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D E C I S I O N
of 5 October 1995

Case Number: T 1022/93 - 3.3.1

Application Number: 88202014.2

Publication Number: 0310164

IPC: C10G 47/02

Language of the proceedings: EN

Title of invention:

Process for converting a hydrocarbonaceous feedstock

Patentee:

SHELL INTERNATIONALE RESEARCH MAATSCHAPPIJ B.V.

Opponent:

Akzo Nobel N.V.

Headword:

Hydrocracking/SHELL

Relevant legal provisions:

EPC Art. 100(a), 104(1), 111(1)

Keyword:

"Novelty (yes)"

"Remittal to the first instance"

"Apportionment of costs (yes) - fresh case at oral proceedings

- reasons of equity"

Decisions cited:

G 0009/91, T 0010/82

Catchword:

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Case Number: T 1022/93 - 3.3.1

D E C I S I O N
of the Technical Board of Appeal 3.3.1
of 5 October 1995

Appellant:
(Proprietor of the patent)

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Representative:

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Respondent:
(Opponent)

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Representative:

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Decision under appeal:

Decision of the Opposition Division of the
European Patent Office dated 13 October 1993
revoking European patent No. 0 310 164 pursuant to
Article 102(1) EPC.

Composition of the Board:

Chairman: A. J. Nuss
Members: P-P. Bracke
R. E. Teschemacher

Summary of Facts and Submissions

- I. European patent No. 0 310 164 was granted on the basis of European patent application No. 88 202 014.2, filed on 14 September 1988.
- II. The patent was opposed. Revocation of the patent was requested on the grounds of Article 100(a) EPC.
- III. By a decision issued on 13 October 1993 the patent was revoked due to lack of novelty of the then pending claims over D3 (GB-A-1 189 934).
- IV. The appellant (proprietor of the patent) lodged an appeal against this decision.

Together with the written statement setting out the grounds of appeal the appellant filed an amended set of 9 claims (hereinafter referred to as the "amended set of claims"), with the only independent claim reading:

"1. Process for converting a hydrocarbonaceous feedstock into products of lower average boiling point by contacting the feedstock at elevated pressure and temperature with hydrogen over a bed of a catalyst A producing hydrocracked effluent and subsequently contacting at least part of said hydrocracked effluent with hydrogen over a bed of a catalyst B, whereby catalyst A comprises an amorphous cracking component, at least one metal of Group VIB and/or Group VIII of the Periodic Table of the Elements and fluorine, and whereby catalyst B comprises a zeolite Y and at least one metal of Group VIB and/or Group VIII of the Periodic Table of the Elements, which zeolite Y has a unit cell size below 2.440 nm, a degree of crystallinity which is at least retained at increasing SiO₂/Al₂O₃ molar ratios, a water

adsorption capacity (at 25°C and a p/p_0 value of 0.2) of at least 8% by weight of zeolite and a pore volume of at least 0.25 ml/g wherein between 10% and 60% of the total pore volume is made up of pores having a diameter of at least 8 nm."

- V. Oral proceedings were held on 5 October 1995.
- VI. The respondent (opponent) acknowledged the novelty of the amended set of claims but submitted that the claimed process was not inventive over the cited prior art. More particularly, he contested that the experimental data in the patent in suit were suitable for showing any critical difference with respect to the cited state of the art, since the only example in the patent in suit was no longer embraced within the wording of claim 1.
- VII. The appellant stated that novelty was the only ground of opposition and, consequently, that inventive step should not be discussed.

After the Board informed the parties in a communication attached to the summons for oral proceedings that inventive step would also be discussed, the appellant contended for the first time at the oral proceedings that the claimed process resulted in superior conversion properties, which was said to be apparent from the comparison of the activity gain between test Nos. 3 and 4, according to the example in the patent in suit, and the activity gain between test Nos. 5 and 6, presented in the additional example provided with letter of 24 August 1992 during the opposition procedure (hereinafter referred to as the "additional example").

- VIII. The respondent submitted that, due to significant differences, such as the difference in pressure and in weight ratio of the catalyst supports used, in both

tests, the data of the additional example could not be compared with those presented in the example of the patent in suit. Moreover, he submitted that in the absence of sufficiently detailed information it could not be deduced from the additional example that it described a process according to the amended set of claims.

