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**D E C I S I O N**  
**of 13 April 2005**

**Case Number:** T 0620/03 - 3.3.3

**Application Number:** 90900353.5

**Publication Number:** 0495099

**IPC:** C08F 10/00

**Language of the proceedings:** EN

**Title of invention:**

Olefin copolymer and production thereof

**Patentee:**

MITSUI CHEMICALS, INC.

**Opponent:**

THE DOW CHEMICAL COMPANY  
BP Chemicals Ltd  
Basell Polyolefine GmbH  
Exxon Chemical Patents Inc.

**Headword:**

-

**Relevant legal provisions:**

EPC Art. 54(2), 111(1)

**Keyword:**

"Novelty - public prior use (no) - insufficient evidence"  
"Remittal to opposition division"

**Decisions cited:**

T 0194/86, T 0472/92

**Catchword:**

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Case Number: T 0620/03 - 3.3.3

**D E C I S I O N**  
**of the Technical Board of Appeal 3.3.3**  
**of 13 April 2005**

**Appellant:** MITSUI CHEMICALS, INC.  
(Proprietor of the patent) 5-2, Higashi-Shimbashi 1-Chome  
Minato-ku  
Tokyo (JP)

**Representative:** Cresswell, Thomas Anthony  
J.A. KEMP & CO.  
14 South square  
Gray's Inn  
London WC1R 5JJ (GB)

**Respondent 01:** Basell Polyolefine GmbH  
(Opponent 03) Industriepark Höchst  
D-65926 Frankfurt (DE)

**Representative:** -

**Respondent 02:** ExxonMobil Chemical Patents Inc.  
(Opponent 04) 13501 Katy Freeway,  
P.O. Box 3272  
Houston, TX 77079-1398 (US)

**Representative:** -

**Decision under appeal:** Interlocutory decision of the Opposition  
Division of the European Patent Office dated  
12 March 2003 and posted 4 April 2003  
concerning maintenance of European patent  
No. 0495099 in amended form.

**Composition of the Board:**

**Chairman:** R. Young  
**Members:** W. Sieber  
E. Dufrasne

## Summary of Facts and Submissions

I. The mention of the grant of European patent no. 0 495 099, in respect of European patent application no. 90 900 353.5, based on International application no. PCT/JP89/01281, filed on 21 December 1989 and claiming priority from Japanese applications filed on 26 December 1988 (three applications), 24 January 1989 and 21 July 1989, was published on 3 June 1998 (Bulletin 1998/23). The granted patent contained two claims which read as follows:

"1. An ethylene copolymer comprising 60 to 96% by mol of structural units (a) derived from ethylene and 4 to 40% by mol of structural units (b) derived from an  $\alpha$ -olefin of 3 to 20 carbon atoms, and having

- (A) a density of 0.85 to 0.92 g/cm<sup>3</sup>,
- (B) an intrinsic viscosity  $[\eta]$  as measured in decalin at 135°C of 0.1 to 10 dl/g,
- (C) a ratio ( $M_w/M_n$ ) of a weight average molecular weight ( $M_w$ ) to a number average molecular weight ( $M_n$ ) as measured by GPC of 1.2 to 4, and
- (D) a ratio ( $MFR_{10}/MFR_2$ ) of  $MFR_{10}$  under a load of 10 kg to  $MFR_2$  under a load of 2.16 kg at 190°C of 8 to 50.

2. A process for preparing an ethylene copolymer as claimed in claim 1 which process comprises copolymerizing ethylene and an  $\alpha$ -olefin of 3 to 20 carbon atoms in the presence of a catalyst comprising

- [A] a hafnium compound having as a ligand a multidentate compound in which at least two groups selected from indenyl groups or substituted groups

thereof are linked together via ethylene groups or hafnium compounds obtained by treating the above-mentioned hafnium compounds with alkylsilylated silica gel, and

[B] an organoaluminum oxy-compound."

