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**Datasheet for the decision
of 4 September 2020**

Case Number: T 0350/17 - 3.3.06

Application Number: 07818806.7

Publication Number: 2094652

IPC: B01J19/24, C07C273/16,
C07D251/62, C07C273/12

Language of the proceedings: EN

Title of invention:

INTEGRATED PROCESS FOR UREA AND MELAMINE PRODUCTION

Patent Proprietor:

CASALE SA

Opponents:

Saipem S.p.A.
EUROTECNICA CONTRACTORS AND ENGINEERS S.p.A.
Stamicarbon B.V.

Headword:

CASALE/UREA-MELAMINE

Relevant legal provisions:

EPC Art. 54, 83, 111(1), 113(1)
RPBA Art. 12(4)
RPBA 2020 Art. 11, 23

Keyword:

Novelty - (yes)

Sufficiency of disclosure - (yes)

Right to be heard - substantial procedural violation

Late-filed request - admitted (yes)

Decisions cited:

G 0007/93, T 0140/12, T 0763/15, T 0688/16

Catchword:



Beschwerdekammern

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Case Number: T 0350/17 - 3.3.06

D E C I S I O N
of Technical Board of Appeal 3.3.06
of 4 September 2020

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Decision under appeal: **Decision of the Opposition Division of the
European Patent Office posted on 20 December
2016 revoking European patent No. 2094652
pursuant to Article 101(3)(b) EPC.**

Composition of the Board:

Chairman J.-M. Schwaller
Members: S. Arrojo
 R. Cramer

Summary of Facts and Submissions

I. The present appeal from the patentee (hereinafter "the appellant") lies from the decision of the opposition division to revoke European patent **No. 2 094 652** for non-compliance with the requirements of Article 54 EPC.

II. In its grounds of appeal the appellant requested to maintain the patent as granted, or, as an auxiliary measure, in amended form on the basis of auxiliary requests 1-12 filed therewith.

Further it requested that the appeal fee be reimbursed for an alleged substantial procedural violation of its right to be heard.

III. The claims which are relevant for the underlying decision read as follows:

Claim 9 as granted (**main request**):

"Integrated plant (1,110) for urea and melamine production, wherein urea is produced in a urea plant (10) comprising a high-pressure urea synthesis section (11) and a low-pressure urea recovery section (21) comprising a decomposer (22) and a condenser (23), said sections (11, 21) being in fluid communication to each other, and melamine is produced in a melamine plant (40) wherein off-gases resulting as by-products of the melamine synthesis are discharged from said plant (40) at a medium pressure and recycled to said high-pressure urea synthesis section (11), the plant (1,110) being characterized in that it further comprises:
- a medium-pressure treatment section (16) of the urea plant (10) of a part of the urea solution produced in

said synthesis section (11), comprising a dissociator (17) and a condensation unit (18);

- connecting means (32) between said melamine synthesis section (41) and said condensation unit (18) of the medium-pressure treatment section (16) for feeding said off-gases coming from said melamine synthesis section (41) to said condensation unit (18) of the medium-pressure treatment section (16);
- connecting means (33) between said condenser (23) of the urea recovery section and said condensation unit (18) of the medium-pressure treatment section (16) for feeding a recycle ammonium carbamate coming from said condenser (23) of the urea recovery section (21) to said condensation unit (18) of the medium-pressure treatment section (16); and
- connecting means (29) between said dissociator (17) of the medium-pressure treatment section (16) and said decomposer (22) of the low-pressure urea recovery section (21) for feeding a urea aqueous solution obtained from dissociation in said treatment section (16) to said decomposer (23) of the urea recovery section."

Claim 9 of **auxiliary request 1** is identical to claim 9 as granted.

Claim 1 of **auxiliary request 2**:

"Integrated process for urea and melamine production, wherein urea is produced in a urea plant comprising a high-pressure urea synthesis section from which a aqueous solution comprising urea, ammonium carbamate and ammonia is obtained, and a low-pressure urea recovery section, and melamine is produced in a melamine plant wherein off-gases resulting as by-products of the melamine synthesis are discharged

therefrom at a medium pressure and recycled to said high pressure urea synthesis section, the process being characterized in that it further comprises the steps of:

