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D E C I S I O N
of 7 May 2001

Case Number: T 0230/99 - 3.3.3

Application Number: 94917077.3

Publication Number: 0701586

IPC: C08K 5/00

Language of the proceedings: EN

Title of invention:
Polyester composition

Applicant:
MONSANTO COMPANY

Opponent:
-

Headword:
-

Relevant legal provisions:
EPC Art. 113(1), 123(2), 56

Keyword:
"Basis of decisions - right to be heard"
"Agreement to a decision on the case as it stands"
"Amendments (not admissible)"
"Inventive step (no)"

Decisions cited:
T 0784/91, T 1069/97

Catchword:
-

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Beschwerdekammern | Boards of Appeal | Chambres de recours

Case Number: T 0230/99 - 3.3.3

D E C I S I O N
of the Technical Board of Appeal 3.3.3
of 7 May 2001

Appellant: MONSANTO COMPANY
800 North Lindbergh Boulevard
St. Louis Missouri 63167 (US)

Representative: Bosch, Henry
Monsanto Services International S.A.
Patent Department
Avenue de Tervuren 270/272
Letter Box No. 1
1150 Brussels (BE)

Decision under appeal: **Decision of the Examining Division of the European Patent Office posted 16 October 1998 refusing European patent application No. 94 917 077.3 pursuant to Article 97(1) EPC.**

Composition of the Board:

Chairman: R. Young
Members: A. Däweritz
J. De Preter

Summary of Facts and Submissions

I. European patent application No. 94 917 077.3, based on International application PCT/GB94/01184, filed on 1 June 1994, claiming the priority of 2 June 1993 of an earlier application in Great Britain (9311399.1) and published on 8 December 1994 under No. WO-A-94/28061, was refused by a decision issued in writing on 16 October 1998, for violation of Article 123(2) EPC and for lack of inventive step (Article 56 EPC).

II. On 8 December 1998, a Notice of Appeal against the above decision was lodged by the Appellant (Applicant). The prescribed fee was paid on the same date.

In the Statement of Grounds of Appeal, submitted on 25 February 1999, the Appellant

(i) submitted arguments to overcome the reasons on which the decision under appeal was based and

(ii) requested that the decision under appeal be set aside and that a patent be granted on the basis of the new Claims 1 to 6 enclosed with the Statement of Grounds.

III. In a Communication issued 2 November 2000, the rapporteur of the Board expressed certain doubts as to whether the requirements of Article 123(2) EPC were met, and on the inconsistency between the arguments presented by the Appellant in order to support the presence of an inventive step and the wording of the new claims, in respect of which the Appellant was

invited to file observations within a period of two months. The Appellant was furthermore informed that, in accordance with Article 110(3) EPC, failure to comply with this invitation would result in the application being deemed to be withdrawn.

IV. By letter of 3 January 2001, an extension of time of two months was requested. Within the extra period, in a further letter dated 6 February 2001, the Appellant informed the Board that it did not wish to make any further observations on the Communication of 2 November 2000.

V. No further submission was received within the extended time limit set.

Reasons for the Decision

1. The appeal is admissible.

2. In the Communication dated 2 November 2000, the Appellant was informed in detail that according to a provisional view of the Rapporteur:

2.1 Claim 3 did not fulfil the requirements of Article 123(2) EPC, because a person skilled in the art was apparently presented in that claim with information which was not directly and unambiguously presented by the application as originally filed, even when account was taken of matter which was implicit to a person skilled in the art. This argument was based on the Statement of Grounds of Appeal received on 25 February 1999 (pages 2/3).

2.2 There were doubts with respect to the presence of an inventive step over D2, US-A-4 900 299, having regard to the fact that the arguments in the Statement of Grounds of Appeal relating to this question were not deemed persuasive due to lack of consistency with the wording of the claims and lack of convincing evidence.

3. By letter received on 6 February 2001, the Appellant informed the Board that it did not wish to file further observations on the Communication mentioned above.

4. The Appellant has replied to the official Communication in due time. Therefore, the application is not deemed to be withdrawn in accordance with Article 110(3) EPC.

5. However, given that the Appellant indicated in writing that it did not wish to file further observations on the case, this is construed as signifying agreement to a decision being taken on the case as it stands. In this respect, the present Board follows the approach taken in decisions T 784/91 of 22 September 1993 and T 1069/97 of 24 January 2000, neither published in the OJ EPO.

6. Additionally, the Board observes that up to the extended time limit set for reply to the above Communication, the Appellant has been given sufficient time for presenting arguments in response to that Communication. No further arguments have been submitted and there is no valid reason for the Board to issue a further invitation to the Appellant.

7. Having reconsidered the arguments which were given in the above Communication and which were not challenged by the Appellant, the Board adopts the Rapporteur's

opinion, since there is no valid reason to depart therefrom. Consequently, according to the file as it stands, the request submitted with the Notice of Appeal and with the Statement of Grounds of Appeal cannot be successful, because it has not been demonstrated that Claim 3 does not extend beyond the content of the application as filed nor that the Examining Division's finding of lack of inventive step was wrong.

It follows that the request to set aside the decision under appeal and to grant a patent on the basis of Claims 1 to 6 submitted on 25 February 1999 cannot be complied with.

Order

For these reasons it is decided that:

The appeal is dismissed.

The Registrar: The Chairman:

G. Görgmaier R. Young