II. Notices of opposition were filed by

- (a) The Dow Chemical Company (opponent 01) on 19 January 1999,
- (b) BP Chemical Limited (opponent 02) on 1 March 1999,
- (c) Elenac GmbH (now Basell Polyolefine GmbH) (opponent 03) on 2 March 1999, and
- (d) Exxon Chemical Patents Inc. (now ExxonMobil Chemical Patents Inc.) (opponent 04) on 2 March 1999,

whereby opponents 01 and 02 withdrew their oppositions in the course of the opposition proceedings.

The grounds of opposition raised were the grounds of Article 100(a) EPC, ie lack of novelty and lack of inventive step, and the grounds of Article 100(b) EPC, ie lack of sufficiency of disclosure. The oppositions were - *inter alia* - supported by the following documents:

D1: EP-A-0 057 891;

D7: *W. Kaminsky et al*, "Isotactic Polymerisation of Olefins with Homogeneous Zirconium Catalysts" in

Transition Metals and Organometallics as Catalysts for Olefin Polymerisation, Springer Verlag (1988), pages 291 to 301;

D9: EP-A-0 164 215;

D9': US-A-4 857 611 (US equivalent to D9);

D11: JP-A-59 051 905 (and Derwent abstract and English translation);

D16: Bill of lading dated 27 May (to Republic Plastics c/o Heisler Compounding);

D17: Bill of lading dated 30 March (to Exxon Chemical Company c/o Colonial Rubber Works);

D27: US-A-3 645 992;

D31: Witness Statement of Ms Debra Lynn Shepherd including Exhibits DLS1 to 10; and

D34: Witness Statement of Dr Henry Wu-Hsiang Yang including Exhibits HWY1 to 3.

III. By an interlocutory decision which was announced orally on 12 March 2003 and issued in writing on 4 April 2003, the opposition division refused the proprietor's main request and auxiliary request 1 and maintained the patent in amended form according to the proprietor's auxiliary request 2.

- (a) The claims of the main request corresponded to the claims as granted, except that in Claim 1 the upper limit of the ratio ( $M_w/M_n$ ) was amended to 3.0.

The claims of auxiliary request 1 corresponded to the claims as granted, except that in Claim 1 the upper limit of the ratio ( $M_w/M_n$ ) was amended to 2.81.

The opposition division refused the proprietor's main request and auxiliary request 1 for lack of novelty in view of the prior use occurring with the sale of Vistalon<sup>®</sup> MDV-746 to Colonial Rubber Works. The evidence relied upon was D17 together with D31 (including Exhibits DLS1 to 10) and D34 (including Exhibits HWY1 to 3).

- (b) The claims of auxiliary request 2 corresponded to the claims of the main request, except that in Claims 1 and 2 the structural units (b) were limited to 1-octene.

The opposition division held that Claims 1 and 2 of auxiliary request 2 met the requirements of the EPC. As regards novelty, it was held that neither the cited documents nor the alleged prior use compounds disclosed all the features of the claimed subject-matter. Furthermore, the claimed subject-matter was neither obvious from a combination of documents D11 and D1 nor from a combination of the commercially available product Vistalon<sup>®</sup> MDV-746 with D1 or D11 or D27.

IV. On 30 May 2003, the proprietor (appellant) filed a notice of appeal against the above decision with simultaneous payment of the prescribed fee. The statement of grounds of appeal was filed on 14 August 2003.

The proprietor (appellant) requested that the decision of the opposition division be set aside and that the patent be maintained on the basis of the set of Claims 1 and 2 entitled "MAIN REQUEST" and filed with the statement of grounds of appeal. These claims were identical to the main request claims considered by the opposition division (point III(a), above). As an auxiliary request, the appellant asked for the appointment of oral proceedings.

