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**Datasheet for the decision
of 23 May 2024**

Case Number: T 1741/20 - 3.3.10

Application Number: 11822699.2

Publication Number: 2611767

IPC: C07C51/43, C11C1/08

Language of the proceedings: EN

Title of invention:

ELIMINATION OF ORGANOHALO AND OXIRANE SPECIES IN CARBOXYLIC
ACID ESTER STREAMS

Patent Proprietor:

Stepan Specialty Products, LLC

Opponents:

Cargill, Incorporated
Bunge Loders Croklaan B.V.
Kraus & Lederer PartGmbH
AAK AB

Headword:

Relevant legal provisions:

RPBA 2020 Art. 12(4)
EPC Art. 123(3)

Keyword:

Amendment to case - amendment admitted (no)
Amendments - broadening of claim (yes)

Decisions cited:

Catchword:



Beschwerdekammern
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Case Number: T 1741/20 - 3.3.10

D E C I S I O N
of Technical Board of Appeal 3.3.10
of 23 May 2024

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Decision under appeal: **Decision of the Opposition Division of the
European Patent Office posted on 30 June 2020
revoking European patent No. 2611767 pursuant to
Article 101(3) (b) EPC.**

Composition of the Board:

Chair P. Gryczka
Members: R. Pérez Carlón
F. Blumer

Summary of Facts and Submissions

- I. The appellant (patent proprietor) lodged an appeal against the opposition division's decision revoking European patent No. 2 611 767.
- II. Four notices of opposition had been filed on the grounds of added subject-matter, insufficiency of disclosure, lack of novelty and lack of inventive step (Article 100(a), (b) and (c) EPC).
- III. Claim 1 as granted reads as follows:
- "A process of preparing a carboxylic acid ester stream with reduced levels of organohalo, glycidyl or other oxirane species, the process comprising:
adding to the carboxylic acid ester stream an effective amount of a carboxylate anion to react with all of the organohalo, glycidyl and oxirane species present in the carboxylic acid ester stream at a temperature of 80°C to 275°C, wherein the carboxylate anion reacts with the organohalo, glycidyl or oxirane species for a sufficient amount of time to provide a carboxylic acid ester stream with reduced levels of organohalo, glycidyl or other oxirane species."*
- IV. At the beginning of the oral proceedings before the board, which took place on 23 May 2024, the appellant withdrew all requests concerning the patent as granted.

The appellant did not dispute that among the 109 requests filed with its statement of grounds of appeal, only auxiliary requests 2A, 3A and 10D had been before the opposition division, all others being new requests.

Claim 1 of auxiliary request 2A differs from claim 1 of the patent as granted by replacing the feature "*with reduced levels of*" with "*essentially free of*" and by a limitation of the temperature range for the reaction.

Claim 1 of auxiliary request 3A differs from claim 1 of auxiliary request 2A by requiring the stream to comprise less than about 0.5 ppm of the impurities mentioned.

Claim 1 of auxiliary request 10D relates to a process for preparing a triglyceride oil having all other features of claim 1 of auxiliary request 2A.

- V. The opposition division concluded that claim 1 of the patent as granted required the level of organohalo, glycidyl or other oxirane species to be reduced. This requirement was absent from claim 1 of auxiliary requests 2A, 3A and 10D, which thus extended the scope of protection of the patent as granted.

In the context of auxiliary request 1C then pending, the opposition division also concluded that the claimed invention was not sufficiently disclosed for it to be carried out by a skilled person.

- VI. The appellant's arguments were as follows.

The appeal was admissible as the statement of grounds of appeal indicated the reasons for setting aside the impugned decision and the facts and evidence on which the appeal was based.

The auxiliary requests not pending before the opposition division were a reply to the impugned decision. The appellant had no reason to expect a

negative conclusion in view of the preliminary opinion annexed to the summons to oral proceedings before the opposition division. The auxiliary requests should thus be admitted into the proceedings.

Claim 1 of auxiliary requests 2A, 3A and 10D did not extend the scope of protection conferred by the patent as granted. The opposition division's conclusion on this issue arose from an erroneous interpretation of the claimed subject-matter.

VII. The respondents' (opponents) arguments were as follows.

The appellant put forward a fresh case in appeal, and none of its requests should be admitted into the proceedings. The appeal should therefore be held inadmissible.

None of the auxiliary requests filed with the statement setting out the grounds of appeal should be admitted into the proceedings due to their large number and the fact that they should have been filed before the opposition division. In addition, the requests filed for the first time in appeal were not sufficiently substantiated.