- feeding a part of said aqueous solution comprising urea, ammonium carbamate and ammonia coming from said urea synthesis section to a medium-pressure treatment section of the urea plant for recovering ammonium carbamate and ammonia contained in it;
- subjecting said part of aqueous solution comprising urea, ammonium carbamate and ammonia to dissociation in said medium-pressure treatment section, obtaining a urea aqueous solution and a vapour phase comprising ammonia, carbon dioxide and water;
- feeding said urea aqueous solution obtained from dissociation in said treatment section to a decomposer of a urea recovery section operating at a predetermined low pressure,
- subjecting said urea aqueous solution to decomposition in said decomposer of said urea recovery section, obtaining a concentrated urea solution and a second vapour phase comprising ammonia, carbon dioxide and water;
- subjecting said second vapour phase to condensation in a condenser of said urea recovery section in fluid communication with said decomposer, obtaining a recycle ammonium carbamate aqueous solution;
- feeding said off-gases coming from said melamine plant and said recycle ammonium carbamate solution to a condensation section of said medium pressure treatment section of the urea plant;
- condensing said off-gases with said recycle carbamate aqueous solution in said condensation unit of the medium-pressure treatment section, obtaining a concentrated carbamate aqueous solution;

- recycling said carbamate aqueous solution to said high pressure urea synthesis section, wherein said condensation unit of the medium-pressure treatment section comprises a single condenser and the process further comprises the steps of:
 - feeding said vapour phase comprising ammonia, carbon dioxide and water, said off-gases and said recycle ammonium carbamate solution in said single condenser of the medium-pressure treatment section;
 - condensing said vapour phase comprising ammonia, carbon dioxide and water as well as said off-gases with said recycle ammonium carbamate solution in said single condenser of said medium-pressure treatment section, obtaining a concentrated ammonium carbamate aqueous solution; and
 - recycling said concentrated ammonium carbamate aqueous solution to said high pressure urea synthesis section, or wherein said condensation unit of the medium-pressure treatment section comprises a first condenser and a second condenser in fluid communication to each other and the process further comprises the steps of:
 - feeding said off-gases coming from said melamine plant and said recycle ammonium carbamate solution to said first condenser of the medium pressure treatment section of the urea plant;
 - condensing said off-gases with said recycle carbamate aqueous solution in said first condenser of the medium-pressure treatment section, obtaining a first concentrated ammonium carbamate aqueous solution
 - feeding said first concentrated ammonium carbamate aqueous solution in said second condenser of the medium-pressure treatment section;
 - feeding said vapour phase comprising ammonia, carbon dioxide and water obtained from dissociation of said part of the aqueous solution comprising urea, ammonium

carbamate and ammonia, in said second condenser of the medium-pressure treatment section;

- condensing said vapour phase comprising ammonia, carbon dioxide and water with said first concentrated ammonium carbamate aqueous solution in said second condenser of the medium-pressure treatment section, obtaining a second concentrated ammonium carbamate aqueous solution; and*
- recycling said second concentrated ammonium carbamate aqueous solution to said high pressure urea synthesis section."*

Claim 7 of **auxiliary request 2** corresponds to claim 9 of the main request with the additional requirements that:

"said condensation unit (18) of the medium-pressure treatment section (16) comprises a single condenser (18a), or

said condensation unit (18) of the medium-pressure treatment section (16) comprises a first condenser (18b) and a second condenser (50) and further comprises:

- connecting means (32) between said melamine synthesis section (41) and said first condenser (18b) of the medium-pressure treatment section (16) for feeding said off-gases coming from said melamine synthesis section (41) to said first condenser (18b) of the medium-pressure treatment section (16);*
- connecting means (33) between said condenser (23) of the urea recovery section (21) and said first condenser (18b) of the medium-pressure treatment section (16) for feeding a recycle ammonium carbamate aqueous solution coming from said condenser (23) of the urea recovery section (21) to said first condenser (18b) of the medium-pressure treatment section (16);*

- connecting means (51) between said first condenser (18b) and said second condenser (50) of the medium-pressure treatment section (16) for feeding a carbamate aqueous solution coming from said first condenser (18b) to said second condenser (50); and
- connecting means between said dissociator (17) and said second condenser (50) of the medium-pressure treatment section (16) for feeding a vapour phase comprising ammonia, carbon dioxide and water from said dissociator (17) to said second condenser (50) of the medium-pressure treatment section."

