

Internal distribution code:

- (A) [-] Publication in OJ
- (B) [-] To Chairmen and Members
- (C) [-] To Chairmen
- (D) [X] No distribution

**Datasheet for the decision
of 27 October 2022**

Case Number: T 0470/21 - 3.3.05

Application Number: 06772283.5

Publication Number: 1901842

IPC: B01J21/04, B01J21/12,
B01J35/10, B01J37/00

Language of the proceedings: EN

Title of invention:

A CATALYST CARRIER

Patent Proprietor:

Saint-Gobain Ceramics & Plastics, Inc.

Opponent:

Scientific Design Company, Inc

Headword:

Catalyst Carrier/Saint Gobain

Relevant legal provisions:

EPC Art. 113(1), 100(c), 123(2)
RPBA 2020 Art. 12(4)

Keyword:

Right to be heard - violation (no)

Grounds for opposition - added subject-matter (yes)

Amendment to case - amendment overcomes objection (no)

Decisions cited:

T 1226/12, T 0916/15, T 1127/16, T 1791/16

Catchword:



Beschwerdekammern

Boards of Appeal

Chambres de recours

Boards of Appeal of the
European Patent Office
Richard-Reitzner-Allee 8
85540 Haar
GERMANY
Tel. +49 (0)89 2399-0
Fax +49 (0)89 2399-4465

Case Number: T 0470/21 - 3.3.05

D E C I S I O N
of Technical Board of Appeal 3.3.05
of 27 October 2022

Appellant: Saint-Gobain Ceramics & Plastics, Inc.
(Patent Proprietor) Intellectual Property Law Department
One New Bond Street
P.O. Box 15138
Worcester, MA 01615-0138 (US)

Representative: Schmitt-Nilson Schraud Waibel Wohlfrom
Patentanwälte Partnerschaft mbB
Pelkovenstraße 143
80992 München (DE)

Respondent: Scientific Design Company, Inc
(Opponent) 49 Industrial Avenue
Little Ferry NJ 07643-1922 (US)

Representative: Hoefler & Partner Patentanwälte mbB
Pilgersheimer Straße 20
81543 München (DE)

Decision under appeal: **Decision of the Opposition Division of the
European Patent Office posted on 1 March 2021
revoking European patent No. 1901842 pursuant to
Article 101(3) (b) EPC.**

Composition of the Board:

Chairwoman O. Loizou
Members: G. Glod
J. Roider

Summary of Facts and Submissions

- I. The patent proprietor's (appellant's) appeal lies from the opposition division's decision to revoke European patent No. 1 901 842 B1.

Claim 1 of the patent as granted reads as follows:

"1. A carrier comprising at least 95 weight percent alpha-alumina and a bond material, said carrier comprising a surface area of at least 1 m²/g, and a total pore volume and a pore size distribution wherein at least 80 % of the total pore volume is contained in pores with diameters in the range of from 0.1 to 10 μm, and at least 80 % of the pore volume contained in the pores with diameters in the range of from 0.1 to 10 μm is contained in pores with diameters in the range of from 0.3 to 10 μm, wherein said bond material comprises alkaline earth metal silicate in the range of from 0.2 to 10 weight percent, calculated as the total weight of alkaline earth metal oxide and silicate, as SiO₂, relative to the total weight of alpha-alumina in the mixture, wherein surface area is determined by the nitrogen BET method, and wherein the pore size distribution and pore volume is determined by mercury intrusion porosimetry to a pressure of 2.1 x 10⁸ Pa using 130° contact angle, mercury with a surface tension of 0.480 N/m, and correction for mercury compression applied."

- II. In a communication under Article 15(1) of the RPBA, the board was of the preliminary opinion that Article 100(c) EPC appeared to prejudice the maintenance of the

patent as granted and that the appeal was likely to be dismissed.