The proprietor (appellant) challenged the finding of the opposition division with respect to the prior use occurring with the sale of Vistalon<sup>®</sup> MDV-746 to Colonial Rubber Works and submitted the following further documents:

D35: Figure 1 showing the relationship between molecular weight distribution and flow parameter of the Examples of D9;

D36: Figure 2 showing the relationship between molecular weight distribution and flow parameter of polymers produced using standard Ziegler chemistry;

D37: Listing from Moody's Inventors Service, Inc. for HANNA (M.A.) Co.;

D38: Macromol. Chemie, 90, 229-242 (1966);

D39: Journal of Polymer Science, vol. 56, 485-499  
(1962); and

D40: Extract from ExxonMobil Chemical Company's web  
site.

The appellant's arguments can be summarized as follows:

- (a) The product Vistalon<sup>®</sup> MDV-746, allegedly sold to Colonial Rubber Works, was not made available to the public because Vistalon<sup>®</sup> MDV-746 was not sold unconditionally to Colonial Rubber Works. The shipment to Exxon Chemical Company USA c/o Colonial Rubber Works indicated in D17 and DLS7 of D31 was not a normal sale to a third party because the customer was a part of the Exxon group and no money exchanged hands in the course of this transfer. Furthermore, Vistalon<sup>®</sup> MDV-746 could not be reproduced by the skilled person as would be required under G 1/92 (OJ EPO 1993, 277).
  
- (b) There was insufficient evidence that Vistalon<sup>®</sup> MDV-746 fell within the scope of the claims. The discrepancies between the identity of the shipped polymer (Lot AH61201) and the tested polymer (Lot AN61201) raised serious doubts as to whether the polymer transferred to Exxon Chemical Company USA c/o Colonial Rubber Works was the same as that which was tested by Dr Yang. These doubts were not answered by evidence to the extent that was required in a case of alleged prior use (up to the hilt).



Thus, it had not been shown conclusively that the polymer in question met all the requirements of Claim 1 of the main request. Apart from the identity of the tested polymer, the issue of degradation of the polymer during storage was not addressed and no information had been provided as to how the properties of the Vistalon<sup>®</sup> MDV-746 sample were measured by Dr Yang.

- V. Opponent 03 (respondent 01) presented its arguments with letter dated 27 December 2003 where it agreed with the finding of the opposition division that the subject-matter of the main request lacked novelty in view of the alleged prior use. Furthermore, it put forward that the reproducibility of a commercial product was not decisive for the question whether or not such a commercial product was made available to the public.
- VI. Following a communication from the board, dated 19 January 2005 and accompanying a summons to oral proceedings, opponent 04 (respondent 02) which had not submitted any argument or request in the appeal proceedings so far informed the board by letter dated 25 February 2005 that it did not intend to be represented at the oral proceedings.
- VII. By letter dated 11 March 2005, the proprietor (appellant) submitted four claim sets as auxiliary requests 1 to 4, to be considered in that order. However, these auxiliary requests are not of importance for this decision and, consequently, they will not be considered in further detail.

In addition, the following documents were submitted:

D41: A summary of data appearing in submissions of the parties including details of the procedure used in D7; and

D42: An English translation of an extract from a decision of the Tokyo High Court regarding the Japanese patent corresponding to the patent in suit.

VIII. On 13 April 2004, oral proceedings were held before the board where opponent 04 (respondent 02) was, as announced, not represented. Because it had been duly summoned, however, the oral proceedings were continued in its absence in accordance with Rule 71(2) EPC.

Both the proprietor (appellant) and opponent 03 (respondent 01) requested at the oral proceedings, in the event the board would not support the finding of the opposition division on the prior use occurring with the sale of Vistalon<sup>®</sup> MDV-746 to Colonial Rubber Works, that the case be remitted to the first instance for further prosecution of any other issue, eg the other two alleged prior uses, novelty in particular over D7 and D9 and inventive step. Consequently, the discussion focussed only on the alleged prior use occurring with the sale of Vistalon<sup>®</sup> MDV-746 to Colonial Rubber Works.

