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**Datasheet for the decision
of 1 March 2016**

Case Number: T 0493/12 - 3.3.10

Application Number: 01110529.3

Publication Number: 1166865

IPC: C07C51/25, C07C57/04, F28D7/16,
B01J12/00, B01J19/24

Language of the proceedings: EN

Title of invention:
Method for starting up reactor and reactor system

Patent Proprietor:
NIPPON SHOKUBAI CO., LTD.

Opponent:
THE DOW CHEMICAL CO.

Headword:

Relevant legal provisions:
EPC Art. 56, 104(1), 111(1)
EPC R. 80
RPBA Art. 12(4)

Keyword:

Main request: inventive step (no) - obvious alternative
Auxiliary requests 2 and 2tris: admissibility (yes) - subject-matter restricted to that of a different category for which no negative decision had been issued
Auxiliary request 2: amendments occasioned by ground for opposition (no)
Auxiliary request 2tris: remittal
Apportionment of costs (no) - no abuse of procedure
Apportionment of future costs (no) - Board not in possession of necessary facts
Request for acceleration of proceedings before the Opposition Division (no) - not in the Board's power

Decisions cited:

G 0009/91, G 0003/14, T 0020/81, T 0153/85, T 0674/96,
T 0369/08, T 1282/08, T 2362/08

Catchword:



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Case Number: T 0493/12 - 3.3.10

D E C I S I O N
of Technical Board of Appeal 3.3.10
of 1 March 2016

Appellant: NIPPON SHOKUBAI CO., LTD.
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Decision under appeal: **Decision of the Opposition Division of the
European Patent Office posted on 20 December
2011 revoking European patent No. 1166865
pursuant to Article 101(3) (b) EPC.**

Composition of the Board:

Chairwoman: J. Mercey
Members: R. Pérez Carlón
C. Schmidt

Summary of Facts and Submissions

I. The Appellant (Proprietor of the Patent) lodged an appeal against the decision of the Opposition Division revoking European patent No. 1 166 865. Said patent had a set of twelve claims, independent claims 1, 6 and 12 reading as follows:

"1. A reactor system comprising a shell-and-tube type reactor (50) forming therein a plurality of chambers (51, 52) partitioned with an intermediate tube sheet, means for storing a heat medium led out of said chambers, heating means (22, 23) for heating the heat medium led out of said storing means, and means for supplying said heat medium heated by said heating means to an elevated temperature to at least one of said chambers, characterized by the fact that said storing means comprising one tank (32) capable of storing at least part of the heat medium in said component chambers and said tank has a volume smaller than the amount of the heat medium circulated within the component chambers."

"6. A method for starting up the reactor system according to at least one of the claims 1 to 5 characterized by introducing a gas of a temperature in the range of 100-400°C into the reaction tubes thereby initiating temperature elevation and then circulating the heat medium in a heated state to the outside of the reaction tubes, wherein the reactor is adapted to circulate a heat medium having a solid point in the range of 50-250°C to the outside of the reaction tube."

"12. Use of the reactor system of any one of claims 1-5 for the production of (meth)acrylic acid or (meth)acrolein."

II. Notice of Opposition had been filed by the Respondent (Opponent), requesting revocation of the patent in its entirety on the grounds of lack of inventive step (Article 100(a) EPC) and that the patent contains subject-matter not present in the application as filed (Article 100(c) EPC). *Inter alia* the following documents were submitted in opposition proceedings:

- (1) US-A-3 850 232 and
- (2) US-A-5 161 605.

III. The Opposition Division found that the reactor system of claim 1 of the then pending main request (patent as granted) was not inventive, document (1) being considered to represent the closest prior art. It also found that the subject-matter of claim 1 of each of auxiliary requests 1 to 5, also relating to a reactor system, did not satisfy the requirements of Article 123(2) EPC. In view of the complexity of auxiliary request 6 submitted during the oral proceedings, it was not admitted into the proceedings.

