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D E C I S I O N
of 15 November 2001

Case Number: T 0070/98 - 3.3.6

Application Number: 92910321.6

Publication Number: 0579744

IPC: D21C 9/14

Language of the proceedings: EN

Title of invention:

Method for reducing colored matter from bleach effluent using a DZD bleach sequence

Applicant:

INTERNATIONAL PAPER COMPANY

Opponent:

-

Headword:

DZD bleach/INTERNATIONAL PAPER

Relevant legal provisions:

EPC Art. 56

EPC R. 71(2), 86(3)

Keyword:

"Abuse of procedure (yes); non-attendance of oral proceedings; announcement of non-attendance and filing of new arguments and requests one day before the date for oral proceedings"

"Inventive step (no)"

Decisions cited:

G 0004/92, T 0055/91

Catchword:



Europäisches
Patentamt

European
Patent Office

Office européen
des brevets

Beschwerdekammern

Boards of Appeal

Chambres de recours

Case Number: T 0070/98 - 3.3.6

D E C I S I O N
of the Technical Board of Appeal 3.3.6
of 15 November 2001

Appellant: INTERNATIONAL PAPER COMPANY
Corporate Research Center
Long Meadow Road
Tuxedo, N.Y. 10987 (US)

Representative: Wiklund, Erik
Awapatent AB
Box 5117
S-200 71 Malmö (SE)

Decision under appeal: Decision of the Examining Division of the European Patent Office posted 8 August 1997 refusing European patent application No. 92 910 321.6 pursuant to Article 97(1) EPC.

Composition of the Board:

Chairman: P. Krasa
Members: G. Dischinger-Höppler
C. Rennie-Smith

Summary of Facts and Submissions

I. This appeal is from the decision of the Examining Division to refuse the European patent application No. 92 910 321.6 (international publication number WO-A-92/17639) relating to a method for reducing coloured matter from bleach effluent using a DZD bleach sequence, on the ground that the subject-matter of the then pending claims lacked an inventive step in view of document

(1) US-A-4 959 124.

In particular, it was held that a skilled person would from the disclosure of document (1) expect the omission from the E stage in the DZED bleaching sequence, for the purpose of saving caustic, to result in effluents containing less coloured matter and lower COD values.

II. In its Grounds of Appeal dated 5 December 1997 the Appellant requested oral proceedings as an auxiliary request if its main request (grant of a patent with the claims as applied for) should not be allowed. This request was not withdrawn at any point during the appeal proceedings.

In addition, the Appellant filed comparative data concerning the claimed DZD and DZDD sequences on the one hand and a prior art DZED sequence on the other hand. It also filed document

(2) "The bleaching of pulp", third Edition, Revised, Edited by Rudra P. Singh; TAPPI Press, 1979, second printing, pages 382 to 387.

III. In a first communication dated 22 December 2000, the Board, in a provisional and non-binding opinion, addressed questions under Articles 84 and 56 EPC.

IV. With a letter of 22 February 2001, the Appellant submitted

a new set of seven claims, Claim 1 reading:

"1. A process for the bleaching of a cellulosic pulp to a target brightness of at least G.E. 75 and a viscosity of at least 14 cP comprising the sequential steps of:

- a first step including contacting said pulp at a consistency of between 2% and 15% and a pH of between 1.5 and 2.5 at the commencement of said first step with a chlorination agent including at least 50% chlorine dioxide and of a chlorination factor of between about 0.1 and 0.25 for a time period in excess of about 45 minutes at a temperature of between 30°C and 60°C, and thereafter, without an intervening treatment other than an optional water wash,
- a second step including contacting said pulp at a pH of less than 5 at the commencement of said second step and a consistency of between 0.1% and 30% at between 30°C and 50°C with ozone, and thereafter, without an intervening treatment other than an optional water wash,
- a third step including contacting said pulp at a consistency of 10% with chlorine dioxide for a period of between about 1 and 3 hours and at a temperature of between 60°C and 70°C, wherein the effluent from said bleaching process contains less coloured matter and exhibits a lower COD than the effluent from a pulp bleaching process wherein there is employed an alkali extraction following an initial chlorination step."

V. A summons to oral proceedings to be held on 15 November 2001 was sent to the Appellant on 5 June 2001 accompanied by a communication making further observations as to the possible non-compliance of the application with the patentability requirements of the EPC. In particular, objections concerning inventive step raised in the first

communication were explained in more detail.

VI. No response to that Communication was made until 14 November 2001, the day before the oral proceedings, when the Appellant informed the Board by fax that it would not attend the oral proceedings. This same fax indicated "further written arguments and a claim amendment for the Board of Appeal to consider before making its Decision" would be submitted and these were received by the Board later the same day in a further fax wherein the Appellant repeated its previous written arguments and filed amended claims by way of an auxiliary request.

VII. The Appellant's arguments submitted with its Statement of Grounds of Appeal and letter of 22 February 2001 can be summarized as follows:

- In contrast to the claimed subject-matter where the pulp was kept acidic all the way through, conventional wisdom, e.g. document (2), taught the necessity of an alkaline extraction stage (E stage) before a final acidic chlorine dioxide stage (D stage).
- The comparative data, which had been prepared taking every reasonable precaution to maintain the same conditions, showed dramatic improvements over the prior art bleaching process of document (1), in that, at substantially the same brightness, the viscosity of the bleached pulp and in particular the properties of the effluent (less coloured matter and lower COD) were much better.
- These were truly perplexing results since, with chlorine dioxide bleaching, it was a well-known fact that viscosity and brightness are inversely proportional.

