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**Datasheet for the decision  
of 25 January 2011**

**Case Number:** T 0933/10 - 3.3.03

**Application Number:** 05021885.8

**Publication Number:** 1772486

**IPC:** C08L 23/04

**Language of the proceedings:** EN

**Title of invention:**

POLYETHYLENE COMPOSITION FOR INJECTION MOULDING WITH IMPROVED  
STRESS CRACK/STIFFNESS RELATION AND IMPACT RESISTANCE

**Applicant:**

Borealis Technology Oy

**Headword:**

Venue of oral proceedings - request for change

**Relevant legal provisions:**

EPC Art. 4, 6, 10(2)(b), 113(1)  
EPC R. 111(2)

**Keyword:**

"Substantial procedural violation (i): decision not reasoned"  
"Substantial procedural violation (ii): argument not taken  
into account"  
"Reimbursement of the appeal fee - (yes)"  
"Venue of oral proceedings - request for change"

**Decisions cited:**

T 0493/88, T 0052/90, T 0292/90, T 1012/03, T 1123/04

**Catchword:**

See point 3 of the reasons



Case Number: T 0933/10 - 3.3.03

**DECISION**  
of the Technical Board of Appeal 3.3.03  
of 25 January 2011

**Appellant:** Borealis Technology Oy  
P.O. Box 330  
FI-06101 Porvoo (FI)

**Representative:** Kador & Partner  
Corneliusstrasse 15  
D-80469 München (DE)

**Decision under appeal:** Decision of the Examining Division of the  
European Patent Office dated 8 December 2009  
and posted 22 December 2009 refusing European  
application No. 05021885.8 pursuant to Article  
97(2) EPC.

**Composition of the Board:**

**Chairman:** R. Young  
**Members:** M. C. Gordon  
C. Vallet

## Summary of Facts and Submissions

- I. European Patent Application no. 05021885.8 filed on 7 October 2005 and published on 11 April 2007 as EP 1 772 486 A1 in the name of Borealis Technology Oy was refused by a decision of the examining division dated 8 December 2009 and posted on 22 December 2009.
- II. During the course of the examination proceedings the examining division issued on 2 July 2009 a summons to attend, on 8 December 2009, oral proceedings at the EPO in Rijswijk (The Hague).

By letter dated 11 August 2009 the applicant submitted:  
*"Our client is concentrating its patent activity in Munich and it is therefore respectfully requested to hold the oral proceedings scheduled for December 8, 2009 in Munich instead of Rijswijk."*

In a "Brief Communication" (EPO form 2008A) dated 1 September 2009 the examining division stated:  
*"The Oral proceedings will take place as planned in Rijswijk. It is not foreseen for the examining division, which is located in Rijswijk, to travel to Munich for Oral Proceedings during the examination procedure."*

In a letter dated 30 November 2009 the applicant confirmed, following a telephone conversation with the primary examiner, that it would neither attend nor be represented during the oral proceedings if the oral proceedings took place in The Hague. However for the case that the oral proceedings would take place in Munich it was indicated that the applicant would be represented during the oral proceedings.

The decision of the examining division records in the final paragraph of the "Summary of Facts and Submissions":

*"In preparation for the oral proceedings the applicant filed a reply on 11-08-2009 and 30-11-2009 and requested to hold the oral proceedings in Munich instead of Rijswijk. The Applicant further stated that he neither will attend or be represented during the oral proceedings if the oral proceedings take place in The Hague."*

In the first paragraph of the Reasons for the Decision it is stated:

*"The present decision is based solely on the grounds of lack of novelty (Art. 52 and 54 EPC), lack of inventive step (Art. 56 EPC) and clarity (Art. 84 EPC) which was communicated to the applicant with the communication dated 05-02-2008 and the summons for oral proceedings dated 02-07-2009. The applicant did not attend the oral proceedings and further evidence was not provided by the applicant.[...] Refusal of the application at this stage is justified and does not violate the applicants right to be heard (Art. 113(1) EPC)."*

The remaining reasons of the decision deal with the substantive aspects of the application, i.e. Art. 54, 56 and 84 EPC.

- III. The applicant filed a notice of appeal against the decision on 19 February 2010, the prescribed fee being paid on the same day.

IV. The statement of grounds of appeal was received on 13 April 2010.

The appellant/applicant made the following requests (emphasis in the following is the appellant's):

"1.1 that the decision under appeal be set aside and the case be remitted to the Examining Division for further prosecution on the basis of the set of claims and the description underlying the appealed decision with the order to conduct oral proceedings at the EPO in Munich;

1.2 auxiliarily that the following question concerning an important point of law be referred to the Enlarged Board of Appeal in accordance with Art. 112(1)(a) EPC:

*"Can a request by a party to conduct oral proceedings at the European Patent Office in Munich instead of at the branch office in The Hague be denied?"*

and

1.3 auxiliarily that the decision under appeal be set aside and the case be granted on the basis of the set of claims and the description underlying the appealed decision."