The respondents agreed with the opposition division's interpretation of the claimed subject-matter and its reasoning and conclusion on auxiliary requests 2A, 3A and 10D regarding Article 123(3) EPC. Nevertheless, even if the appellant's interpretation of claim 1 were to be considered correct, the conclusion on Article 123(3) EPC should be negative.

The large number of auxiliary requests represented an abuse of procedure which justified a different

apportionment of costs.

VIII. The parties' final requests were as follows.

The appellant (patent proprietor) requested that the decision under appeal be set aside and that the patent be maintained with the claims of one of the auxiliary requests filed with the statement of grounds of appeal.

Respondents I, II, III and IV (opponents 1, 2, 3 and 4) requested that the appeal be dismissed.

Respondent II requested that the appeal be held inadmissible.

Respondents I and II requested that none of the appellant's auxiliary requests be admitted into the proceedings.

Respondents III and IV requested that all the auxiliary requests filed for the first time in appeal not be admitted.

Respondent III requested that the case not be remitted to the opposition division if the decision were set aside or at least that the issue of novelty be examined by the board.

Respondent IV requested remittal in such a case.

Respondent IV requested a different apportionment of costs.

IX. At the end of the oral proceedings, the decision was announced.

Reasons for the Decision

Appeal's admissibility

1. Rule 99(2) EPC requires the appellant to indicate the reasons for setting aside the impugned decision and the facts and evidence on which the appeal is based. The board considered the grounds of appeal to fulfil these criteria and the appeal to be admissible.
2. Respondent II requested that the appeal be rejected as inadmissible. It argued that since the appellant relied on a fresh interpretation of the claimed subject-matter which had not been brought forward before the opposition division, all requests in appeal concerned, in substance, fresh subject-matter, and they should thus not be admitted into the proceedings. Lacking any admissible request, the appeal was inadmissible.

However, the admissibility of an appeal does not depend on whether the board admits the appellant's requests into the proceedings, the appellant's case is ultimately convincing or whether an allegedly fresh interpretation of the claimed subject-matter is admitted under Article 12(4) RPBA (see Case Law of the Boards of Appeal of the EPO, 10th edn. 2022, V.A. 2.6.4.b and c). Even if both the requests and the interpretation were held to be inadmissible, the appeal would not automatically be inadmissible. Be that as it may, some of the appellant's auxiliary request are admissible for the reasons given below.

Admissibility of the appellant's requests

3. The respondents requested that the requests not pending before the opposition division not be admitted into the

proceedings. Respondents I and II further requested that none of the appellant's requests be admitted.

4. Requests filed for the first time in appeal

4.1 It was undisputed that among the requests filed by the appellant with the statement of grounds of appeal, only auxiliary requests 2A, 3A and 10D had been requests before the opposition division. The appellant thus filed in appeal 106 requests which had not been pending before the opposition division.

4.2 The board does not agree with the respondent's argument that the sheer number of fresh requests rendered all the appellant's requests or those not filed before the opposition division inadmissible. A large number of requests is not a sufficient reason to deny admission into the proceedings.

It is, however, incumbent on the appellant to guide the board and the respondents through its requests, all the more if the number of requests is large. This includes identifying in every detail the amendments made, explaining the link between the amendments and the outstanding objections against the patent, and providing reasons for filing some of its requests only in appeal (Article 12(4) RPBA 2020).

The appellant has failed to fulfil these requirements.

4.3 The appellant argued at the oral proceedings that the requests were easily understandable, most amendments arose from combinations of the claims as granted and that those features coming from the description only served to further focus on the core of the invention. The requests filed for the first time in appeal should

thus be admitted into the proceedings.

4.4 The board does not agree.

For example, the appellant considered auxiliary request 1A admissible as claim 1 was identical to claim 1 of request 1C before the opposition division.

However, items b) and c) in claim 5 of auxiliary request 1A in appeal were not in any of the requests dealt with by the opposition division and are thus not addressed in the impugned decision. Although these items were in claim 13 of the patent as granted, the appellant did not defend it in this form (see appealed decision, point I.4).

The statement of grounds of appeal only indicates that claim 1 of auxiliary request 1A is the same as claim 1 of auxiliary request 1C in opposition but does not mention other changes, such as those in claim 5, the implications of the differences on the outstanding issues or why the request was submitted in this form only in appeal.

The appellant thus has failed to fulfil the requirements set by Article 12(4), second paragraph RPBA 2020.

