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**Datasheet for the decision
of 4 December 2015**

Case Number: T 1651/12 - 3.3.05

Application Number: 01930323.9

Publication Number: 1280638

IPC: B27K5/06, B27K5/00

Language of the proceedings: EN

Title of invention:

PROCESS FOR PRODUCING DURABLE PRODUCTS

Patent Proprietor:

New Polymeric Compound (NPC) Industries B.V.

Opponent:

Timura Holzmanufaktur GmbH
Hüttenhof 1
06548 Rottleberode

Headword:

Process for preserving wood/NEW POLYMERIC COMPOUND

Relevant legal provisions:

EPC Art. 123(2), 123(3), 111(1), 84, 134(1), 134(2), 100(b)
RPBA Art. 13(1), 13(3), 12(4)

Keyword:

Late-filed request - admitted (yes)
Amendments - allowable (yes)
Oral proceedings - postponement (no)

Decisions cited:

G 0010/91, G 0003/14, T 0419/12

Catchword:



**Beschwerdekammern
Boards of Appeal
Chambres de recours**

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Case Number: T 1651/12 - 3.3.05

D E C I S I O N
of Technical Board of Appeal 3.3.05
of 4 December 2015

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Decision under appeal: **Decision of the Opposition Division of the
European Patent Office posted on 8 May 2012
revoking European patent No. 1280638 pursuant to
Article 101(3) (b) EPC.**

Composition of the Board:

Chairman J.-M. Schwaller
Members: A. Haderlein
P. Guntz

Summary of Facts and Submissions

- I. The present appeal lies from the decision of the opposition division to revoke European patent EP 1 280 638, which concerns a process for preserving wood.
- II. According to the impugned decision, claim 1 of the main request and claim 1 of the auxiliary request filed at the oral proceedings before the opposition division did not comply with Article 123(2) EPC.
- III. With its statement of grounds of appeal, the appellant (proprietor of the patent) filed a main request and an auxiliary request, each including a "new main claim".
- IV. In its reply, the respondent objected to the appellant's requests under Article 12(4) RPBA and Articles 84, 123(2) and 83 EPC.
- V. In a communication, the board informed the parties of its preliminary opinion, and stated that it assumed that the main request and the auxiliary request each included only a single claim.
- VI. At the oral proceedings before the board, the appellant filed a new main request and a new auxiliary request, both including dependent claims and apparatus claims.
- VII. The claims of the main request read as follows:

*"1. Process for preserving wood, said process comprising the following treatment steps:
i) drying the wood during a drying step;
ii) subjecting the wood to a modification step in which wood is heated to a modification temperature and is*

maintained at that temperature for a specific time, the modification step taking place at a temperature of 200°C - 290°C; and

iii) cooling the wood during a cooling step, characterised in

iv) that the modification step takes place under vacuum;

v) that heating elements are positioned in-between the wood;

vi) that during the treatment steps a pressure is applied to the wood;

vii) that during the cooling step the wood is cooled to a temperature of 50 - 120°C; and

viii) that both the heating during the drying and modification steps and the cooling during the cooling step takes place by the heating elements.

2. Process as claimed in claim 1, characterized in that the drying step takes place at a temperature of 30°C - 120°C.

3. Process as claimed in claim 1 or 2, characterized in that the drying step takes place under vacuum.

4. Apparatus for preserving wood for implementing the process as claimed in one of the claims 1 - 3, comprising:

- a housing for receiving the wood to be preserved;

- heating means;

- means for application of a vacuum in the housing;

- wherein the heating means comprise heating elements adapted to be located between the wood to be preserved;

- pressure means for applying a variable pressure to the wood;

- control means for controlling the heating elements, the control means being designed for raising or

lowering the temperature in a stepwise manner, characterized in that heating means are adapted to heat the wood to any temperature of 200°C - 290°C, and that the heating elements are formed by hollow elements.

5. Apparatus as claimed in claim 4, characterized by means for determining the temperature of the wood connected the control means."

VIII. The arguments of the appellant are summarised as follows:

The main request was a reaction to the reasons given in the contested decision and to the objections raised by the respondent at the oral proceedings before the board. In the statement setting out the grounds of appeal, reference was made to a "new main claim" implying that the request would also include dependent claims, as in the main and auxiliary requests underlying the contested decision.

Claim 1 of the main request was based in particular on claim 13 as filed and on the description, page 5, from line 6 onwards, of the application as filed. Claim 1 of the main request contained all the features of granted claim 1. Thus, the requirements of Articles 123(2) and (3) EPC were complied with.

