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D E C I S I O N
of 12 December 1997

Case Number: T 0443/95 - 3.4.2

Application Number: 88306783.7

Publication Number: 310221

IPC: B01D 24/00, B01D 24/46

Language of the proceedings: EN

Title of invention:
Slow sand filter cleaning device

Patentee:
Thames Water Utilities Limited

Opponent:
Entreprises Morillon Corvol Courbot S.A.

Headword:
-

Relevant legal provisions:
EPC Art. 123(2), 101, 110
EPC R. 86(3)

Keyword:
"Amendments - added subject-matter (no - after return to claim as granted)"
"Return to claim as granted: no abuse of procedure"

Decisions cited:
T 0833/90, G 0010/91

Catchword:
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Boards of Appeal

Chambres de recours

Case Number: T 0443/95 - 3.4.2

D E C I S I O N
of the Technical Board of Appeal 3.4.2
of 12 DEcember 1997

Appellant:
(Proprietor of the patent) Thames Water Utilities Limited
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Representative: Johnson, Terence Leslie
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Respondent:
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Decision under appeal: Decision of the Opposition Division of the
European Patent Office posted 24 march 1995
revoking European patent No. 0 310 221 pursuant
to Article 102(1) EPC.

Composition of the Board:

Chairman: E. Turrini
Members: R. Zottmann
L. C. Mancini

Summary of Facts and Submissions

- I. The Appellant (Patentee) lodged an appeal against the decision of the Opposition Division revoking the patent 0 310 221 with the application No. 88 306 783.7.

The opposition was based on the ground of Article 100(a) EPC that the subject-matter of the patent lacked inventive step (Articles 52(1) and 56 EPC).

The Opposition Division held that the amended independent claims contravened Article 123(2) EPC.

- II. In a communication accompanying the summons to oral proceedings, the Board of Appeal expressed its preliminary opinion that and why amended versions of claim 1 as granted are not acceptable.

- III. At the end of the oral proceedings the Appellant requested that the decision under appeal be set aside and the case be remitted to the Opposition Division for further prosecution on the basis of claim 1 as granted, as main request, or claim 1 filed at the oral proceedings of 12 December 1997, as auxiliary request.

The Respondent requested that the appeal be dismissed.

- IV. The Appellant's arguing is summarized as follows:

An examination of claim 1 as granted with regard to the requirements of Article 100(c) EPC would mean that a fresh ground of opposition would have to be introduced. This is not acceptable at this stage.

The Appellant did not abandon any part of the patent at any time. Re-submittance of claim 1 as granted is no abuse of procedure.

V. The Respondent's arguing is summarized as follows:

Claim 1 as granted contains a variant which is not disclosed in the application as originally filed.

Re-introduction of claim 1 as granted, which had been abandoned at the beginning of the oral proceedings of the opposition procedure, would lead to the same situation as four years ago today, considerably prolong the procedure and thus amount to an abuse of procedure. Admittance of such a claim would give full license to repeated submittance of already abandoned claims and an arbitrary prolongation of procedure by a patentee.

Reasons for the Decision

1. The appeal is admissible.
2. *Main request*
 - 2.1 In general, opposition appeal proceedings are not a continuation of the examination proceedings involving third parties, but are a substantive legal test of the decision under appeal within the framework of the grounds of opposition referred to in Article 100 EPC and properly submitted and substantiated. Fresh grounds for opposition (grounds which have not been introduced during the opposition proceedings) can only be introduced during the appeal procedure when the Patentee agrees with the introduction (G 10/91, EPO OJ 1993, 420).

However, when a patent is amended, Article 102(3) EPC requires that it is examined whether said amendments comply with all provisions of the EPC.

During the opposition proceedings only the ground of Article 100(a) EPC that the subject-matter of the patent lacks inventive step had been introduced. Since the Appellant did not agree to an introduction of the ground of opposition referred to in Article 100(c) EPC, the question as to whether claim 1 **as granted** contains subject-matter beyond the content of the application as filed cannot be dealt with.

- 2.2 The decision under appeal is based on the ground that the amendments with respect to the granted claim 1 of the independent claim 1 of the main and auxiliary requests do not comply with Article 123(2) EPC. The question whether claim 1 as granted involves an inventive step has not been decided or at least dealt with during the opposition proceedings. Moreover, said claim has never been formally abandoned.

A request to reinstate the case in the opposition proceedings on the basis of such a claim was already made at the beginning of the appeal procedure, then called "First Subsidiary Request".

Therefore, such a claim cannot be excluded from further prosecution and an abuse of the opposition procedure and the appeal procedure on the part of the Appellant cannot be identified. As a further consequence, the question of apportionment of the costs of the Respondent for the appeal procedure is not up for discussion.

For the further proceedings, a request to admit a claim already submitted during the opposition and appeal proceedings or of a claim quite similar to such a claim

could be rejected - unless such a (re-)submission is well reasoned - e.g. by referring to the principle by which proceedings before the EPO should be speedily concluded, in the interests in particular of the general public and the parties involved. This principle is most clearly expressed in Rule 86(3) EPC. Although not stated with the same degree of clarity in Articles 101 and 110 EPC, this principle also applies in opposition and opposition appeal proceedings (see e.g. decision T 833/90, unpublished).

Moreover, in opposition proceedings only such amendments are acceptable which serve to meet the objections put forward in connection with the grounds of opposition (see e.g. Article 100 and Rule 57a EPC).

- 2.3. It goes without saying that the grounds for the decision under appeal - the amendments of the independent claims (as granted) contravene Article 123(2) EPC - do not apply to (unamended) claim 1 as granted. Therefore, the decision under appeal must be set aside.

3. *Auxiliary request*

Since the main request is allowable, it is not necessary to deal with the auxiliary request.

4. In view of the fact that novelty and inventive step of none of the claims have been dealt with during the opposition proceedings and the request of the Appellant (see paragraph III above), the Board of Appeal makes use of its powers under Article 111(1) EPC to remit the case to the Opposition 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 Opposition Division for further prosecution on the basis of claim 1 as granted (main request).

The Registrar:

The Chairman:

P. Martorana

E. Turrini