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**Datasheet for the decision
of 21 July 2015**

Case Number: T 1459/11 - 3.3.03

Application Number: 00977754.1

Publication Number: 1276777

IPC: C08F10/00

Language of the proceedings: EN

Title of invention:
POLYMERSATION PROCESS

Patent Proprietor:
Ineos Sales (UK) Limited

Opponent:
THE DOW CHEMICAL COMPANY

Headword:

Relevant legal provisions:
EPC Art. 123(2)
RPBA Art. 12(4), 13(1), 15(1)

Keyword:
Amendments - added subject-matter
(yes) (Main request, second auxiliary request)
Late-filed auxiliary requests - admitted
(no) (first, third and fourth auxiliary requests) - admitted
(no) Request could have been presented in first instance proceedings (fourth auxiliary request)

Decisions cited:

Catchword:

The purpose of the communication of a board of appeal pursuant to Art. 15(1) RPBA is to prepare the oral proceedings; it is not an invitation to the parties to make further submissions or to file further requests (See Reasons 3.1-3.3)



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Case Number: T 1459/11 - 3.3.03

**D E C I S I O N
of Technical Board of Appeal 3.3.03
of 21 July 2015**

Appellant:
(Patent Proprietor)

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(Opponent)

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Decision under appeal:

**Decision of the Opposition Division of the
European Patent Office posted on 3 May 2011
revoking European patent No. 1276777 pursuant to
Article 101(3) (b) EPC.**

Composition of the Board:

Chairwoman B. ter Laan
Members: M. C. Gordon
R. Cramer

Summary of Facts and Submissions

I. The appeal lies from the decision of the opposition division revoking European patent number EP-B1-1 276 777 (granted on European patent application number 00 977 754.1, derived from international application number PCT/GB2000/004578, published under the number WO 01/040323) on the grounds pursuant to Art. 123(2) and (3) EPC.

II. The patent has 25 claims, claims 19 and 20 as originally filed and as granted reading as follows:

"19. A film made from polyethylene produced in a single reactor, having a relationship

$$M > -6.58D^2 + 148.82D - 90,$$

where D = dart impact in g/ μ m and M = the lower of machine direction secant modulus and transverse direction secant modulus.

20. A film made from polyethylene having a relationship

$$M > -6.58D^2 + 148.82D + 20$$

where D = dart impact in g/ μ m and M = the lower of machine direction secant modulus and transverse direction secant modulus."

Claims 1-16 concern a process for producing polyolefin, shaped or moulded polyolefin or polyolefin film. They all have in common the use of a specific catalyst for the polymerisation and the subsequent crosslinking of the resulting polyolefin. Claims 17 and 18 are directed to shaped articles or films, both claims referring to the catalyst and crosslinking of the previous claims. Claim 25 concerns a crosslinked polyolefin composition prepared according to claim 1.

Claims 21-24 are directed to preferred embodiments of claims 19 and 20. Claims 1-18 and 21-25 are not relevant to this decision.

III. Opposition against the patent was raised on the grounds pursuant to Art. 100(a) (both novelty and inventive step) and Art. 100(b) EPC.

IV. The decision of the opposition division was based on an amended set of claims as the main and sole request.

Claims 19 and 20 thereof differed from claims 19 and 20 as originally filed in that the wording "having an annealed density of greater than 957 kg/m³" was introduced after the wording "A film made from polyethylene".

The only claims considered in the decision were claims 19, 20 and 25, the considerations in respect of claim 25 not being of relevance for the present decision. According to the appealed decision the amendment to claims 19 and 20 constituted an unallowable generalisation compared to the original disclosure, contrary to Art. 123(2) EPC.

V. The patent proprietor lodged an appeal against the decision. Together with the statement of grounds of appeal amended sets of claims forming a main and a first auxiliary request were filed.

Claims 19 and 20 of the main request read as follows:

"19. A blown film made from polyethylene having an annealed density of greater than 957 kg/m³ produced in a single reactor, having a relationship $M > -6.58D^2 + 148.82D - 90$,

where D = dart impact in $g/\mu m$ and M = the lower of machine direction secant modulus and transverse direction secant modulus.

