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D E C I S I O N
of 26 October 1994

Case Number: T 0648/94 - 3.3.1

Application Number: 92904499.8

Publication Number: 0569465

IPC: C10M 173/02

Language of the proceedings: EN

Title of invention:

Antimicrobial lubricant composition containing diamine acetate

Applicant:

ECOLAB INC.

Opponent:

-

Headword:

Lubricant composition/ECOLAB INC.

Relevant legal norms:

EPC Art. 109, 111

Keyword:

"Duty to rectify a decision if the appeal removes the ground of refusal"

Decisions cited:

T 0139/87

Catchword:



Case Number: T 0648/94 - 3.3.1

D E C I S I O N
of the Technical Board of Appeal 3.3.1
of 26 October 1994

Appellant: ECOLAB INC.
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Saint Paul
Minnesota 55102 (US)

Representative: Desaix, Anne
Ernest Gutmann - Yves Plasseraud S.A.
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Decision under appeal: Decision of the Examining Division of the European Patent Office dated 15 March 1994 refusing European patent application No. 92 904 499.8 pursuant to Article 97(1) EPC.

Composition of the Board:

Chairman: A. Jahn
Members: P. P. Bracke
R. E. Teschemacher

Summary of Facts and Submissions

- I. European patent application No. 92 904 499.8 (publication number WO 92/13050) with the international filing date of 15 January 1992 was refused by the Examining Division on 15 March 1994.

The ground for the refusal was that the subject-matter of the set of claims, filed on 6 January 1994 in response to the communication of 8 November 1993, lacked inventive step over

D1: EP-A-0 384 282.

More particularly, it was argued by the Examining Division that in the absence of any evidence that the problems mentioned in the description were solved and in the absence of any showing of an improvement over D1 an inventive step could not be accepted for the set of claims.

Moreover, it was stated that for proof of an inventive step comparative examples are necessary.

- II. An appeal was lodged against this decision on 19 May 1994 and the appeal fee was paid on the same day.

With the Statement of Grounds of Appeal filed on 25 July 1994 turbidity test data were provided.

The Appellant requested that the appeal be allowed.

Reasons for the Decision

1. The appeal is admissible.

2. The filing of turbidity test data, wherein the turbidity of aqueous solutions containing compounds according to the present application were compared with the turbidity of aqueous solutions containing compounds according to D1, is to be considered as a serious attempt to prove that the main problem underlying the invention, namely the avoidance of precipitation of the lubricating compound, resulting in plugging of spray nozzles, is effectively solved by the claimed compositions and that with the compounds according to the invention an improvement over the closest prior art is obtained. This means that the reasons given for the ground of refusal of the application are no longer valid.

Therefore, in the Board's view the Examining Division should have considered the appeal as well-founded and consequently should have rectified the decision under appeal pursuant to Article 109 (1) EPC [see the principles described in T 139/87 (OJ EPO, 1990, page 68) and the Guidelines for Examination in the European Patent Office, E-XI, 7, last paragraph of the January 1992 version]. Interlocutory revision is always appropriate if in consequence of the requests and submissions of the Appellant, the examination of the application has to be continued on a new basis.

The Examining Division itself mentioned under point VII of the appealed decision that during the period for interlocutory revision proof of an effect over D1 should be provided by comparative data. Therefore, the Appellant could reasonably expect that with the filing

of the comparative test data with the Statement of Grounds of Appeal, the Examining Division would rectify the decision.

3. With a view to mitigating the unfavourable delay of proceedings caused by the failure of the first instance to rectify the contested decision, the Board gave priority to this case.

4. In the present case the Board finds it appropriate to exercise its power under Article 111 (1) EPC and to remit the case to the Examining Division for further prosecution.

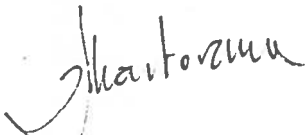
Order

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 set of claims submitted with the letter of 6 January 1994 and taking the turbidity test data submitted with the Statement of Grounds of Appeal into consideration.

The Registrar:



P. Martorana

The Chairman:



A. Jahn

