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File No.: T 1097/92 - 3.3.3
Application No.: 87 201 440.2
Publication No.: 0 255 181
Classification: C08F 2/44
Title of invention: Process of (co)polymerization of alpha-olefins in the presence of stabilizers

D E C I S I O N
of 27 September 1993

Applicant: Enichem Synthesis S.p.A.
Proprietor of the patent: -
Opponent: -

Headword: Interlocutory revision/ENICHEM

EPC: Art. 109(1), (2)

Keyword: "Binding character of one-month term and prohibition of comment by Art. 109(2), but not of exclusion of telephone contact with applicant stipulated by Guidelines"

Catchwords



Case Number: T 1097/92 - 3.3.3

D E C I S I O N
of the Technical Board of Appeal 3.3.3
of 27 September 1993

Appellant: Enichem Synthesis S.p.A.
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Decision under appeal: Decision of the Examining Division of the
European Patent Office dated 29 May 1992 refusing
European patent application No. 87 201 440.2
pursuant to Article 97(1) EPC.

Composition of the Board:

Chairman: F. Antony
Members: P. Kitzmantel
M.K.S. Aúz Castro

Summary of Facts and Submissions

- I. European patent application No. 87 201 440.2, filed on 27 July 1987, claiming priority from an Italian application filed on 30 July 1986, and published under the publication number EP-A-255 181, was refused by a decision of the Examining Division dispatched on 29 May 1992. The decision was based on Claim 1 filed with letter of 19 December 1991 and on Claims 2 to 14 as originally filed.
- II. In its decision the Examining Division held that the amendments carried out in the formulae of Claim 1 went beyond what could be directly and unambiguously derived from the application as originally filed. In particular, those amendments could not be justified by the information contained in 8 documents referred to at pages 6 and 7 of the application. It was held, therefore, that Claim 1 did not comply with the requirements of Article 123(2) EPC.
- III. An appeal was lodged against that decision on 14 July 1992 and the appeal fee was paid on the same day. The statement of grounds of appeal, together with new Claims 1 to 3, was submitted on 23 September 1992.
- IV. In order to be able to decide on a possible interlocutory revision under Article 109(1) EPC, the first examiner of the Examining Division, in a telephone call on 27 October 1992, asked the Appellant for certain clarifications with respect to the new Claim 1, setting a one month time limit for reply.

With letter of 26 November 1992 the Appellant filed the first page of a further amended Claim 1.

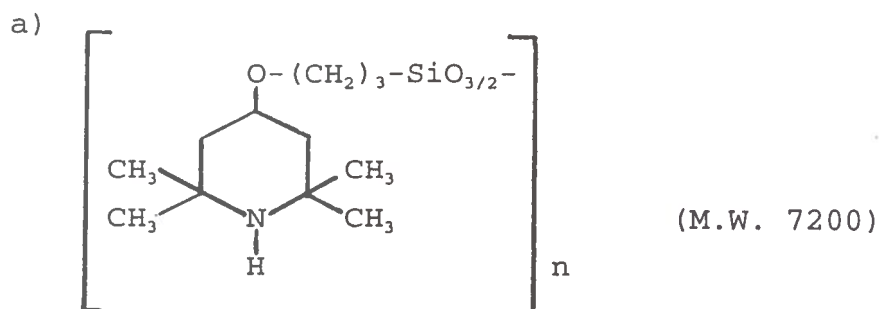
Having apparently come to the conclusion that the appealed decision could not be rectified, the Examining Division, on 15 December 1992, instructed the Formalities Section to remit the appeal to the Board of Appeal.