- IX. The appellant requested that the appeal be set aside and that the case be remitted to the first instance.

The respondent requested that the appeal be dismissed.

- X. At the conclusion of the oral proceedings, the Board's decision to remit the case to the first instance was announced.

Reasons for the Decision

1. The appeal is admissible.
2. At the oral proceedings the respondent no longer contested that the present claims meet the requirements of Article 123(3) EPC. Since the initially raised objection was clearly not pertinent, there is no reason to deal with this matter in detail.

3. *Novelty*

After examination of the cited prior art, the Board has reached the conclusion that none of the available prior art documents discloses a process, wherein a catalyst having all the parameters defined in claim 1 of the amended set of claims is used. Since the respondent

acknowledged the novelty of the claimed subject-matter, it is not necessary to give detailed reasons for this finding.

4. *Inventive step*

4.1 The set of claims was amended in the course of the appeal proceedings and, consequently, as specifically stated in G 9/91 (OJ EPO 1993, 408, point 19 of the Reasons) such amendments are to be fully examined as to their compatibility with the requirements of the EPC. Therefore, the question whether the amended set of claims meets the requirement of inventive step should also be examined. This was no longer contested by the appellant at the oral proceedings.

4.2 The additional example, referred to by the appellant and used for the first time at the oral proceedings to demonstrate a surprising effect for the subject-matter of the amended set of claims, was filed during the opposition procedure in order to illustrate the attractiveness of the process claimed in the then pending set of claims.

However, it could not be deduced from this additional example that the process described therein corresponds with the process claimed in the amended set of claims, more particularly, that the catalyst C in test No. 6 corresponds with catalyst B as defined in claim 1 of the amended set of claims, since neither the unit cell size, nor the degree of crystallinity, the water adsorption capacity or the pore volume of that catalyst are specified therein.

Consequently, the respondent could not expect that, in order to show a superior effect for the process in accordance with the amended set of claims, the appellant

would rely on a comparison with the data presented in this additional example, let alone that by comparing the conversion data gain of the additional example with the conversion data gain of the example of the patent in suit a surprising effect could be shown.

Since the respondent was confronted for the first time at the oral proceedings with the submission that the process of the amended set of claims corresponds to the process of the additional example, the Board considers that the respondent did not have any reason to verify the data of the additional example and to provide possible evidence to rebut the allegation that the claimed process does not result in superior conversion properties.

Therefore, the Board considers it appropriate under these circumstances to make use of the power conferred by Article 111(1) EPC to remit the case to the first instance for further prosecution, thus enabling the appellant to provide proper and complete comparative data obtained in a process according to the amended set of claims by conducting the conversion reaction such that it can be clearly established which features are causal to the alleged unexpected improvement and thus enabling both parties to have their case examined by two instances.

5. *Apportionment of costs*

In the present case the oral proceeding^s on 5 October 1995, requested only by the appellant, turned out to be superfluous. The appellant had refrained from communicating at an earlier stage (i.e. in the written appeal procedure) why, in his opinion, the claimed process should be considered inventive and from specifying that the additional example describes a


process according to the amended set of claims. This made it impossible either to remit the case without oral proceedings or to deal with the substance of the case at the oral proceedings. For reasons of equity, therefore, the appellant should be required pursuant to Article 104(1) EPC to reimburse to the respondent the costs incurred as a result of the participation at the oral proceedings before the Board (see also decision T 10/82, OJ EPO 1983, 407).

Order

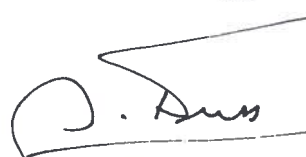
For these reasons it is decided that:

1. The decision under appeal is set aside.
2. The case is remitted to the first instance for further prosecution on the basis of comparative tests to be submitted by the patentee.
3. The appellant shall bear the costs incurred by the respondent in taking part in the oral proceedings of 5 October 1995.

The Registrar:


E. Görgmäier

The Chairman:


A. Nuss