

BESCHWERDEKAMMERN
DES EUROPÄISCHEN
PATENTAMTS

BOARDS OF APPEAL OF
THE EUROPEAN PATENT
OFFICE

CHAMBRES DE RECOURS
DE L'OFFICE EUROPEEN
DES BREVETS

Internal distribution code:

- (A) [] Publication in OJ
(B) [] To Chairmen and Members
(C) [X] To Chairmen

D E C I S I O N
of 2 December 1996

Case Number: T 0180/95 - 3.3.1
Application Number: 89850245.5
Publication Number: 0354889
IPC: D21H 21/02
Language of the proceedings: EN

Title of invention:
A method of controlling microbiological deposits on paper
making equipment and paper obtained thereby

Applicant:
W. R. GRACE & CO. -CONN.

Opponent:
-

Headword:
Controlling of deposits/GRACE & CO.

Relevant legal provisions:
EPC Art. 109(1) and 111(1)

Keyword:
"Claims substantially amended to meet the ground for refusing
the application"
"Interlocutory revision-duty of examining division to rectify
its decision (yes)"
"Remittal"

Decisions cited:
T 0139/87, T 0047/90

Catchword:
-



Europäisches
Patentamt

European
Patent Office

Office européen
des brevets

Beschwerdekammern

Boards of Appeal

Chambres de recours

Case Number: T 0180/95 - 3.3.1

D E C I S I O N
of the Technical Board of Appeal 3.3.1
of 2 December 1996

Appellant: W. R. GRACE & CO. -CONN.
1114 Avenue of the Americas
US - New York, New York 10036 (US)

Representative: Henningsson, Gunnar
Awapatent AB
Box 45086
SE - 104 30 Stockholm (SE)

Decision under appeal: Decision of the Examining Division of the
European Patent Office posted 18 October 1994
refusing European patent application
No. 89 850 245.5 pursuant to Article 97(1) EPC.

Composition of the Board:

Chairman: A. J. Nuss
Members: J. M. Jonk
R. E. Teschemacher

Summary of Facts and Submissions

1. The Appellant lodged an appeal against the decision of the Examining Division on the refusal of the application No. 89 850 245.5 (publication No. 0 354 889). The decision was based on the originally filed claims, Claim 1 reading as follows:

"A method of controlling productivity disturbing microbiological deposits, e.g. slime, on paper making equipment, characterized by applying to any locus or surface of said paper making equipment which locus or surface has a tendency of causing build-ups of such microbiological deposits, a deposition-controlling amount, preferably at least about 0.1 parts per million of dilution water, of a deposition-controlling substance selected from the group consisting of cationic polymers and cationic surfactants, preferably water soluble polymers and surfactants."

2. The Examining Division held that the patent application did not meet the requirements of Article 56 EPC, having regard to the following documents:

- (1) Betz, Handbook of Industrial Water Conditioning, Eighth Edition (1980), 293-301, and
- (2) EP-A-0 232 015.

They considered that the closest state of the art with respect to the subject-matter of Claim 1 of the present patent application was document (1) describing the use of cationic surfactants, in particular quaternary ammonium compounds, for controlling microbiological deposits, e.g. slime, in paper mill systems. They held that in view of this state of the art the problem to be solved was to provide a process of efficiently removing the microbiological deposits from the paper making

equipment and preventing their build-up, and that this problem was solved by applying the cationic surfactants to the surface of said paper making equipment instead of incorporating them into the aqueous fiber suspension. However, the application of the cationic surfactants to the places where the microbiological depositions occurred was considered to be obvious to the skilled person. They also held that this point of view was supported by document (2) teaching the addition of deposition ("pitch") controlling substances to the paper making suspension, or to the suspension preparing or paper fabricating machinery.

3. Together with the Statement of Grounds the Appellant filed on 16 February 1995 new Claims 1 to 21. Claim 1 of this set of claims differed from that as originally filed in that the passage "selected from the group consisting of cationic polymers and cationic surfactants, preferably water soluble polymers and surfactants" was replaced by "selected from the group consisting of cationic polymers, preferably water soluble polymers".

The Appellant argued that by the new Claim 1 the claimed invention was clearly delimited from the prior art referred to in the decision of the Examining Division, since document (1) merely disclosed the use of cationic surfactants as a biocide, i.e. did not give any incentive that cationic polymers might have a similar activity. Moreover, they contended that document (2) only concerned the problem of pitch controlling, i.e. of controlling sticky water-insoluble deposits originating from the paper making materials such as the wood, or the ink or adhesives present in recycled paper, which problem did not have any relation to the problem of controlling microbiological deposits. He concluded that in these circumstances, and in view of the examples of the present patent application

showing that the conventional way of treating the aqueous paper making suspension was not so efficient as that of the claimed invention, the subject-matter of present Claim 1 involved an inventive step.

4. The Appellant requested that the decision under appeal be set aside and a patent granted on the basis of Claims 1 to 21 submitted on 16 February 1995.

Reasons for the Decision

1. The appeal is admissible.
2. The filing of the new set of claims by the Appellant, restricting the subject-matter of Claim 1 to the use of cationic polymers as microbiological deposits controlling substances, has the effect that the reasons given for refusing the present patent application based on document (1) are clearly no longer valid, since this document describes the use of cationic **surfactants** as biocides due to their cell membrane disrupting activity (see page 299, third paragraph, to page 230, line 6).
3. Therefore, in accordance with the established jurisprudence of the Boards of Appeal, 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.

In this context, the Board observes that an appeal is to be considered as well founded if the amendments submitted by the Appellant clearly meet the objections on which the decision relies, and that other objections

which were not the subject of the contested decision cannot preclude the application of Article 109 EPC (see T 0139/87, OJ EPC, 1990, page 68). Moreover, interlocutory revision is also appropriate if the Appellant no longer seeks grant of the patent with a text corresponding to that which was rejected by the Examining Division, and if substantial amendments are proposed which are clearly intended to overcome the objections raised in the decision under appeal, so that the examination has to be continued on a new basis (see T 0047/90, OJ EPO 1991, page 486).

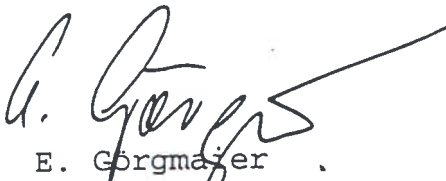
4. In these circumstances, the Board considers it appropriate to exercise its power under Article 111(1) EPC, and to remit the case to the Examining Division for further prosecution.

Order

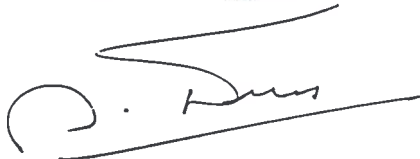
For these reasons it is decided that:

1. The decision under appeal is set aside.
2. The case is remitted to the Examining Division for further prosecution.

The Registrar:


E. Gorgmajer

The Chairman:


A. J. Nuss