The proprietor (appellant) essentially relied on its detailed written submissions.

Opponent 03 (respondent 01) could not provide further details as regards the alleged prior use since it was opponent 04 (respondent 02) which had filed the prior use objection during the opposition proceedings. Nevertheless, it argued that it was conceivable in industry that a sale took place at no cost.

IX. The proprietor (appellant) requested that the decision under appeal be set aside and the patent be maintained on the basis of the set of Claims 1 and 2 entitled "MAIN REQUEST" and filed with the statement of grounds of appeal on 14 August 2003 or, in the alternative, on the basis of auxiliary requests 1 to 4, all filed with letter of 11 March 2005.

Opponent 03 (respondent 01) requested that the appeal be dismissed.

Opponent 04 (respondent 02) did not file any request.

Furthermore, the parties attending the oral proceedings, ie the proprietor (appellant) and opponent 03 (respondent 01), requested, in the event the board would not support the finding of the opposition division on the prior use of Vistalon<sup>®</sup> MDV-746 by sale to Colonial Rubber Works, that the case be remitted to the first instance for further prosecution.

## Reasons for the Decision

1. The appeal complies with Articles 106 to 108 EPC and Rule 64 EPC and is therefore admissible.

### *Main request*

2. *Amendments*

The claims of the main request, which are identical with the main request claims considered by the opposition division (point III(a), above), correspond to the claims as granted, except that in Claim 1 the upper limit of the ratio ( $M_w/M_n$ ) was amended to 3.0. Although the decision under appeal is silent with respect to the allowability of the amendment in Claim 1, it is evident from the minutes of the oral proceedings before the opposition division that opponents 03 and 04 raised no objections under Article 123(2) and (3) EPC against the amendment. The board sees no reason to depart from that view, in particular because a basis for the amendment can be found on page 18, line 13 of the application as originally filed (page 5, line 47 of the patent in suit). Since, furthermore, no objection under Article 84 EPC arises out of the amendment, the amendment to Claim 1 is allowable.

3. *Prior use*

- 3.1 It is noted that the decision under appeal has not dealt with the patentability of the subject-matter of the main request claims except with regard to the allegation of prior use occurring with the sale of Vistalon<sup>®</sup> MDV-746 to Colonial Rubber Works. The

proprietor (appellant) challenged the opposition division's finding to refuse the main request in view of this prior use.

3.2 In accordance with the jurisprudence of the boards of appeal (eg T 194/86 of 17 May 1988, unpublished; point 2 of the reasons), in order to decide whether an alleged prior use is comprised in the state of the art it is necessary to establish

(i) the date on which the alleged prior use occurred;

(ii) exactly what was used; and

(iii) under what circumstances the alleged use occurred, eg place of alleged use, possible secrecy agreements.

3.3 As regards the date on which the alleged prior use occurred, exhibit DLS6 of D31, a copy of invoicing information which was generated from Exxon's computerised invoicing system and stored on microfiche records, shows that a shipment of four quantities of polymer (10786, 10806, 6140, 1700) was made to Colonial Rubber Works Inc on 30 March 1987. However, the type of polymer that was shipped is not apparent from this document. This missing element is provided by the bill of lading DLS7 of D31 (identical with D17). This bill of lading records that four quantities of polymer (10786, 10806, 6140, 1700) were sold to Exxon Chemical Company USA c/o Colonial Rubber Works whereby two of these four quantities were of MDV-746, one of 11 boxes of lot number AH61201 (ie 6140), the other of 3 boxes of lot number AJ61201 (ie 1700).