IV. With the statement of grounds of appeal dated 25 April 2012, the Appellant filed auxiliary requests 1 and 2. Auxiliary request 2 is based on the main request, namely the granted claims, but differs therefrom in that granted claims 1 to 5, namely the claims to the reactor system, have been deleted, and granted independent claim 6, directed to a method for starting up the reactor system of claim 1, has been reformulated as claim 1, the features of the reactor system of granted claim 1 now being written out in full in said claim. Three new dependent claims 7 to 9 have been added, and the independent claim 12 to the use of the reactor system of claims 1-5 for the production of (meth)acrylic acid or

(meth)acrolein has been reworded in claim 10 as the use of the reactor system for a method of claims 1-10 for the production of (meth)acrylic acid or (meth)acrolein. Claims 1 and 10 of said request read:

"1. A method for starting up a reactor system, characterized by introducing a gas of a temperature in the range of 100-400°C into the reaction tubes thereby initiating temperature elevation and then circulating the heat medium in a heated state to the outside of the reaction tubes, wherein the reactor is adapted to circulate a heat medium having a solid point in the range of 50-250°C to the outside of the reaction tube, wherein, the reactor system comprising a shell-and-tube type reactor (50) forming therein a plurality of chambers (51, 52) partitioned with an intermediate tube sheet, means for storing a heat medium led out of said chambers, heating means (22, 23) for heating the heat medium led out of said storing means, and means for supplying said heat medium heated by said heating means to an elevated temperature to at least one of said chambers, characterized by the fact that said storing means comprising one tank (32) capable of storing at least part of the heat medium in said component chambers and said tank has a volume smaller than the amount of the heat medium circulated within the component chambers."

"10. Use of the reactor system for a method of anyone of claims 1-10 for the production of (meth)acrylic acid or (meth)acrolein."

V. In response to objections raised by the Respondent under Article 84 EPC, and by the Board under Rule 80 EPC in a communication dated 9 November 2015, the Appellant filed

auxiliary request 2bis which essentially differed from auxiliary request 2 in that the wording of claim 1 was rearranged and claims 7 to 10 were deleted so as to avoid any potential conflict with Rule 80 EPC.

VI. During the oral proceedings before the Board, held on 1 March 2016, the Appellant withdrew auxiliary requests 1 and 2bis and filed auxiliary request 2tris, consisting of a set of six claims, claim 1 of which was identical to claim 1 of auxiliary request 2bis, claims 2 to 6 being dependent thereon. Claim 1 of this request reads:

"1. A method for starting up a reactor system, wherein the reactor system is comprising a shell-and-tube type reactor (50) forming therein a plurality of chambers (51, 52) partitioned with an intermediate tube sheet, means for storing a heat medium led out of said chambers, heating means (22, 23) for heating the heat medium led out of said storing means, and means for supplying said heat medium heated by said heating means to an elevated temperature to at least one of said chambers, and is characterized by the fact that said storing means is comprising one tank (32) capable of storing at least part of the heat medium in said component chambers and said tank has a volume smaller than the amount of the heat medium circulated within the component chambers, wherein the method is characterized by introducing a gas of a temperature in the range of 100-400°C into the reaction tubes thereby initiating temperature elevation and then circulating the heat medium in a heated state to the outside of the reaction tubes, wherein the reactor is adapted to circulate a heat medium having a solid point in the range of 50-250°C to the outside of the reaction tubes."

VII. The Appellant submitted that the subject-matter of claim 1 of the main request was inventive. In the light of document (1), the problem to be solved by the present invention was the provision of a reactor system allowing the sequential heating to different temperatures of different parts of the reactor, with a single heat medium, with a reduction of the starting up time and a reduction of equipment necessary for starting up the reactor. The Appellant argued that the claimed reactor differed from that of document (1) not only by comprising a plurality of chambers partitioned with an intermediate sheet, but also by virtue of the storing means for storing a heat medium **led out** of the chambers, and heating means for heating the heat medium **led out** of said storing means, since in document (1) the heat medium circulated without passing **through** the expansion tank, said tank serving merely to accommodate the natural increase in volume of heat medium arising from increase in temperature. According to the present invention, each chamber of the reactor could be heated according to the different temperature required (e.g. for the reaction of propylene to acrolein and then acrolein to acrylic acid) by simply having one heating means and one storing means, each chamber being thereby heated individually and in sequence, said sequential heating being effective to heat each chamber for starting up the reactor. The solution could not be arrived at by simply combining the reactor systems of documents (1) and (2), neither document even dealing with the problem of starting up the reactor.