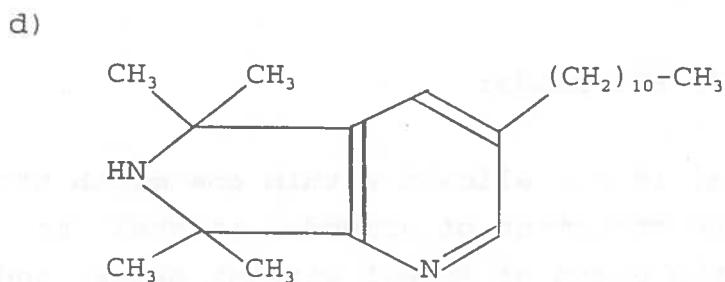
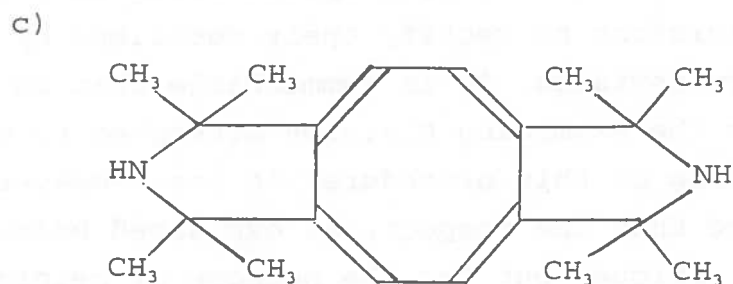
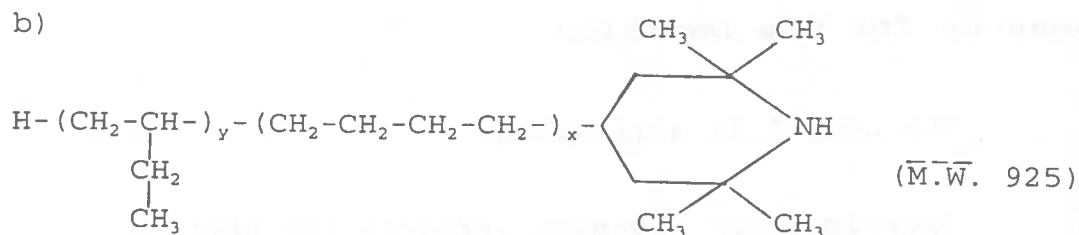
- V. Taking account of objections and suggestions made with respect to Article 123(2) EPC by the Board of Appeal in its communication of 22 June 1993, the Appellant, with his letter of 9 August 1993, filed amended sets of claims for the Contracting States BE, CH, FR, DE, GB, GR, LI, LU, NL and SE (set A: Claims 1 to 3), and for the Contracting States ES and AT (set B: Claims 1 and 2).

The Appellant filed also amended pages 3, 3A, 3B and 4 to 22 of the description.

- VI. Claim 1 of both sets of claims reads as follows:

"Process for catalytically homopolymerizing or copolymerizing alphaolefin monomers in the presence of at least one thermostabilizer in order to obtain a heat stable homopolymer or copolymer, comprising the steps of reacting the monomer(s) concerned with a Ziegler-Natta catalyst system, and introducing at any time during the polymerization up to and including the step of quenching of the catalyst, an amount of a thermostabilizer, selected from:





sufficient to have, in the final thermostabilized homopolymer or copolymer, an amount of the thermostabilizer concerned of from 0.01% to 0.5% by weight relative to said final thermostabilized homopolymer or copolymer."

Claim 2 of both sets is dependent on Claim 1 and Claim 3 of set A relates to the stabilized polymer prepared according to the process of Claim 1.

VII. The Appellant implicitly requests that the decision under appeal be set aside and a patent be granted on the basis of the amended documents referred sub V. above, preceded by original pages 1 and 2 of the description.

Reasons for the Decision

1. The appeal is admissible.
2. *Interlocutory revision (Article 109 EPC)*
 - 2.1 Especially in view of the wide-spread reluctance of Examining Divisions to rectify their decisions by way of interlocutory revision, it is commendable that in the present case the Examining Division attempted to do so. In its handling of this procedure, it has, however, erred in more than one respect, as explained below. Not as a harsh critique, but for the purpose of helping for future such situations, the Board wants to explain its position in detail.
 - 2.2 Article 109(2) EPC reads:

"If the appeal is not allowed **within one month** after receipt of the statement of grounds, it shall be remitted to the Board of Appeal without delay, and **without comment as to its merit.**" (Emphasis by the Board).
 - 2.2.1 In the present case, the statement of grounds of appeal was received on 23 September 1992; hence the appeal should either have been allowed by 23 October 1992, or within a few days thereafter ("without delay") remittal to the Board should have occurred, without comment as to the merit of the appeal.
 - 2.2.2 Instead, it was only on 27 October 1992, i.e. after the term for any allowance by way of interlocutory revision had expired, that the Examining Division, through its first member, phoned the Appellant in an attempt to

clarify a point which it thought required clarification prior to any allowance of the appeal. Moreover, a term of one further month was granted to the Appellant for giving such clarification, and it was only on 15 December 1992 that the Formalities Section was instructed to remit the case to the Board.

It is appreciated that the one-month term stipulated by Article 109(2) EPC is very short considering the practicalities of the procedure. Nevertheless, unless and until it is extended by amendment of the Convention - which the Administrative Council has the power to do under Article 33(1)(a) - it has to be strictly adhered to.

