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Aktenzeichen / Case Number / N^o du recours : T 42/84

Anmeldenummer / Filing No / N^o de la demande : 80 304 734.9

Veröffentlichungs-Nr. / Publication No / N^o de la publication : 33 424

Bezeichnung der Erfindung: Removal of sulphur and/or sulphur compound from
Title of invention: process streams using metal alumina spinel
Titre de l'invention :

Klassifikation / Classification / Classement : B01D53/34

ENTSCHEIDUNG / DECISION

vom / of / du 23 March 1987

Anmelder / Applicant / Demandeur : Exxon Research and Engineering Company

Patentinhaber / Proprietor of the patent /
Titulaire du brevet :

Einsprechender / Opponent / Opposant :

Stichwort / Headword / Référence :

EPO/EPC/CBE Articles 111(1), 123(2) and Rule 67 EPC

Kennwort / Keyword / Mot clé : "Remittal for further prosecution" - "Added
subject-matter" (no) - "Reimbursement of Appeal Fee" (no).

Leitsatz / Headnote / Sommaire

The Guidelines not having the binding authority of a legal text, a failure by the Examining Division to follow them is not to be regarded as a procedural violation within the meaning of Rule 67 of the EPC unless it also constitutes a violation of a rule or principle of procedure governed by an article of the EPC or one of the Implementing Regulations.



Case Number : T 42/84

D E C I S I O N
of the Technical Board of Appeal 3.4.1
of 23 March 1987

Appellant : Exxon Research and Engineering Company
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Decision under appeal : Decision of Examining Division 031
of the European Patent Office
dated 11.10.1983 refusing European
patent application No. 80 304 734.9
pursuant to Article 97(1) EPC

Composition of the Board :

Chairman : K. Lederer
Member : J. Roscoe
Member : P. Ford

Summary of Facts and Submissions

- I. European patent application No. 80 304 734.9 filed on 29 December 1980 was published under No. 33424.
- II. In a first communication the Examining Division raised objection that certain of the alternative processes explicitly claimed in the originally filed Claim 1 were lacking in novelty and the remainder in inventive step, having regard to DE-A-2 119 897 and US-A-4 147 763.
- III. In response to this objection the applicant filed a new set of Claims 1 to 13 to replace the original set together with amended pages of description.
- IV. In a second communication the Examining Division reported *inter alia* that the new Claims 2, 4 and 6 contained new subject-matter and were therefore objectionable under Article 123(2) EPC.
- V. In a response to this communication the applicant contested the objection, and, maintained the wording of Claims 4 to 13 unaltered but filed new Claims 1 to 3. The Examiner was requested to telephone the applicant's representative should there be any further matters requiring attention.
- VI. There was however no further communication between the Examiner and applicant's representative prior to the issue on 11 October 1983 of the decision of the Examining Division to refuse the application. This decision was based on Claims 1 to 3 filed on 11 May 1983 and Claims 4 to 13 filed on 15 September 1982. The ground for refusal was that Claims 4 and 6 involved new subject-matter so that the provisions of Article 123(2) EPC were contravened.

VII. An appeal against the decision was lodged by the applicant on 26 November 1983 and a Statement of Grounds filed on 28 January 1984. The appeal fee was duly paid.

VIII. Following an exchange of correspondence the appellant now requests that the contested decision be set aside and that a patent be granted on the basis of:

(1) Main request:

(a) Claims 1 to 7 filed 25 April 1985 and Claims 8 to 13 filed on 15 September 1982;

(b) description pages 1 to 3 and 11 as originally filed, pages 4 and 4A filed on 25 April 1985, page 5 filed on 11 May 1983, and pages 6 to 10 filed on 15 September 1982.

(2) Auxiliary request:

(a) Claims 1 to 7 filed 6 October 1984, marked F, and Claims 8 to 13 filed on 15 September 1982;

(b) description as in main request.

Reimbursement of the appeal fee in accordance with Rule 67 EPC is also requested.

The relevant claims of the main request read as follows:

1. A process for removing sulfur and/or sulfur compound from a process stream containing sulfur and/or sulfur compound wherein the process stream is passed in contact with a sorbent substance which adsorbs sulfur and/or sulfur compound from the process stream thereby reducing its

sulfur and/or sulfur compound content, characterized in that the sorbent substance is a metal alumina spinel of formula MA_2O_4 wherein M is selected from chromium, iron, cobalt, nickel, copper, cadmium, mercury and zinc.

2. A process as in Claim 1 in which the process stream contains hydrogen and moisture.
3. A process as in Claim 1 or Claim 2 in which the sulfur compound is hydrogen sulfide.
4. A process as in Claim 3 in which the hydrogen sulfide is contained in a process stream of hydrogen-containing recycle gas obtained from the last reactor or a series of on-stream reactors of a hydrocarbon reforming unit provided with beds of sulfur-sensitive platinum-containing catalyst.
5. A process as in Claim 1 or Claim 2 in which the process stream is a sulfur-containing hydrocarbon feedstock.
6. A process as in Claim 5 in which the hydrocarbon feedstock, following contact with the said substance to remove sulfur therefrom, is passed to the first reactor of a series of on-stream reactors of a hydrocarbon reforming unit provided with beds of a sulfur-sensitive platinum-containing catalyst.

Reasons for the Decision

1. The appeal complies with Articles 106 to 108 and Rule 64 EPC and is, therefore, admissible.
2. The wording of Claims 4 and 6 of the main request is, except for the deletion of the words "with hydrogen" from Claim 6, identical to that of the like-numbered claims

which in the opinion of the Examining Division contained new subject-matter, and the claims to which Claims 4 and 6 are appendant, though somewhat differently formulated, correspond in substance to the correspondingly numbered claims effective at the time of the appealed decision.