- 3.3.1 It is noted that no year is shown on the bill of lading DLS7 of D31, at least not in the format in which it was submitted during the opposition proceedings, but merely the month and the day, ie 03/30. Since, however, the four quantities of polymer, the product codes, the customer and the day and the month indicated in DLS7 of D31 correspond with the data in DLS6 of D31, the board accepts that both DLS6 of D31 and DLS7 of D31 record the same transfer of polymer occurring on 30 March 1987 to Colonial Rubber Works.
- 3.3.2 Thus, the evidence on file demonstrates that a transfer of one quantity of Vistalon<sup>®</sup> MDV-746 (ie 6140) of 11 boxes of lot number AH61201 and another quantity of Vistalon<sup>®</sup> MDV-746 (ie 1700) of 3 boxes of lot number AJ61201 occurred on 30 March 1987 to Colonial Rubber Works.
- 3.4 In order to demonstrate exactly what was used, Ms Debra L. Shepherd, a Vistalon technical sales representative with ExxonMobil Chemical Company, located a box of Vistalon<sup>®</sup> MDV-746 from lot AN61201 at Linden Warehouse and Distribution ("Linden Warehouse"), an off-site warehouse located in New Jersey with which ExxonMobil Chemical Company has a contract (D31, point 4). She requested Mr Gerald Michaud from Bennett Testing, an analytical testing and consulting service, to retrieve a 5 lb sample of Vistalon<sup>®</sup> MDV-746, lot AN61201, from Linden Warehouse and to send it directly to Dr Henry Yang at the Baytown Polymers Center (DLS1 of D31). In a confirmation report from Bennett Testing (DLS2 of D31), Mr Michaud stated that a 5 lb sample of Vistalon<sup>®</sup> MDV-746, lot AN61201 and box number B612015729, had

been sent to Dr Henry Yang. Dr Henry Yang, a senior staff engineer in the Basic Chemicals and Intermediates Technology Group at ExxonMobil Chemical Company at the Baytown Polymer Center, analysed the 5 lb sample of Vistalon<sup>®</sup> MDV-746, lot AN61201, and found that this polymer met the requirements of Claim 1 of the main request: ethylene-propylene copolymer with an ethylene content of 81.2 mol%, a density of 0.874 g/cm<sup>3</sup>, an intrinsic viscosity of 1.61 dl/g, a  $M_w/M_n$  ratio of 1.93 and a  $MFR_{10}/MFR_2$  ratio of 9.75 (D34).

- 3.4.1 However, there is a discrepancy between the identity of the polymer transferred to Colonial Rubber Works and that on which the tests were carried out. Thus, Dr Yang carried out the tests on a sample of Vistalon<sup>®</sup> MDV-746 of lot AN61201 whereas the samples shipped to Exxon Chemical Company USA c/o Colonial Rubber Works were Vistalon<sup>®</sup> MDV-746 of lot AH61201 and of lot AJ61201, respectively.
- 3.4.2 The opposition division indicated in the decision under appeal that opponent 04 made credible that AN61201 must read AH61201. Because there never existed a lot AN61201, the use of "N" instead of "H" must be based on a clerical error. In this context, the opposition division referred to DLS3 of D31, a list of computerised records of shipping records from Wilson Warehouse, located in Baton Rouge, Louisiana. This list did not record Vistalon<sup>®</sup> MDV-746 with a lot number AN61201.
- 3.4.3 However, this list cannot demonstrate that Vistalon<sup>®</sup> MDV-746 with the lot number AN61201 never existed. Firstly, DLS3 of D31 is a list from the Wilson

Warehouse whereas the sample tested by Dr Henry Yang was retrieved from the Linden Warehouse. The non-existence of lot AN61201 at the Wilson Warehouse cannot demonstrate the non-existence of such a lot at the Linden Warehouse. Secondly, there is nothing in the witness statement of Ms Shepherd (D31) itself which could demonstrate or even suggest that a lot AN61201 never existed. To the contrary, Ms Shepherd tried to retrieve from the very beginning a sample of Vistalon<sup>®</sup> MDV-746 with the lot number AN61201 (D31, point 4). Such a lot number was found at the Linden Warehouse and a sample thereof was analysed (point 3.4, above). Why Ms Shepherd searched for a Vistalon<sup>®</sup> MDV-746 with the lot number AN61201 and not for a Vistalon<sup>®</sup> MDV-746 with the lot number AH61201 or AJ61201 which were actually transferred to Colonial Rubber Works could not be clarified because opponent 04 (respondent 02) neither gave further explanations in the written procedure nor was it present at the oral proceedings before the board.

