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D E C I S I O N
of 13 September 2000

Case Number: T 0148/94 - 3.3.6

Application Number: 87201616.7

Publication Number: 0259918

IPC: C11B 3/00

Language of the proceedings: EN

Title of invention:

Process for preparing refined oil

Patentee:

UNILEVER N.V., et al

Opponent:

N.V. Vandemoortele International
Grace GmbH

Headword:

Refined oil/UNILEVER

Relevant legal provisions:

EPC Art. 54, 84, 113(1), 123

Keyword:

"Novelty - no"

"A process 'comprising' certain features is not limited to these features"

Decisions cited:

-

Catchword:

-



Case Number: T 0148/94 - 3.3.6

D E C I S I O N
of the Technical Board of Appeal 3.3.6
of 13 September 2000

Appellant: UNILEVER N.V.
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Decision under appeal: Decision of the Opposition Division of the
European Patent Office posted 15 December 1993
revoking European patent No. 0 259 918 pursuant
to Article 102(1) EPC.

Composition of the Board:

Chairman: P. Krasa
Members: G. N. C. Rath
C. Rennie-Smith

Summary of Facts and Submissions

- I. This appeal is from the Opposition Division's decision revoking, for lack of inventive step, European patent No. 259 918 containing seventeen claims.
- II. Two oppositions had been filed, both based on the grounds of lack of novelty and inventive step (Article 100(a) EPC).
- III. During the oral proceedings before the Opposition Division, the Appellant (Proprietor) had requested the maintenance of the patent with amended Claim 1 reading as follows:
- "Process for preparing refined oil comprising removing nickel by adding to oil before, during or after hydrogenation using particulate nickel catalyst 0.01 to 4 wt.%, calculated on the weight of the oil, of an aqueous substance comprising at least 80 wt.% water, and forming a dispersion containing water, nickel and oil, allowing contact between the nickel particles and the added liquid aqueous substance such that nickel particle agglomerates are formed, and thereafter filtering the dispersion containing water, the formed nickel agglomerates and oil."
- IV. An appeal was filed against the decision not to maintain the patent with the above claim. The Appellant contested the Opposition Division's reasons for finding a lack of inventive step and complained of a substantial procedural violation in that, although the Opposition Division had not requested comparative tests to show a surprising effect, its decision to revoke the patent was also based on the ground of lack of a

surprising effect on which no opportunity to comment was given (Article 113(1) EPC).

- V. Respondents I and II (Opponents 01 and 02) contested the Appellant's submissions; in particular, Respondent II raised objections under Article 123(2) EPC; it also filed with the letter of 3 November 1994 document

(7) *F.V.K. Young*, "The Refining and Hydrogenation of Fish Oil", Fish oil bulletin No.17, International Association of Fish Meal Manufacturers, Vernon Young Consultant, 67 Freshfield Road, Formby, Liverpool L37 3HL, United Kingdom, August 1985, i-viii, 1-27.

It argued that the subject-matter of Claim 1 was not novel in view of this citation.

It also argued that there was no procedural violation under Article 113(1)EPC, since the Opposition Division had simply considered whether or not there was a surprising effect as an indicator of the presence or absence of an inventive step.

- VI. The Appellant requested that the decision under appeal be set aside and that the patent be maintained in accordance with the grounds of appeal dated 15 April 1994.

The Respondents requested that the appeal be dismissed.

- VII. Oral proceedings before the Board of Appeal took place on 13 September 2000 which none of the parties attended (see letters dated 16 August 2000 (Appellant), 1 September 2000 (Respondent I) and 12 September 2000

(Respondent II)).

VIII. At the end of the oral proceedings the Chairman announced the Board's decision.

Reasons for the Decision

1. *Articles 84 and 123 EPC*

The Board is satisfied that Claim 1 of the only request on file, which corresponds to Claim 1 as amended before the Opposition Division, meets the requirements of Articles 84 and 123 EPC. Since the appeal fails for lack of novelty (see point 2), no detailed reasons need be given.

2. *Novelty*

Document (7) discloses a process for improving the oil quality by post-refining it immediately after the removal of the catalyst from the catalytically hydrogenated oil: "The oil at 90°C is treated with 0.01 to 0.02% of citric acid added as a 10 to 15% solution in water. The acid is vigorously agitated into the oil which is then dried under vacuum. The citric acid splits the nickel soaps and also acts as a metal chelating agent. The contact time between oil and citric acid should be a minimum of 15 minutes before bleaching earth is added, again under vacuum. Bleaching earth quantity (0.2 to 1.0%) and activity depend on the oil quality. The oil is filtered and stored as before" (page 22, right hand column, point 5.2, lines 4 and 5, and 3rd paragraph).

A recalculation of the water concentrations disclosed by document (7) in terms of the weight percentages used in Claim 1 of the patent in suit shows that these water concentrations fall within the terms of that claim. Thus, the feature of present Claim 1 "0.01 to 4 wt.%, calculated on the weight of the oil, of an aqueous substance comprising at least 80 wt.% water" is implicitly disclosed by document (7). Therefore, the skilled person carrying out the teaching of document (7) would necessarily obtain nickel agglomerates since the vigorous agitation "is allowing contact between the nickel particles and the added liquid aqueous substance" and no other measures are specified in the patent in suit to form "nickel particle agglomerates".

It follows that the feature "that nickel particle agglomerates are formed" is not distinguishing and cannot render the claimed subject-matter novel over the state of the art disclosed in document (7). The process disclosed in document (7) further calls for a drying step and for the addition of bleaching earth, both process features not being mentioned explicitly in present Claim 1. However the process of Claim 1 for preparing refined oil also allows for additional steps since the term "comprising" in Claim 1 of the patent in suit is not limiting.

Indeed, according to the description of the patent in suit, the process also encompasses drying the oil after acid addition by evaporating "free" and dissolved water (patent in suit, page 8, lines 14 to 15) under a partial vacuum and the addition of bleaching earth as an adsorbent (page 8, lines 17 to 21 in combination with page 7, lines 48 to 49), process steps which are covered by Claim 1 of the patent in suit.

It follows that a process having all the features of the process of present Claim 1 was previously disclosed by document (7). Therefore, the subject-matter of Claim 1 is not novel.

3. *Articles 56 and 113(1) EPC*

In view of the above findings, the Board maintains the Opposition Division's decision to revoke the patent in suit, although for a different reason. Therefore, it is not necessary to consider further either the issue of inventive step or the Appellant's allegation that its right to be heard was violated in respect of an argument relating to lack of inventive step, those both being matters which, as a result of the Board's findings, have no further significance.

Order

For these reasons it is decided that:

The appeal is dismissed.

The Registrar:

The Chairman:

G. Rauh

P. Krasa