

Internal distribution code:

- (A) [-] Publication in OJ
- (B) [X] To Chairmen and Members
- (C) [-] To Chairmen
- (D) [-] No distribution

**Datasheet for the decision
of 6 October 2020**

Case Number: R 0002/19

Appeal Number: T 0589/15 - 3.3.03

Application Number: 05791246.1

Publication Number: 1793994

IPC: B29C55/28

Language of the proceedings: EN

Title of invention:

POLYLACTIC ACID BLOWN FILM AND METHOD OF MANUFACTURING SAME

Patent Proprietor:

PLASTIC SUPPLIERS, INC.

Opponent:

Infiana Germany GmbH & Co. KG

Headword:

Fundamental violation of the right to be heard

Relevant legal provisions:

EPC Art. 112a(2)(c), 112a(4), 113(1)
EPC R. 106, 109(2)(a), 109(3)
RPEBA Art. 13, 14(2)

Keyword:

Petition for review - admissible (yes) - obligation to raise objection (no) - review of substantive law excluded - fundamental violation of the right to be heard (no) - clearly unallowable

Decisions cited:

R 0001/08

Catchword:



Große Beschwerdekammer
Enlarged Board of Appeal
Grande Chambre de recours

Boards of Appeal of the
European Patent Office
Richard-Reitzner-Allee 8
85540 Haar
GERMANY
Tel. +49 (0)89 2399-0
Fax +49 (0)89 2399-4465

Case Number: R 0002/19

D E C I S I O N
of the Enlarged Board of Appeal
of 6 October 2020

Petitioner:
(Patent Proprietor)

PLASTIC SUPPLIERS, INC.
2887 Johnstown Road
Columbus, OH 43219 (US)

Representative:

Nederlandsch Octrooibureau
P.O. Box 29720
2502 LS The Hague (NL)

Other party:
(Opponent)

Infiana Germany GmbH & Co. KG
Zweibrückenstrasse 15-25
91301 Forchheim (DE)

Representative:

Kutzenberger Wolff & Partner
Waidmarkt 11
50676 Köln (DE)

Decision under review:

**Decision of the Technical Board of Appeal 3.3.03
of the European Patent Office of
19 December 2018.**

Composition of the Board:

Chairman C. Josefsson
Members: I. Beckedorf
R. Lord

Summary of Facts and Submissions

- I. The petition for review, filed by the patent proprietor (petitioner), lies from the decision of Technical Board of Appeal 3.3.03 (hereinafter: the Board) of 19 December 2018 in case T 589/15 (hereinafter: the decision under review) on an appeal by the opponent against the interlocutory decision of the opposition division posted on 23 January 2015 concerning the maintenance of the European patent No. 1 793 994 in amended form. The Board set the decision under appeal aside and revoked the patent.
- II. The appeal was directed against the finding of the opposition division that the subject-matter of the claimed subject-matter of the petitioner's then new main request was novel over the disclosure of document G3 (US 5 502 158) and inventive in view of the teaching of example 37 of document G3. In appeal, the petitioner as respondent defended the patent in amended form according to said main request and, in the alternative, on the basis of eight auxiliary requests, of which the new auxiliary request 1, was filed at the oral proceedings before the Board.
- III. The Board held oral proceedings on 19 December 2018 and found in the decision under review (with references to the relevant section of the reasons for the decision):
- that the subject-matter of the operative claim 13 of the main request did not involve an inventive step over the teaching of document G3 (point 2);
 - that the new auxiliary request 1 was not admitted into the proceedings (point 3); and
 - that auxiliary requests 2 to 8 did not overcome the objection of lack of inventive step raised against the main request (points 4 and 5).

In the context of the assessment of inventive step the Board found that the petitioner had argued for the first time during the oral proceedings and without providing evidence that it would not be possible to prepare a blown film using the usual blow moulding process used in G3 (point 2.4.4 of the reasons of the decision under review).

- IV. The petitioner, who with the petition for review originally had submitted two complaints, maintained at the oral proceedings before the Enlarged Board only the following alleged procedural deficiency of which they became aware only from the reasoned decision in writing:

Whereas the Board had expressed its preliminary opinion in support of the opposition division's findings that document G3 teaches away from reducing the amount of lactides to less than 10 percent as claimed in claim 13 of the main request, it then decided that the claims of all requests on file lacked inventive step over examples 34 - 39 of document G3 because there was no evidence that it was not possible to prepare a blown film using less than 10 percent lactide as plasticizer. However, if the appellant-opponent or the Board had an issue with that, they should have raised it in a timely manner to allow the petitioner a proper defence. Not doing so amounted to a fundamental violation of the petitioner's right to be heard under Article 113(1) EPC.

The petitioner's essential lines of argument in support of the alleged procedural deficiency will be discussed in detail in the reasons for this decision.

