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**D E C I S I O N**  
**of 5 July 1995**

**Case Number:** T 1066/92 - 3.3.2

**Application Number:** 82200382.8

**Publication Number:** 0067459

**IPC:** C01B 33/16

**Language of the proceedings:** EN

**Title of invention:**  
Silica particles and method for their preparation

**Patentee:**  
SHELL INTERNATIONALE RESEARCH MAATSCHAPPIJ B.V.

**Opponent:**  
EKA Nobel Aktiebolag

**Headword:**  
Silica particles/SHELL

**Relevant legal provisions:**  
EPC Art. 100, 114(1)  
EPC R. 55(c)

**Keyword:**  
"Extension of opposition (not allowed)"  
"New grounds for opposition (remittal)"

**Decisions cited:**  
G 0009/91

**Catchword:**  
-



Case Number: T 1066/92 - 3.3.2

**D E C I S I O N**  
of the Technical Board of Appeal 3.3.2  
of 5 July 1995

**Appellant:**  
(Proprietor of the patent) SHELL INTERNATIONALE RESEARCH  
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**Respondent:**  
(Opponent) EKA Nobel Aktiebolag  
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**Representative:**  
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**Decision under appeal:** Interlocutory decision of the Opposition Division  
of the European Patent Office dated 28 September  
1992 concerning maintenance of European patent  
No. 0 067 459 in amended form.

**Composition of the Board:**

**Chairman:** P. A. M. Lançon  
**Members:** G. J. Wassenaar  
R. L. J. Schulte

### Summary of Facts and Submissions

I. European patent No. 0 067 459 was granted in response to European patent application No. 82 200 382.8.

II. A Notice of Opposition was filed against granted Claims 3 to 5 by the Respondent (Opponent). Rejection of these claims was requested on the grounds of lack of novelty and lack of inventive step (Articles 52, 54, 56 and 100(a) EPC).

Two prior art documents were cited as evidence within the opposition period mentioned in Article 99(1) EPC. Later in the proceedings more evidence was filed including FR-A-1 475 929, referred to as document (5).

III. The Opposition Division maintained the patent in amended form on the basis of Claims 1 and 2 as granted. They considered that the products of Claims 3 to 5 lacked novelty over (5) and that Claims 6 to 10 lacked an inventive step in view of general technical knowledge in combination with (5).

IV. The Appellant (Patentee) lodged an appeal against this decision.

In the Statement of Grounds of Appeal, the Appellant refuted the novelty and inventive step arguments of the Opposition Division with respect to granted Claims 3 to 10. With respect to product Claims 3 to 5 it was argued that the data disclosed in (5) were insufficient to destroy the novelty of these claims. Attention was further drawn to the high resistance against attrition and high water resistance of the claimed products

compared with commercially available silicas. With respect to Claims 6 to 10 it was emphasized that they had not been the subject of the opposition.

A new set of Claims was presented as auxiliary request I containing Claims 3 to 9, whereby the subject-matter of granted Claim 5 had been incorporated into Claim 3.

In response to a request in the Board's communication of 3 November 1994, to file evidence with respect to the "Peter Spence method" an undated operation manual titled "ROTATING TUBE ATTRITION TEST (SPENCE METHOD)" was filed with Appellant's letter of 30 December 1994.

VI. The Respondent disagreed with Appellants submissions and maintained that document (5) fully discloses the product of Claims 3 to 5 as granted.

With respect to Claim 5 it was argued that the "Peter Spence method" is not conventional in the art and no reliable parameter to distinguish claimed subject-matter from prior art subject-matter.

For similar reasons a clarity objection under Article 84 EPC was raised against amended Claims 3 and 4 of auxiliary request I, which included the subject-matter of granted Claim 5.

An objection of unallowable extension under Article 123(3) EPC was raised against Claims 3 and 4 of the auxiliary request because the reference to the process of Claim 1 had been omitted.

In response to Appellant's new evidence with respect to the "Peter Spence method" an objection on the grounds of insufficiency according to Article 100(b) EPC was raised

against granted Claim 5 and Claims 3 and 4 of the auxiliary request because the loss of attrition could not be measured for the whole range of particles.

- V. During oral proceedings, which were held on 5 July 1995, the Appellant abandoned the main request and filed an amended set of claims based on the auxiliary request as the new and only request. The reference to the process of Claim 1 was reintroduced into Claim 3.

