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**D E C I S I O N**  
**of 15 February 2002**

**Case Number:** T 0555/98 - 3.3.5

**Application Number:** 87402408.6

**Publication Number:** 0266271

**IPC:** B01D 53/22

**Language of the proceedings:** EN

**Title of invention:**

Process for membrane separation of gas mixtures

**Patentee:**

L'AIR LIQUIDE, SOCIETE ANONYME POUR L'ETUDE ET L'EXPLOITATION  
DES PROCEDES GEORGES CLAUDE

**Opponent:**

THE DOW CHEMICAL COMPANY

**Headword:**

Gas separation/L'AIR LIQUIDE

**Relevant legal provisions:**

EPC Art. 21(1), 102(3), 104(1), 106(1), 108, 113(2), 117  
EPC R. 64, 89

**Keyword:**

"Admissibility of appeal (yes) - reasoned statement of Grounds  
of Appeal"  
"Competence of the Board to revise a decision of another Board  
(no)"  
"Award of costs (no)"

**Decisions cited:**

G 0008/95, G 0001/97, T 0065/96, T 0079/89, J 0022/86

**Catchword:**

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Case Number: T 0555/98 - 3.3.5

**D E C I S I O N**  
**of the Technical Board of Appeal 3.3.5**  
**of 15 February 2002**

**Appellant:** L'AIR LIQUIDE, SOCIETE ANONYME POUR  
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**Respondent:** THE DOW CHEMICAL COMPANY  
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**Decision under appeal:** Decision of the Opposition Division of the  
European Patent Office posted 5 May 1998 revoking  
European patent No. 0 266 271 pursuant to  
Article 102(1) EPC.

**Composition of the Board:**

**Chairman:** R. K. Spangenberg  
**Members:** G. Dischinger-Hoeppler  
J. H. Van Moer

## Summary of Facts and Submissions

- I. This appeal is from the decision of the Opposition Division, dated 5 May 1998, to revoke European patent No. 0 266 271 for a third time. The decision was based on the ground that the patent proprietor (Appellant) had failed to submit a text in which the European patent could be maintained.
- II. The two previous decisions of the Opposition Division to revoke the patent were set aside by the then competent Board of Appeal 3.4.2. With its first decision T 1027/93, the Board remitted the case to the Opposition Division for further prosecution. With its second decision T 367/96, the Board decided that the case be remitted to the first instance with the order to maintain the patent in amended form on the basis of the claims filed as the Appellant's fourth auxiliary request (filed as "Patentee's Fifth Request" during the oral proceedings of 3 December 1997 before the Board and hereinafter referred to as "the Fourth Auxiliary Request"), with the description and drawings to be adapted, where necessary.
- III. Claim 1 of the Fourth Auxiliary Request reads:
- "1. A fermentation process wherein the off-gases is comprised of a gas mixture, comprising the steps of
- providing a semipermeable membrane having a feed gas side and a sweep gas side,
- contacting said feed gas side of said semipermeable membrane with a feed gas mixture

comprising said off-gases, said feed gas mixture containing two gases to be retained which gases are present on said sweep gas side, and at least one gas to be separated therefrom,

simultaneously contacting said sweep side of said semipermeable membrane with a sweep gas having a pressure lower than that of said feed gas,

withdrawing a residue gas after contact with said feed side of said membrane which is substantially depleted of said gases to be separated,

withdrawing a permeate gas after contact with said sweep side of said membrane which is substantially enriched with said gases to be separated,

characterized by further comprising:

balancing said partial pressure of a first gas to be retained to provide as close as possible substantially equal partial pressures on both sides of the membrane while at the same (read "same") time providing a partial pressure differential across the membrane for a second gas to be retained, which partial pressure differential is less than the partial pressure differential of said gas to be separated to maximize diffusion across the membrane of said gas to be separated while minimizing diffusion across the membrane of said gases to be retained."

IV. Subsequently, the Opposition Division sent out an invitation for the Appellant to file an adapted version of the description, and the Appellant, in a letter of

response dated 10 April 1998, explicitly disagreed. It submitted that the decision T 367/96 was based on an obvious mistake consisting in an erroneous interpretation of the prior art, namely a wrong calculation of the partial pressure which contradicted the laws of physics. The Appellant asked the Opposition Division to correct under Rule 89 EPC the obvious mistake made and to reissue an appealable decision on non-obviousness. It further indicated that, in case of disagreement by the Opposition Division, it would like to join the case J 3/95 pending before the Enlarged Board of Appeal as G 1/97 in order to learn how to obtain a revised decision where a procedural mistake was an obvious mistake.