(a) The appellant/applicant considered that the decision of the examining division was based on a procedural error because Art. 113 EPC, namely the right to be heard had been violated:

- With reference to the first paragraph of the reasons for the decision (cited in section II, above), it was observed that no reasons had been

given why the examining division was of the opinion that the right to be heard had not been violated;

- It followed from the EPC that the applicant was entitled to request oral proceedings at the European Patent Office in Munich. A refusal of this request amounted to a violation of the right to be heard under Art. 113(1) EPC.
- (b) With respect to the entitlement to have oral proceedings in Munich the appellant/applicant essentially argued as follows:
- The European Patent Office had its seat in Munich;
  - This could be derived directly from Art. 4 EPC and Art. 6 EPC.
  - In particular according to Art. 4(2) EPC it followed that the European Patent Office was part of the European Patent Organisation which according to Art. 6(1) EPC had its "headquarters", which term was synonymous with "seat", in Munich.
  - From this it followed that the seat of the Office could only be in Munich;
  - Oral proceedings according to Art. 116 EPC had to be conducted at the seat of the Office, this being the place of interaction between the Office and users of the patent system, in this case the applicant;
  - Nowhere in the EPC was there any indication that the Office might be free to conduct oral proceedings elsewhere than at the seat of the Office, be it at a branch according to Art. 6 EPC or a sub-office according to Art. 7 EPC, or

any other place the Office might deliberately choose;

- Decision T 1012/03 (1 December 2006, not published in OJ EPO) was based on similar facts;
- The Board however in that case had concluded that:

*"It is legally incorrect to conclude that the European Patent Office has a seat at Munich in the narrow legal sense set out in paragraph 27 above"* (reference being made by the appellant/applicant to points 27 and 28 of the cited decision).

In point 27 of the decision the deciding board had concluded *"In this case the term "seat" only defines where an entity is located and does not mean that this location is a legal seat where specific juridical acts can be performed"*.

- This logic was difficult to follow since Art. 4 EPC and Art. 6(1) EPC clearly defined the legal seat of the Office being part of the Organisation (Art. 4(2) EPC) having its seat in Munich (Art. 6(1) EPC);
- The Office, although not a legal entity in itself was part of a legal entity - the Organisation - which had its seat in Munich;
- The fact that the Office had its seat in Munich was reflected in many published commentaries on the EPC, a number of which were cited.

(c) The appellant/applicant also presented considerations relating to Art. 10(2)(b) EPC which can be summarised as follows:

- In T 1012/03 the deciding board appeared to interpret Art. 10(2)(b) EPC 1973 in such a way

that the President was free to decide where oral proceedings take place.

- This went far beyond what Art. 10 EPC was about;
  - Art. 10 EPC concerned the management of the Office but did not provide any legal basis for interfering with rights originating from the fact that the Office had its seat in Munich;
  - The President was to this extent bound by the EPC which was *expressis verbis* mentioned in Art. 10(2)(b) EPC itself with the wording "*unless this Convention provides otherwise*";
  - The Convention provided that the seat of the Office was in Munich and consequently all legal consequences originating from the seat being in Munich had to remain unaffected by the President's management under Art. 10 EPC.
- (d) The first auxiliary request - numbered "1.2" in the submissions of the appellant/applicant - see section IV, above - was for a question of law to be put to the Enlarged Board pursuant to Art. 112(1)(a) EPC, namely:

*"Can a request by a party to conduct oral proceedings at the European Patent Office in Munich instead of at the branch office in The Hague be denied?"*

This question was of general interest for all users of the Office and was a point of law of fundamental importance because it was a decisive matter whether the applicant had the right that oral proceedings be conducted in Munich or whether the Office was free in selecting the location for oral proceedings, be it at a branch, a sub-office or any other location in Europe.



(e) Submissions were also made with respect to matters pertaining to Art. 54, 56 and 84 EPC.

V. The Board issued, on 29 October 2010, a summons to attend oral proceedings.

In a communication dated 16 November 2010 the Board presented its preliminary, provisional view with respect to substantive matters (Art. 84, 54 and 56 EPC).

Further, in relation to Art. 113(1) EPC/venue of the oral proceedings, the Board stated that the issue of the venue of the oral proceedings before the first instance would be discussed in particular in relation to the findings of decision T 1012/03, referred to by the appellant in its statement of grounds of appeal (See section IV.(b) and (c), above).

VI. In a letter dated 20 December 2010 the Appellant/Applicant noted:

- The procedural mistake pursuant to Art. 113(1) EPC had not been addressed in any detail in the Board's communication;
- This violation of Art. 113 EPC was however the basis for two of the appellant's pending requests, numbered 1.1 and 1.2 (see section IV, above).
- Not remitting the case back to the examining division to correct the fundamental violation was in itself to be regarded as a fundamental violation of Art. 113 EPC giving rise to a possible petition under Art. 112 [*sic*] EPC.