Product Claim 3 reads as follows:

"3. Silica particles, prepared by the process of Claim 1 characterised by having a pore size distribution wherein at least 70% of the pore volume is made up of pores having pore diameter which have a tolerance of not more than 10 nm on the mean pore diameter and at least 60% of the pore volume is made up of pores having pore diameters which have a tolerance of not more than 5 nm on the mean pore diameter when the mean pore diameter is not more than 30 nm (as determined by mercury porosimetry) and having a pore size distribution wherein at least 65% of the pore volume is made up of pores having pore diameters which have a tolerance of not more than 20 nm on the mean pore diameter and at least 55% of the pore volume is made up of pores having pore diameters which have a tolerance of not more than 10 nm on the mean pore diameter when the mean pore diameter is more than 30 nm (as determined by mercury porosimetry), and by having a loss on attrition of less than 0.1% w as determined by the standard attrition test according to the Peter Spence method."

- VI. The Appellant requested that the decision under appeal be set aside and that the patent be maintained on the basis of the Claims 1 and 2 as granted and Claims 3 to 9 as filed during oral proceedings.

The Respondent requested that the appeal be dismissed.

### **Reasons for the Decision**

1. The appeal is admissible.
2. *Extension of the opposition*

The Opponent declared in the Notice of Opposition that his opposition is filed against Claims 3, 4 and 5 of the patent in suit. Therefore, the opposition was directed only to granted Claims 3 to 5. Neither within the time limit for opposition nor even later in the proceedings before the Opposition Division there had been any specific request of the Opponent to extend the opposition to granted Claims 6 to 10. Under these circumstances, the Board, following the decision of the Enlarged Board of Appeal G 9/91 (OJ 7/1993, 408), considers that the Opposition Division had no power to extend the opposition to granted Claims 6 to 10 and therefore was not entitled to revoke these claims.

Before the Board, the Respondent expressed his opinion that Article 114(1) EPC gave the Opposition Division the power to extend the opposition, especially, if non-extension of the opposition would result in the maintenance of claims which are obviously not patentable. Apart from the fact that the Board does not consider the subject-matter of granted Claims 6 to 10 to be, prima facie, not patentable, the opinion of the Respondent is not supported by G 9/91. The decision of the Enlarged Board leaves no room for any extension of the opposition beyond the statement under Rule 55(c) EPC; see in particular paragraph 10 of said decision. This Board sees no reasons to deviate from the

conclusions laid down in G 9/91. Therefore, granted Claims 6 to 10 should have been maintained by the Opposition Division. The decision to revoke the non-opposed claims is therefore a decision ultra vires and has to be set aside insofar.

3. *Allowability of amended claims under Article 123 EPC*

Present Claim 3 is a combination of Claim 3 as granted with the feature of Claim 5 as granted. The feature of Claim 5 as granted, referring to the "standard attrition test according to the Peter Spence method", is regarded to be equivalent to the "standard attrition test as described hereinbefore" mentioned in Claim 11 as originally filed. Since said Claim 11 was a sub-claim dependent upon original Claim 9, which was equivalent to granted Claim 3, it is evident that the combination of granted Claims 3 and 5 is based on the application as originally filed.

Since the feature of granted Claim 5 further limits the scope of granted Claim 3, it is also evident that present Claim 3 does not extend the protection conferred. In fact no objection was raised under Article 123(3) EPC against present Claims 3 and 4. Thus present Claim 3 and its dependent Claim 4 satisfy the requirements of Article 123(2) and(3) EPC.

4. *New grounds under Article 100(b) EPC*

No opposition grounds under Article 100(b) EPC were put forward in the opposition procedure before the Opposition Division. An insufficiency objection against granted Claim 5 and Claims 3 and 4 of the auxiliary request then on file was raised by the Opponent only after the summons for oral proceedings before the Board. The objection equally applies to present Claims 3 and 4.

The Respondent argued that this objection was raised late because the objection became only apparent after the explanation of the "Peter Spence method" given by the Appellant in his petition of 30 December 1994.

Following the principles laid down in G 9/91 (paragraph 18) the Board cannot consider such a new ground without the consent of the Appellant. In the absence of such a consent, taking further into account that the objection under Article 100(b) EPC appears prima facie highly relevant and should be decided upon before novelty and inventive can be considered, the Board exercises his power under Article 111(1) EPC to remit the case to the Opposition Division, who under the principles laid down in G 9/91 (paragraph 16), has the power to raise on its own motion a ground for opposition not covered by the statement pursuant to Rule 55(c) EPC.

**Order**

**For these reasons it is decided that:**

1. The decisions under appeal is set aside.
2. The case is remitted to the first instance for further prosecution on the basis of the request of the Appellant filed during oral proceedings.

The Registrar:

The Chairman:

P. Martorana

P. A. M. Lançon