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File Number: T 996/92 - 3.3.1
Application No.: 85 201 499.2
Publication No.: 0 176 150
Title of invention: Cracking catalyst, process for heavy oil

Classification: C10G 11/04

D E C I S I O N
of 23 March 1993

Proprietor of the patent: Catalyst & Chemicals Industries Co., Ltd.
Opponent: Akzo N.V.

Headword: Cracking catalyst/CATALYST & CHEMICALS

EPC Article 102(3); Rule 67

Keyword: "Maintenance of patent in amended form - incomplete agreement
between claim and description"
"Substantial procedural violation:(yes)"



Case Number : T 996/92 - 3.3.1

D E C I S I O N
of the Technical Board of Appeal 3.3.1
of 23 March 1993

Appellant :
(Opponent)

Akzo N.V.
Velperweg 76
P.O. Box 9300
6800 SB Arnhem (NL)

Representative :

Respondent :
(Proprietor of the patent)

Catalysts & Chemicals Industries Co., Ltd.
No. 6-2 Ohtemachi 2-chome
Chiyoda-ku
Tokyo (JP)

Representative :

van der Beek, George Frans et al
Nederlandsch Octrooibureau
Scheveningsweg 82
P.O. Box 29720
2502 LS 's-Gravenhage (NL)

Decision under appeal :

Interlocutory Decision of the Opposition Division
of the European Patent Office dated 4 September
1992 concerning maintenance of European patent
No. 0 176 150 in amended form.

Composition of the Board :

Chairman : K.J.A. Jahn
Members, : R.W. Andrews
 : J.A. Stephens-Ofner

Summary of Facts and Submissions

- I. European patent No. 0 176 150 in respect of European patent application No. 85 201 499.2, which was filed on 18 September 1985, was granted on 31 May 1989 (cf. Bulletin 89/22).
- II. A notice of opposition, which was filed on 22 February 1990, requested the revocation of the patent on the grounds that its subject-matter lacked novelty and did not involve an inventive step.
- III. In a telecopy received on 8 October 1991, the Opponent agreed in principle to the maintenance of the patent in suit on the basis of Claim 2 filed on 6 August 1990.

In a letter filed on 27 March 1992, the Opponent pointed out that none of the Examples illustrated the invention as claimed in the amended claim filed on 14 February 1992. In a further letter filed on 13 July 1992, the Opponent maintained that original Example 3 (renumbered Example 1 in the amended description filed on 18 May 1992) did not fall within the scope of the above-mentioned amended claim.

- IV. By an interlocutory decision issued on 4 September 1992, the Opposition Division maintained the patent in amended form on the basis of the claim and pages 2 to 11 filed on 18 May 1992 (amendments having been made to pages 2 and 3 by the Opposition Division).
- V. An appeal was lodged against this decision on 28 October 1992 with payment of the prescribed fee. In his statement of grounds filed on the same date, the Appellant contended that Example 1 was not covered by the present claim of the disputed patent and requested that either this Example be headed "Comparative Example 4" or that the present

Comparative Examples 1 to 3 and Example 1 should be deleted.

The Appellant also requested the reimbursement of the appeal fee since he considered that the failure of the Opposition Division to take notice of his letters filed on 27 March 1992 and 13 July 1992 represented a substantial procedural violation.

- VI. In a letter filed on 23 December 1992, the Respondent (Patentee) declared his willingness to amend "Example 1" to read "Comparative Example 4".

Reasons for the Decision

1. The appeal is admissible since the fact that the description has not brought into complete agreement with the present claim could lead to legal uncertainty as to its actual scope (cf. the unpublished decisions of this Board T 273/90 of 10 June 1991 and T 113/92 of 17 December 1992, in particular paragraph 2).
2. The requested amendment is clearly allowable under Article 123 EPC. Since this is not in dispute, no further comments are necessary.
3. According to Rule 67 EPC the reimbursement of the appeal fee can only be ordered if the appeal is allowable and if such reimbursement is equitable by reason of a substantial procedural violation.

The Opposition Division did not take any action with respect to the Opponent's letters filed on 27 March 1992 and 13 July 1992 in which he pointed out that none of the examples illustrated the invention as claimed in the amended claim filed on 14 February 1992 and re-filed on 18 May 1992.

Furthermore, the Opposition Division issued its interlocutory decision on 4 September 1992 without giving any reasons why the patent could be maintained on the basis of the documents submitted on 18 May 1992 despite the Opponent's clear objection to Example 1.

This failure to respond to the Opponent's objection represents a substantial procedural violation justifying the reimbursement of the appeal fee.

Order

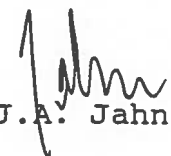
For these reasons, it is decided that:

1. The decision under appeal is set aside.
2. The case is remitted to the Opposition Division with the order to maintain the patent on the basis of the documents according to the interlocutory decision of 4 September 1992, apart from the amendment of "Example 1" on page 8 to read "Comparative Example 4".
3. Reimbursement of the appeal fee is ordered.

The Registrar:


E. Görgmäler

The Chairman:


K.J.A. Jahn