The Appellant did not propose any text for adaptation of the description to the claims of the Fourth Auxiliary Request.

V. Thereafter the Opposition Division rendered said third decision mentioned under I. above, against which the Appellant, on 8 June 1998, lodged its present and third appeal and paid the appeal fee. In a letter headed "Grounds of Appeal Statement" filed on 2 September 1998, the Appellant essentially repeated its arguments and requests submitted to the Opposition Division (see IV. above) but proposed, as an alternative to join case J 3/95, to wait for the issuance of opinion G 1/97. In addition, the Appellant requested - as its last auxiliary request - to be given another opportunity to accept the claims of the Fourth Auxiliary Request.

VI. In a letter dated 10 December 1998, the Respondent (Opponent) submitted that the "appeal must be rejected"

since none of the alleged grounds of appeal addressed the only ground on which the patent was revoked, namely that there was no text in which the patent may be maintained, and since the decision of the Board of Appeal was final and not open to further appeal. It requested that the appeal be dismissed as inadmissible and that an award of costs of the present appeal proceedings be made in favour of the Respondent.

- VII. Due to a change of business distribution scheme of the technical Boards of Appeal, this appeal was allocated under case number T 555/98 to the present technical Board 3.3.5 which stayed the proceedings until the issuance, on 10 December 1999, of the decision of the Enlarged Board of Appeal in the case G 1/97 (OJ, EPO 2000, 322) in order to comply with the Appellant's respective request (see V. above).

Following the opinion given in G 1/97, the Board, in a letter dated 12 May 2000, communicated its preliminary opinion that the present Board had no competence to revise a decision given by another Board, and further that the competence to correct an appeal decision under Rule 89 EPC lies with the Board which has given the decision, as was established by the Enlarged Board of Appeal in its opinion G 8/96. Finally, the Board did not see any reasons justifying an award of costs as requested by the Respondent.

- VIII. In order to comply with the Appellant's respective request (see IV. and V. above), oral proceedings were held before the Board on 26 January 2001, in the absence of the Respondent (Opponent) as announced by a letter of 28 July 2000. These proceedings were terminated with the decision to continue the

proceedings in writing to give the Appellant, upon its request, the opportunity to submit the case to the Board of Appeal 3.4.2 which has given decision T 367/96 (see communication of Board 3.3.5 dated 6 March 2001).

- IX. Accordingly, the Appellant in a letter dated 27 February 2001 requested that Board 3.4.2 correct under Rule 89 EPC an obvious mistake present in the decision T 367/96 issued on 3 December 1997.

In its decision dated 21 June 2001, Board of Appeal 3.4.2 decided to refuse this request since the correction did not relate to an error or mistake open for correction under Rule 89 EPC.

- X. In a communication dated 11 July 2001, Board 3.3.5 invited the Appellant to present its ultimate requests in respect of the still pending appeal T 555/98 and to submit a description adapted to the claims of the Fourth Auxiliary Request declared patentable in decision T 367/96.

- XI. With a letter submitted by telefax on 11 September 2001 (dated 19 July), the Appellant filed an amended version of the description "adapted to the fourth auxiliary request as granted in decision T 367/96, as earlier requested, for further grant of a modified patent, if there is no possibility to obtaining a fair treatment of this case".

In a communication dated 31 October 2001, the Board informed the parties of its intention to maintain the patent in amended form on the basis of the claims according to the Fourth Auxiliary Request with the proviso that further amendments to the description of



the patent in accordance with the Board's proposal were filed or agreed to within the time period given. The Appellant, in a letter of reply of 27 November 2001, gave its agreement. The Respondent informed the Board by a letter dated 7 December 2001 that he had no further comments.

### **Reasons for the Decision**

From the parties' ultimate requests as they stand (see VI. and XI. above), the following issues are to be decided in the present case:

- whether the present appeal is admissible;
- whether the present Board of Appeal has any other competence than to decide on the maintenance of the patent on the basis of the claims of the Fourth Auxiliary Request and an adapted description; and
- whether there is any justification for an apportionment of costs of the present appeal proceedings.

#### 1. *Admissibility of the appeal*

The appeal complies with the requirements of Articles 106 and 107 EPC as well as with those laid down in the first and second sentence of Article 108 EPC and in Rule 64 EPC. Its admissibility was only challenged by the Respondent on whether the document headed "Grounds of Appeal Statement" contains a "statement setting out the grounds of appeal" according

to the third sentence of Article 108 EPC.