20. A blown film made from polyethylene having an annealed density of greater than 957 kg/m^3 having a relationship $M > -6.58D^2 + 148.82D + 20$ where D = dart impact in $g/\mu m$ and M = the lower of machine direction secant modulus and transverse direction secant modulus."

In claims 19 and 20 of the auxiliary request it was specified that the polyethylene was crosslinked and the feature relating to the annealed density was omitted. Thus the preamble of both claims read:
"A blown film made from crosslinked polyethylene ..."

VI. On 22 April 2015 the Board issued a summons to attend oral proceedings and on 13 May 2015 dispatched a communication pursuant to Art. 15(1) RPBA in preparation of the oral proceedings in which the preliminary position was set out.

VII. With letter dated 12 June 2015 the appellant filed four sets of claims constituting first to fourth auxiliary requests.

In the first auxiliary request Claims 19 and 20 differed from the corresponding claims of the main request in that the term "blown" was omitted.

In claims 19 and 20 of the second auxiliary request it was specified that the polyethylene was crosslinked while the feature relating to the annealed density was omitted compared to the corresponding claims of the

main request. Thus the preamble of both claims read:
"A blown film made from crosslinked polyethylene ..."

In the third auxiliary request claims 19 and 20 differed from the corresponding claims of the main request in omitting the features "blown" and "having an annealed density ..." and in specifying that the film was made from crosslinked polyethylene. Thus the preamble of both claims read:

"A film made from crosslinked polyethylene..."

In the fourth auxiliary request claims 19-24 of the main request were deleted and claim 25 was renumbered accordingly.

VIII. Oral proceedings were held before the Board on 21 July 2015.

IX. The arguments of the appellant can be summarised as follows:

- a) The lower limit of the density as specified in the main request was clearly disclosed as preferred, which statement was consistent with the examples. The wording on page 36 of the description "The density of all films as defined above..." would be understood as relating to the blown films of examples 6 and 7, no other films being disclosed. From the discussion of example 6.2 it was clear that the annealed density of the blown film was meant, the corresponding ISO standard being given. No value had been isolated from the description nor had any examples been generalised. The examples supported the density feature.

- b) The first auxiliary request had been filed in response to the communication of the Board and hence could not be considered to have been filed late. The same arguments regarding "annealed density" applied as for the main request.
- c) The mathematical relationship in claim 19 of the second auxiliary request was a consequence of and hence effectively synonymous with a polymer obtained following the process of the patent, as explained in the description. Blown films were also generally disclosed in the description. The general validity of the mathematical relationship of claim 20 was supported by the examples and the general specification.
- d) The third auxiliary request had been submitted as a response to the preliminary opinion of the Board, from which it appeared that the term "blown film" might be objectionable, said feature hence being deleted.
- e) The fourth auxiliary request had also been submitted as a response to the preliminary opinion of the Board. It was acknowledged that had this request been presented as an auxiliary request before the opposition division then it would have been possible to appeal the rejection of claims 19-24, regardless of the conclusions with respect to claims 1-18 and 25. Even under these - theoretical - circumstances however an appeal would still have had to be filed, so the procedure overall would not have been shorter.

X. The arguments of the respondent can be summarised as follows:

- a) The definition of the annealed density in the main request as having a value in a specified range was an unallowable generalisation of the examples, which related to specific polymers made with specific catalysts. Further it was not even explicit from the examples that the "annealed" density was meant. The mathematical relationship was disclosed in the application only for a specific set of polymers, namely those "made by the above process".
- b) The first auxiliary request could have been filed during the proceedings before the opposition division, or at the very latest at the commencement of the appeal proceedings since the relevant objections were already on record. The omission of the term "blown" resulted in claims 19 and 20 relating to an intermediate generalisation and furthermore to a divergence with the requests filed on appeal.
- c) The films of claims 19 and 20 of the second auxiliary request were not limited to those prepared by the process of the patent, the mathematical relationship in the claims notwithstanding. Hence these claims constituted an intermediate generalisation.
- d) The third auxiliary request request should not be admitted since there was no reason for filing it at such a late stage of the proceedings. Furthermore it was broader than auxiliary request 2.
- e) A request such as the fourth auxiliary request could have been filed during the opposition

proceedings or at the latest with the statement of grounds of appeal. Hence it should not be admitted to the proceedings.

