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**D E C I S I O N**  
**of 11 January 1999**

**Case Number:** T 0722/97 - 3.2.4

**Application Number:** 90301974.3

**Publication Number:** 0384781

**IPC:** F01K 23/06

**Language of the proceedings:** EN

**Title of invention:**

Improvements in operating flexibility in integrated  
gasification combined cycle power stations

**Patentee:**

Jacobs Engineering Limited

**Opponent:**

Foster Wheeler International Corporation  
John Cone, c/o Strasberger & Price  
Texaco Development Corporation

**Headword:**

Admissibility of appeal/JACOBS

**Relevant legal provisions:**

EPC Art. 107

**Keyword:**

"Appellant not adversely affected"

**Decisions cited:**

T 0239/92, T 0549/93, T 0552/97, T 0953/96, J 0012/85

**Headnote:**

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Boards of Appeal

Chambres de recours

Case Number: T 0722/97 - 3.2.4

**D E C I S I O N**  
**of the Technical Board of Appeal 3.2.4**  
**of 11 January 1999**

**Respondent I:**  
(Opponent I)

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(Opponent II)

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Fusina, Gerolamo (IT)  
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(Opponent III)

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**Appellant:**  
(Proprietor of the patent)

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**Decision under appeal:** Interlocutory decision of the Opposition Division of the European Patent Office posted 23 April 1997 concerning maintenance of European patent No. 0 384 781 in amended form.

**Composition of the Board:**

**Chairman:** C. A. J. Andries  
**Members:** H. A. Berger  
M. Lewenton

## Summary of Facts and Submissions

- I. European patent No. 0 384 781 was opposed by three opponents on the grounds that the subject matter of the claims as granted lacked novelty and/or inventive step (Articles 100(a), 54 and 56 EPC).
- II. Oral proceedings were held before the Opposition Division on 28 November 1996. The opponents requested the revocation of the patent. After having put forward different requests the patentee finally requested to maintain the patent in amended form, on the basis of a sole new main request presented during the oral proceedings. The Opposition Division issued an interlocutory decision maintaining the patent on the basis of said main request.
- III. The Appellant (patentee) filed an appeal against this decision. He essentially argued that the limitation introduced into amended claim 1 as allowed by the Opposition Division was not necessary to render the claim novel and inventive over the prior art, and he requested that the patent should be maintained without said limitation. He stated that he had not the intention of abandoning all previous requests at the oral proceedings on 28 November 1996. They were merely withdrawn in order to expedite the issuance of the interlocutory decision to maintain the patent in amended form, this decision being preferable to one which would have rejected the patent in its entirety.
- IV. Respondents I and III (Opponents I and III) submitted and requested with their letters of 17 July, 5 August, 14 October and 31 October 1997 as well as of 10 August 1998, that the appeal should be rejected as inadmissible since the decision of the Opposition Division was based on the main, and only remaining

request of the patentee. According to the Respondents all other requests had been abandoned by the patentee during the oral proceedings. Therefore the patentee was not and could not be adversely affected by the appealed decision.

V. Respondents I and III requested auxiliarily that oral proceedings be appointed to deal with the issue of admissibility in the event that the Board considered the appeal as being admissible. Respondent III further or alternatively requested that a question of law concerning the admissibility of appeals in circumstances where a patentee seeks to reinstate a request expressly withdrawn before the Opposition Division be referred to the Enlarged Board of Appeal.

VI. On 28 January 1998 the Board sent a communication to the parties informing them on its provisional opinion on the inadmissibility of the appeal.

VII. In his reply of 22 May 1998 to the above communication the appellant submitted that he did not intend to file further submissions or requests and that he withdrew the requests for oral proceedings and referral of this case to the Enlarged Board of Appeal. However he asked for several amendments of the Minutes of the oral proceedings held on 28 November 1996 before the Opposition Division and dated 23 April 1997.

VIII. In a further communication of 9 June 1998 the Board informed the parties that it had no competence to decide on any question concerning the Minutes of the oral proceedings of 28 November 1996 and further that it was its intention to take a decision in writing after the time limit set by this communication, namely two months, had lapsed.