4.5 The reasoning for auxiliary request 1A applies equally to all fresh requests in appeal. The appellant has not provided a comprehensive and complete summary of the amendments made, has not explained the relevance of all the amendments for the outstanding issues and has not provided reasons why the amendments could not have been carried out earlier.

4.6 All the auxiliary requests which had not been pending before the opposition division are thus not admitted into the proceedings.

4.7 The appellant argued at the oral proceedings before the board that it was caught by surprise by the opposition division's decision as its preliminary opinion had been positive. The board is not convinced by this argument. An opposition division may change its view at oral proceedings and accept another party's arguments. This is, in fact, the whole purpose of the hearing. Such an outcome cannot thus be surprising.

5. Auxiliary requests 2A, 3A and 10D

5.1 It was undisputed that only these requests underlay the appealed decision.

5.2 Respondents I and II requested that these requests not be admitted into the proceedings. However, the sole reason provided was the large number of total requests, which the board does not see as a sufficient reason to deny admission of each and every request into the proceedings.

Auxiliary requests 2A, 3A and 10D are part of the appeal proceedings in view of Article 12(2) RPBA 2020.

6. Amendments

6.1 The opposition division concluded that claim 1 of auxiliary requests 2A, 3A and 10D extended the scope of protection of the patent as granted. Claim 1 of the patent as granted related to a process of preparing a carboxylic acid ester stream with reduced levels of organohalo, glycidyl or other oxirane species, which

are in the following grouped as "impurities" for the sake of readability. The method requires treating the stream with a carboxylate anion. In contrast, claim 1 of auxiliary requests 2A, 3A and 10D only required the level of impurities to be low; not reduced, i.e. decreased.

- 6.2 The appellant relied in appeal on a different interpretation of claim 1 which aimed to show that the wording of claim 1 of auxiliary requests 2A, 3A and 10D did not extend the scope of protection.

The board considers the opposition division's interpretation of the claimed subject-matter to be correct, and the respondents requested that the appellant's line of argument based on a different interpretation not be admitted into the proceedings. To the appellant's advantage, the issue of Article 123(3) EPC is examined below accepting the appellant's interpretation. The conclusion is nevertheless negative.

- 6.3 According to the appellant, the feature "reduced" in claim 1 as granted did not set a comparison between the impurity level before and after carboxylate treatment, as concluded by the opposition division. The term "reduced" only required comparing the amount of impurities in the final product of the claimed process with the amount of impurities observed in an analogous process carried out in the absence of added carboxylate.

In view of this interpretation and taking into account that it was undisputed that the impurities defined in claim 1 were inevitably produced if a carboxylic acid ester stream was heated, a skilled person would have

recognised that a process in which the amount of impurities was negligible both at the beginning and at the end of the process was contemplated as an embodiment of the patent as granted.

6.4 The board is, however, not convinced.

The feature "reduced" inevitably requires comparing two different level of impurities, one being lower than the other. According to the appellant's argument, the level of impurities should be lower if carboxylate is used. In contrast, a process leading to a feed substantially free of impurities does not necessarily require a reduction of the impurities.

According to the patent's description, a feed having less than 0.5 ppm of the impurities in claim 1 is "substantially free" from them (see paragraph [0013]). Suppose there are two processes, the first without carboxylate and leading to a feed having 0.2 ppm impurities, the second using carboxylate and leading to 0.4 ppm. The second process allows obtaining a feed substantially free from impurities and is thus according to claim 1 of auxiliary request 2A. It is, however, not according to claim 1 of the patent as granted, even under the appellant's interpretation, as the amount of impurities is not reduced with respect to the first process.

Claim 1 of auxiliary request 2A thus extends the scope of protection conferred by the patent as granted (Article 123(3) EPC).

6.5 The appellant acknowledged that the conclusion would not differ for claim 1 of auxiliary requests 3A and

10D.

7. The board concludes that all the appellant's requests are either not admissible or not allowable. The appeal is thus dismissed.

8. Apportionment of costs

8.1 Respondent IV requested a different apportionment of costs in view of the large number of requests and the appellant putting forward a fresh case in appeal.

8.2 As a rule, each party should bear its own costs. The board sees no reason to depart from this principle in the current case. Neither the large number of the requests nor a different interpretation of the claimed subject-matter is in itself an abuse of procedure.

8.3 The request for a different apportionment of costs is thus refused.

Order

For these reasons it is decided that:

The appeal is dismissed.

The Registrar:

The Chair:



C. Rodríguez Rodríguez

P. Gryczka

Decision electronically authenticated