- IV. In their replies to appeal the respondents (opponents 1, 2 and 3) requested to reject the appeal and not to admit auxiliary requests 2-12 into the proceedings.
- V. In its preliminary opinion the board informed the parties that auxiliary requests 1 and 2 should be admitted into the proceedings, that the main and auxiliary requests 1 were not novel and that auxiliary request 2 was novel. Further the patentee's right to be heard had not been respected during first instance proceedings, so the appeal fee should be reimbursed.
- VI. Opponent 3 filed further arguments against the admissibility of auxiliary requests 2-12. It also argued that the case should not be remitted to the opposition division.
- VII. Oral proceedings were held on 4 September 2020.
- VIII. Before the closure of the debate, the parties' requests were established to be as follows:

The appellant requested that the decision under appeal be set aside and the patent be maintained as granted,

or, auxiliary, in amended form on the basis of one of auxiliary requests 1-12 filed together with the statement of grounds of appeal dated 28 April 2017. It also requested the reimbursement of the appeal fee.

The respondents requested that the appeal be dismissed.

Reasons for the Decision

1. Main request - Article 100(a)/54 EPC
 - 1.1 The board has concluded that the ground for opposition under Article 100(a) EPC in relation to Article 54 EPC prejudices the maintenance of the patent as granted.
 - 1.2 Document D10 (DE 2 053 358) discloses (see figure) a melamine-urea production plant comprising a high-pressure urea synthesis section (1), a medium-pressure treatment section including a dissociator (6) and a condensation unit formed by two absorber/condensers (11 and 16) (these units are arranged to absorb gases into a liquid solution, so they can effectively be regarded as condensers), and a low-pressure urea recovery section including a decomposer (7) and a condenser (12). The dissociator (6) is connected to the low-pressure decomposer (7) and to the medium-pressure condensation unit (11,16), the condenser (12) of the low-pressure urea recovery section is connected to the decomposer (7) and to the condensation unit (11,16) of the medium-pressure section, and the off-gases (14) of a melamine synthesis section are connected to the condensation unit (11,16) of the medium-pressure section.
 - 1.3 According to the appellant, the medium-pressure treatment section defined in claim 9 at issue would be

restricted to an arrangement in which only part of the urea solution produced in the synthesis section is treated. While claim 9 did not explicitly disclose the presence of a split, it was clear that the definition of *"a medium-pressure treatment section (16) of the urea plant (10) of a part of the urea solution produced in said synthesis section (11)"* implied that the system had to be arranged for supplying only a portion of the urea solution produced in the synthesis reactor to the medium-pressure treatment section. Since in the plant of D10 (see figure) the connection of the urea synthesis reactor (1) to the medium-pressure decomposer (6) via line 4 did not include any split, all of the urea solution produced in the reactor, and not only part of it as required by claim 9, would be fed to the medium-pressure section of the plant.

The appellant also argued that the absorber 16 in D10 (figure 1) was not part of the medium-pressure section, because a pump was arranged between the absorbers 11 and 16, so that these devices would operate at different pressures and could not be regarded as belonging to the same medium-pressure section. Consequently, the medium-pressure section would comprise only units 6 and 11 and would not include connecting means between the melamine synthesis section and the condensation unit of the medium-pressure treatment section as defined in claim 9.

1.4 The board does not follow the appellant's argumentation for the following reasons:

- As correctly pointed out by the respondents, apparatus features defined in functional terms or as method steps are anticipated by any structural configuration suitable to carry out the defined

function or step. In the present case, the plant of D10 is clearly suitable to treat only a part of the urea solution since, for example, there would be no restriction for an operator to feed only part of the produced urea solution into the downstream arranged treatment steps.

- Furthermore the wording of claim 9 does not require the plant to be suitable for feeding only part of the urea solution to the medium-pressure section, as the appellant argues. Instead, the feature *"medium-pressure treatment section of the urea plant of a part of the urea solution produced in said synthesis section"* in claim 9 merely implies that the medium-pressure section is suitable for treating part of the urea solution. Since in D10 the *"medium-pressure treatment section"* is formed by units 6, 11 and 16 and only part of the urea solution is actually treated in steps 11 and 16 (i.e. part of the urea exits the plant through line 8), it is apparent that the medium-pressure section as a whole (i.e. 6, 11 and 16) is arranged to treat only part of the urea solution.