XI. The appellant requested that the decision under appeal be set aside and the case be remitted to the first instance for further prosecution on the basis of the main request filed with the statement of grounds of appeal, or on the basis of any of the first to fourth auxiliary requests filed with the letter of 12 June 2015.

XII. The respondent requested that the appeal be dismissed.

Reasons for the Decision

1. The appeal is admissible

2. *Main request - Art. 123(2) EPC*

2.1 Claim 19 specifies *inter alia* that the blown film is made from polyethylene having an annealed density of greater than 957 kg/m^3 . On page 36 of the application as filed the results of the examples relating to blown films are discussed. Following that discussion, at line 18 it is stated that "The density of all films as defined above is preferably greater than 957 kg/m^3 ."

That passage does not contain the word "annealed". Said term in combination with blown film is present only in a single example, namely example 6.2. However it is not stated either at this part of the description or elsewhere that the further densities reported in the

examples relating to blown films are annealed densities.

It is not even entirely clear to which of the examples the wording on page 36 "as defined above" refers, i.e. whether to the immediately preceding example 7, to examples 6 and 7 or to all films of the application. Even applying the most favourable interpretation for the appellant that the lower limit of the density at page 36 is intended to apply not only to the films of the example families 6 and 7 but in general to all films of the application, there nevertheless lacks a disclosure that the density so meant is the annealed density. Consequently there is no general disclosure in the application as filed that films satisfying the other features of claim 1 have an annealed density in the defined range.

The feature "having an annealed density of greater than 957 kg/m³" thus represents an unallowable generalisation of the disclosure of example 6.2 of the application as originally filed.

2.2 Consequently the subject-matter of claim 19 of the main request extends beyond the content of the application as originally filed, contrary to the requirements of Art. 123(2) EPC.

2.3 The main request is therefore refused.

3. *First auxiliary request*

3.1 Admissibility

According to the appellant this request should be admitted to the proceedings because it had been filed

"in response" to the communication pursuant to Art. 15 RPBA issued by the Board in preparation of the oral proceedings.

- 3.2 According to Art. 15(1) RPBA the purpose of the communication is to draw attention to matters "which seem to be of special significance....or containing other observations that may help concentration on essentials **during the oral proceedings**" (emphasis of the Board).

The purpose of the communication is thus - explicitly - to establish the framework of the oral proceedings. The communication does not - explicitly or implicitly - represent an invitation or opportunity to file further written submissions or to shift the focus of the case to be heard at oral proceedings, it being recalled that the terms of the appeal are determined by the statement of grounds of the appeal and the reply thereto (Art. 12(2) RPBA).

- 3.3 Consequently there is no legal basis in either the EPC or the RPBA for the filing of a "response" to a communication pursuant to Art. 15 RPBA. This means that a Board is under no obligation to take such a "response" into account. Furthermore in view of the purpose of the communication pursuant to Art. 15 RPBA the argument that a "response" to the communication cannot be regarded as late filed, is moot. Any submissions - either arguments or requests - contained in such a "response" that go beyond those contained in the statement of grounds of appeal or the reply thereto may constitute an amendment to the case presented, and it is a matter for the discretion of the Board whether such submissions are to be taken into account (Art. 13(1) RPBA).

- 3.4 The first auxiliary request - filed with said "response" retains the feature of the "annealed density" having a specific lower limit which gave rise to the refusal of the main request.
- 3.5 Consequently, the conclusions reached for the main request apply to the first auxiliary request meaning that said request is *prima facie* not allowable.
- 3.6 The first auxiliary request is therefore not admitted to the proceedings.
4. *Second auxiliary request (filed as auxiliary request with the statement of grounds of appeal) - Art. 123(2) EPC*
- 4.1 A basis for the subject-matter of claim 19, i.e. specifying a blown film from crosslinked polyethylene satisfying the mathematical relationship, without any limitation as to the density, is provided by the disclosure of original claim 19, together with the passage at original page 4 lines 23-26, disclosing the mathematical relationship as applying to films "made by the above process", which includes the crosslinking step. The feature "blown films" is disclosed at page 16, line 25 as an optional feature. Thus the subject-matter of claim 19 is based on the generality of the original description together with a single selection (blown films).
- 4.2 In the case of claim 20 the mathematical relationship is disclosed in original claim 20. The mathematical relationship is also discussed at page 36, line 7 of the application as filed. This latter disclosure of the relationship is however restricted to the specific