VIII. In its two communications, the Board raised, inter alia, the following objections:

- Document (2) did not appear to warn against any consecutive performance of three or more acid stages, but merely advised performing an E stage in advance of any final acid stage. Likewise, the claimed subject was not restricted to a sequence with any E stage at all, but preferably (Claim 3) also included an E stage before the final D stage.

- The comparative data supplied by the Appellant did not appear to describe completely all experimental parameters. Moreover, the experiments were conducted with different amounts of chlorine dioxide in that the amount of chlorine dioxide applied in the prior art test was about 12 to 15% lower than in the tests according to the application in suit. It was therefore questionable whether reliable conclusions could be drawn from these tests.

- If anything, the comparative tests appeared to show that omitting the E stage lead to a decreased brightness of the pulp despite the increased overall amount of applied chlorine dioxide. Thus, saving caustic as one of the objects set out in the application in suit (page 3, lines 9 to 17), possibly at the expense of other properties, by omitting an E stage from the bleaching sequences disclosed in document (1), seemed to be obvious.

IX. No new arguments of substance were contained in the Appellant's last letter of 14 November 2001.

X. The Appellant requests in writing that the decision under appeal be set aside and that the patent be granted on the basis of the claims filed by letter of 22 February 2001 or the claims of the auxiliary request filed by fax of 14 November 2001.

- XI. Oral proceedings, at which the Appellant was not represented, took place on 15 November 2001.

Reasons for the Decision

1. The appeal is admissible. However, the admissibility of the auxiliary request raises serious procedural issues.

- 2.1 After an applicant's reply to the first communication of the Examining Division, any subsequent amendment of a European patent application is only admitted as a matter of discretion (Rule 86(3) EPC). Further, in appeal proceedings the admissibility of late-filed requests is always a matter for the Boards' discretion. The Boards of Appeal have often been prepared, in particular in ex parte proceedings where there is no other party which can be taken by surprise, to exercise that discretion in favour of Appellants filing new requests shortly before or even during oral proceedings. One reason why this practice has been allowed is that the Boards have been able to discuss such requests with Appellants at the oral proceedings, thereby rectifying minor deficiencies without unduly delaying a final decision. Thus the inconvenience of late filing may be mitigated by the opportunity to examine the request in the oral proceedings.

- 2.2 In the present case however, the behaviour of the Appellant has been completely different from that of a party attending oral proceedings. Although the Appellant requested oral proceedings in its Grounds of Appeal and maintained that request throughout the appeal, it announced, nearly four years after making that request and on the day before the oral proceedings, that it would not attend. Then, by a second faxed letter on the same day, received only a few working hours before the oral proceedings were due to commence, the Appellant sought to make further written submissions and to file amended claims by way of an auxiliary request.

The written submissions contained no new arguments of substance and therefore call for no comment by the Board. As regards the new request however, by filing this only hours before the oral proceedings and not attending such proceedings, the Appellant placed the Board in the position of having to consider that request on a "take it or leave it" basis. Apart from the discourtesy thereby shown to the Board, such behaviour cannot be condoned as a matter of procedure. The extreme lateness of filing the request was not mitigated by the opportunity to discuss it with the Appellant in oral proceedings but, on the contrary, aggravated by the Appellant's non-attendance at such proceedings.

- 2.3 If the Appellant entertained hopes that it might by its tactics delay a decision in the present proceedings, it was misguided. While the discretion of the Board as to the admissibility of late-filed arguments and requests applies equally in both ex parte and inter partes cases, the right to be heard (Article 113 EPC) does not permit an Appellant in ex parte proceedings to file new last-minute arguments and/or requests so as to delay a decision. In decision T 55/91 (unpublished), in a case which as to procedural matters was similar to the present case although no late request was filed, Board 3.3.2 found against an Appellant in ex parte proceedings which did not avail itself of the opportunity to present arguments at oral proceedings against views of the Board expressed in a communication sent during the written proceedings. In the present case the Board sent two such communications and the Appellant, having replied to both in terms which made clear it disagreed with the Board, its failure to attend the oral proceedings it requested should not be allowed to work to its advantage. Even in inter partes proceedings, a party which chooses to absent itself from oral proceedings is only protected from an adverse decision based on new facts, but not new arguments, presented for the first time at oral proceedings (see G 4/92, OJ EPO 1994, 149, a decision expressly confined to inter partes

proceedings - see Reasons, paragraph 1).

- 2.4 A further factor the Board must consider when faced with a possible delay, apart from the behaviour of parties in the case before it, is the effect delay may have upon the timely and efficient disposal of other appeals pending before it. While some delay arising from the volume of pending appeals is inevitable, to allow parties to cause additional and avoidable delay in one case can have a delaying effect on other pending appeals the parties to which have complied with all the usual procedural requirements.
- 2.5 In all the circumstances of the present case, for the Appellant to announce on the day before the oral proceedings that it would not attend and then to file a new auxiliary request amounted to an abuse of procedure and the Board holds accordingly that the request be disregarded as inadmissible.
3. On considering the case at the oral proceedings, held in accordance with Rule 71(2) EPC despite the absence of the Appellant, the Board came to the conclusion that the subject-matter of Claim 1 was not based on an inventive step in view of document (1) for the reasons already set out in detail in the communications dated 22 December 2000 and 5 June 2001 (see VIII above).
4. It follows that the Appellant's request must fail on the ground of non-compliance with the requirements of Article 56 EPC and the appeal must be dismissed.

Order

For these reasons it is decided that:

The appeal is dismissed.

The Registrar:

The Chairman:

G. Rauh

P. Krasa