- V. The Enlarged Board as composed under Rule 109(2) (a) EPC issued a communication pursuant to Articles 13 and 14(2) RPEBA informing the petitioner of its preliminary opinion.

VI. The petitioner commented in detail on said communication.

VII. Oral proceedings before the Enlarged Board were held on 6 October 2020 at which the petitioner as the only party essentially repeated their written submissions with supporting arguments and clarified their requests:

that the decision under review be set aside;
that the proceedings before the Board be re-opened; and
that the fee for the petition for review be reimbursed.

The decision was announced at the end of the oral proceedings.

Reasons for the Decision

1. Scope of the petition for review

As clarified by the petitioner at the oral proceedings, the present petition for review is built on the allegation that the appeal proceedings leading to the decision under review involved a fundamental violation of the petitioner's right to be heard (Articles 112a(2) (c) and 113(1) EPC) in that the Board considered the absence of evidence to support the petitioner's argument that PLA blown films with low lactide content (10 percent or less) could not be manufactured by the method of G3 a reason for rejecting said argument and thus for revoking the contested patent. This aspect however had neither been raised by the appellant-opponent nor put to the petitioner by the Board.

2. Admissibility of the petition for review

- 2.1 The petitioner is adversely affected by decision under review. The written decision was notified to the parties by registered letter with advice of delivery posted on 5 February 2019. As the reasoned petition for review was filed and the fee was paid on 8 April 2019, it also complies with Article 112a(4) EPC.
- 2.2 Rule 106 EPC provides that a petition for review under Article 112a(2) (a) to (d) EPC is only admissible where an objection in respect of the procedural defect was raised during the appeal proceedings and dismissed by the Board of Appeal, except where such objection could not be raised during the appeal proceedings.
- 2.2.1 Raising such an objection under Rule 106 EPC is a procedural act and a precondition for access to the extraordinary legal remedy under Article 112a EPC and serves the purpose of giving the Board of Appeal a chance to react immediately and appropriately by either removing the cause of the objection or by dismissing it, thereby ensuring legal certainty for the parties and the public as to whether the ensuing substantive decision of the Board of Appeal is open to review under Article 112a EPC (established case law of the Enlarged Board of Appeal, Case Law of the Boards of Appeal, 9th edition 2019, V.B.3.6, with further references).
- 2.2.2 As is evident from the minutes of the oral proceedings before the Board and from the decision under review, the petitioner did not raise any objection under Rule 106 EPC.

The petitioner rather submits that the need for experimental evidence had never been mentioned in the

entire proceedings. The alleged lack of evidence, as relied on by the Board in the written decision, had not been discussed during oral proceedings. The petitioner first learned from the Board's written decision that the Board considered that the absence of evidence to support the petitioner's argument was a reason for rejecting its argument and thus for revoking the patent. Hence, the petitioner could not have raised an objection during the appeal proceedings, and the exception in Rule 106 EPC should apply.

- 2.2.3 The Enlarged Board concedes that neither the minutes of the oral proceedings before the Board nor the facts and submissions as established in the decision under review contain a clear mention of a need for, or rather the lack of evidence in support of the petitioner's argument.

As far as the petitioner submitted at the oral proceedings before the Enlarged Board that the appellant-opponent had not made any such claim during the appeal proceedings, this issue cannot be finally clarified in the first phase of the petition for review proceedings at which the Enlarged Board shall decide without the involvement of the other party on the basis of the file and of the petitioner's submissions alone (Rule 109(2) (a) and (3) EPC).

- 2.2.4 In this procedural situation, the Enlarged Board assumes in favor of the applicant that the petition for review is at least not clearly inadmissible.

3. Allowability of the petition

- 3.1 It has to be borne in mind that review proceedings under Article 112a(2) (c) EPC are confined to procedural

defects so fundamental as to be intolerable for the legal system and overriding the principle that proceedings that have led to a final decision should not be reopened in the interest of legal certainty and that substantive issues are excluded (consistent case law since R 1/08, not published in the OJ EPO, Reasons 2.1, and the *travaux préparatoires* there cited).

3.2 The petitioner submitted that the Board decided on the appeal in violation of the petitioner's procedural rights in a manner that gave the petitioner no opportunity to effectively respond regarding the required evidence. The petitioner's line of argument in support of this can be summarised as follows:

- (a) The issue of inventive step in view of the teaching of document G3 had been discussed in general, and the relevance of the amount of lactide specifically, during the appeal proceedings, both in writing and at the oral proceedings before the Board.
- (b) The petitioner had argued during the appeal proceedings that the position that PLA blown films with low (10 percent or less) lactide content could not be manufactured by the method of G3.
- (c) That submission had been questioned neither by the appellant-opponent nor by the Board. The appellant-opponent had only argued that it would be obvious to the skilled person to lower the lactide content of the films of G3.
- (d) Neither the appellant-opponent nor the Board, before notifying the fully reasoned decision under review, had mentioned that evidence for the petitioner's position might be required but was lacking.