- In D10 the condenser 16 operates at a higher pressure than the condenser 11 but at a lower pressure than the urea synthesis reactor 1 (this is directly evident from the last 2 lines of page 5, which indicate that the carbamate solution exiting the absorber 16 is compressed to the reactor's pressure). Consequently, while condensers 11 and 16 operate at different pressures, these can be considered to fall within a range higher than that of the low pressure section (i.e. units 7 and 12) but lower than that of the urea synthesis reactor. The terms "high-pressure", "medium-pressure" and "low-pressure" in claim 9 at issue are not associated with any particular limitation beyond

the suitability of the plant to form sections operating under different pressure ranges (the terms "low", "medium" and "high" providing only a relative restriction for the ranges, wherein "high" > "medium" > "low"). Thus, condensers 11 and 16 can plausibly be regarded as part of the same "*medium-pressure treatment section*" in the sense of claim 9.

1.5 The board therefore concludes that the subject-matter of claim 9 is not novel at least in view of D10.

2. Auxiliary request 1 - Article 54 EPC

Since claim 9 of this request is identical to that of the main request the above arguments and conclusions apply equally to this request, which is therefore not considered to be allowable under Article 54 EPC.

3. Auxiliary request 2 - Admittance

The board has decided not to exercise its discretionary power under Article 12(4) RPBA 2007 not to admit auxiliary request 2 into the proceedings for the reasons indicated below. it is thus in the proceedings.

3.1 Auxiliary request 2 is substantially identical to auxiliary request 6 filed on 23 September 2016, i.e. within the time limit specified in the summons to oral proceedings under Rule 116 EPC (on page 12 of the decision the opposition division erroneously stated that this request was filed after the time limit for responding to its preliminary opinion).

In its summons the division had indicated that the claims as granted appeared to be novel in view of the cited prior art, but at the oral proceedings it changed

its preliminary opinion and concluded that apparatus claims 9, 14 and 15 as granted were not novel (page 7 of the decision). This implied that the main request as well as auxiliary requests 1-8 filed on 23 September 2016 were not novel either, because the independent apparatus claim in these requests was based either on claim 9 as granted or on a combination of claims 9, 14 and 15 as granted.

Despite this significant change in the subject of the proceedings, the division indicated that it would only admit the filing of one further auxiliary request (last paragraph of page 11 of the decision).

The patentee nevertheless filed four auxiliary requests, which substituted auxiliary requests 1-9 then on file. In particular, auxiliary request 2 corresponded to previous auxiliary request 6, wherein the apparatus claims had been deleted in order to overcome the novelty objection raised by the division.

The division then applied its discretionary power under Article 114(2) EPC and Rule 116 EPC not to admit the newly filed auxiliary requests 2-4 into the proceedings.

- 3.2 The respondents argued that auxiliary request 2 should not be admitted into the proceedings because auxiliary request 6, on which auxiliary request 2 is based, was withdrawn during oral proceedings and substituted by an auxiliary request 2 (filed during the oral proceedings), which was not admitted by the opposition division.

Furthermore, as indicated in T 140/12 (reasons, point 8), a request which was withdrawn during the first

instance proceedings should not be admitted upon re-submission in appeal proceedings under Article 12(4) RPBA, because this would preclude a decision of the opposition division on this request, and it would be inequitable for the opponents to suffer the consequences of actions over which they had no power.

Further, auxiliary request 2 at issue should not be admitted as an amended version of auxiliary request 2 filed and not admitted during the oral proceedings before the opposition division. Regardless of whether the division committed a substantial procedural violation or not, decision G 7/93 established that the boards of appeal should only overrule the exercise of discretion of the first instance if the wrong principles had been applied or if the discretion had been exercised in an unreasonable way. Since the patentee had not argued that either of these conditions applied in the present case, it would not be justified to overrule the free exercise of the division's discretion not to admit auxiliary request 2 into the proceedings.

- 3.3 The board does not follow the respondents' argumentation because auxiliary request 2 is based on auxiliary request 6 filed on 23 September 2016, and not on the auxiliary request 2 not admitted by the division, and so the question of admissibility does not involve overruling the division's decision, so the conditions set out in decision G 7/93 do not apply in the present case.

For the sake of completeness the board however notes that the division's decision not to admit this request was not based on applying the right principles in a reasonable way. In particular, Rule 116 EPC

(implementing the discretion under Article 114(2) EPC) indicates that a submission is considered late filed when it is presented after the time limit specified in the summons "unless ... the subject of the proceedings has changed". Since the change of opinion of the division on the question of novelty at the oral proceedings significantly affected the subject of the proceedings, and considering that auxiliary request 2 was a direct response to this change, the board considers, in line with decision T 688/16 (reasons, point 2), that it was not filed late and, consequently, that it is questionable whether the opposition division exercised its discretion under Article 114(2) EPC in a reasonable way.

