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D E C I S I O N
of 16 January 1995

Case Number: T 0047/94 - 3.4.2
Application Number: 88202577.8
Publication Number: 0320033
IPC: B01D 71/02, B01D 69/10, B05C 3/18,
C04B 41/00

Language of the proceedings: EN

Title of invention:

Composite ceramic micropermeable membrane, process and apparatus for producing such membrane

Patentee:

HOOGOSENS GROEP B.V.

Opponent:

PECHINEY, S.A.
Metallgesellschaft AG

Headword:

Relevant legal provisions:

EPC Art. 111(1), 116

Keyword:

"Claims substantially amended on appeal"
"Remittal to Opposition Division"
"Respondent's auxiliary request for oral proceedings not granted as being neither necessary nor appropriate"

Decisions cited:

Catchword:



Case Number: T 0047/94 - 3.4.2

D E C I S I O N
of the Technical Board of Appeal 3.4.2
of 16 January 1995

Appellant:
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Respondent:
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Representative:

Respondent:
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Decision under appeal: Decision of the Opposition Division of the
European Patent Office dated 6 October 1993,
written decision posted on 26 October 1993
revoking European patent No. 0 320 033 pursuant to
Article 102(1) EPC.

Composition of the Board:

Chairman: E. Turrini
Members: C. Black
L. C. Mancini

Summary of Facts and Submissions

- I. European patent No. 0 320 033 (application No. 88 202 577.8) was granted on the basis of a set of Claims 1 to 21 of which Claims 1 to 7 were product claims (to a membrane) and Claims 8 to 21 were process claims (for producing the membrane).
- II. Opposition to the granted patent was filed by Pechiney SA (01) and Metallgesellschaft AG (02). 01's grounds of opposition were those mentioned in Article 100(a) and (b), in particular that the subject-matter of the product claims lacked novelty and inventive step. 02 opposed on the same grounds, also arguing that the subject-matter of Claims 1 to 6 lacked novelty and that of Claim 7 lacked inventive step. As regards the process claims, these were variously objected to as lacking novelty and inventive step or, in the case of Claims 8, 9, 11 and 18, that their subject-matter "ermittelt dem Fachmann keine eindeutige und vollständige Lehre zum technischen Handeln", for which reason the ground of opposition under Article 100(b) was invoked.
- III. From the minutes of oral proceedings and the Opposition Division's decision it appears that the documents given most consideration in the opposition proceedings were the following:
- D2/I: "Nouveaux médias filtrants céramiques pour microfiltration tangentielle et ultra-filtration", J. Gillot et al. from Ceraver, Filtra 84 (conference paper)
- D3/I: "Les différentes membranes minérales d'ultrafiltration mises au point par le C.E.A.", J.M. Martinet from C.E.A., Filtra 84 (conference paper)

D6/I: FR-A-2 502 508 (also cited in the search report)
D1/II: "MEMBRALOX multichannel ceramic membranes",
brochure from Ceraver dated November 1986
D2/II: "MEMBRALOX Tubular ceramic membranes", brochure
from Ceraver dated November 1986
D1/P: "New ceramic filter media for cross-flow
microfiltration and ultrafiltration", J. Guillot
et al. from Ceraver, article dated April 1986
D1/D: EP-A-0 242 208,

wherein the suffixes I, II, P and D indicate that the documents were introduced by 01, 02, the Patentee and the Opposition Division respectively.

- IV. In its communication accompanying the summons to oral proceedings, the Opposition Division expressed the opinion that the objections of both Opponents under Article 100(b) EPC were in fact objections under Article 84 EPC and therefore not grounds for opposition. According to the minutes of the oral proceedings, 01 did not pursue this ground.
- V. In oral proceedings, amended claims according to a main and a subsidiary request were submitted. The Opposition Division revoked the patent on the ground that the subject-matter of Claim 1 according to the main request was not novel having regard to the disclosure in D6/I and also having regard to the disclosure in D1/P. The subject-matter of Claim 1 according to the auxiliary request was not novel over the disclosure in D1/P.
- VI. In section III of the decision, entitled "Issues not forming base for this decision" the Opposition Division reaffirmed its view on the inappropriateness in the present case of the Article 100(b) EPC ground of opposition and expressed the view that no objection under Article 83 EPC arose. The Division also noted that

novelty and/or inventive step of the product claims according to both requests could have been attacked using other cited documents.