The subject-matter of auxiliary requests 2 and 2tris was restricted to a method for starting up a reactor system essentially as defined in granted independent claim 6, it not being an abuse of the proceedings to file on appeal a request in which claims from a request as filed

before the first instance were merely deleted and to thereby restrict to subject-matter of an independent claim for which no negative decision had been issued by the Opposition Division. Auxiliary request 2tr is additionally overcame the problems raised by the Respondent under Article 84 EPC and by the Board under Rule 80 EPC to the claims of auxiliary request 2.

VIII. The Respondent submitted that the subject-matter of claim 1 of the main request was not inventive and that the additional distinction *vis-à-vis* the reactor system of document (1) now proposed by the Appellant did not in fact exist, as the expansion tank of said document communicated to the pump housing and was therefore also able to store heat medium from the reactor. The advantages alleged by the Appellant were not attributable to the claimed invention, since claim 1 did not necessarily define a system which could provide different heating to different chambers, the claim requiring only a heater supplying heat medium to at least one of the chambers. Even if the system were configured to provide heating to both chambers, independent control of the heating to the two chambers was not a feature of claim 1. The Appellant's argument that the claimed reactor system required only one heating means was not convincing as the claim was not restricted to one heating means and Figure 1 indeed showed two heaters, reference numbers for which were given in claim 1.

The Respondent submitted that auxiliary requests 2 and 2tr is should not be admitted into the proceedings, since the Appellant had failed to provide any reasons as to why the subject-matter thereof should be inventive, over and above the reasons given for inventiveness of the reactor system *per se*. Furthermore, there were various

problems regarding the clarity of the claims of said requests, such that for this reason too, their claims were not clearly allowable. Admitting these requests and then remitting one of them to the first instance, would result in many more years of delay for which the Appellant was entirely responsible, since it could have filed such a request before the Opposition Division. As such, the filing of these requests only on appeal was an abuse of procedure and remittal of the case to the first instance would be inequitable to the Respondent. Should the Board nevertheless be inclined to remit, then it was requested that it award all costs of the present proceedings and of any subsequent proceedings in favour of the Respondent, and that it direct the Opposition Division to accelerate the subsequent proceedings before it.

- IX. The Appellant requested that the decision under appeal be set aside and that the patent be maintained as granted, or, alternatively on the basis of auxiliary request 2 filed with the letter dated 25 April 2012, or on the basis of auxiliary request 2tris filed during the oral proceedings before the Board.

The Respondent requested that the appeal be dismissed and further requested apportionment of costs.

- X. At the end of the oral proceedings, the decision of the Board was announced.

Reasons for the Decision

1. The appeal is admissible.

Main request

2. *Inventive step*

- 2.1 Claim 1 is directed to a reactor system comprising a means for storing a heat medium and a heating means for heating the heat medium, said reactor being, for example, for use in the production of (meth)acrylic acid or (meth)acrolein (see claim 12), for example by the catalytic gas phase oxidation of propylene which is an exothermal reaction (see patent in suit, paragraphs [0003], [0007] and [0039] to [0049]).

- 2.2 Document (1) discloses (see Fig. 1) a shell and tube reactor 1 (see col. 2, lines 47 to 49) suitable for carrying out exothermic chemical reactions (col. 1, lines 14 to 15), comprising a means for storing a heat medium, namely expansion tank 27, led out of said reactor via connection tube 11 and pump housing 13, heating means 16 (see col. 2, lines 66 to 67) for heating the heat medium led out of said storing means, and means 12, for supplying said medium heated by said heating means to an elevated temperature to the reactor. Figure 1 shows that the tank 27 has a minimum level for the heating medium i.e. there is always at least some heating medium in said tank, such that this tank may be considered to represent a storage tank. Since the volume of the tank 27 is dimensioned to assure that in the desired range of operational temperatures, the pump housing and the cooler housing will always be filled with heat carrier (see col. 3, lines 62 to 67), said

tank must have a volume smaller than the amount of the heat medium circulated within the component chambers.