While from a formal point of view, it would have been recommendable to maintain auxiliary request 6 as filed on 23 September 2016 in order to avoid issues of admissibility during the appeal proceedings, the board considers that the withdrawal or substitution of this request took place under exceptional circumstances which justify its resubmission. First, the withdrawal of auxiliary request 6 did not preclude any discussion on patentability, because the division had already announced that claims 9, 14 and 15 - on which claim 7 of that request was based - were not novel (page 7 of the decision). Second, the division's warning that only one further auxiliary request would be admitted arguably put pressure on the patentee to streamline the proceedings and to focus on requests which would overcome the outstanding objections. Thus, none of the circumstances mentioned in the above cited decision T 140/12 apply in the present case.

In view of these exceptional circumstances, the board considers that the withdrawal or substitution of

auxiliary request 6 by the patentee represented a *bona fide* attempt to overcome the outstanding issues and to have the new requests admitted into the proceedings. Even if this way of acting might be formally questionable, in practice it did not adversely affect the other parties to the proceedings, because maintaining the request would not have changed the substantial content of the decision. The reintroduction of the request is thus seen as a legitimate attempt to contest the division's conclusion that claims 9, 14 and 15 (corresponding to claim 7 of auxiliary request 2 at issue) were not novel in view of D10.

4. Sufficiency of disclosure

The board has concluded that the invention is sufficiently disclosed under Article 83 EPC.

- 4.1 The respondents argued that according to paragraph [0032] of the patent in suit, the off-gases from the melamine synthesis were discharged at a pressure of at least 2 bar. It was thus clear that when working within such low pressure ranges, the off-gases would have to be compressed before introducing them in the medium-pressure condensation unit. Conventional solutions like a compressor would lead to serious problems such as the corrosion of the equipment (see D10, page 2, 2nd paragraph). The only known solution for this problem was to pass the gas through a stripper and a condenser before increasing its pressure. However, if this solution was implemented, the resulting process would not include a step of introducing a gas to the medium-pressure condensation unit (as required in claim 1) but a step of introducing a liquid. The process of the invention could therefore not be carried out throughout its entire scope and was insufficiently disclosed.

4.2 The board is not convinced by this argumentation, because, as argued by the patentee, the invention defined in claim 1 specifies that the *"off-gases resulting as by-products of the melamine synthesis are discharged therefrom at a medium pressure and recycled to said high pressure urea synthesis section"*.

Consequently, the process of the invention is restricted to melamine off-gases discharged at a medium pressure, which implies that they do not need to be further compressed in order to introduce them into the medium-pressure condensation unit.

5. Auxiliary request 2 - Article 54 EPC

The board has concluded that this request complies with the requirements of Article 54 EPC.

5.1 In D10 (DE 2 053 358) the off-gases from the melamine synthesis section are connected to a first condenser 16 of the medium-pressure section whereas the low-pressure condenser is connected to a second condenser 11 of the medium-pressure section. By contrast, claims 1 and 7 define that both the off-gases from the melamine synthesis section and the solution from the low-pressure condenser are connected to one and the same medium-pressure condenser (i.e. condenser 18a in the single condenser configuration and the first condenser 18b in the double condenser configuration).

5.1.1 In the appealed decision it was argued (page 11, paragraphs 1-4) that the feature *"feeding a part of said aqueous solution"* (claim 1) encompassed high percentage values such as 99.95%, which could be rounded up to 100% because no margin of error had been defined. The subject-matter of claim 1 was therefore

anticipated by processes with no split, such as the one described in D10 (line 4), in particular considering that it was inevitable to have some losses, which would reduce the 100% feed to a somewhat lower value.

- 5.1.2 The board cannot agree with this argumentation, because while it is generally acceptable to take into account possible margins of error when comparing explicitly defined end-values to assess novelty, in the present case neither claim 1 nor D10 discloses a range or an end-value. Document D10 defines a process in which the only line flowing out of the urea synthesis reactor (4) directly feeds unit 6 (i.e. the medium-pressure section). Thus, it must be concluded that in this process all of the urea solution is fed to the medium-pressure section. The question of whether, in practice, this would represent a 100% or a slightly lower value (e.g. as a result of inevitable losses) appears to be speculative and should not lead to the conclusion that this document directly and unambiguously anticipates the feeding of only part of the solution produced in the urea synthesis reactor (the condition "directly and unambiguously" in the gold standard precisely intends to exclude features which require speculative interpretations). It is furthermore apparent that the restriction "*feeding a part (...)*" in claim 1 refers to "feeding only a part" (i.e. the plant includes a split and a valve which are clearly intended for this purpose), thus discarding the feeding of all the urea solution as described in D10. The board therefore concludes that D10 does also not anticipate the feature "*feeding a part of said aqueous solution*" in claim 1.

