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**D E C I S I O N**  
**of 18 July 2003**

**Case Number:** T 0916/99 - 3.3.5

**Application Number:** 95200809.2

**Publication Number:** 0663510

**IPC:** E21B 37/06

**Language of the proceedings:** EN

**Title of invention:**  
Sulfate scale dissolution

**Applicant:**  
EXXONMOBIL OIL CORPORATION

**Opponent:**  
-

**Headword:**  
Scale dissolution/EXXONMOBIL

**Relevant legal provisions:**  
EPC Art. 56, 84, 111(1)(2)  
EPC R. 51(4)

**Keyword:**  
"Objections leading to refusal overcome"  
"Remittal for further prosecution"

**Decisions cited:**  
G 0010/93, G 0010/92

**Catchword:**  
-



Case Number: T 0916/99 - 3.3.5

**D E C I S I O N**  
of the Technical Board of Appeal 3.3.5  
of 18 July 2003

**Applicant:**

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**Representative:**

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**Decision under appeal:**

Decision of the Examining Division of the  
European Patent Office posted 21 April 1999  
refusing European application No. 95200809.2  
pursuant to Article 97(1) EPC.

**Composition of the Board:**

**Chairman:** R. K. Spangenberg  
**Members:** B. P. Czech  
H. Preglau

## Summary of Facts and Submissions

I. The appeal is from a decision of the examining division refusing the European patent application No. 95 200 809.2.

II. In the course of the substantive examination the following documents have been referred to:

D1: JP-A-63-178 199 (as Derwent abstract)

D2: US-A-3 625 761

D3: US-A-3 660 287

D4: US-A-3 684 720

D5: US-A-3 956 164

D6: US-A-4 030 548

D7: US-A-4 215 000

D8: US-A-4 276 185

D9: US-A-4 708 805

In the contested decision, the examining division held that the amended claim 1 underlying the contested decision did not fulfil the requirements of Article 123(2) EPC and that its subject-matter was not based on an inventive step in view of the disclosure of D9.

Under the heading "ADDITIONAL REMARKS", the examining division also indicated that the claims 1 and 2 filed as a first auxiliary request during the oral proceedings of 8 July 1998 (which request was dropped at a later stage) were found to meet the requirements of the EPC. Moreover the examining division stated that "these claims can therefore be the basis for the grant of a patent provided that the applicant approves the text already having been proposed under Rule 51(4) EPC", ie with the communication dated 20 November 1998.

III. With its statement of grounds of appeal, the appellant presented an amended set of claims as a new main request. As first auxiliary request, it requested the grant of a patent on the basis of the set of claims refused by the examining division in the contested decision. As second auxiliary request, it requested oral proceedings. As third auxiliary request, the appellant requested that a patent be granted on the basis of the claims found by the examining division to be allowable (ie the claims according to the first auxiliary request filed during the oral proceedings of 8 July 1998).

IV. The appellant was summoned to oral proceedings. In an annex to the summons, the board *inter alia*

- expressed its reservations concerning the admissibility of the independent claims according to all requests (lack of clarity and support of by the description for the feature "polyaminocarboxylic");

- cited and analysed D9 as well as documents D1 to D8, which it also considered to be of some relevance with respect to the subject-matter of the claims on file; and,
  
- more particularly, considered that it might be arguable whether, in the light of the prior art cited, and in particular of D7, the subject-matter as claimed according to the third auxiliary request could be considered to be inventive by virtue of the achievement of an **unexpected** effect.

V. With its letter dated 28 April 2003 (telecopied 29 April 2003), the appellant requested "that this application be remitted to the examining division with an order to grant the patent according to the Druckexemplar attached to the communication under Rule 51(4) EPC dated 20 November 1998".

Without indicating reasons, the appellant also stated that "despite the comments in the annex to the Summons, paragraph 9", it believed "that the board of appeal does not have the right to overrule the Examining Division insofar as this specification" be "found to meet the requirements of the EPC".

VI. The scheduled oral proceedings were cancelled as suggested by the appellant.

## Reasons for the Decision

1. In the decision under appeal, the claims upon which the present decision is based, ie claims 1 and 2 as filed during the oral proceedings of 8 July 1998, and as attached to the communication under Rule 51(4) EPC dated 20 November 1998, were considered to meet the requirements of the EPC.
2. Since the appellant has withdrawn its main and first auxiliary requests as presented upon appeal, the objections that lead to the refusal of the application and to the filing of the appeal no longer apply.
3. However, the board cannot, for the following reasons, accept the submission of the applicant that the board does not have the right to overrule the earlier positive finding of the examining division concerning the patentability of the present claims.
  - 3.1 According to opinion G 10/93 (OJ EPO 1995, 172, reasons, point 7), which deals with a comparable situation, "the examining division is not bound by the view - whether positive or negative - expressed in the examination pursuant to Article 96(2) EPC. Examination proceedings may be reopened "for whatever reason" after the approval in accordance with Rule 51(4) EPC (see G 10/92, OJ EPO 1994, 633, reasons, 7)". See also the "Guidelines for examination in the European Patent Office", C-VI, 4.11 and 15.1.5. The same must apply to the board of appeal when exercising "any power within the competence of the department which was responsible for the decision appealed" according to Article 111(1) EPC.

- 3.2 Moreover, pursuant to G 10/93 (see Order and Reasons 3), the board has the power to examine whether the application or the invention to which it relates meets the requirements of the EPC, including requirements which the examining division regarded as being met. If the board considers there is a reason to believe that such a requirement has not been met, it shall include this ground in the proceedings.
  
4. After the initial examination of the present appeal case, the board felt that there was still a need to discuss the issues of clarity and inventive step with respect to the claims according to the sole request now on file. In the annex to the summons to attend the oral proceedings, the board pointed out and commented on the specific issues concerned.
  - 4.1 These comments were not dealt with in the appellant's reply. Rather, the board understands from the appellant's submissions that the latter does not wish the board to continue the examination of the case on the basis of the comments made in the annex to the summons to attend oral proceedings.
  - 4.2 Pursuant to the provisions of Article 111(1) EPC, the board, when deciding on the appeal, "may either exercise any power within the competence of the department which was responsible for the decision appealed or remit the case to that department for further prosecution".

- 4.3 The feature "polyaminocarboxylic" as used in present claim 2 has not been objected to by the examining division up to now. In the proceedings before the examining division, D7 has only been addressed in a very general manner, see the application as filed, page 4, lines 3 to 5, and the applicant's letter dated 24 January 1996, page 3, first paragraph. Considering the applicant's request and submissions, and considering that the board's annex to the summons addresses circumstances which are of a type and nature as to (at least) potentially render non-patentable the claimed subject-matter, and which the board therefore considered to require clarification or further investigation, the board considers it appropriate to (partially) comply with the request of the appellant by remitting the case to the examining division for further prosecution (see G 10/93, Reasons 5).
5. The board however wishes to point out that it is up to the examining division to decide whether or not, taking into account the circumstances addressed by the board in its annex to the summons, it will consider it appropriate to pursue or raise objections against the claims on file, based on the board's comments. Since the board has not decided on any particular aspect of the patentability of these claims, there is no corresponding ratio decidendi by which the examining division shall be bound in the sense of Article 111(2) EPC.



**Order**

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

1. The decision under appeal is set aside.
2. The case is remitted to the first instance for further prosecution.

The Registrar:

The Chairman:

U. Bultmann

R. Spangenberg