Claim 1 of the main request complied with the requirement of clarity, the expression "for a specific time" being well understood by the skilled person.

No consent was given to the admission of the fresh ground of opposition of lack of sufficiency of disclosure.

If the board found one of the requests to comply with Articles 84 and 123(2) and (3) EPC, remittal of the case for further prosecution was requested.

IX. The arguments of the respondent are summarised as follows:

The main request should not be admitted into the proceedings, under Article 13(1) and (3) RPBA. In particular, neither dependent process claims nor apparatus claims were included in the requests filed with the statement of grounds of appeal. The further claims now also included apparatus claims, i.e. claims of a different category. It was not possible to react to such a new claim request on the day of the oral proceedings since the representative needed to consult his client.

Should the board admit the main request into the proceedings, postponement of the oral proceedings was requested to allow the representative to consult his client.

Article 123(2) EPC was not complied with. The feature "for a specific time" was not originally disclosed. The temperature range of 200 to 290°C was disclosed only in combination with the softening step, which step was however absent from claim 1 of the main request. The feature "during the treatment steps a pressure is applied to the wood" was only disclosed in claim 13 as filed, which was absent from the patent as granted.

The requirement of clarity set forth in Article 84 EPC was not complied with; a number of features in the claims, in particular the feature "during a specific time", were not clear.

The requirement of Article 83 EPC was also not complied with.

If the board found one of the requests to comply with Articles 84 and 123(2) and (3) EPC, and the request for postponement of the oral proceedings was not granted, remittal of the case for further prosecution was requested.

X. Requests

The appellant requested that the decision under appeal be set aside and that the patent be maintained in amended form according to the main request or, in the alternative, according to auxiliary request 1, both requests as submitted during oral proceedings before the board.

The respondent requested that the appeal be dismissed.

Reasons for the Decision

1. Main request - admissibility

1.1 The main request was filed at the oral proceedings. Its admission was therefore at the board's discretion (Article 13(1) and (3) RPBA).

1.2 Claim 1 of the main request corresponds to claim 1, entitled "main claim", of the main request submitted with the grounds of appeal, with the word "treatment" being inserted in the first line of the claim.

Claims 2 to 5 correspond to the four claims which, in addition to claim 1, were present in the auxiliary

request underlying the impugned decision (see Annex 4 to the minutes of oral proceedings before the opposition division).

- 1.3 According to the respondent, the "main claim" of the main request submitted with the grounds of appeal differed from claim 1 of the auxiliary request underlying the impugned decision only by the feature "that during the treatment steps pressure is applied to the wood". As the issue of Article 123(2) EPC was discussed extensively at the oral proceedings before the opposition division, claim 1 could have been submitted in the proceedings before the opposition division.

The board does not agree for the following reasons.

- 1.3.1 The opposition division stated in the annex to the summons dated 25 May 2011 (see point 6.a.ii) that it was not clear where there was a basis for a process with no pressure being applied during the cooling step. Also, according to the minutes of the oral proceedings (see point 11), the chairman of the opposition division "directed the patentee to discuss also the objection brought forward in written [sic] by the division and relating to the missing feature of applying pressure at least also during the cooling step". He also informed the parties that one reason why claim 1 of the then pending main request did not comply with Article 123(2) EPC was that "the step of application of pressure during the cooling step" was missing (see the minutes, point 19). In the course of the oral proceedings, the patentee (now appellant) filed two requests (see Annexes 3 and 4) including the feature "that during the ... cooling step a pressure is applied to the wood", one of which (see Annex 4) became the

auxiliary request on which the impugned decision was based. The patentee thus made a *bona fide* attempt to overcome the above objection under Article 123(2) EPC.

1.3.2 In its decision, the opposition division was of the opinion that the feature that "*during the modification step a pressure is applied to the wood*" was not disclosed in the application as filed "*which specifies merely that pressure is applied to the wood during the [treatment] steps*" and that "*pressure is preferably applied to the wood during the process*" (see reasons, 1.b). Thus this specific reasoning was given for the first time in the impugned decision. The board thus concludes that there was no specific reason in the proceedings leading up to the impugned decision to include in claim 1 the feature "that during the treatment steps pressure is applied to the wood", and that a specific reason only arose in view of the reasons given in the impugned decision (cf. T 419/12, reasons 2.1.2).

1.4 Also, the insertion of the word "treatment" in the first line of the claim was a reaction to the discussion in the oral proceedings before the board.