VII. Oral Proceedings were held before the Board on 25 January 2011.

(a) Regarding the general background to the case, the appellant/applicant submitted essentially as follows:

- The client company had its principal research activities in Austria;
- The firm of representatives appearing before the Board, which was the main one employed by the appellant/applicant, was located in Munich;
- It was reasonable for the appellant/applicant to request oral proceedings in Munich since this was easier to reach than The Hague;
- Even if only the representative attended the oral proceedings the client still had to bear the travel and associated costs incurred;
- This was not reasonable especially in the current economic climate.

(b) With respect to the request for having oral proceedings in Munich the appellant/applicant emphasised that this was well justified. In making these submissions the appellant/applicant essentially rehearsed the submissions made in the statement of grounds of appeal relating to the seat of the office in particular with reference to the findings of T 1012/03 (see sections IV.(b) and (c), above) and concluded that as a consequence of these considerations, the client would be surprised by the rejection of a request to hold oral proceedings in Munich instead of The Hague.

(c) There had to be good reasons - clearly and unequivocally based on the EPC - for refusing such a request:

- Such reasons might be that there existed provisions, e.g. prescriptions or directives, which meant either that it was possible to hold an oral proceedings in The Hague or alternatively which obliged the examining division to reject a request for a change of venue;
- No such provisions in the EPC existed;
- The representatives were entitled to have good reasons - clearly and unequivocally based on the EPC - for having such requests for a change of venue rejected so that these could be communicated to the client companies;
- Under the present situation however the burden was on the representatives to justify this situation to their clients.

(d) The applicant/appellant also presented more detailed considerations relating to Art. 10(2)(b) EPC and in particular the question of the possibility of further provisions existing regarding the venue of oral proceedings. These can be summarised as follows:

- It was known that there were examining divisions in The Hague;
- However the appellant/applicant was not aware that the President had prescribed that oral proceedings were to be held in The Hague;

- Such a prescription would necessitate application of Art. 10(2)(b) EPC;
- However even if such a prescription did exist this would not be sufficient to deal with the situation in cases such as the present one where oral proceedings had been summoned for The Hague but a request made by the party to hold the oral proceedings at Munich instead had been refused;
- For the Office to refuse such a request would necessitate that the President had further prescribed - invoking the powers under Art. 10(2)(b) EPC - that such requests were to be refused;
- However the appellant/applicant was not aware that such a prescription existed;
- In any case it was not sufficient that such a prescription or directive of the President was merely a theoretical possibility but it had to have been issued and in effect on the date that the decision under appeal had been taken, i.e. 8 December 2009;
- There was however nothing either in the Articles or Rules of the EPC, nor was there any official notification from the EPO from which anything to this effect relating to the venue of oral proceedings could be derived;
- Finally Art. 10(2)(b) EPC contained the proviso "unless this Convention provides otherwise". Consequently any such prescription of the President to reject a request to hold an oral proceedings at Munich, i.e. at the seat would itself be against the convention.

(e) With respect to the decision under appeal the appellant/applicant noted:

- No reasons at all had been given for rejecting the request regarding location of the oral proceedings;
- In the section of the decision relating to Art. 113 EPC it was not explained why refusal of this request was justified;
- No reasons could be deduced from the decision on which Article the rejection of the request was based. None of Art. 4, 6 or 10(2)(b) EPC could provide a basis for the rejection of the request;
- In the absence of reasons for rejecting the request, it had to be allowed;
- Reimbursement of the appeal fee was also requested.

VIII. The appellant/applicant requested that the decision under appeal be set aside and that the case be remitted to the examining division for further prosecution on the basis of the set of claims and the description underlying the appealed decision with the order to conduct oral proceedings at the EPO in Munich.

Auxiliarily that the following question concerning an important point of law be referred to the Enlarged Board of Appeal in accordance with Art. 112(1)(a) EPC: "*Can a request by a party to conduct oral proceedings at the EPO in Munich instead of at the branch office in The Hague be denied?*".

Auxiliarily that the decision under appeal be set aside and the case be granted on the basis of the set of claims and the description underlying the appealed decision.

He requested reimbursement of the appeal fee.

## Reasons for the Decision

1. The appeal is admissible.
2. Article 113 EPC/Rule 111 EPC.

Rule 111(2) EPC (corresponding to R. 68(2) EPC 1973) requires that decisions of the European Patent Office which are open to appeal shall be reasoned.