2.2.3 The telephone contact with the Appellant on 27 October 1992 is not in accordance with the Guidelines E-XI.9, last sentence of the second paragraph. This does **not** mean that the Board would criticise such a contact as a matter of principle. As the Guidelines are intended to cover normal occurrences the examining staff may depart from these instructions in exceptional cases (General Introduction, point 1.2). In certain situations, a telephone contact with the Appellant during the term available for any interlocutory revision may be quite appropriate and indeed helpful to remove minor obstacles to allowing an appeal.

If such a telephone contact is held, however, it should not be recorded in writing in such a way as to constitute a comment on the merits of the appeal accessible to third parties inspecting the file, or to the Board of Appeal should the case be remitted to it.

In the present case, not only was the contact by telephone made too late, it was also recorded in a form not permitted by Article 109(2) EPC.

2.3 Article 109(1) EPC reads:

"If the department whose decision is contested considers the appeal to be admissible and well founded, it shall rectify its decision ..."

2.3.1 In interpreting this stipulation, the Board follows the opinion of another Board in Decision T 139/87 "Governor valve/BENDIX" (OJ EPO 1990, 68) that "an appeal is to be considered well founded if the amendments submitted by the applicant (appellant) clearly meet the objections on which the decision (under appeal) relies. That there are other objections which have not been removed but which were not the subject of the contested decision cannot preclude the application of Article 109 EPC" (first full paragraph on page 70).

2.3.2 In the present case, the only reason stated in the decision under appeal for refusing the application in suit was non-compliance with Article 123(2) EPC with respect to the definitions of the substituents at the alicyclic rings of the formulae in the then Claim 1. In the amended (partial) Claim 1 submitted together with the appeal grounds, the objected definitions were no longer contained; rather, the structural formulae for the thermostabilizers were re-defined on the basis of the originally exemplified compounds. Accordingly, the objections on which the decision under appeal had relied were clearly met, it being irrelevant to the question of interlocutory revision whether other deficiencies (as pointed out by the Examining Division over the telephone or as raised by the Board in its communication of 22 June 1993) existed. Any contact of the Examining Division, by telephone or otherwise, was therefore unnecessary at that stage: The appeal should have been allowed forthwith by way of interlocutory revision, and the examination continued.

2.4 While the circumstances set out in section 2.1 could have justified remittal of the case to the Examining Division without further action on the part of the Board of Appeal, the Board considers it appropriate in the present case in the interests of a streamlined procedure to deal itself with all matters arising under Article 123(2) EPC.

3. *Compliance with Article 123(2) EPC*

3.1 The thermostabilizers comprised by Claim 1 are now defined in accordance with the specific compounds UV-1, UV-2, UV-3 and UV-4 used i.a. in examples 2, 3, 10 and 12 of the original text. Thereby, for these formulae, the requirements of Article 123(2) are met.

3.2 All other features of Claim 1 are also based on the original application. As far as they go beyond the disclosure of original Claim 1, their basis can be found as follows:

3.2.1 "Ziegler-Natta catalyst system": original Claim 8;

3.2.2 "introducing at any time during the polymerization up to and including the step of quenching of the catalyst": page 10, lines 22 to 26 and original Claim 6;

3.2.3 "sufficient to have, in the final thermostabilized homopolymer or copolymer ... relative to said final thermostabilized homopolymer or copolymer.": Claims 12 and 13.

3.2.4 The deletion of the bond symbol "-" (superscript to the square bracket) from formula a) amounts to an obvious correction under Rule 88 EPC, since this bond symbol was superfluous.

3.3 Claim 2 (both sets) is based on original Claim 9 and Claim 3 (set A) is based on original Claim 14.

3.4 The requirements of Article 123(2) EPC are therefore complied with by the amended claims.

4. *Remittal to the Examining Division*

As regards the further requirements of the EPC, particularly the substantive requirements of Articles 52 to 57 EPC, the Examining Division has not yet performed its examination. In these circumstances, in the Board's judgement, it is appropriate to exercise its power under Article 111(1) EPC and to remit the case to the Examining Division for further prosecution.

5. *Other matters*

The Board observes that the amended pages of the description are not consistent with the new claims in several respects. Before granting account should be taken, for example, of the fact that Claim 1 is now restricted to the use of a Ziegler-Natta catalyst system (compare page 8, lines 28 and 29 and page 9, lines 12 to 22 of the description) and to a restricted range of amounts of the thermostabilizer (compare the sentence bridging pages 9 and 10). Furthermore Examples 6, 7, 14 to 17 and 21, which are not according to the invention, ought to be labelled accordingly.

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 prosecution on the basis of the sets of claims submitted on 10 August 1993.

The Registrar:


E. Gorgmaier

The Chairman:


F. Antony

MG

