 1, the wording of this claim goes beyond the original disclosure.

Third auxiliary request - Article 83 EPC

- The multitude of possible ways to determine the crystallite size renders the invention so unclear, that the skilled person is faced with a lack of sufficiency of disclosure.

VII. The Appellant requested that the decision under appeal be set aside and that the patent be granted on the basis of the main request or, in the alternative, on the basis of one of the four auxiliary requests filed with the letter of 27 July 2012.

The Respondent requested that the appeal be dismissed.

Reasons for the Decision

1. Admissibility of the main request and the first auxiliary request
 - 1.1 The Appellant argued, that the main request and the first auxiliary request were only submitted about one month prior to the oral proceedings because of a recent change in the jurisdiction of the EPO Boards of Appeal and of the practice of the UK Patent office. Allegedly only since this change a clear distinction between the requirements of Articles 83 and 84 EPC has been made.
 - 1.2 The Board cannot share the Appellant's line of argumentation. Being two distinct articles of the EPC, the requirements of clarity and sufficiency of disclosure were always examined separately by the Boards of Appeal. Such an alleged recent change of jurisprudence of the Boards does not justify the submission of amended claims with a broader scope, compared to the previously filed claims, only one month prior to the oral proceedings.
 - 1.3 Throughout the entire appeal procedure claims were discussed which referred to **specific zeolite crystallites**, which consequently lead the Respondent to argue solely with a focus on those compounds. Only shortly prior to the oral proceedings the wording of the claims has been changed by the Appellant to the **more general metallosilicate** crystallites. This is not considered to leave sufficient time for the Respondent

to properly react and to submit further arguments on the amended sets of claims.

1.4 Therefore, the Board exercises its discretion under Article 13(1), (3) RPBA to reject the main and the first auxiliary request as late filed.

2. Second auxiliary request - Article 123(2) EPC

2.1 The Respondent objected that the size of the metallosilicate crystallites ranging between 0.05 and 0.2 μm would only be originally disclosed for zeolites in combination with a dealumination treatment.

2.2 The Appellant countered that the passage on page 12, lines 8-10 of the original version reading "Preferable catalysts are used having a crystallite size of between 0.05 and 0.2 μm and which have been subjected to dealumination treatment" should be interpreted as relating to two different embodiments, which may be considered separately.

It was furthermore argued that both, small crystallite sizes and dealumination treatment, are preferred in the application as originally filed. In this case too, the skilled person would read the teachings separately. Example 2c was cited as a proof that crystallites may be used without dealumination.

2.3 The Board does not share the Appellant's point of view.

The range 0.05 to 0.2 μm is disclosed only on page 12, lines 8-10 and in Claim 20 of the application as originally filed. Both passages refer to **dealumination**

treatment. No hint could be found that the specific crystallite size range could be seen independently from the said dealumination step.

Example 2c relates to a different crystallite size range (0.1 to 0.2 μm) and to a specific zeolite (ZSM-12). Thus, no support for the more general teaching of Claim 1 of the second auxiliary request could be found.

2.4 Therefore, Claim 1 of the second auxiliary request does not meet the requirement of Article 123(2) EPC.

3. Third auxiliary request

3.1 Article 84 EPC

3.1.1 The Respondent objected that an ambiguity would arise from the use of the term "crystallite" (singular form) in Claim 1.

As the text of Claim 1 further continues "**have** a Constraint Index" (emphasis added), the Board considers the use of the singular form as a typing error, which is apparent to the skilled person.

3.1.2 According to the Respondent a lack of clarity arises, because it is not defined in Claim 1 **how much** the number of aluminium moieties is reduced.

Paragraph [0020] of the patent-in-suit describes that "dealumination results in the reduction of the number of alumina moieties present in the zeolite". Thus, "dealumination" and the said "reduction of alumina

moieties" are in the present case to be regarded as synonyms. Since the step of dealumination has already been mentioned in Claim 7 as granted, the alleged lack of clarity has not been introduced by the amendment of the feature in question and, according to common practice of the Boards of Appeal, the Board has no authority to object clarity thereof.

- 3.1.3 A further objection raised by the Respondent concerned the alleged contradiction between the wording of Claim 1 and the more broad definition of the claimed subject-matter given in Claims 4 and 5.

Since Claims 4 and 5 are **dependent** on Claim 1, such a contradiction cannot be seen by the Board.

- 3.1.4 Finally, the Respondent argued that a lack of clarity would arise due to the lack of a precisely defined dealumination process in Claim 1.

The Board can also in this case not see a lack of clarity, as any suitable method could be used.

Examples of such suitable methods known to the person skilled in the art have for instance described in paragraph [0022] of the patent-in-suit. This passage points towards the teachings of WO-A-9641849 and US-A-5157191. No arguments or proof have been submitted by the Respondent that the cited references would not be applicable to the claimed process.

- 3.1.5 Therefore, the requirement of Article 84 is considered to be met by the claims of the third auxiliary request.

3.2 Article 123(2) EPC

3.2.1 According to the Respondent the lack of a defined method concerning the reduction of alumina moieties in Claim 1 results in an infringement of the requirements of Article 123(2) EPC. However, it was also pointed out that support for the feature in question "and of which crystallites the number of alumina moieties has been reduced" could be found on page 10, lines 17-20 of the application as originally filed.

3.2.2 Thus, since the objected wording of Claim 1 has been originally disclosed in the same context as used in the claim, the Board sees no reason to conclude that the requirement of Article 123(2) EPC would not be met.

3.3 Article 83 EPC

3.3.1 The Respondent argued that, given the many possible ways for measuring the crystallite size, the skilled person would not know what to do in order to carry out the present invention. The fundamental lack of clarity of Claim 1 would be so severe, that it resulted in a lack of disclosure. It would also be impossible to know, whether or not any given method were outside or within the scope of the invention.

3.3.2 The Board does not share this reasoning.

3.3.3 The Respondent admitted, that the claimed process can be carried out once a definition for the crystallite size has been chosen. Thus, the only step to be taken is the selection of a definition. Given the number of different definitions, this may possibly lead to a lack

of clarity of Claim 1, but not to a lack of sufficient disclosure.

Similar considerations apply also to a possible difficulty to determine, whether a given process lies within or outside the claimed invention.

3.3.4 Respondent's argument, that a specific definition how to determine the crystallite size has to be used to achieve an effect, may have an impact on inventive step and may have to be taken into consideration when examining this issue, but does not relate to sufficiency of disclosure either.

3.3.5 Furthermore, the examples on file show ways how to carry out the claimed process. No proof has been submitted that they cannot be reproduced.

3.3.6 Thus, the subject-matter claimed in the third auxiliary request is considered to be sufficiently disclosed, **as far as the definition of the crystallite size is concerned.**

3.4 Remittal to the department of first instance

3.4.1 In order to give the parties the opportunity to have the case examined by two instances and taking account of the requests for remittal **by both parties**, the case is remitted to the department of first instance.

3.4.2 Several objections with regard to sufficiency of disclosure have been raised by the Respondent, but only the arguments concerning the "crystallite size" have

been discussed in detail in the decision of the Opposition Division and in the present decision.

- 3.4.3 Therefore, the remaining Article 83 objections as well as the further objections raised will have to be examined by the department of first instance upon continuation of the opposition procedure.

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 third auxiliary request filed with letter of 27 July 2012.

The Registrar

The Chairman

D. Magliano

P.-P. Bracke