- 3.4.4 Furthermore, it is conspicuous to the board that the witnesses of opponent 04 (respondent 02) did not rely only on a clerical error for the occurrence of the discrepancy. Since the two letters in the lot number are an indication of the "slice" of quality of that particular sample of polymer (D31, point 11), Ms Shepherd put forward another possible reason for the occurrence of the discrepancy in lot number, namely that "the quality designation for this sample may have been changed after shipment" (D31, point 15). If this is so, the use of "N" instead of "H" is not due to a clerical error, but rather due to an initial inaccurate quality designation, or, perhaps, due to changes in the polymer properties. In either case, it is admitted by



the employee of opponent 04 (respondent 02), Ms Shepherd, that the difference in lot number might indeed be due to a difference in the properties of the polymer. This is confirmed by Dr Yang in his witness statement where he discusses the possibility of the difference in the lot number reflecting a difference in the properties of the polymer (D34, point 13). Dr Yang indicates that a likely explanation for the allocation of different two letter codes to two polymers would be to reflect a variation in Mooney viscosity, but suggests that the sample would have fallen within the claimed range for intrinsic viscosity, even accounting for the likely change in Mooney viscosity between AH and AN quality designations (D34, point 14). However, no comment is made regarding the difference in molecular weight distribution or melt flow ratio (which is connected to the degree of long chain branching). Thus, there is no evidence that the polymer transferred to Exxon Chemical Company USA c/o Colonial Rubber Works has a molecular weight distribution or melt flow rate ratio which falls within the scope of the main request claims.

- 3.4.5 In summary, there are serious doubts as to whether the polymer Vistalon<sup>®</sup> MDV-746 shipped to Exxon Chemical Company USA c/o Colonial Rubber Works falls within the scope of Claim 1 of the main request. Given the requirement for prior use allegations to be proven up to the hilt, in particular in the case of a prior use by the opponent themselves (eg T 472/92, OJ EPO 1998, 161; point 3.1 of the reasons), these serious doubts must lead to the conclusion that no lack of novelty has been sufficiently proven in the context of the alleged prior use.

3.5 As regards the circumstances of the alleged prior use, the proprietor (appellant) contested that Vistalon<sup>®</sup> MDV-746 was sold unconditionally to Colonial Rubber Works on 30 March 1987 as stated in the decision under appeal. In fact, there are several strands of evidence which support the proprietor's (appellant's) view that the shipment to Colonial Rubber works does not amount to a straightforward sale to a third party.

3.5.1 The bill of lading DLS7 of D31 indicates that the shipment of polymer was consigned to Exxon Chemical Company USA. The shipment was made "c/o Colonial Rubber Works" as the delivery address but there is certainly no evidence of any **sale** to Colonial Rubber Works themselves.

In this regard it is noted that the second prior use alleged by opponent 04 (respondent 02) is a "sale" to Republic Plastics. The bill of lading DLS5 of D31, which has been provided as evidence of this alleged prior use, indicates that the rubber was consigned to Republic Plastics c/o Heisler Compounding, ie the consignment was to be delivered into the care of Heisler Compounding who would hold it on behalf of the new owner, Republic Plastics. Opponent 04 (respondent 02) themselves stated that this second alleged prior use was a sale to Republic Plastics and made no suggestion there was any sale to Heisler Compounding. DLS4 of D31, which is a copy of an invoice for the sale to Republic Plastics provides corroboration that the sale was to Republic Plastics.