3. Having regard to the terms of Article 123(2) EPC it is necessary to consider the content of the application as originally filed. In the present case, the original description opens with a statement that the invention relates to removal of sulphur and/or sulphur compound from process streams using metal alumina spinel. It then proceeds to discuss the problems caused by the presence of sulphur in process streams and specifically refers to a typical catalytic naphtha (i.e. hydrocarbon) reforming process using a series of reactors with fixed beds of catalyst. When using multi-metallic platinum catalysts it is said to be necessary to reduce the sulphur level, not only in the feed but also in the hydrogen recycle stream, to avoid contamination of the catalyst and that zinc oxide has been used as sorbent for this purpose. The shortcomings of zinc oxide and prior art attempts to improve its quality as a sorbent are then discussed. Immediately following this discussion is a statement that the primary object of the invention is to fill the need for further improving the processes referred to, and subsequently the objects are said to be achieved by a process which is in substance that claimed in the present Claim 1.
4. These passages represent, in the opinion of the Board, a clear instruction to apply the process of Claim 1 to recycle gas from the last stage of a reforming unit provided with beds of platinum containing catalyst and to the feedstock for such a unit.

Therefore neither Claim 4 nor Claim 6 of the main request can fairly be regarded as containing new subject-matter and the decision under appeal must be set aside.

5. The question of whether the feature "held by said metal alumina", which in the opinion of the Examining Division rendered Claim 1 open to objection under Article 123(2) EPC, does in fact do so need not be considered here since this feature is absent from the claims of the main request.
6. It remains to be determined whether the application satisfies the other requirements of the EPC.

As regards the requirements of Article 52(1) EPC the Examining Division appears not to have reached a final conclusion. In its last communication to the applicant before the decision, although maintaining its earlier objection to Claim 1 based on an alleged lack of novelty and inventive step, it made two proposals for amendment which would presumably have met its objection. However, in the new Claim 1 submitted with the applicant's reply, and in Claim 1 of the main request, only the first of the two proposals has been adopted.

In the decision, evidently in connection with the second of the proposals, it is simply stated that "the desorption should be inserted into Claim 1". Neither in the decision nor in the earlier communication is it explained why this amendment is required.

In these circumstances and since the appealed decision is founded exclusively on an objection under Article 123(2) EPC, the Board considers it appropriate to make use of the powers conferred on it by Article 111 EPC to remit the

case to the first instance for further prosecution.

7. It is therefore unnecessary for the Board to consider the claims of the auxiliary request.
8. Regarding the request for reimbursement of the appeal fee, it is observed that according to Rule 67 EPC it is a prerequisite for reimbursement not only that the Board renders a decision in the appellant's favour, but also that such reimbursement is equitable by reason of a substantial procedural violation.
9. The Guidelines, as stated in the General Introduction to them, do not have the binding authority of a legal text. Therefore a failure by the Examining Division to follow them is not to be regarded as a procedural violation within the meaning of Rule 67 unless it also constitutes a violation of a rule or principle of procedure governed by an article of the EPC or one of the Implementing Regulations.
10. It has therefore to be decided in the present case whether the action of the Examiner in disregarding the request made by the applicant's representative in the letter dated 3 May 1983 that he be informed by telephone if there should be any further matters which might require attention, and in failing to communicate with the representative in any other way prior to issue of the decision to refuse was indeed such a violation.
11. The Board is satisfied that the decision is based solely on grounds which were communicated to the applicant in the communication dated 25 January 1983 and therefore on which the applicant had an opportunity to present, and did in fact present, his comments. It also finds that the request in the letter of 5 May 1983 cannot be considered to be a

request for oral proceedings made under the provisions of Article 116 EPC. Therefore there was no failure to meet the requirements of Articles 113(1) and 116 EPC.

12. The only other Article of the EPC relating to the examination of the European patent application relevant to the conduct of the Examining Division is Article 96(2), which requires the Examining Division to invite the applicant, in accordance with the Implementing Regulations and as often as necessary to file his observations within a period to be fixed by the Examining Division.

In the present case the Division twice communicated with the applicant and invited him to file observations, though the objection on which the refusal was based was, and could only have been, raised in the second communication, since it arose from a voluntary amendment made after issue of the first communication. In the Board's view the issue of a further invitation to file observations was not necessary since both the Division and the applicant had already expressed their opinions on the point at issue, which remained the same. There has therefore also been no violation of Article 96(2) of the EPC.

13. The alleged failure of the Office to enclose the text of Articles 106 to 108 EPC with the decision neither invalidates the decision nor does it constitute a serious procedural violation. It is clearly stated in Rule 68 that the parties may not invoke the omission of the written communication of the possibility of appeal which has also to draw the attention of the parties to the provisions laid down in Articles 106 to 108, the text of which should be attached, and this must in the Board's view be read as applying also to omission of the text of the articles alone.

14. For the above reasons reimbursement of the appeal fee cannot be allowed.

Order

For these reasons it is decided that

1. The decision under appeal is set aside.
2. The case is remitted to the Examining Division for further substantive examination on the basis of the following documents:
 - (a) Claims 1 to 7 filed on 25 April 1985, and Claims 8 to 13 filed on 15 September 1982;
 - (b) description pages 1 to 3 and 11 as originally filed, pages 4 and 4A filed on 11 May 1983, and pages 6 to 10 filed on 15 September 1982.
3. The request for reimbursement of the appeal fee is refused.

The Registrar:

J. Ruckerl

The Chairman:

K. Lederer