Therefore, the Board considers, in agreement with the Opposition Division, Appellant and the Respondent, that the disclosure of document (1) specified above represents the closest state of the art and starting point in the assessment of inventive step.

2.3 In view of this state of the art, the problem underlying the claimed invention, as formulated by the Appellant, was the provision of a reactor system allowing different parts of the reactor to be sequentially heated to different temperatures with a single heat medium, and with a reduction of the starting up time and a reduction of equipment necessary for starting up the reactor.

2.4 As the solution to this problem, granted claim 1 proposes a reactor system having a plurality of chambers (51, 52) partitioned with an intermediate sheet.

2.4.1 The Appellant submitted that the features that the storing means for storing a heat medium **led out** of the chambers, and heating means for heating the heat medium **led out** of said storing means, further characterised the subject-matter of granted claim 1 *vis-à-vis* the reactor of document (1), since the tank 27 therein was above the pump housing 13 and it could be seen from the arrows in Figure 1 showing the flow of the heat medium, that the heat medium did not necessarily pass through the tank 27.

However, since claim 1 is directed to a reactor system and not to a process, the term "led out" merely indicates that the storing means is in connection with both that part of the reactor containing the heat medium

and with the heating means for heating the heat medium. In document (1), the tank 27 is described as communicating to the pump housing 13 (see col. 3, lines 15 to 16) and the pump housing 13 is in communication with the reactor 1 *via* tube connections 11 and 12, such that the heat medium led out of said reactor *via* tube 11 enters said pump housing 13 (see col. 3, lines 34 to 37) and at increased temperatures, some of the heat medium enters the tank 27 (see col. 3, lines 62 to 67). Thus, the storing means is in connection with that part of the reactor containing the heat medium. In addition, since the heating means 16 extends into the pump housing 13 (see col. 2, lines 66 to 67), said heating means is also in connection with the tank 27. Thus, in the reactor of Figure 1 of document (1), the storing means is also in connection with the heating means for heating the heat medium.

Hence, these features do not further differentiate the subject-matter of granted claim 1 from the reactor of document (1).

- 2.5 The Appellant and the Respondent were divided as to whether or not the problem defined in point 2.3 above was successfully solved *vis-à-vis* the closest prior art. The Appellant argued that the claimed reactor system allowed each chamber of the reactor to be heated according to the different temperature required (e.g. for the reaction of propylene to acrolein and then acrolein to acrylic acid) by simply having one heating means and one storing means, each chamber being thereby heated individually and in sequence, said sequential heating resulting in the shortening of the time required for starting up the reactor.

However, the reactor system of granted claim 1 is merely defined as having a means for supplying a heat medium at an elevated temperature to at least **one** of the reactor chambers. As such, the reactor system does not necessarily supply heat medium to more than one chamber and thus all of the Appellant's arguments based on the effects obtained by each chamber being independently and sequentially heated to different temperatures, e.g. faster start up time, are redundant. In addition, the reactor system of granted claim 1 is not defined as having **only one** heating means, the open wording "comprising" a heating means allowing the presence of more than one, the reference signs (22, 23) after the feature "heating means" referring to the two heaters in Figure 1. Hence, the Appellant's arguments which are based on the effects obtained by having only one heating means, e.g. less equipment, are also redundant.

- 2.6 According to the case law of the Boards of Appeal, alleged but unsupported advantages cannot be taken into consideration in respect of the determination of the problem underlying the invention (see e.g. decision T 20/81, OJ EPO 1982, 217, point 3, last paragraph of the Reasons). Since in the present case no improvements have been shown, the technical problem as defined in point 2.3 above needs reformulation in a less ambitious way.
- 2.7 Consequently, the objective problem underlying the claimed invention in the light of the teaching of document (1) is merely the provision of an alternative reactor system.
- 2.8 It remains to be decided whether or not the proposed solution to this problem is obvious in view of the cited state of the art.

