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**Datasheet for the decision  
of 25 April 2017**

**Case Number:** T 0029/16 - 3.3.06

**Application Number:** 01272112.2

**Publication Number:** 1363985

**IPC:** C10L3/10

**Language of the proceedings:** EN

**Title of invention:**

PROCESS FOR THE REDUCTION OR ELIMINATION OF HYDROGEN SULPHIDE

**Patent Proprietors:**

- 1) M-I L.L.C.
- 2) Statoil ASA

**Opponent:**

Clariant Produkte (Deutschland) GmbH

**Headword:**

Scavenging H<sub>2</sub>S / STATOIL

**Relevant legal provisions:**

EPC Art. 107, 108, 111(1), 113(1)  
EPC R. 79(3), 82(1)

**Keyword:**

Substantial procedural violation - opportunity to comment (no)  
- reimbursement of appeal fee (yes) - violation of the right  
to be heard (yes)

**Decisions cited:**

T 0113/92, T 0996/92

**Catchword:**



**Beschwerdekammern**  
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Case Number: T 0029/16 - 3.3.06

**D E C I S I O N**  
**of Technical Board of Appeal 3.3.06**  
**of 25 April 2017**

**Appellant:** Clariant Produkte (Deutschland) GmbH  
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**Representative:** Mikulecky, Klaus  
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**Respondent I:** M-I L.L.C.  
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**Respondent II:** Statoil ASA  
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**Representative:** Brady, Paul Andrew  
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**Decision under appeal:** **Interlocutory decision of the Opposition**  
**Division of the European Patent Office posted on**  
**4 December 2015 concerning maintenance of the**  
**European Patent No. 1363985 in amended form.**

**Composition of the Board:**

**Chairman**            B. Czech  
**Members:**            G. Santavicca  
                              C. Vallet

## **Summary of Facts and Submissions**

- I. The appeal filed by the opponent lies from the interlocutory decision of the Opposition Division, posted on 4 December 2015, concerning maintenance of the European patent n° 1 363 985 in amended form.
- II. The impugned decision follows a first decision, T 130/11 dated 20 December 2013, by which the Board decided to remit the case to the Opposition Division with the order to maintain the patent on the basis of the claims according to the Main Request submitted with letter dated 6 December 2013, and of description and figures to be adapted thereto where appropriate.
- III. In a communication dated 18 November 2014 the Opposition Division invited the "Applicant" [sic] to adapt the description and the drawings to the claims held allowable by the Board.
- IV. On 18 March 2015 the Patent Proprietors submitted amended pages of the description and of the drawings.
- V. A copy of the Opposition Division's communication dated 18 November 2014 and of the amended description and drawings pages submitted with letter of 18 March 2015 was sent to the Opponent with "Brief Communication" dated 26 March 2015.
- VI. In a consultation by telephone held on 25 March 2015, between the first examiner of the Opposition Division and the representative of the Patent Proprietors, objections were raised against the proposed adapted description.
- VII. A copy of the "Result of consultation" was notified to

the parties (posting date 30 March 2015).

- VIII. With their letter dated 21 May 2015, the Patent Proprietors submitted newly amended description pages 2, 3, 3a-d, 4, 4a, 5, 5a, 6 to 10, 10a, 11 to 13, and amended drawing sheet 6/7.
- IX. These amended pages were sent to the Opponent with a "Brief Communication" dated 28 May 2013.
- X. The interlocutory decision under appeal was received by the Opponent on 8 December 2015.
- XI. By letter of 16 December 2015, the Opponent lodged an appeal against this decision and submitted its statement of grounds of appeal.
- XII. The Appellant (Opponent) requested
- that the decision under appeal be set aside,
  - that the case be remitted to the Opposition Division with the order to designate Preparation Example C and its further uses as comparative example, or to delete it, and
  - that the appeal be reimbursed.
- XIII. In its response to the statement setting out the grounds of appeal, dated 1 February 2016, the Respondents/Patent Proprietors requested that the appeal be dismissed. With the response, the Respondents also filed amended description pages 10 and 12 labelled First Auxiliary Request, and amended description pages 10, 11 and 12 labelled Second Auxiliary Request. As a precautionary measure, it requested oral proceedings (Third Auxiliary Request) in the event that none of the Main, First Auxiliary or Second Auxiliary Request were found allowable by the board.

XIV. In a further letter dated 12 February 2016, the Appellant expressly indicated that the amended description according to the Respondent's First or Second Auxiliary Request was sufficiently adapted to the claims held allowable.

XV. The arguments of the Appellant of relevance for the present decision can be summarised as follows:

The description allowed by the Opposition Division referred (page 10) to a Preparation Example C, illustrating the reaction between formaldehyde and glucose, the product of which was used as H<sub>2</sub>S-scavenger (page 12, line 5). As the use of a reaction product of formaldehyde and glucose no longer fell under the H<sub>2</sub>S-scavengers to be used in the method according to Claim 1, Preparation Example C and its product were not in accordance with the claimed invention. This fact was not expressly indicated in the description, however.

The Opponent was adversely affected by this omission, hence by the impugned decision. In this respect, T 113/92 of 17 December 1992 and T 996/92 of 23 March 1993 were invoked.

Moreover, the Opposition Division had addressed the need to adapt the description in at least two communications, and ultimately in a telephone conversation involving only the first examiner and the Patent Proprietor. In particular the Opposition Division took the impugned decision without previously asking the Opponent to take position on the ultimate version of the adapted description.

After issuance of the impugned decision, the sole remedy available to the Opponent was thus an appeal.

The violation of the right to be heard amounted to a substantial procedural violation that warranted the reimbursement of the appeal fee.