3.3 This submission is not supported by the course of the appeal proceedings and the appeal file.

3.3.1 Regarding arguments (a) and (b)

The petitioner acknowledged that the issues of inventive of the claimed subject-matter and of the relevance of the teaching of document G3 were discussed in detail by the parties in their mutual written submissions and at the oral proceedings before the Board.

The appellant-opponent in the statement setting out the grounds of appeal (point 5.1 thereof) objected to attributing a decisive effect to the amount of lactide in the PLA blown film and argued that the claimed solution was obvious in view of the teaching of G3, in particular of example 37 thereof.

The Board's communication pursuant to Article 15(1) RPBA 2007, in particular in points 7.2 and 8.3.4 thereof, dealt with this matter. The Board indicated that the

"by-product element of that claim [13] can only be given some weight if it were to be shown to be reflected in the product itself. Considering that it appears that no evidence is on file showing that the process of claim 1 is reflected in any way in the product so obtained other than in the content and type of plasticiser specified in claim 1, it appears that operative claim 13 encompasses any PLA blown film comprising less than 10 percent lactide, as argued by the appellant [opponent] ... That conclusion does not appear to be contested by the respondent",
i.e. the petitioner.

In addition, the Board indicated to the parties to the appeal proceedings that, in the context of inventive step of the claimed subject-matter, it would have *"to be assessed which problem was effectively solved as compared to the closest prior art. In the absence of any improvement, the problem may have to be seen to reside in the provision of a further blown film (claim 13) ... as compared to example 37 of G3."*

Irrespective of this mention in the Board's communication in preparation for the oral proceedings, and even more importantly, the minutes of the oral proceedings show that the parties were heard *i.a.* on the objection of lack of inventive step of the claimed subject-matter of the main request based on document G3 whereby the parties relied on their written arguments.

This is also reflected in point XII. and XIII. of the facts and submissions and in points 2.1 to 2.4.5 of the reasons for the decision under review, and it is also confirmed by the petitioner (points 26 to 28 of the petition). This includes also the petitioner's submission during the appeal proceedings that the position that PLA blown films with low (10 percent or less) lactide content could not be manufactured by the method of G3 (*supra*, point XII.(b), last sentence on page 6, and point 2.4.4, first paragraph).

Hence, the relevance of the claimed amount of lactide as plasticizer in the blown film as claimed in the patent in suit compared to the teaching of G3 had been discussed in the appeal proceedings.

3.3.2 Regarding arguments (c) and (d)

The petitioner criticised that the Board held against the petitioner the fact that they did not provide evidence that it was not possible to prepare a blown film using less than 10 percent lactide as plasticizer.

However, in this respect the petitioner misjudges that it was them, in amending their case only at the oral proceedings (see decision under review, Reasons, points 2.4.4 and 3.4), who submitted this allegation. Thus, the Board's conclusion that it was therefore the petitioner who should demonstrate and prove the correctness of this allegation does not raise any doubt as to the procedural pertinency of the decision under review. Rather, it reflects the general rule that each party to the proceedings bears the onus of demonstration and proof for any contested allegation in its favour.

Furthermore, in point XII.(b), last sentence on page 6 of the facts and submissions, the Board summarised the appellant-opponent's submission that

"(t)here was no evidence on file, nor it could be derived from the information given in G3 that it was not possible to prepare a blown film with a PLA composition comprising less than 10 percent lactide as plasticiser using the process according to example 37 of G3, as argued by the respondent during the oral proceedings before the Board."

Hence, contrary to the petitioner's allegation, the appellant-opponent actually had objected to the petitioner's argument that PLA blown films with low (*i.e.* 10 percent or less) lactide content could not be manufactured by the method of G3.

The correctness of this finding of fact by the Board had not been questioned by the petitioner with the petition for review.

Rather, in point 26 on page 7 of the petition for review the petitioner confirmed that, at the oral proceedings before the Board, the appellant-opponent had argued

"that the skilled person would consider using a composition with reduced amount of lactide for blowing PLA films, based on examples 34 - 39 of G3 ... According to the appellant, the problem with reduced lactide resided solely in the high-MW PLA used in example 34, and not with the actual possibility of film blowing. Thus, when using lower-MW PLA, the skilled person would not add additional lactide and would simply blow a PLA film with reduced lactide according to the appellant's theory. ... The appellant's allegations where [sic] entirely speculation. Furthermore, this was notably the first time throughout the whole proceedings both in opposition and appeal that the appellant made such statements and disputed all that had been said by us with regard to the possibility to blow PLA films with reduced lactide. Understandably, we were not only surprised by these new arguments at such a late stage, but also to later learn that these arguments formed the basis for the Board's decision to revoke the patent."

