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D E C I S I O N
of 17 April 2002

Case Number: T 0700/01 - 3.3.3

Application Number: 97402823.5

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IPC: C08F 8/42

Language of the proceedings: EN

Title of invention:
Curable composition

Applicant:
KANEKA CORPORATION

Opponent:

-

Headword:

-

Relevant legal provisions:

EPC Art. 109, 113
EPC 67

Keyword:

"Interlocutory revision - rectification (yes)"
"Basis of decision - right to be heard (no)"

Decisions cited:

J 0032/95, T 0790/98

Catchword:

Particularity of case law concerning a request for refund of the appeal fee after the granting of interlocutory revision (Reasons 3).



Case Number: T 0700/01 - 3.3.3

D E C I S I O N
of the Technical Board of Appeal 3.3.3
of 17 April 2002

Appellant: KANEKA CORPORATION
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Kita-Ku
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Osaka 530-8288 (JP)

Representative: Le Roux, Martine
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Decision under appeal: Decision of the Examining Division of the
European Patent Office posted 21 September 2000
refusing European patent application
No. 97 402 823.5 pursuant to Article 97(1) EPC.

Composition of the Board:

Chairman: R. Young
Members: P. Kitzmantel
J. C. M. De Preter

Summary of Facts and Submissions

I. This appeal, which was filed on 28 November 2000, lies against the decision of the Examining Division dated 21 September 2000, refusing European patent application No. 97 402 823.5 filed on 25 November 1997 in the name of KANEKA CORPORATION, and published under No. 0 844 257. The appeal fee was paid together with the Notice of Appeal and the Statement of Grounds of Appeal was filed on 2 February 2001.

II. The decision under appeal was based on a set of eight claims filed with a submission dated 4 November 1999. Claim 1 reads as follows:

"1. A curable composition comprising the components (A), (B), (C) and (D) below:

(A) an isobutylene polymer which contains in a molecule, at least one alkenyl group capable of hydrosilylation reaction;

(B) a curing agent which contains at least two hydrosilyl groups in a molecule;

(C) a hydrosilylation catalyst; and

(D) an organic compound selected from the group consisting in the α -olefins having 6 to 20, advantageously 8 to 20 carbon atoms which contain, in a molecule, at least one alkenyl or alkynyl group capable of hydrosilylation reaction and the organic compounds which contain in a molecule, one alkenyl or alkynyl group capable of hydrosilylation reaction."

The part of the definition of component (D) "selected from the group consisting in and the organic compounds which contain in a molecule, one alkenyl or alkynyl group capable of hydrosilylation reaction" is essentially identical to the corresponding definition of Claim 1 as filed but for the replacement of the original term "at least one alkenyl ..." by the term "one alkenyl ...".

III. That decision argued that the embodiment of Claim 1 wherein component (D) was defined as "the organic compounds which contain in a molecule, one alkenyl or alkynyl group capable of hydrosilylation reaction" (hereinafter "variant (ii)") was anticipated by the disclosure of documents

D1: EP-A-0 709 403 and

D2: EP-A-0 658 575.

In the Examining Division's view, components (A), (B) and (C) of the curable compositions according to both documents were identical to the corresponding components of Claim 1 of the application in suit and the plasticizing compounds polybutene, α -methylstyrene and liquid polybutadiene mentioned by D1 and D2 as further additives satisfied the definition of component (D) of present Claim 1.

IV. With the Statement of Grounds of Appeal the Appellant submitted four sets of amended claims and requested *inter alia* that the decision under appeal be set aside and that the appeal fee be reimbursed because, in the Appellant's view, the Examining Division in issuing its decision had committed a substantial procedural

violation.

- V. In view of the afore-mentioned amended sets of claims the Examining Division, by its decision dated 6 March 2001, rectified the appealed decision under Article 109(1) EPC but did not allow the Appellant's request for reimbursement of the appeal fee. In that respect the Examining Division referred the case to the boards of appeal.

Reasons for the Decision

1. The appeal is admissible.
2. The decision J 32/95 (OJ EPO 1999, 713) held that "under Rule 67, second sentence, EPC the department of first instance, in the event of an interlocutory revision, can order reimbursement of the appeal fee but cannot refuse it and that the power to do so resides only with the board of appeal" (Reasons, Section 2.4, last paragraph).

Accordingly, it was concluded in lines 10 to 16 of the following Section 2.5 of J 32/95: "If given this situation, it [ie the department whose decision is contested] does not consider the request for reimbursement of the appeal fee to be well-founded, it has to grant interlocutory revision and to remit the request for reimbursement of the appeal fee to the board of appeal for a decision."