VII. The present appeal lies against this decision.

The Appellant (Patentee) with the grounds for the appeal submitted an amended set of claims in which Claims 1 to 14 are process claims corresponding in substance to granted process Claims 8 to 21. Claims 15 to 20 are product claims corresponding to previous Claims 1 to 5 and 7, but reformulated as product-by-process claims. The granted Claims 1 to 7 have been deleted. The Appellant requested that the decision under appeal be set aside and the patent maintained in amended form on the basis of the said claims.

VIII. The Respondent (02) requested that the appeal be dismissed and the patent with the new claims to be revoked in full. The Respondent also requested the appointment of oral proceedings as an auxiliary measure.

IX. The Board foresaw that one possible outcome of the appeal was that the case should be remitted to the Opposition Division. The Board's Registrar accordingly telephoned 02's representative to establish whether the auxiliary request for oral proceedings also applied if the Board was minded to remit the case to the Opposition Division. The representative maintained the said auxiliary request, but as will be seen, the Board decided that the appointment of oral proceedings was neither necessary nor appropriate.

Reasons for the Decision

1. The appeal is admissible.
2. The patent was revoked for the sole reason that the subject-matter of Claim 1 according to a main and an auxiliary request lacked novelty. The said claims, to a product (membrane) and Claims 2 to 7 appendant thereto, have now been deleted so that the reasons for the decision no longer apply and the decision in this respect cannot stand.
3. As far as can be ascertained from the minutes of the oral proceedings and the content of the decision itself, the question of the patentability of the process claims of the granted patent was at no time seriously considered, if at all, by the Opposition Division. The only indication in this respect is in paragraph 2.2 of the communication accompanying the summons to oral proceedings where it is suggested that FR-A-1 531 810 might be relevant for the process claims. This issue does not appear to have been pursued.
4. Accordingly the Appellant's request is based on a set of claims containing process Claims 1 to 14 which have never been examined by the Opposition Division to the extent of establishing their patentability. The set also contains the product-by-process Claims 15 to 20. The Respondent is in substance arguing that these claims do not differ significantly in scope from the product claims found by the Opposition Division to be not allowable. However this is a matter for argument and response and the Opposition Division at no time was faced with product-by-process claims.

5. In order that neither party is deprived of the right to have the current set of claims examined for patentability at two levels of jurisdiction, the Board deems it appropriate to make use of its power under Article 111(1) EPC to remit the case to the Opposition Division for further prosecution. The Board therefore does not offer any opinion on the said claims, but would draw the attention of the parties and the Opposition Division to the useful summary of Board of Appeal decisions concerning product-by-process claims which is contained in Case Law of the Boards of Appeal of the European Patent Office 1987-1992, Section II B 6, pages 62 to 64 (pages 69 to 72 in the German version).

6. As regards the Respondent's auxiliary request for oral proceedings, in the Board's opinion the correct interpretation of such a request is that it only requires to be granted for the case that it is envisaged that a decision might be issued which is adverse to the party making the request. The decision to remit the case to the Opposition Division may be inconvenient for the Respondent, but it is not adverse. Moreover in the Board's view it is neither necessary nor appropriate to appoint oral proceedings solely to discuss whether or not the case should be remitted to the Opposition Division, particularly since this would further delay the final decision. The Respondent will in any case have the opportunity to have oral proceedings before the Opposition Division, or for that matter before the Board of Appeal if there is a further appeal.

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 for further prosecution.

The Registrar:

The Chairman:

P. Martorana

E. Turrini