reticulated polyethylene of "the above examples". As pointed out above (point 2.1), it is however not unambiguous whether the reference to "the above examples" is intended to cover only the example family 7 or also the example family 6, both of which refer to blown films. In any case the consequence of the reference to "the above examples" is that the mathematical relationship of claim 20 is not disclosed as being generally applicable to all polymers made by the process of the application but is restricted to a specific, albeit ambiguously defined, subset thereof.

Original claim 20 does not contain the features "crosslinked" or "blown". Although these features are disclosed in the application in general, there is no disclosure thereof - individual or in combination - specifically in the context of whichever group of polymers satisfies the mathematical relationship of claim 20. Consequently, the combination of the features "blown film" and "crosslinked" in operative claim 20 constitutes a two-fold selection compared to the application as originally filed, and thus contravenes the requirements of Art. 123(2) EPC.

The second auxiliary request is therefore refused.

5. Third auxiliary request - Admissibility

Claims 19 and 20, which were filed after issue of the summons to oral proceedings, diverge from the corresponding claims of the second auxiliary request (auxiliary request submitted with the statement of grounds of appeal) in that they are no longer directed to a "blown film" but to a "film". The feature "crosslinked" is maintained.

The argument of the appellant that the amendment by deletion of "blown" was undertaken "in response" to the communication of the Board cannot in itself provide support for the admissibility of this request for the reasons explained with respect to the first auxiliary request in respect of Art. 15 RPBA (points 3.1 to 3.3 above).

The consequence of the amendment by which the restriction to "blown films" has been removed is to change the case compared to that presented on appeal by extending the scope of claims 19 and 20.

- 5.1 In exercise of the discretion permitted pursuant to Art. 13(1) RPBA the Board does not consider it appropriate to permit this change of case at such a late stage of the proceedings.
- 5.2 The third auxiliary request is therefore not admitted to the proceedings.
- 6. Fourth auxiliary request - Admissibility
 - 6.1 All claims relating to the film have been removed. Again, the appellant submitted that this amendment had been undertaken "in response to the communication of the Board".

The problems arising from the claims directed to the films were however already raised during the proceedings before the opposition division and resulted in the revocation of the patent.

As a consequence the patent proprietor would have been aware already during the opposition proceedings that there were concerns with respect to the claims directed

to films, and it would have been possible for and incumbent on the patent proprietor to submit a set of claims from which the film claims had been deleted as an auxiliary request during the course of the opposition proceedings, insofar as the patent proprietor considered that a patent so restricted would be of interest.

Such a course of action on the part of the patent proprietor would have resulted in a decision by the opposition division in respect of all the independent claims, in the form of different requests, whilst still preserving for the patent proprietor the right to file an appeal *inter alia* in order to seek to have the film claims reinstated following consideration by the Board, meaning that both families of claims would have been the subject of consideration upon appeal.

- 6.2 As a consequence of the failure to submit such an amended set of claims to the opposition division and the resulting absence of any decision in respect thereof, admitting the fourth auxiliary request to the present appeal proceedings would necessitate immediate remittal of the case to the opposition division, resulting in a further opposition procedure and possibly a further appeal procedure. Such remittal would thus extend the period of uncertainty for the opponent and the public.

The argument of the appellant that no further delay would occur as a consequence of admitting the fourth auxiliary request is thus manifestly incorrect.

- 6.3 Since it was apparent during the opposition proceedings that retaining the claims directed to films would likely lead to revocation of the patent, the patent

proprietor would have been aware of the need for a request corresponding to the present fourth auxiliary request. Such a request could therefore have been filed during the opposition proceedings before the opposition division. Under these circumstances, the Board considers it appropriate, pursuant to Art. 12(4) RPBA, not to admit the fourth auxiliary request to the proceedings.

Order

For these reasons it is decided that:

The appeal is dismissed.

The Registrar:

The Chairwoman:



L. Malécot-Grob

B. ter Laan

Decision electronically authenticated