The board which issued decision J 32/95 arrived at this conclusion because, in its opinion, Rule 67 EPC revealed "something of a lacuna" with respect to the

instance entitled to decide on the request for reimbursement of the appeal fee (cf. third but last sentence of Section 2.4). This "lacuna", if proper account was taken of the procedural requirements at this juncture, could only be "filled" by the devolution to the boards of appeal of the power to decide on the request for reimbursement of the appeal fee; the reasons being essentially (i) that, according to Article 109 EPC, the department of first instance was only entitled to decide in favour of the Applicant, ie to grant an interlocutory revision (cf. first sentence of Section 2.2.2), (ii) that the remittal to the boards of appeal of the decision concerning the issue of reimbursement of the appeal fee accelerated and facilitated the proceedings for the applicant (first paragraph of Section 2.2.4), and (iii) that such remittal was the only equitable way of procedure for applicants entitled to a refund of the appeal fee (Section 2.2.5).

Decision J 32/95 was followed by decision T 790/98 dated 15 June 1999 which was essentially based on the ground that a strict interpretation of Rule 67 EPC would lead to an inequitable situation for applicants entitled to a refund of the appeal fee.

3. It is a particularity of the above case law, that the lower instance, whilst not being permitted to refuse reimbursement of the appeal fee, is nevertheless permitted, and indeed required, to remit the case to the higher instance, ie the Board of Appeal, for further prosecution in this respect. Whilst the legal situation thus created is novel, not least because the board of appeal is called upon although the decision under appeal has been set aside, the Appellant's

procedural rights are preserved, and in any case the Appellant did not contest the remittal.

As a consequence of this procedural characteristic the board of appeal derives its competence only by the remittal of the request for reimbursement of the appeal fee. This situation is not envisaged by Article 21 EPC which only deals with the composition of boards in the case of an appeal. Moreover, as such a request is accessory to the main request, the remittal predicates that a technical board which would have been competent if no interlocutory revision had been granted is competent to deal with the case.

Finally, such a conclusion is all the more evident in the present case, in which the alleged substantial procedural violation relates to technical issues upon which the refusal of the application was based.

4. The Appellant's request for reimbursement of the appeal fee can only be granted if, in arriving at their decision of refusal, the Examining Division had committed a substantial procedural violation (Rule 67 EPC).
5. According to the decision under appeal, D1 and D2 anticipated the claimed subject-matter because, in the Examining Division's view, their disclosures comprised compositions which not only contained components (A), (B) and (C) but also component (D) of this subject-matter.

In this respect, the decision under appeal set out in paragraphs 4 and 6 of Section II:

"At page 9, lines 29 to 32 polybutene, α -methylstyrene and liquid polybutadiene are explicitly mentioned as plasticizing components, these compounds being particularly distinguished from their hydrogenated equivalents containing no unsaturated bonds, therefore, these plasticizers contain at least one alkenyl group in the molecule." (emphasis by the Board)

"The same arguments apply for D2 (Claims 1 to 10) disclosing at page 5, lines 37 to 41 the same plasticizing compounds as D1 containing at least one alkenyl group in the molecule." (emphasis by the Board)

6. This argumentation contrasts with the fact that variant (ii) of Claim 1 defines component (D) as "the organic compounds which contain in a molecule, one alkenyl or alkynyl group capable of hydrosilylation reaction" (emphasis by the Board).
7. It thus appears that the decision under appeal completely ignored the fact that variant (ii) of Claim 1 had been amended with respect to the corresponding embodiment of original Claim 1 by the substitution of the wording "one alkenyl or alkynyl group" for the original language "at least one alkenyl or alkynyl group" (cf. last paragraph of Section II supra).
8. However, this amendment is not only apparent on a careful reading of Claim 1 but was even highlighted in the Appellant's submission dated 4 November 1999 whose last two paragraphs on page 4 of the attached "Observations" read:

"The documents D1 and D2 do not explicitly disclose an

organic compound containing in a molecule one alkenyl or alkynyl group capable of hydrosilylation reaction (emphasis by the Applicant/Appellant!).

Thus, the disclosure of D1 and D2 does not anticipate the subject matter of variant **(ii)** of the present invention."

9. By the reference in the decision under appeal (cf. statements referred to in point 4 supra) to compounds allegedly having in the molecule "at least one alkenyl group in the molecule", ie to a feature different from the corresponding feature of Claim 1, and by the lack of any reference to the (amended) operative feature of variant (ii) of Claim 1 "one alkenyl group in the molecule", the Examining Division contravened Article 113 EPC.

It can only be speculated if the Examining Division overlooked this amendment, and thus, in contravention of the provision of Article 113(2) EPC, based its decision on a text not submitted and agreed by the Applicant, or if the Examining Division was of the opinion that the amendment had no significance for the assessment of novelty and thus, in contravention of the provision of Article 113(1) EPC, based its decision on a ground on which the Applicant had not had the opportunity to present its comments.

10. In both cases the reasoning of the decision under appeal violates the Applicant's fundamental right to be heard, which conduct amounts to a substantial procedural violation justifying reimbursement of the appeal fee.

Order

For these reasons it is decided that:

The reimbursement of the appeal fee is ordered.

The Registrar:

The Chairman:

E. Görgmaier

R. Young