1.5 With respect to claims 2 to 5 the board observes the following:

1.5.1 It is not contested that the grounds of appeal made no explicit reference to dependent process claims or to apparatus claims. Moreover, the board had informed the parties in its communication prior to the oral proceedings that it assumed that the main request contained only a single claim.

From an objective point of view, the respondent could thus have expected that the appellant would react to the board's communication by supplementing claim 1 of the main request with further claims.

- 1.5.2 Moreover, in its reply to the grounds of appeal, the respondent raised several objections which were apparently directed against a dependent process claim and an apparatus claim (see sections 3.2, 3.3 and 5 of the reply).

It appeared therefore that the respondent assumed that the then pending main request included further claims.

- 1.5.3 The board furthermore notes that the opposition division found that apparatus claim 4 of the now pending main request complied with the requirements of Article 123(2) EPC (see the impugned decision, reasons 2.a and 2.b)

- 1.5.4 In view of the above circumstances, the board concluded that the respondent, from an objective point of view, could have expected that the appellant would file a set of claims including present claims 2 to 5.

- 1.6 For these reasons and considering that the proceedings before the board were confined to the issues of Articles 123(2) and (3) and 84 and to a fresh ground of opposition under Article 100(b) EPC to which no consent was given by the appellant (see *infra* point 5.), the board concluded that the respondent could reasonably have been expected to deal with the amendments made by the appellant without adjournment of the oral proceedings (Article 13(3) RPBA).

1.7 The board therefore admitted the main request into the proceedings.

2. Main request - Article 123(2) EPC

2.1 In the opinion of the respondent, the feature "for a specific time" in claim 1 was not disclosed in the application documents as filed.

2.2 The board cannot agree, because claim 1 as originally filed included the words "*for a specific time*".

2.3 Further according to the respondent, the feature "*the modification step taking place at a temperature of 200°C to 290°C*" was taken in isolation from the description, thus leading to an unallowable generalisation.

2.3.1 The board does not accept this argument. As is readily apparent from the description, page 5, lines 30 *et seq.*, of the application as filed (in its English version as received on 6 July 2001), the softening step is present only in a preferred embodiment. The passage on page 1, lines 3 and 4, and claim 1 clearly teach that the "preservation step" is the core of the process as originally disclosed. This step however corresponds in the preferred embodiment disclosed on page 6, lines 3 *et seq.*, to heating at a temperature of from 200 to 290°C. Nothing in the application documents as filed indicates that the temperature of the "preservation step" depends on the presence or absence of the softening step.

2.3.2 It is true that the preservation step should be as brief as possible in order to avoid the formation of by-products (see page 6, lines 3 to 7). But this does not support the respondent's contention that the

softening step was essential when the modification step was carried out at a temperature of 200 to 290°C. The same reasoning applies to the respondent's argument that the table on page 8 supports this contention. This table only teaches that the preserving step is shorter than the softening step, which however does not mean that the softening step is essential when carrying out the preserving step at the temperature indicated in the table.

2.4 Concerning the insertion of the word "treatment" in the first line of claim 1, this feature is disclosed in originally filed claim 13. The fact that this claim was not present in the claims as granted is immaterial when assessing compliance with Article 123(2) EPC, since the latter provision refers to the application documents as filed. By the above insertion, claim 1 is now directed to a process wherein pressure is applied during all three process steps, i.e. drying, modification and cooling. In addition to claim 13 as originally filed, the passage on page 3, lines 11 to 23, also supports this amendment.

2.5 Claim 4 is based on claims 14 and 15; page 6, lines 13 to 18 and lines 23 to 26, as originally filed. To that extent the board agrees with the opposition division's finding that the subject-matter of claim 4 is disclosed in the application documents as filed (see the impugned decision, reasons 2.a and 2.b).

The board cannot agree with the respondent, who argued that the feature "for raising or lowering the temperature in a stepwise manner" was only disclosed on page 6, lines 19 to 22, corresponding to paragraph [0028] of the patent as granted, wherein the control means were said to also control the vacuum and the

pressure applied to the wood.

Clearly, claim 14 as filed discloses such control means which do not necessarily control the vacuum and the pressure applied to the wood.

2.6 Claims 2, 3 and 5 find their basis in claims 5, 6 and 16 as originally filed, respectively.

3. Main request - Article 123(3) EPC

3.1 Independent claims 1 and 4 contain all the features of their granted counterparts and thus the amendments do not extend the scope of protection conferred. In particular, feature iv) requires that pressure is applied during the treatment steps, which treatment steps include the modification step. According to the granted claim 1, pressure is applied during modification. Thus, this feature is still present in claim 1.