III. The appellant's arguments, insofar as they are relevant to the present decision, can be summarised as follows.

The skilled person would not have inferred that the term "the mixture" in claim 1 related to the composition of the carrier as a whole in a finished state after firing. The term "mixture" was normally used to designate a material made up of two or more different substances which were not chemically combined and retained their identities. This was not the case in a sintered carrier. After firing the green body, chemical bonds were formed and the alkaline earth metal silicate was no longer present as such. A combination of two or more substances that are chemically bonded was called a "compound".

Since the term "mixture" was not defined in claim 1, it had to be interpreted in the light of the description. Therefore, it was clear that the mixture referred to the mixture of starting materials of the carrier before sintering.

The auxiliary requests were filed in response to the surprising decision. The opposition division misunderstood a core aspect of the technology in the opposed patent and did not even indicate to the parties that, in its view, the case was ready to be decided without giving a preliminary opinion or conducting oral proceedings. The appellant did not know about the opposition division's misunderstanding beforehand and could only respond with the appeal. Therefore, the reasoning of T 1226/12 applied in the present case and

the auxiliary requests should be admitted into the appeal proceedings.

- IV. The respondent's (opponent's) arguments are reflected in the Reasons below.
- V. At the end of the oral proceedings of 27 October 2022, the parties' requests were as follows.

The appellant (patent proprietor) requested that the decision under appeal be set aside and that the case be remitted to the opposition division to decide on the outstanding issues, in particular inventive step in view of E5 and E6, or, auxiliary, that the opposition be rejected (main request). Further auxiliary, it requested that the patent be maintained in amended form on the basis of one of auxiliary requests 1 to 3, submitted with the statement setting out the grounds of appeal.

Procedurally it requested that the auxiliary requests, the new test results, the evidence for the common general knowledge, new arguments and Mr Howard's declaration be admitted.

The respondent (opponent) requested that the appeal be dismissed.

Procedurally it requested that the auxiliary requests, the new test results, the evidence for the common general knowledge, new arguments and Mr Howard's declaration not be admitted.

Reasons for the Decision

1. Article 113(1) EPC

The board does not find that the opposition division conducted the proceedings in a surprising or even procedurally incorrect way to the detriment of the appellant, as alleged.

It is accepted practice that the opposition division may decide the case after the patent proprietor has been given the chance to comment on the opposition with due consideration of the requirements of Articles 113(1) and 116 EPC (see also Guidelines for Examination in the EPO, November 2019, D-VI, 7.1 and E-X, 2).

Not issuing at least one communication under Article 101(1) EPC cannot in itself substantiate an allegation of infringement of the right to be heard under Article 113 EPC (Case Law of the Boards of Appeal of the EPO, 10th edition, 2022, IV.C.6.2).

The discretionary character when deciding on such a course of action, when no request for oral proceedings has been made, undoubtably does not set an obligation on the opposition division to hold oral proceedings. This is also acknowledged by the appellant (see page 5 of the grounds of appeal).

In the current case the decision is based on the grounds of opposition substantiated in the notice of opposition. In particular, point 4 on page 8 forms the basis for the decision on Article 100(c) EPC and points 1.5.1 (pages 9 to 14), 1.5.2 (page 15) and 1.5.5 (pages 19 to 20) form the basis for the decision on Article 100(a) EPC in combination with Article 56 EPC. The arguments put forward by the patent proprietor in its

reply to the opposition of 13 October 2020 were duly considered in the impugned decision (see in particular page 4, second paragraph onwards and point 2.1.2).

If one ground of opposition prejudices the maintenance of the patent, the remaining issues do not need to be assessed.

Therefore, the opposition division's decision cannot be considered surprising to the appellant. It is in the nature of any contentious proceedings that one party considers the other party's submissions to be incorrect. It is, however, to be expected that the opposition division might not be convinced by one party's arguments and therefore might follow the other party's arguments and reasoning and will ultimately base its decision on them.

The opponent's submissions filed on 18 January 2021 did not contain any new fundamental arguments that were used in the impugned decision, and therefore the final decision could not be unexpected for the appellant. Therefore, the question of whether the opposition division was allowed to issue the decision only one month after notification of said letter of 18 January 2021 is irrelevant in the case at hand.