2.8.1 Reactors having a plurality of chambers are well-known from, for example, document (2). Said document describes a tubular reactor for exothermic reactions (see claim 1), wherein the reactor housing 72 is subdivided into two sections 76 and 78, which are separated from one another by a plate 74 (see Fig. 5 and col. 3, lines 43 to 46). Thus, in the absence of an unexpected effect associated with such a type of reactor, the replacement of an undivided shell and tube reactor with a subdivided shell and tube reactor, both types being suitable for performing exothermic reactions, is obvious. Thus by combining the teachings of documents (1) and (2), the person skilled in the art would arrive at the solution proposed by granted claim 1 without exercising an inventive step.

2.9 For the following reasons the Board cannot accept the Appellant's arguments designed for supporting inventive step.

2.9.1 The Appellant submitted that the solution could not be arrived at by simply combining the reactor systems of documents (1) and (2) and in its letter dated 28 January 2016 provided three figures representing the reactor systems it believed would be constituted by merely combining said teachings.

However, each of the reactor systems of Figs. 1 to 3 in the letter dated 28 January 2016 comprises a means for storing a heat medium led out of reaction chambers, a heating means for heating the heat medium led out of said storing means, and a means for supplying said heat medium heated by said heating means to an elevated temperature to at least one of said chambers, such that each of these reactor systems in fact falls under the

subject-matter of granted claim 1. By way of example, the Appellant argued that in contrast to its invention, the reactor system of Fig. 2 required the same number of heating means as the number of chambers. However, the reactor system of granted claim 1 is not defined as having only one heating means, it indeed specifically referring by way of reference signs to two chambers (51, 52) and two heating means (22, 23) (see also point 2.5 above). These figures thus in fact contradict the Appellant's assertion that the reactor system of the disputed patent cannot be arrived at by a mere combination of documents (1) and (2).

2.9.2 All of the Appellant's arguments in support of inventive step based on the premise that the reactor system was improved *vis-à-vis* that of document (1) are not pertinent, as such an improvement has not been shown (see point 2.5 above).

2.10 As a result, the Appellant's main request is not allowable as the subject-matter of claim 1 thereof lacks inventive step pursuant to Article 56 EPC.

Auxiliary request 2

3. *Admissibility*

3.1 Auxiliary request 2 was filed with the statement of grounds of appeal. It is based on the main request wherein granted claims 1 to 5, namely the claims to the reactor system, have been deleted, and granted independent claim 6, directed to a method for starting up the reactor system of claim 1, has been reformulated as claim 1, wherein the features of the reactor system of granted claim 1 have now been incorporated into said claim in full. Three new dependent claims 7 to 9 have

been added, and the independent claim 12 to the use of the reactor system of claims 1-5 for the production of (meth)acrylic acid or (meth)acrolein has been reworded as claim 10 to the use of the reactor system for a method of claims 1-10 for the production of (meth)acrylic acid or (meth)acrolein.

3.2 Appeal proceedings are based *inter alia* on the statement of grounds of appeal filed pursuant to Article 108 EPC, said statement containing the party's complete case (see Art. 12(1) and (2) RPBA). The Board may however hold inadmissible requests which could have been presented in the first instance proceedings (see Art. 12(4) RPBA).

3.3 The Respondent submitted that auxiliary request 2 should not be admitted into the proceedings, since the Appellant had failed to provide proper justification as to why said request had been filed only on appeal when it could have been presented before the first instance. Nor had had any reasons been given in the statement of grounds of appeal as to why the subject-matter of the method of this request was inventive over and above the reasons given for inventiveness of the reactor system used in the claimed method. Indeed to the contrary, the Appellant had implied several times in the opposition-appeal proceedings that the method claims were subsidiary to the claims to the reactor system and stood or fell with them. Furthermore, there were various new problems regarding the clarity of the claims of said request, such that for this reason too, its claims were not clearly allowable. Said request did not represent a serious attempt to overcome the objections on file, nor did it represent a response to unforeseen developments. It was not in the interest of procedural economy to admit the request and then remit it to the first instance, since this would result in many more years of

delay. Said delay was entirely the Appellant's responsibility, since it could have filed a request consisting exclusively of the method claims before the Opposition Division, such that withholding the filing of such a request until the appeal stage was an abuse of procedure.