- 5.1.3 Consequently, claims 1 and 7 differ therefrom at least in the provision of connecting means between a medium-pressure condenser (the condenser 18a in the single

condenser configuration and the first condenser 18b in the double condenser configuration) and both the low-pressure condenser and the melamine off-gases. Claim 1 further differs from D10 in that only part of the urea solution is fed to the medium-pressure treatment section.

- 5.2 Document D1 (WO 2005/080321 A1)discloses (figure 1; page 5, lines 19-20 and 28-30) a plant and process for the production of melamine and urea with a recovery section 16 including a low-pressure recovery section and, optionally, a medium-pressure recovery section. It further discloses a condenser (17) connected to the off-gases (37) from a melamine synthesis section (13) and to a carbamate solution line (38) from the urea recovery section (it is not specified whether line 38 is connected to the low or medium pressure sections, and whether it starts from a condenser or from a dissociator).

Therefore, claims 1 and 7 differ from D1 at least in the provision of connecting means between a medium-pressure condenser (the condenser 18a in the single condenser configuration and the first condenser 18b in the double condenser configuration) and both the low-pressure condenser and the melamine off-gases. Claim 1 further differs in that only part of the urea solution is fed to the medium-pressure treatment section.

- 5.3 Document D5 (GB 1 266 363)discloses (figure) a plant and process for the production of melamine and urea comprising a medium-pressure section formed by absorbers/condensers 4 and 15 (from now on "condensers") and by decompressor/dissociator 2, and a low-pressure section formed by condensers 5 and 14 and dissociators 3 and 10. The low-pressure condenser 14 is

connected to a melamine off-gases line 13. In an alternative embodiment (page 3, lines 11-18) the condensers 4 and 15 are combined into a single condenser.

5.3.1 The respondents argued that the embodiment of page 3, lines 11-18 anticipated the configuration comprising a condensation unit with a single condenser in claim 7. While the melamine off-gases line 13 was connected to condenser 14, which was part of the low-pressure section, the gases were further directed via compressor 16 towards condenser 15, which was part of the medium-pressure section. Consequently, document D5 also disclosed connecting means between the melamine synthesis section 12 and the condensation unit of the medium-pressure section as defined in claim 7.

5.3.2 The board does not follow this argumentation because the off-gas from the melamine synthesis section is first introduced and absorbed in condenser 14. The off-gas which has not been absorbed is then compressed and introduced into the medium-pressure condenser 15. It is thus clear that there is no connecting means between the melamine synthesis section 12 and the medium-pressure condenser 15, but rather two different connecting means: line 13 carrying the off-gases from the melamine plant 12 to the low-pressure condenser 14, and the line connecting condensers 14 and 15 carrying gases which have not been absorbed in the low-pressure condenser 14.

Consequently, claims 1 and 7 differ from this document at least in the provision of connecting means between the melamine synthesis section and the condensation unit of the medium-pressure treatment section. Claim 1 further differs from D5 in that only part of the urea

solution is fed to the medium-pressure treatment section.

6. Substantial procedural violation (Article 113(1) EPC)

The board has concluded that the way in which the division decided not to admit auxiliary request 2 into the proceedings violated the patentee's right to be heard under Article 113(1) EPC.

6.1 The opposition division did not admit auxiliary request 2 filed by the patentee during oral proceedings (see chain of events in point 3.1 above). According to the minutes, the non-admission of this request took place as follows:

6.1.1 After concluding that document D10 anticipated claims 9, 14 and 15 as granted (page 2, last paragraph), "The Patentee was given the opportunity to file one Auxiliary Request" (page 3, 1st paragraph). The patentee then filed four auxiliary requests. "The Chairmen [sic] underlined that it was at the discretion of the Opposition Division (OD) to allow one further request at this stage of the procedure. In view of the deplorable letter delivery problem indicated by the Patentee at the beginning of the procedure and the related request to file a further Request, it appeared only fair to the Patentee to now allow one further Request" (page 3, 2nd paragraph). Opponent 3 "expressed his disagreement on allowing a further Request at this stage of the proceedings". Following this discussion, the division concluded that "only one Request is admitted into the procedure" (page 3, 4th paragraph).

