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**Datasheet for the decision
of 15 May 2014**

Case Number: T 1095/11 - 3.3.03

Application Number: 03728021.1

Publication Number: 1507815

IPC: C08G65/28, C08G65/332

Language of the proceedings: EN

Title of invention:

PRODUCTION PROCESS FOR ALKYLENE OXIDE ADDITION PRODUCT AND
CEMENT ADMIXTURE COMPRISING IT

Patent Proprietor:

NIPPON SHOKUBAI CO., LTD.

Opponents:

THE DOW CHEMICAL COMPANY
BASF SE

Headword:

Relevant legal provisions:

RPBA Art. 13(1), 13(3)

Keyword:

Late-filed request - admitted (no)

Decisions cited:

Catchword:



**Beschwerdekammern
Boards of Appeal
Chambres de recours**

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Case Number: T 1095/11 - 3.3.03

D E C I S I O N
of Technical Board of Appeal 3.3.03
of 15 May 2014

Appellant: NIPPON SHOKUBAI CO., LTD.
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Respondent: THE DOW CHEMICAL COMPANY
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Representative: Marsman, Hermanus Antonius M.
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Respondent: BASF SE
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Decision under appeal: **Decision of the Opposition Division of the
European Patent Office posted on 21 February
2011 revoking European patent No. 1507815
pursuant to Article 101(3)(b) EPC.**

Composition of the Board:

Chairwoman B. ter Laan
Members: M. C. Gordon
R. Cramer

Summary of Facts and Submissions

I. The appeal lies from the decision of the opposition division announced on 15 April 2010 and posted on 21 February 2011 revoking European patent number 1 507 815 (granted on European patent application number 03 728 021.1, derived from international application number PCT/JP03/05602, published under the number WO03/097716).

II. The application as filed had nine claims, claim 1 reading as follows:

"A production process for an alkylene oxide addition product, which comprises the step of carrying out an addition reaction of an alkylene oxide to a hydroxyl-group-containing saturated compound in order to obtain the alkylene oxide addition product; with the production process being characterized by further comprising: the initial step of causing the alkylene oxide to add to the hydroxyl-group-containing saturated compound in an amount of not larger than 20 mols on average of the alkylene oxide per 1 mol of the hydroxyl-group-containing saturated compound to thereby obtain an alkylene oxide low-mol-addition product; and the molar-degree-of-polyaddition-adjusting step of causing the alkylene oxide to further add to the alkylene oxide low-mol-addition product as obtained in the initial step; wherein a portion of the entirety of the alkylene oxide low-mol-addition product as obtained in the initial step is used in the molar-degree-of-polyaddition-adjusting step."

The patent was granted with a set of 7 claims. Claim 1 of the granted patent read as follows (additions compared to claim 1 of the application as originally

filed being indicated in **bold**, deletions in ~~strikethrough~~):

"A production process for an alkylene oxide addition product, which comprises the step of carrying out an addition reaction of an alkylene oxide to a hydroxyl-group-containing saturated compound in order to obtain the alkylene oxide addition product; with the production process being characterized by ~~further~~ comprising: ~~the~~ **an** initial step of causing the alkylene oxide to add to the hydroxyl-group-containing saturated compound in an amount of not larger than 20 mols on average of the alkylene oxide per 1 mol of the hydroxyl-group-containing saturated compound to thereby obtain an alkylene oxide low-mol-addition product; and ~~the~~ **a** molar-degree-of-polyaddition-adjusting step of causing the alkylene oxide to further add to the alkylene oxide low-mol-addition product as obtained in the initial step **in an amount of the alkylene oxide of not larger than 20 mole on average per 1 mol of the alkylene oxide low-mol-addition product**; wherein a portion of the entirety of the alkylene oxide low-mol-addition product as obtained in the initial step is used in the molar-degree-of-polyaddition-adjusting step; **and wherein the hydroxyl group-containing saturated compound has a water content of not more than 6,000 ppm.**"

- III. Two oppositions against the patent were filed. The opponents requested revocation of the patent in its entirety, invoking the grounds pursuant to Art. 100(a) EPC (lack of novelty, lack of inventive step; both opponents), Art. 100(b) EPC and Art. 100(c) EPC (opponent 1).

- IV. The decision of the opposition division was based on a main request filed with letter of 12 March 2009, and two auxiliary requests submitted during the oral proceedings. These requests were found to meet the requirements of Art. 123(2), 123(3) and 83 EPC. The main request and the first auxiliary request however did not comply with Art. 54. The second auxiliary request was found to fulfil the requirements of Art. 54 EPC but did not satisfy Art. 56 EPC, with the result that the patent was revoked.
- V. On 20 April 2011 the patent proprietor lodged an appeal against the decision, the prescribed fee being paid on the same date.
- VI. The statement of grounds of appeal was submitted on 21 June 2011 accompanied by three sets of claims forming a main and first and second auxiliary requests. Claim 1 of all requests differed from claim 1 of the patent as granted, and from the claims as considered by the opposition division, *inter alia* by introduction of the following wording at the end of the claim:
- "... wherein the volume of a reactor used in the production process for an alkylene oxide addition product is not smaller than 1m³."**
- VII. The opponents - now the respondents - responded to the grounds of appeal with letters dated 7 November 2011 (opponent 1) and 9 November 2011 (opponent 2).
- VIII. On 20 September 2013 the Board issued a summons to attend oral proceedings.