The Enlarged Board understands from the petitioner's own summary of the proceedings that the petitioner understood the appellant-opponent's line of argument on the relevance and suitability of the method of document G3 to lead the skilled person in an obvious manner to the claimed invention, but did not object to it as

late-filed. The mere surprise that the Board followed the appellant-opponent's arguments does not constitute a ground for petition for review pursuant to Article 112a(2) EPC. That the petitioner was given an opportunity to respond to those arguments has been confirmed in point 27 on page 7 of the petition of review.

It was only in the response to the Enlarged Board's communication pursuant to Article 13 and 14(2) RPEBA that the petitioner claimed that the appellant-opponent had not objected to the petitioner's argument regarding the unsuitability of the method of document G3. At the oral proceedings before the Enlarged Board the petitioner went even further in claiming that the Board erroneously indicated its subjective conclusion as being a submission by the appellant-opponent.

Despite this late amendment of the petitioner's case, the Enlarged Board does not consider this new submission plausible.

The petitioner acknowledged that it had been them who raised the issue of unsuitability of the method of document G3 (see letter of 5 September 2020, page 2, point (1), second paragraph).

Despite the fact that the issue of whether the appellant-opponent had contested the petitioner's argument and had argued that the lack of evidence represented a crucial aspect of the inventive step discussion, an alleged incorrectness of the facts and submission section of the decision under review was not pleaded prior to the oral proceedings, either in the petition for review itself or in the petitioner's

response to the Enlarged Board's communication pursuant to Articles 13 and 14(2) RPEBA.

Even if one were to concede that the appellant-opponent's submissions as summarised in essence in the decision under review do not correspond to their exact wording, what remains is that the appellant-opponent relied on the teaching of document G3 to show that the claimed invention lacked inventive step throughout the opposition appeal proceedings. Since it was the petitioner submitting that the method of G3 was unsuitable, the burden of demonstration and proof for that counter-argument rested with the petitioner.

Consequently, even if the appellant-opponent had not explicitly referred to the lack of evidence in support of the petitioner's allegation of fact, the need for such evidence was nevertheless obvious as directly occasioned by the appellant-opponent's clear line of argument with regard to inventive step.

Hence, the petitioner's own submissions are contradictory as regards the decisive issue of whether the petitioner's allegation concerning the unsuitability of the method of document G3 for arriving at the claimed invention in an obvious manner had been contested by the appellant-opponent. The appeal proceedings show that the petitioner's late argument in amending their case in the petition for review proceedings, according to which the appellant-opponent had neither contested the petitioner's allegation nor addressed the issue of evidence in support of the petitioner's allegation, is not plausible.

3.3.3 Bearing in mind that the Boards of Appeal are not obliged to provide the parties in advance with all

reasons for a decision in detail, Article 113(1) EPC requires that decisions may only be based on grounds or evidence on which the parties concerned have had an opportunity to present their comments (see Case Law of the Boards of Appeal, *supra*, V.B.4.3.8 a), with further references).

In the case at hand there is no doubt that the petitioner had the opportunity to state their case in respect of all the issues on which the decision under review was taken in respect of the relevance of the teaching of document G3 for the assessment of inventive step of the claimed subject-matter. Considering that the petitioner was legally represented and, therefore, should have been familiar with the procedural framework of the appeal proceedings, the petitioner was in a position to defend their rights both as to the procedural and as to the substantive law at all stages of the appeal proceedings. This includes in particular the issue that it was for the petitioner to provide evidence for the alleged unsuitability of the method of document G3 and that the failure to do so could be held against the petitioner. Hence, the respective reasoned finding of the Board against the petitioner could not have been objectively surprising to them.

- 3.4 Consequently, there is no basis for assuming that the petitioner did not have sufficient opportunity to comment exhaustively on all aspects on which the decision was taken. The Enlarged Board cannot establish that the petitioner's right to be heard was infringed by the reasoned finding of the Board in the decision under review that the petitioner had failed to submit persuasive facts and evidence to show the alleged unsuitability of the method of document G3.

Thus, no violation of Article 113(1) EPC was committed by the Board.

- 3.5 Investigating any further would involve a review of the decision under review on the merits. The mere fact that the petitioner does not share the view of the Board and does not accept the outcome of the decision under review cannot justify further elaborating on this, because it would necessitate a review of the merits of the decision, but such a review of the merits would be beyond the scope of the petition for review proceedings as a specific and limited means of redress provided for in the EPC.

4. Conclusions

For the aforementioned reasons the petition for review is clearly unallowable.

Order

For these reasons it is decided that:

The petition for review is unanimously rejected as clearly unallowable.

The Registrar:

The Chairman:



N. Michaleczek

C. Josefsson

Decision electronically authenticated