6.1.2 The question of novelty of auxiliary request 1 was then discussed and the division concluded that the

requirements of Article 54 EPC were not met. At that point, the minutes indicate that "In view of the fact that it had been already indicated that only one Request would be admitted into the procedure" the division was in a position to announce a decision (page 4, 3rd paragraph).

6.1.3 In response to this announcement "The Patentee mentioned that if he had understood that only one of the Auxiliary Requests would be effectively admitted, then he would have chosen a different request, and felt penalized by the conduct of the OD on this matter. No further arguments were submitted" (page 4, 4th paragraph).

6.1.4 Finally, "The Chairman asked the other members of the OD if the oral proceedings should be interrupted. In view of the previous discussion on the admissibility of further requests, it was concluded that a decision could be taken. Accordingly the Chairman could announce the decision that the opposed European patent was revoked under Article 101(3)b EPC" (page 4, last paragraph).

6.1.5 Furthermore, according to the decision (section "admissibility of auxiliary requests 2-4" on page 11), the appellant "was informed before filing AR1-4 that only one more auxiliary request would be admitted into the proceedings" (emphasis added by the board).

6.2 In view of the above facts, the opposition division's decision not to admit auxiliary request 2 appears to be based on the following assumptions:

- the division's warning that only one further request would be admitted at that stage (prior to the filing of

the auxiliary requests) represented an objection to the admissibility of auxiliary requests 2-4;

- the discussion concerning the admissibility of further requests which led to the admittance of auxiliary request 1 implicitly encompassed a discussion on the admissibility of auxiliary requests 2-4; and

- the subsequent decision to admit "only one request" was equivalent to a decision not to admit auxiliary requests 2-4.

6.3 Opponent 3 further indicated that his argumentation on admissibility during oral proceedings (see page 3, third paragraph of the minutes) implicitly concerned all the auxiliary requests at issue and that, consequently, the admissibility of auxiliary requests 2-4 had been implicitly discussed. Opponent 3 also argued that, in practice, the patentee had had at least two opportunities to present its position concerning the admissibility of auxiliary requests 2-4: the first one during the discussion on admissibility, and the second one after the announcement that auxiliary request 1 was not novel but before the decision was announced.

6.4 The board disagrees with the above assumptions and argumentation because under Article 113(1) EPC a decision may only be based on grounds or evidence on which the parties concerned have had an opportunity to present their comments.

6.4.1 In the present case, the patentee was not given an opportunity to comment on the admissibility of auxiliary requests 2-4 since the discussion on admissibility only addressed the right to file further

requests at a late stage, with no reference being made to the specific requests, let alone to their content.

- 6.4.2 Even if opponent 3 intended to target all the requests with its argumentation, it is clear that it did so within the broad context of the right to file further requests. In this discussion, the division clearly indicated that, in view of the circumstances, it was fair to admit one further request (page 3, 2nd paragraph of the minutes), which conveyed the idea that the discussion concerned the admissibility of the first auxiliary request on the basis of the general right to file further requests at that stage. There was however no specific argumentation either from the division or from the opponents as to why auxiliary requests 2-4 should not be admitted, such as a reference to their *prima facie* relevance, to their contents or at least an indication of why the filing of four requests would be considered to be excessive in view of the circumstances. In other words, while it could have been argued that a discussion concluding that no further request could be admitted at that stage would have necessarily concerned all the newly filed auxiliary requests, the discussion on the right to file further requests, and the subsequent conclusion that the first auxiliary request had to be admitted, essentially implied that the patentee had the right to file at least one request, which left the question of admittance of the further requests entirely open. The final conclusion that only one request was admitted lacked any prior substantiation or discussion, because no reason had been presented as to why the patentee had the right to file further requests in general and auxiliary request 1 in particular, but no right to file auxiliary requests 2-4.