- 3.4 The Board holds that the filing with the statement of grounds of appeal of a request which essentially corresponds to a request decided upon by the Opposition Division, wherein claims which were found unallowable by the first instance have been deleted, said request thereby being restricted to subject-matter of a different category for which no negative decision has been issued by the Opposition Division, deprives the contested decision of its basis, and is normal behaviour of a losing party. This behaviour of the Appellant is thus not considered to constitute an abuse of procedure.
- 3.5 With regard to the arguments of the Respondent, the Appellant had indeed provided arguments before the Opposition Division as to why the method for starting up a reactor system of granted claim 6 was inventive (see pages 9 and 10 of letter dated 27 May 2010). At the time of filing its statement of grounds of appeal, the Appellant had no negative decision from the first instance with regard to this method, such that it did not need to defend itself, it never having been determined, neither by the Opposition Division nor by the Respondent, which document represented the closest prior art for said subject-matter, the Appellant having argued all along, both before the Opposition Division and the Board, albeit in the statement of grounds of appeal only in relation to the reactor system *per se*, that none of the cited documents related to a method for starting up a reactor. As such, the Board holds that the

filing of a request which is restricted to subject-matter which deprives the contested decision of its basis, clearly represents a serious attempt to overcome the objections on file. With regard to the Respondent's objections to lack of clarity of the claims of this request, the claim essentially corresponded to (combinations of) granted claims, such that *prima facie* their clarity could not be contested (see G 3/14, OJ EPO 2015, A102), so that the Board holds that any purported lack of clarity is not sufficient reason to not admit the claims into the proceedings. There is no requirement that the admissibility of claims filed with the statement of grounds of appeal be "clearly allowable", said requirement applying rather to requests which have been filed at a later stage, e.g. during the oral proceedings (see T 153/85, point 2.1 of the Reasons, OJ EPO 1988, 1). Similarly, the argument based on unforeseen developments is irrelevant at the stage of filing the statement of grounds of appeal, since at this stage of the appeal proceedings, no developments have yet occurred which may be considered to be unforeseen or not. Procedural economy alone cannot be a reason for not admitting a request into the proceedings which deprives the contested decision of its basis. In any case, had the Opposition Division in the contested decision also decided upon the patentability of granted method claim 6, which lay before it, remittal would not now be necessary, such that the delay in ending the proceedings did not lie in the hands of the Appellant alone.

3.6 The Board thus admits the auxiliary request 2 into the appeal proceedings.

4. *Amendments (Rule 80 EPC)*

4.1 The claims of auxiliary request 2 have been amended *vis-à-vis* the granted claims *inter alia* in that three new dependent claims, namely claims 7 to 9, have been added.

4.2 According to Rule 80 EPC, the claims of a granted patent may be amended, provided that the amendments are occasioned by a ground for opposition specified in Article 100 EPC, even if the respective ground has not been invoked by the opponent.

4.3 The addition of dependent claims, however, leaves unimpaired the scope of the independent claim to which such dependent claim refers. It neither limits nor amends the subject-matter claimed in the corresponding independent claim. The addition of a dependent claim is therefore no response at all to an objection against the patentability of the subject-matter claimed (see T 674/96, point 3.10 of the Reasons, not published in OJ EPO).

4.4 The Appellant argued that granted claim 6 referred back to the reactor systems of claims 1 to 5. In order to reflect this dependency in the process claims, more claims were required and for that reason new claims had been introduced.

However, these amendments can under no circumstances overcome and, hence, cannot be occasioned by, any ground for opposition as required by Rule 80 EPC.

4.5 As a result, the auxiliary request 2 is not allowable.

Auxiliary request 2tris

5. *Admissibility*

5.1 Auxiliary request 2tris was filed during the oral proceedings before the Board, the amendments to the claims of which overcoming the objections under Article 84 EPC raised by the Respondent, and under Rule 80 EPC raised in the communication of the Board to the claims of auxiliary request 2. Therefore, these amendments are considered to be appropriate and necessary (Article 13(1) RPBA).