Main request (patent as granted)

2. Article 100(c) EPC

2.1 Construction of claim 1

Claim 1 is a **product** claim and relates to a carrier that comprises at least 95 weight percent alpha-alumina and a bond material. This wording implies that alpha-

alumina and a bond material are part of the carrier. The carrier is specified by the surface area, the total pore volume and the pore size distribution. The amount of bond material is given relative to the total weight of alpha-alumina in the mixture. In addition, the methods for determining the surface area, the pore size distribution and pore volume are indicated. The skilled person reading the claim would realise that "the mixture" has no antecedent and that a mixture in the commonly used scientific sense is not directly recognisable in claim 1.

Claim 1 is not a product-by-process claim, does not contain any process steps, let alone process (firing) conditions, and it does not specify the shape of the carrier. To argue that the bond material is no longer present in the carrier is depriving the claim of its meaning and is reading process features into the claim that are simply not present. Therefore, the skilled person interpreting the whole claim on its own would understand that, in the specific context of the claim, the mixture relates to the combination of alpha-alumina and the bond material in the carrier. Such understanding of the skilled person is not unreasonable, since the appellant also calculates the bond material based on the total weight of alumina in the fired carrier in its grounds of appeal (pages 38, 39 and 40).

Consequently, this claim interpretation is considered to be a reasonable one and is to be taken into consideration for the assessment of Article 123(2) EPC (see T 1791/16; point 11 of the Reasons). Article 69(1) EPC may be used to interpret the scope of protection under Article 123(3) EPC, but it is not used to

determine whether the requirements of Article 123(2) EPC are met (see T 916/15, point 1.3.1 of the Reasons).

The board's understanding is also completely in line with T 1127/16 (points 2.6.1 and 2.6.2 of the Reasons), according to which a claim should essentially be read and interpreted on its own merits, even if the claim possibly includes inconsistencies.

The appellant's argument that the skilled person would immediately turn to the description to make sense of the wording "the mixture" puts too much emphasis on that wording in the light of the claim as a whole and is not in line with the fact that a technically skilled reader does not normally need any further description-based guidance.

2.2 Original disclosure

The basis for the weight indication of the alkaline earth metal silicate is found on page 14, lines 1 to 6 of the application as filed; however, it is undisputed that this indicated weight relates to the mixture prior to firing and that the composition prior to firing is not necessarily the same as at the end of the process (see also the last full paragraph on page 4 of the impugned decision). Consequently, the weight indicated in claim 1 as granted is not the same as that originally present in the application as filed.

2.3 Therefore, Article 100(c) EPC prejudices the maintenance of the patent as granted.

Auxiliary requests 1 to 3

3. Article 12(4) RPBA 2020

According to Article 12(4) RPBA 2020 any amendment to the case may be admitted only at the discretion of the board. The board shall exercise its discretion in view of, *inter alia*, the complexity of the amendment, the suitability of the amendment for addressing the issues which led to the decision under appeal, and the need for procedural economy.

Auxiliary requests 1 to 3 were first submitted in appeal proceedings and are undisputedly an amendment within the meaning of Article 12(4) RPBA 2020. They were submitted in response to the impugned decision to anticipate the further course of opposition proceedings in case the board remitted the case to the opposition division. They are intended to address a possible inventive-step discussion based on different closest prior-art documents to the one used in the impugned decision; however, they are not suitable for addressing the issue under Article 123(2) EPC, which led to the decision under appeal. Therefore, the board does not admit auxiliary requests 1 to 3 into the proceedings.

T 1226/12 is irrelevant in the current case, since in that case requests 2, 3, 5, 6, 11, 12 and 14 admitted into the proceedings were considered a direct and suitable response to the critical issue of novelty underlying that case. It should also be noted that, in T 1226/12, Article 12(4) RPBA 2020 did not yet apply.

Order

For these reasons it is decided that:

The appeal is dismissed.

The Registrar:

The Chairwoman:



C. Vodz

O. Loizou

Decision electronically authenticated