- IX. Within the time limit, apart from a letter of the appellant dated 26 June 1998 to the attention of the Opposition Division, no further reply, comments or requests of the appellant have been received.
- X. In a communication dated 28 September 1998 the Opposition Division has informed the appellant that his request for amendment of the Minutes of the oral proceedings held on 28 November 1996 before the Opposition Division cannot be followed.

### **Reasons for the Decision**

1. As to the reasons for the inadmissibility of the appeal reference is made to the Board's communication of 28 January 1998. Since no comments on these reasons have been brought forward by the appellant, the Board wants to emphasise solely the essential aspects.
2. A conclusive interpretation of what is meant in Article 107 EPC with "adversely affected by a decision" has been given by the Legal Board in its decision J 12/85 (OJ EPO 1986, 155). As stated there (section 3 of the reasons) an applicant for a European patent can only be adversely affected by a decision to grant the patent when such decision is inconsistent with what he had specifically requested. In this context, the Board particularly refers to the French text "pour autant qu'elle (la décision) n'ait pas fait droit à ses prétentions".

The following decisions also relate to analogous problems and show that the case law of the Boards in this respect is clear and consistent:

T 953/96 (dated 25 June 1997, section 2)  
T 549/93 (dated 2 February 1994, sections X und 3)  
T 239/92 (dated 23 February 1995, section 1) and  
T 552/97 (dated 4 November 1994, section 1).

With respect to the case, when firstly, in an opposition procedure, a patent has been maintained in accordance with Article 102(3) EPC, where secondly the impugned decision was only based on the patentee's sole request, and where thirdly an appeal was filed by the patentee, decisions T 239/92 and T 552/97 clearly show the consistent case law of the Boards in indicating the rejection of such an appeal as being inadmissible, if the impugned decision did follow the respective appellant's sole request.

3. Based on the Minutes of the oral proceedings held on 28 November 1996, the content of the impugned interlocutory decision taken by the Opposition Division and the reasons given in the notice of appeal and the written statement setting out the grounds of appeal for the filing of an appeal there can be no considerable doubt that at the end of the oral proceedings the patentee agreed to the maintenance of the patent in amended form which was thought acceptable to the Opposition Division and thus finally became content of the impugned decision. Since the accepted request was, at the time the decision was made, the sole remaining request on the side of the patentee, which fact has been confirmed by the respondents I and III, he was not and could not be adversely affected by the impugned decision. Indeed, the reasons that "The patentees consider that in the light of the Reasons for the decision the limitation introduced into amended claim 1 as allowed is not necessary..." (notice of appeal dated 30 June 1997, page 1) and that "The Proprietor - Appellant is adversely affected in the sense that they consider the claims of the text of the application as

found acceptable in the Interlocutory Decision are unduly narrow in scope" (written statement dated 3 September 1997, page 1), cannot be considered by the Board as reasons which permit a party to be adversely affected by a decision in the meaning of Article 107 EPC, since these reasons result from the proprietor's own main and sole request and do not result from not allowed requests.

4. The Board can furthermore not follow the patentee's argument that the announcement of the Chairman in the oral proceedings of 28 November 1996 that claim 1 of the main request originally discussed during the oral proceedings did not involve an inventive step should be considered as a "verbal decision" which adversely affected the patentee's position and therefore would allow an appeal. Since the Minutes clearly indicate that the respective announcement was a mere opinion of the Opposition Division which was not intended to terminate the proceedings but to reopen the discussion on the case, an appeal against such an "opinion" would be inadmissible. In the present case that opinion did not become part of the final decision since the request for which that opinion was relevant was withdrawn by the patentee. This must have been clear to a party represented by an experienced professional representative. Furthermore, this handling with main and subsidiary requests is such normal practice in the proceedings before the EPO, that there was no necessity on the side of the Opposition Division to direct the patentee to potential problems. The Board therefore can not find any of the alleged procedural violations.
5. In view of the above, the appeal has to be rejected as inadmissible.



Therefore, the subsidiary requests of the Respondents (see above section V) do not have to be taken into account.

**Order**

**For these reasons it is decided that:**

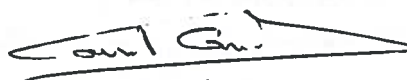
The appeal is rejected as inadmissible.

The Registrar:



N. Maslin

The Chairman:



C. Andries