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**Datasheet for the decision
of 11 October 2017**

Case Number: T 0711/15 - 3.2.07

Application Number: 09785284.2

Publication Number: 2303473

IPC: B07B1/46

Language of the proceedings: EN

Title of invention:

IMPROVED SIFTING SCREEN

Applicants:

United Wire Limited
M-I LLC

Headword:

Relevant legal provisions:

EPC Art. 123(2), 111(1)

Keyword:

Amendments - allowable (yes)
Remittal to the department of first instance - (yes)

Decisions cited:

Catchword:



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Case Number: T 0711/15 - 3.2.07

D E C I S I O N
of Technical Board of Appeal 3.2.07
of 11 October 2017

Appellant: United Wire Limited
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Edinburgh
Fife EH5 1HT (GB)

Appellant: M-I LLC
(Applicant 2) 5950 North Course Drive
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Representative: Murgitroyd & Company
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Decision under appeal: **Decision of the Examining Division of the
European Patent Office posted on 26 November
2014 refusing European patent application No.
09785284.2 pursuant to Article 97(2) EPC.**

Composition of the Board:

Chairman V. Bevilacqua
Members: G. Patton
G. Weiss

Summary of Facts and Submissions

I. The applicants (appellants) lodged an appeal against the decision of the examining division to refuse European patent application No. 09 785 284.2.

II. The following documents considered in the impugned decision are referred to:

D1: US 2008/083660 A;
D2: US 2002/033358 A;
D3: WO 01/17659 A;
D4: GB 1 372 686 A;
D5: DE 35 42 635 C;
D6: WO 03/057376 A;
D7: WO 2004/035234 and
D8: WO 2004/098798.

III. According to the impugned decision, the then single applicants' request did not fulfill the requirements of Article 123(2) EPC. In additional comments (*obiter dictum*), it was further mentioned that the requirements of Article 56 EPC were also fulfilled, starting from D8 as closest prior art and combined with the skilled person's common general knowledge as illustrated in D1, D2, D3 and D7.

Oral proceedings were held before the board on 11 October 2017 during which the matter was discussed.

The appellants requested that the decision under appeal be set aside and that a patent be granted on the basis of the set of claims filed as main request during the oral proceedings.

The Board announced its decision at the end of the oral proceedings.

IV. Independent claim 1 of the main request reads as follows:

"A shaker comprising a screen frame (30) to separate solids from a liquid/solid mixture, the screen frame (30) comprising an outer perimeter (32) and a plurality of plastics ribs (38), each plurality of plastics ribs extending between each opposing regions (34 and 36, 35 and 37) of the perimeter (32), the screen frame (30) also comprising a woven wire mesh attached to the screen frame, the screen frame (30) being arranged in the shaker such that a portion of the opposing regions (35 and 37) is clamped in place and a portion of the opposing regions (34 and 36) is not clamped, with the number of plastics ribs (38) per unit length for the clamped portion greater than the number of plastics ribs (38) per the same unit length for the unclamped portion; wherein the screen frame (30) has a rectangular perimeter (32), the plastics ribs (38) extending between both pairs of opposing regions (34 and 36, 35 and 37), thus forming a plurality of rectangular openings; wherein the screen frame (30) further comprises at least one metal rib (50), extending between opposing, clamped regions (35 and 37) of the perimeter (32); and wherein the at least one metal rib (50) is part of a wire mesh structure (40) which is encased in plastics material."

V. The appellants have essentially argued that the requirements of Article 123(2) EPC are fulfilled by the new main request and that the discussion on inventive step of its claimed subject-matter could be finalized before the board on the basis of the most relevant

pieces of prior art D7 and D8 which have been thoroughly discussed in the appeal proceedings.

Reasons for the Decision

1. Amendments

The board shares the appellants' view that claim 1 of the main request is based on claims 1, 2, 4, 11 and 12, description page 3, lines 1-4, page 4, lines 8-11 and 22-23, page 7, lines 15-21 and figure 3 of the application as originally filed.

Dependent claims 2-8 are based on original claims 3, 5-10.

As a consequence, the requirements of Article 123(2) EPC are fulfilled.

2. Remittal

2.1 The appellants consider that the board should decide on inventive step of the claimed subject-matter before remitting to the examining division in view of documents D7 and D8 which were the most relevant prior art documents discussed in both the *obiter dictum* of the impugned decision and in the appeal proceedings. The appellants hold the view that the claimed subject-matter has *de facto* already been considered by the examining division since the features introduced into claim 1 originate from original dependent claims. In particular, the examining division would have already explicitly expressed that the documents D1 to D6, cited before introducing D7 and D8 into the proceedings, were no longer relevant for the claimed subject-matter. This is all the more true now since the claimed subject-

matter is narrower. The board should then be in the position to take a positive final decision on inventive step of the claimed subject-matter on the basis of the discussion held on D7 and D8.

- 2.2 The board cannot share this view since the features added to claim 1 result in a substantial amendment as they relate to subject-matter which clearly goes beyond the framework of what was submitted to the examining division when the appealed decision was taken. The board also cannot see for which reasons the discussion on inventive step of the subject-matter of the newly filed main request should be limited to only documents D7 and D8. As appearing for instance from the search opinion provided with the International Search Report dated 11 January 2011 this combination of features was originally at stake with respect to inventive step. Inventive step of this subject-matter has in fact never been discussed during the examination proceedings, a *fortiori* not in the decision under appeal.

Consequently, the board considers appropriate to remit the case to the department of first instance for further prosecution on the basis of the claims filed as main request during the oral proceedings before the board.

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 set of claims filed as main request during the oral proceedings.

The Registrar:

The Chairman:



G. Nachtigall

V. Bevilacqua

Decision electronically authenticated