XVI. The counter-arguments of the Respondents can be summarised as follows:

The presence of Preparation Example C in the description did not cause any lack of clarity of the claims. It merely represented a disclosure that the product illustrated had been made. Thus, the amended text of the patent was clear.

It was not appropriate that Preparation Example C be qualified as "comparative", because it was not an example of the prior art. Therefore, in the amended description pages according to the First Auxiliary Request, the composition of Preparation Example C had been designated as being "outside the claims".

## **Reasons for the Decision**

### *Admissibility of the appeal*

1. For an appeal to be admissible the Appellant must be adversely affected by the impugned decision (Article 107 EPC).
2. In the present case this requirement is met for the following reasons.
  - 2.1 Although a reaction product of formaldehyde and glucose is **not** listed as one of the H<sub>2</sub>S-scavengers to be used according to the method of pending Claim 1, the amended description found allowable according to the decision



under appeal still contains Preparation Example C, illustrating the preparation of Product C, obtained by the reaction between formaldehyde and glucose. There is no indication in this version of the description that Preparation Example C and Product C are **not** in accordance with the invention.

- 2.2 The fact that the description has possibly not been brought into complete agreement with Claim 1 could lead to legal uncertainty as to its actual scope (cf. T 996/92 of 23 March 1993, Reasons 1, also mentioning T 113/92 of 17 December 1992, see Reasons 2 and 4).
- 2.3 Consequently, the Opponent is adversely affected by the impugned decision concerning maintenance of the patent with the allegedly insufficiently adapted description (Article 107 EPC). Since the requirements of Article 108 EPC are also met, the appeal is admissible.

*Substantial procedural violation*

3. According to Article 113(1) EPC "*The decisions of the European Patent Office may only be based on grounds or evidence on which the parties concerned have had an opportunity to present their comments*".

This Article lays down a general procedural principle which applies to all proceedings before the European Patent Office and is designed to ensure the right of the parties to be heard before any adverse decision against them.

- 3.1 The right to be heard is more particularly defined, as regards the present case in Rule 82(1) EPC which reads: "*Before the Opposition Division decides to maintain the European patent as amended, it shall inform the parties*

*of the text in which it intends to maintain the patent, and shall invite them to file their observations within two months if they disapprove of that text."*

3.2 In the present case, the amended description pages and drawings sheet submitted by the Patent Proprietor with its letter dated 21 May 2015 after its the telephone conversation with the first examiner, i.e. the adapted description and drawings on which the impugned decision is based, were sent to the Opponent. However, this "brief communication" dated 28 May 2015 did not contain an invitation to take position on the amended description and drawings, let alone within a given time limit.

3.3 Hence, the provision of Rule 82(1) EPC has not been complied with by the Opposition Division. The Opponent has not been invited to comment on the text, on the basis of which the Opposition Division intended to maintain the patent in amended form, and the decision under appeal does not indicate that the Opponent has commented on the final version of the amended description. The decision under appeal thus came as a surprise to the Opponent

3.4 Therefore, the Board concludes that a substantial procedural violation occurred.

#### *Remittal*

4. Article 11 of the Rules of Procedure of the Boards of Appeal stipulates that "*[a] Board shall remit a case to the department of first instance if fundamental deficiencies are apparent in the first instance proceedings, unless special reasons present themselves for doing otherwise*".

Hence, a remittal of the case for further prosecution would in principle be justified in view of the fundamental deficiency identified *supra*.

5. However, the amended version of the patent considered allowable by the Opposition Division is, for the Board, indeed *prima facie* objectionable under Article 84 EPC considering the uncertainty as regards the ambit of Claim 1 and its support by the description in view of the unamended sections of the description referring to the preparation and use of H<sub>2</sub>S-scavengers not mentioned in the exhaustive list of scavengers to be used according to Claim 1 at issue.

Accordingly, the Respondent's Main Request is not allowable.

6. Moreover, it is apparent from the Appellant's letter dated 12 February 2016 that it considers the description pages according to the Respondent's First Auxiliary Request to be sufficiently adapted to the pending claims, i.e. that it has no objections against the patent being maintained with a description amended in this manner.

The Board sees no reason for taking a different stance in this respect, considering that

- the composition of the "*formaldehyde-glucose reaction product*" is expressly referred to as "*composition outside the claims*", according to Preparation Example on amended page 10 according to the pending First Auxiliary Request,

and

- "*Product C*" is expressly stated to be "*outside the*

*claims*" on amended page 12 according to the pending First Auxiliary Request.

7. Considering the fact that the Respondent did not request oral proceedings in the event that the First Auxiliary Request was found allowable, and taking into account the need for procedural economy, the Board considers it appropriate to remit the case for maintenance of the patent in suit with the amended description according to the First Auxiliary Request.

*Reimbursement of the Appeal fee*

8. According to Rule 103(1)(a) EPC the reimbursement of the appeal fee shall be ordered if the appeal is allowable and if such reimbursement is equitable by reason of a substantial procedural violation.

- 8.1 As established above, the appeal is allowable, and the issuance of the decision under appeal without having heard the Opponent on the text on which the patent should be maintained amounts to a substantial procedural violation.

- 8.2 Therefore, the reimbursement of the appeal fee is equitable.

## 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 with the order to maintain the patent in the version held allowable by the Opposition Division in the decision under appeal, but with pages 10 and 12 being replaced by pages 10 and 12 filed as First Auxiliary Request with letter of 1 February 2016.
3. The appeal fee is to be reimbursed.

The Registrar:

The Chairman:



D. Magliano

B. Czech

Decision electronically authenticated