In a communication dated 30 January 2014 the Board set out its preliminary view of the case. *Inter alia* it was

considered that the claims of all requests suffered from defects pursuant to Art. 123(2) EPC.

- IX. By letter of 1 April 2014 the appellant/patent proprietor submitted three sets of claims forming a main and first and second auxiliary requests. *Inter alia* the final feature of the respective claim 1 of the requests was amended to read (emphasis is that of the Board):

"... wherein the **production scale** ~~the volume of a reactor~~ used in the production process for an alkylene oxide addition product is not smaller than 1m³."

- X. Oral proceedings were held before the Board on 15 May 2014.

In the course of the oral proceedings the appellant withdrew the sets of claims submitted with the letter of 1 April 2014 and replaced these with a single set of claims which differed from the sets of claims previously considered, *inter alia*, in that the whole feature relating to the "production scale" had been deleted and further in that the following phrase had been introduced at the end of the claim:

"... wherein the reaction is carried out using, as a catalyst, sodium hydroxide, added in the initial step and/or in the molar-degree-of-polyaddition-adjusting step."

- XI. The arguments of the appellant can be summarised as follows:

In the statement of grounds of appeal it was explained that the restriction relating to the volume of the

reactor was considered to be of significance, since in particular in an industrial process it was difficult completely to eliminate water from the apparatus, and that it was in such an industrial process that the invention was of most importance and the practical effects of reducing contamination with by-products was most observable.

At the oral proceedings the appellant submitted that the feature relating to production scale had been removed from the claim in order to address objections pursuant to Art. 123(2) and 84 EPC.

The amendments made compared to the claims as present at the outset of the appeal proceedings were not extensive and the respondents could not have been surprised by them, so that the new request should be admitted to the proceedings.

After discussion of the main request in view of Art. 123(2) and 84 EPC, the appellant requested the possibility to file a new main request in order to respond to the problems regarding compliance with Art. 123(2) EPC of the wording "and/or" in the last part of claim 1.

XII. The arguments of the respondents can be summarised as follows.

The set of claims filed at the oral proceedings represented a divergence from the case presented on filing the appeal due to the removal of the feature relating to reactor volume/production scale. Furthermore, there was no basis in the application as filed for the possibility that the catalyst was present only in the second step of the reaction, which

possibility was now included by the use of "and/or" in the amended claim. The respondent acknowledged that the admissibility of yet another request, as filed at the oral proceedings by the appellant, was a matter for the discretion of the Board. It was however observed that the appellant had already had sufficient opportunity to deal with formal problems which were foreseeable and could have been dealt with at a much earlier stage of the proceedings.

XIII. The appellant (patentee) requested that the decision under appeal be set aside and that a patent be granted on the basis of the set of claims according to the main request as filed at the oral proceedings on 15 May 2014.

XIV. The respondents (opponents) requested that the appeal be dismissed.

Reasons for the Decision

1. The appeal is admissible.
2. Admissibility of the main request to the proceedings.
 - 2.1 Upon filing the appeal the appellant introduced a restriction in respect of the reactor volume, arguing in effect that it was at large volumes that the effects of the claimed process would manifest themselves.

The definition of the reaction scale was therefore a central aspect of the case presented on appeal, although this feature had been present neither in any

- of the claims of the patent as granted nor in any of the claims considered by the opposition division in its decision.
- 2.2 By removing said restriction - notwithstanding questions relating to allowability thereof with respect to Art. 84 and 123(2) EPC - the appellant presented the respondents and the Board on the occasion of the oral proceedings with a fresh case. Neither the Board nor the respondents could have expected such a turn of events in view of the emphasis given to the aspect of reactor volume in the statement of grounds of appeal.
- 2.3 The Board therefore deems it appropriate to exercise its discretion not to admit the newly filed request to the proceedings (Art. 13(1) and (3) RPBA).
3. The appellant has had ample opportunity to react to the issues under Art. 123(2) and 84 EPC after the respondents' rejoinders and the communication of the Board and moreover had been allowed to file a new request in an attempt to deal with those issues. Since it was indicated by the appellant that the filing of yet another request would be in order to address the problem caused by the presence of "and/or" in that part of the claim relating to the catalyst but would not address the issue of presenting a fresh case (see point 2.2 above), the Board considered it appropriate to exercise its discretion not to admit any further requests to the proceedings (Art. 13(1) and (3) RPBA).
4. Article 113(2) EPC stipulates that the instances of the EPO shall examine and decide upon a European patent only in the text submitted to it, or agreed, by the

proprietor of the patent. Since the appellant's claims request has not been admitted into the proceedings, there is no basis for a patent to be maintained and thus the appeal has to be dismissed.

Order

For these reasons it is decided that:

The appeal is dismissed.

The Registrar:

The Chairman:



E. Goergmaier

B. ter Laan

Decision electronically authenticated