3.2 The requirement of Article 123(3) EPC is therefore met.

4. Main request - Article 84 EPC

4.1 In the reply to the grounds of appeal, the respondent argued that a number of features in the independent process claim and in the independent apparatus claim were unclear (see reply, section 3).

4.2 According to G 3/14, in opposition proceedings the claims of the patent may be examined for compliance with the requirements of Article 84 EPC only when, and then only to the extent that, the amendment introduces non-compliance with Article 84 EPC.

4.3 With the exception of the feature "*for a specific time*", all the features objected to by the respondent for lack of clarity were present in the granted claims. So any lack of clarity is not the result of the amendments made during the opposition or appeal proceedings. This was not contested by the respondent at the oral proceedings, when it argued that the above feature was not clear.

In line with G 3/14, the board is therefore empowered only to examine compliance with Article 84 EPC with respect to the feature "*for a specific time*", the remaining clarity objections being inadmissible.

4.4 According to the respondent, the skilled person did not know whether this feature meant short periods of some minutes or longer periods of several hours.

4.5 For the board this feature does not lead to a lack of clarity.

4.5.1 In particular, the skilled person would not read this feature in isolation. Rather, he would read it in the context of the claim and more specifically in the context of the wood being "*maintained at [the modification] temperature*". It is clear that in the context of the latter expression, the feature "*for a specific time*" means that the process is to be carried out such that the skilled person is able to distinguish the phase wherein the temperature is maintained at a certain value from the phases occurring before and after that phase.

4.5.2 The board also fails to see why the heating-up and the cooling-down of the wood would also be encompassed by the expression "*for a specific time*" as submitted by

the respondent. It is clear that this expression refers to the modification step and to the phase wherein the temperature is maintained at the modification temperature. Moreover, it is also clear from the wording of claim 1 that the claimed process requires at least three steps: drying, modifying and cooling, which have to be distinguishable one from each other.

4.5.3 The board also notes that the contentious feature is contained in the preamble of claim 1 and, thus, it is not used to establish a distinction over the prior art on which the appellant could rely when arguing novelty and inventive step.

4.6 The board is therefore satisfied that the requirement of clarity set forth in Article 84 EPC is complied with.

5. Sufficiency of disclosure

5.1 According to the respondent, the requirement of sufficiency was not complied with, in particular because of an alleged lack of clarity of a number of features of claim 1. The ground of opposition under Article 100(b) EPC was neither raised by the opponent nor introduced *ex officio* during the proceedings before the opposition division. Thus, it constitutes a fresh ground which may be considered in appeal proceedings only with the approval of the patentee (see G 10/91, reasons 18, second paragraph).

5.2 As the appellant (patentee) did not give its approval, the objections based on this ground of opposition are inadmissible.

6. Since the main request complies with the requirements of Articles 84 and 123(2) and (3) EPC and since the board decides to remit the case to the opposition division for further prosecution, it is not necessary to take a position on the appellant's auxiliary request.

7. Request for postponement of the oral proceedings

7.1 The respondent requested postponement of the oral proceedings, i.e. setting a new date for oral proceedings, in order to allow the representative to consult its client.

7.2 As set out in point 1.6 above, the respondent could reasonably have been expected to deal with the amendments made by the appellant without adjournment of the oral proceedings. Also, as mentioned above, the proceedings before the board were confined to issues of Articles 123 and 84 EPC. Bearing in mind moreover that the documents as originally filed comprise only eight pages of description and sixteen claims in total, the board is of the opinion that a professional representative within the meaning of Article 134(1) and (2) EPC could be expected to deal with amendments made in connection with the above EPC provisions at oral proceedings, at least after a break. The board observes that the representative was offered such a break but declined it.

7.3 For these reasons the board refused to postpone the oral proceedings.

8. Remittal

The board notes that the opposition division revoked

the patent for lack of compliance with Article 123(2) EPC only. Since in the notice of opposition the grounds of novelty and inventive step were raised and since both parties requested remittal for further prosecution, the board exercises its discretion pursuant to Article 111(1) EPC and remits the case to the opposition division for further prosecution.

Order

For these reasons it is decided that:

1. The impugned decision is set aside.
2. The case is remitted to the opposition division for further prosecution on the basis of the main request filed during oral proceedings before the board.

The Registrar:

The Chairman:



S. Sánchez Chiquero

J.-M. Schwaller

Decision electronically authenticated