- 6.4.3 There was also no real opportunity for the patentee to discuss the matter. As already indicated, the discussion on admissibility only concerned the general right to file further requests, and the division explicitly argued in favour of the patentee's right to file one request in view of the circumstances. Since there were no specific objection concerning auxiliary requests 2-4, there was also no reason at that point to present arguments explicitly addressing the admissibility of these auxiliary requests. The patentee could also not be expected to request a reopening of the debate on the admissibility of auxiliary request 2 after the announcement that only one request was admitted, because it was apparent that the division had already decided on this matter and was convinced that a corresponding discussion had taken place. Consequently, at that stage, reopening the debate would only have made sense if the division itself had realised that the issue had not been properly discussed.
- 6.4.4 The final objection by the patentee indicating that he had not understood that only one request would be admitted appears therefore to be justified and to reinforce the idea that no corresponding discussion had taken place. At that point, the division should have granted the appellant the opportunity to comment on the admittance of auxiliary requests 2-4. In this respect, the reference in the minutes to "no further arguments were submitted" (second to last paragraph of page 4 in the minutes) cannot be seen as an indication that a discussion took place concerning admittance of auxiliary requests 2-4, because, as indicated above, at that point it was clear that the decision had already been taken.

6.4.5 The fact that no specific discussion was conducted addressing the admissibility of auxiliary requests 2-4 is further supported by the following statements from the opponents/respondents in their replies to appeal (emphasis added by the board):

- "Clearly, none of the Opponents commented the number of auxiliary requests, because the matter was not discussed. Discussion concerned only the admissibility of the First Auxiliary Request" (point 6. on page 17 of the reply to appeal of opponent/respondent 1);

- "As a matter of fact and as indicated by the same Patent Proprietor, object of discussion was the admissibility of the First Auxiliary Request and thus the relevant arguments to request not to admit the First Auxiliary Request were presented by the opponents. If the OD had disregarded its own clear indication that only one Auxiliary Request could have been filed during the Oral Proceeding and a discussion about the admissibility of the further requests was opened, we were ready to make very clear that the filing of the further three auxiliary requests was not admissible in view of the same clear indications of the OD during the Oral Proceedings." (page 43, last paragraphs of reply to appeal of opponent/respondent 2).

6.4.6 All in all, since the question of admittance of auxiliary requests 2-4 was not discussed, it is concluded that the opposition division violated the patentee's right to be heard under Article 113(1) EPC when it announced that "only one Request is admitted into the proceedings".

6.4.7 In fact, since the division warned the patentee that only one further request would be admitted before the auxiliary requests were even filed (section "admissibility of auxiliary requests 2-4" on page 11 of the decision), it can also be concluded (particularly in view of the subsequent events) that the decision was made even earlier (i.e. not only before the discussion took place but before there was any request to be decided upon), which represents in its own right a violation of the patentee's right to be heard.

6.4.8 In this respect, it is noted that while an opposition division has the discretion not to admit late-filed requests, there is no discretion, regardless of how late a request is filed, to deny the patentee's right to discuss the admittance of a request (cf. T 763/15).

7. Remittal of the case

The board has decided to remit the case to the opposition division for further prosecution under Article 111(1) EPC.

7.1 The respondents argued that remitting the case would unnecessarily delay the proceedings and that, since the issue of admittance of auxiliary request 2 had already been decided upon by the board, there was no special reason under Article 11 RPBA-2020 to justify the remittal.

7.2 The board does not follow this argumentation because the non-admittance of auxiliary request 2 did not only concern the question of admissibility as such, but also precluded a discussion on inventive step. Thus, the consequences of the substantial procedural violation went beyond the mere question of admissibility,

essentially depriving the parties and the board from a basis to address a discussion on the question of inventive step (i.e. selection of the closest prior art, problem solved by the invention, etc). In the board's opinion, this deficiency amounts to a special reason under Article 11 RPBA 2020 and therefore justifies the remittal to the first instance.

Furthermore the board considers that in the present case, the patentee's request to have the question of inventive step examined at two different levels of jurisdiction takes precedence over the procedural economy, because the patentee was deprived from a first instance decision on this matter as a result of the substantial procedural violation.

- 7.3 For the sake of completeness, the board also notes that the concept of "special reasons" in Article 11 RPBA 2020 should not be narrowly interpreted in a way which unduly restricts the discretion of the board to remit a case to the first instance enshrined in Article 111(1) EPC, as this would be contrary to the spirit of the convention, which, in case of conflict, takes precedence (see Article 23 RPBA 2020).

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.
3. The appeal fee will be reimbursed.

The Registrar:

The Chairman:



A. Pinna

J.-M. Schwaller

Decision electronically authenticated