By this is meant that the decision has to contain the logical chain of reasoning which led to the relevant conclusion. See for example section 2 of the reasons of T 292/90 (16 November 1992, not published in the OJ EPO) and section 2 of the reasons of T 52/90 (8 January 1992, not published in the OJ EPO) as well as the various other decisions discussed in section VI.J.5.3.4 of "Case Law of the Boards of Appeal of the European Patent Office", 6th edition.

It is also the established case law of the EPO that the failure to provide reasons pursuant to Rule 111(2) EPC (R. 68(2) EPC 1973) constitutes a substantial procedural violation justifying reimbursement of the appeal fee - see section 7 of the reasons of T 493/88 (OJ EPO 1991, 380) as well as section VII.E.17.4.4 of "Case Law of the Boards of Appeal of the European Patent Office", 6th Edition.

- 2.1 The "Brief Communication" of 1 September 2009 issued by the examining division in response to the request of the Applicant to hold oral proceedings in Munich instead of The Hague (see section II, above) merely

stated that it was "not foreseen" for an examining division which was located in Rijswijk to travel to Munich for oral proceedings.

This statement does not do more than elaborate the physical circumstances associated with the refusal of the request.

The communication thus contains nothing that can be regarded as "reasoning" justifying the refusal of the request concerning the venue of the oral proceedings. Nor were any legal norms, e.g. Articles or Rules of the EPC or Information or Directives issued by the Office invoked by the examining division to support its conclusion.

Accordingly this communication cannot be regarded as containing any reasons at all in support of the conclusions reached, let alone as providing a "logical chain of reasoning" justifying the conclusions.

2.2 Regarding the status of this communication, as held in T 1012/03 in section 6 of the reasons, there was no need to decide whether the communication issued by the division was a non-appealable interlocutory decision or only a precautionary indication to the applicant. Either way, the refusal of the request to hold oral proceedings in Munich was the subject of and therefore appealable with the final decision.

2.3 In the present case, however, the written final decision also contained nothing that can be regarded as providing reasons to justify the refusal of the request of the applicant to hold oral proceedings at the European Patent Office in Munich instead of in The Hague (Rijswijk). Although this matter was referred to in the Facts and Submissions of the decision under

appeal (see section II, above), this is not further mentioned in the reasons for the decision.

2.4 Pursuant to Rule 111(2) EPC the absence of any reasoning in either the communication (see sections 2.1 and 2.2, above) or the decision (see section 2.3, above) concerning the refusal of the request regarding the venue of oral proceedings constitutes a serious procedural violation which according to the established case law (see above) would justify reimbursement of the appeal fee.

2.5 Further, an argument presented by the appellant/applicant in support of this request was not dealt with in the decision under appeal:

- In its submissions to the examining division (letter of 11 August 2009, see section II, above) the Applicant gave a reason for its request to hold oral proceedings in Munich, namely the concentration of the patent activities of the client in Munich;
- Neither in the communication issued by the division, nor in the written decision is there even a reference to this argument, let alone a logical chain of reasoning showing why this argument would have to fail (see section II, above);
- On the contrary it is recalled that the first paragraph of the reasoning states (see section II, above):

*"The present decision is based solely on the grounds of lack of novelty (Art. 52 and 54 EPC), lack of inventive step (Art. 56 EPC) and clarity (Art. 84 EPC) which was*



*communicated to the applicant with the communication dated 05-02-2008 and the summons for oral proceedings dated 02-07-2009. [...]".*

- 2.5.1 According to the established jurisprudence of the boards of appeal, the opportunity to present comments and arguments guaranteed by Art. 113(1) EPC is a fundamental principle of the examination, opposition and appeal procedures - see section 2.2.4 of the reasons of T 1123/04 (25 August 2006, not published in OJ EPO).
- 2.5.2 This is not just a right to present comments, but also to have these duly considered - see section 4 of the reasons T 508/01 of 9 October 2001, not published in OJ EPO which decision was also cited in the aforementioned T 1123/04.
- 2.5.3 The fact that the decision under appeal failed to take account of an argument of the appellant/applicant represents a further violation of the right to be heard and consequently a further substantial procedural violation which would also justify reimbursement of the appeal fee.
- 2.6 Summarising, the decision under appeal suffers from two substantial procedural violations (see section 2, above):
- No reasons were given for the refusal of the request of the applicant to hold oral proceedings in Munich instead of The Hague, which is contrary to R. 111 EPC;

- There is no evidence that an argument presented by the Applicant in support of this request was taken into account by the division in reaching its decision, i.e. the applicant had *de facto* been denied the right to be heard, which is contrary to Art. 113(1) EPC.
3. Since each of these violations justifies in the Board's view referral back to the first instance and reimbursement of the appeal fee, it would be premature for the Board further to assess the probative value of the appellant/applicant's other arguments, for instance those based on T 1012/03 with respect to the seat of the Office.

## **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.
3. Reimbursement of the appeal fee is ordered.

The Registrar:

The Chairman

E. Goergmaier

R. Young