In the Respondent's opinion, such grounds must address the reasons in the decision under appeal.

No definition of "the grounds of appeal" is provided by the EPC and there is no explicit requirement in the EPC that these grounds should contain a reference to the reasons of the appealed decision but the Board in any case has found that in the Appellant's statement of grounds of appeal such reference has been provided, at least implicitly:

The patent was revoked for the sole reason that the Appellant did not - in accordance with Article 113(2) EPC - submit or agree to a text in which the patent could be maintained as stipulated in Article 102(3) EPC, but the Appellant, in its statement of grounds of appeal, gave the reasons why it declined to approve any proposed text except that of the patent as granted, as it did in its previous letter of reply to the Opposition Division's invitation to adapt the description. Moreover, in a last auxiliary request, pursuit of the patent on the basis of the claims of the Fourth Auxiliary Request was requested.

Thus, the statement of grounds of appeal meets at least the minimum requirement by putting forward in an intelligible manner the substance of the Appellant's case, ie the reasons why the appeal should be allowed and why the decision under appeal should be set aside (see J 22/86, OJ EPO, 1987, 280, reasons No. 2).

Even if such reasons may turn out to be not promising, any unsuccessful outcome of the appeal will not render

it inadmissible (T 65/96 of 18 March 1998; not published in the OJ EPO, reasons No. 1.1).

Consequently, the appeal complies with Article 108 EPC, third sentence.

2. *Competence of the Board*

2.1 At present, the Appellant seeks before the present Board 3.3.5 as main request in its own words "a fair treatment". The Board considers that the only reasonable understanding of said request is that the Appellant still requests revision of decisions T 367/96 of 3 December 1997 and 21 June 2001.

However, according to Articles 21(1) and 106(1) EPC, the Board has no competence to revise a decision of a Board of Appeal (decision of the Enlarged Board of Appeal G 1/97, reasons Nos. 2 and 6). Therefore, the main request is rejected.

2.2. Thus, the present Board's competence is restricted to decide whether there is any text suitable for maintenance of the patent on the basis of the claims according to the Fourth Auxiliary Request.

In order to adapt the description to a fermentation process and apparatus suitable therefore, in accordance with the independent Claims 1 and 5 of this request, it has been found necessary by the Board, agreed to by the Appellant and not disapproved by the Respondent to amend in the patent specification

- column 2, lines 11 to 12 into "In a mixture of gases, certain gas components";

- column 2, lines 20 to 23 into "This invention is in accordance with claim 1. Air enriched with oxygen is passed through a fermentation vat by any suitable means for purposes of";
- column 3, lines 23 to 24 into "Figure 1 shows a schematic representation of the concept of the process";
- column 4, line 6 into "The concept comprises selecting a feed" and
- column 8, line 41 into "A feature of the invention comprises".

These amendments are found sufficient for maintenance of the patent in amended form on the basis of the Fourth Auxiliary Request.

### 3. *Award of costs*

The Respondent requested an award of costs "against the Patentee on an indemnity basis" since the present appeal proceedings were an abuse of procedure.

The rules for apportionment of costs are laid down in Article 104(1) EPC where it is said that normally each party to the proceedings shall bear its own costs. As an exception and for reasons of equity, "costs incurred during taking of evidence or in oral proceedings" may be apportioned differently.

In the present case, however, the arguments put forward in the Appellant's statement of Grounds of Appeal have no relation to a taking of evidence within the meaning

of Article 117 EPC, nor did any costs result for the Respondent who absented itself from the oral proceedings held in the present appeal proceedings.

Hence, the Respondent's request for award of costs must fail.

## **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 with the order to maintain the patent in the following version:

#### **Claims:**

Nos. 1 to 5 of the fourth auxiliary request filed as "Patentee's fifth Request" during oral proceedings of 3 December 1997 before Board 3.4.2;

#### **Description:**

Columns 1 to 9 of the patent specification with the following amendments:

- column 2, lines 11 to 12: "In a mixture of gases, certain gas components";
- column 2, lines 20 to 23: "This invention is in accordance with claim 1. Air enriched with oxygen

is passed through a fermentation vat by any suitable means for purposes of";

- column 3, lines 23 to 24: "Figure 1 shows a schematic representation of the concept of the process";
- column 4, line 6: "The concept comprises selecting a feed" and
- column 8, line 41: "A feature of the invention comprises".

**Drawings:**

Figures 1 to 4 of the patent specification.

3. The request for apportionment of costs is refused.

The Registrar:

The Chairman:

U. Bultmann

R. Spangenberg