3.5.2 If, on the one hand, the shipment to Republic Plastics c/o Heisler Compounding represents a sale to Republic Plastics (actually supported with an invoice) it cannot be correct to argue that the shipment consigned to Exxon Chemical Company USA c/o Colonial Rubber Works was a sale to Colonial Rubber Works (unsupported by any invoice). On the contrary, it appears that the bill of lading DLS7 of D31 relates to a consignment to Exxon Chemical Company USA.

3.5.3 Further evidence relating to the shipment c/o Colonial Rubber Works is provided by exhibit DLS6 of D31, a copy of invoicing information which was generated from Exxon's computerised invoicing system and stored on microfiche records (see also point 3.3, above). Inspection of the relevant column in DLS6 reveals that no money whatsoever changed hands in relation to this shipment (price; .000000).

It may be conceivable, as argued by opponent 03 (respondent 01) at the oral proceedings before the board, that a sale took place at no cost. However, it also may be that Colonial Rubber Works were not charged because they were merely handling the material on behalf of the consignee or that the consignee, another Exxon company, did not have to pay as this was an internal transfer within the group and not an arm's length sale to a third party.

3.5.4 In summary, the circumstances of the transfer of Vistalon<sup>®</sup> MDV-746 with the lot numbers AH61201 and AJ61201 remain unclear because, firstly, the "customer" was apparently a part of the Exxon group, and secondly, no money exchanged hands in the course of this transfer.

The evidence on file therefore strongly suggests that the transfer of Vistalon<sup>®</sup> MDV-746 to Exxon Chemical Company c/o Colonial Rubber Works was an internal transfer of goods and that the product was not at any stage made available to the public.

- 3.6 In conclusion, there is insufficient evidence on file that Vistalon<sup>®</sup> MDV-746 (with lot numbers AH61201 and AJ61201) transferred to Exxon Chemical Company c/o Colonial Rubber Works falls within the scope of Claim 1 of the main request. Furthermore, the circumstances under which the alleged prior use occurred remain unclear which gives rise to serious doubts as to whether the material transferred was made available to the public. Since the alleged prior use already fails for these reasons, it is not necessary for the board to decide on the questions as to whether Vistalon<sup>®</sup> MDV-746 could be reproduced by the skilled person or degraded during storage (points IV(a) and (b), above).

Hence, the subject-matter of Claim 1, and by the same token the subject-matter of Claim 2, of the main request are novel over the allegation of prior use by "sale" of Vistalon<sup>®</sup> MDV-746 (with lot numbers AH61201 and AJ61201) to Exxon Chemical Company USA c/o Colonial Rubber Works.

4. *Remittal to first instance*

- 4.1 It is apparent from the decision under appeal that the opposition division has not dealt with the patentability of the subject-matter of Claims 1 and 2 of the main request except with the alleged prior use discussed above. No decision was taken on other matters

relevant to the patentability of the subject-matter of the main request claims, eg the other two alleged prior uses, novelty over the cited documents, in particular over D7 and D9, and inventive step. Therefore, these matters constitute new issues. Under those circumstances, a case is normally remitted to the first instance in order not to deprive the parties of the opportunity to have all facts of a case considered by two instances.

- 4.2 Furthermore, the proprietor (appellant) expressly requested, despite the fact that the patent in suit is due to expire in less than five years time, that the case be referred back to the opposition division for further prosecution in the event the board would not support the finding of the opposition division occurring with the sale of Vistalon<sup>®</sup> MDV-746 to Colonial Rubber Works.

In this connection, opponent 03 (respondent 01) also adopted this request of the proprietor (appellant) (point IX, above).

- 4.3 Hence, the board considers it appropriate to exercise its power under Article 111(1) EPC to remit the case to the first instance.

**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 on the basis of the set of Claims 1 and 2 entitled "MAIN REQUEST" and filed with the statement of grounds of appeal on 14 August 2003.

The Registrar:

The Chairman:

E. Görgmaier

R. Young