The Respondent had no additional arguments over and above those presented for auxiliary request 2 (see point 3.3 above) regarding lack of admissibility for auxiliary request 2tris.

5.2 The Board thus exercises due discretion to admit the auxiliary request 2tris into the appeal proceedings.

Auxiliary request 2tris

6. *Amendments (Rule 80 EPC)*

6.1 Auxiliary request 2tris essentially differs from auxiliary request 2 in that claims 7 to 10 have been deleted. Thus the above objection under Rule 80 EPC (see point 4 above) has been overcome.

6.2 The request is now restricted to the six claims corresponding to granted method claims 6 to 11.

7. *Remittal (Article 111(1) EPC)*

- 7.1 The Opposition Division has not yet ruled on the method claims. It is not the duty of the Boards of Appeal to consider and decide upon questions raised for the first time during the appeal proceedings. Instead, the main purpose of appeal proceedings is to give the losing party the opportunity to challenge the decision of the Opposition Division (cf. G 9/91, *loc. cit.*, point 18 of the Reasons). Taking into account that the closest prior art for these method claims has not yet been ascertained, the Board considers it appropriate to exercise its power conferred on it by Article 111(1) EPC to remit the case to the Opposition Division for further prosecution on the basis of the claims according to the auxiliary request 2tris.

In view of Article 114(1) EPC, it will be the task of the first instance to examine and decide on the grounds of opposition raised, i.e. Articles 100(a) and (c) EPC, of the subject-matter of these method claims.

8. *Apportionment of costs (Article 104(1) EPC)*

- 8.1 Under Article 104(1) EPC, each party to opposition proceedings shall bear the costs it has incurred, unless the Opposition Division, for reasons of equity, orders a different apportionment of costs. This principle applies equally to the opposition-appeal proceedings in view of Article 111(2) EPC in combination with Rule 100(1) EPC.
- 8.2 In the present case, the Respondent requested that the Board award all costs in its favour, both of the present and all future proceedings, on the basis that it was essentially an abuse of the proceedings on behalf of the Appellant to file a request relating exclusively to the

method claims at such a late stage of the opposition(appeal) proceedings. It was entirely the Appellant's responsibility to have filed such a request before the Opposition Division which would have avoided the need for any remittal.

8.3 However, the Board has already ascertained that the Appellant has not committed an abuse of procedure (see point 3.4 above), the present proceedings being in any case necessary in view of the finding in the contested decision that the subject-matter of granted claim 1 was not inventive (see point III above), the filing of auxiliary request 2 being irrelevant in this respect.

8.3.1 Hence, the Board sees no reason for a different apportionment of costs for the present proceedings.

8.4 With regard to future costs, the Board is not in possession of the necessary facts at this stage to decide upon an apportionment of costs for subsequent proceedings, of which the unfolding and outcome is pure speculation (see T 369/08, point 7.12 of the Reasons and T 1282/08, point 22 of the Reasons, both not published in OJ EPO).

8.4.1 Thus, the Board holds that it is incumbent on the Opposition Division in its further prosecution of the case following remittal to it by the Board, to consider and decide upon the issue of apportionment of costs in the light of the facts and requests before it, in accordance with the power conferred upon it by Article 104(1) EPC.

9. *Request for acceleration of the opposition proceedings*

9.1 The Respondent requested that the Board direct the Opposition Division to accelerate the further proceedings before it.

9.2 There is no provision of the EPC under which any competence is given to a Board of Appeal to decide the time frame of first instance proceedings after remittal (see T 2362/08, point 6 of the Reasons, not published in OJ EPO). The Board therefore cannot take any decision on the request for acceleration of the opposition proceedings. This should be presented to the opposition division taking into account the conditions under which a request of this kind may be made (see notice in OJ EPO 2008, 221).

Order

For these reasons it is decided that:

1. The decision under appeal is set aside.
2. The case is remitted to the Opposition Division for further prosecution on the basis of auxiliary request 2tris filed during the oral proceedings before the Board.
3. The request for apportionment of costs is refused.

The Registrar:

The Chairwoman:



C. Rodríguez Rodríguez

J. Mercey

Decision electronically authenticated