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**Datasheet for the decision
of 19 May 2015**

Case Number: T 0035/12 - 3.3.03
Application Number: 03738009.4
Publication Number: 1511803
IPC: C08L23/00, C08L23/10,
C08L23/14, C08L23/16
Language of the proceedings: EN

Title of invention:

PROPYLENE COPOLYMER COMPOSITIONS HAVING A GOOD LOW-TEMPERATURE
IMPACT TOUGHNESS AND A HIGH TRANSPARENCY

Patent Proprietor:

Basell Polyolefine GmbH

Opponent:

Borealis Technology OY

Headword:

Relevant legal provisions:

RPBA Art. 12(4), 13(1), 13(3)

Keyword:

Late-filed request -
request clearly allowable (no) (Main request, first-
third, fourth and fifth auxiliary requests)

Decisions cited:

T 0036/12

Catchword:



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Case Number: T 0035/12 - 3.3.03

D E C I S I O N
of Technical Board of Appeal 3.3.03
of 19 May 2015

Appellant:
(Patent Proprietor)

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Decision under appeal:

**Decision of the Opposition Division of the
European Patent Office posted on 4 November 2011
revoking European patent No. 1511803 pursuant to
Article 101(3) (b) EPC.**

Composition of the Board:

Chairwoman B. ter Laan
Members: M. C. Gordon
C. Brandt

Summary of Facts and Submissions

I. The appeal lies from the decision of the opposition division revoking European patent number 1 511 803 (granted on European patent application number 03 738 009.4, derived from international application number PCT/EP03/06043, published under the number WO 03/106553).

II. The application as originally filed had 15 claims, claim 1 reading as follows:

"A propylene copolymer composition comprising
A) a propylene polymer containing from 0 to 10% by weight of olefins other than propylene and
B) at least one propylene copolymer containing from 5 to 40% by weight of olefins other than propylene,

where the propylene polymer A and the propylene copolymer B are present as separate phases and the propylene copolymer composition has a haze value of $\leq 30\%$, based on a path length of the propylene copolymer composition of 1 mm, and the brittle/tough transition temperature of the propylene copolymer composition is $\leq -15^{\circ}\text{C}$ ".

III. The patent was granted with a set of 13 claims, whereby claim 1 differed from claim 1 of the application as filed in that feature B) of claim 1 read as follows:

"B) at least one propylene copolymer containing from 12 to 18% by weight of olefins other than propylene,"

and in that the following part of the claim specified:

"where the propylene polymer A and the propylene copolymer B are present as separate phases, the weight ratio of propylene polymer A to the propylene copolymer B is from 80:20 to 60:40 [and the propylene copolymer]".

IV. A notice of opposition against the patent was filed in which revocation of the patent on the grounds of Art. 100(a), (b) and (c) EPC was requested.

V. The decision of the opposition division was based on two sets of claims forming a main and a first auxiliary request.

Claim 1 of the main request differed from claim 1 of the patent as granted in that feature A) was limited to a propylene homopolymer and in that feature B) read as follows:

"B) one propylene copolymer containing from 12 to 18% by weight of olefins other than propylene and from 0.1 to 1% by weight, based on the total weight of the propylene copolymer composition, of a nucleating agent,".

Claim 1 of the auxiliary request further specified the glass transition temperature of copolymer B.

VI. According to the decision neither of the requests met the requirements of Art. 83 EPC. The details of the reasons underlying that conclusion are not of relevance for the present decision.

Accordingly the patent was revoked.

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

Claim 1 of both requests differed from claim 1 of the corresponding request considered in the decision under appeal in that in feature B the content of olefins other than propylene was specified as being 14 to 18% instead of 12 to 18% by weight.

VIII. The opponent - now the respondent - replied to the statement of grounds of appeal.

IX. The Board issued a summons to attend oral proceedings. In a communication dated 12 February 2015 the Board set out its preliminary opinion of the case. Objections pursuant to Art. 123(2) EPC were raised, in particular with respect to feature B) of claim 1. *Inter alia* the amendment, compared to the originally filed claims consisting in deletion of the feature "at least [one propylene copolymer]", was addressed. It was further held that the subject-matter of claim 1 of both requests was the result of a non-disclosed multiple selection of features from the application as filed.

X. In a letter dated 16 April 2015 the appellant submitted sets of claims forming a "new" main and "new" first to third auxiliary requests, and discussed the preliminary opinion of the Board in respect of the features common to the "previous" main request and the newly filed main request.

The main and first auxiliary requests differed from the requests filed with the statement of grounds of appeal in that feature B) read "At least [one...]".

The second and third auxiliary requests corresponded to the "new" main request and first auxiliary requests respectively, but now specified the content of olefins other than propylene in component B) as being 14-17% by weight.

XI. The Respondent made further written submissions with letters dated 19 April 2015 and 12 May 2015, *inter alia* objecting to the new requests as being late filed so that they should not be admitted to the proceedings.

XII. Oral proceedings before the Board were held on 19 May 2015.

In the course of the oral proceedings the appellant sought to (re)introduce the sets of claims according to the main request and auxiliary request as filed with the statement of grounds of appeal as the fourth and fifth auxiliary requests respectively.

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

a) *Admissibility to the procedure of the main request and first-third auxiliary requests*

The amendment made to the main request and the first to third auxiliary requests corresponded essentially to reinstating wording of the claims of the patent as granted. The case law afforded patentees great latitude in formulating requests following revocation regardless of the nature of requests pursued on opposition. Reference was made to "Case Law of the Boards of Appeal of the European Patent Office", 7th edition section IV.E. 4.5.2. The case law cited by the opponent related

to the situation of an interlocutory decision, not revocation and hence was not relevant.

The amendment compared to the claims filed with the statement of grounds of appeal had been made in response to an objection raised by the Board in respect of feature B).

The difference in wording arising from deletion of "at least" was small and did not result in a significant modification of the scope of the claims.

Considerations of problems that might potentially arise in later proceedings resulting from the amendments should not influence the question on the admissibility thereof.

b) *Allowability of the main request and first to third auxiliary requests*

The features of said requests found their basis in a combination of features taken from a number of claims and from the description, so that Article 123(2) EPC was complied with.

c) *Admissibility of the fourth and fifth auxiliary requests*

The fourth and fifth auxiliary requests had already been in the proceedings and hence were not newly filed. The refiling thereof could not take the opponent by surprise. The requests filed with the statement of grounds of appeal were not referred to in the letter of April 2015 submitting the new main and first to third auxiliary

requests. Hence there were no grounds for considering that said requests had been withdrawn.

XIV. The arguments of the respondent/opponent can be summarised as follows:

a) *Admissibility of the main and first to third auxiliary requests*

The patentee had abandoned the granted claims containing the phrase "at least one" at an early stage of the opposition proceedings. Said claims were consequently not the object of the decision under appeal. The new requests, filed after the submission of the statement of grounds of the appeal, created an entirely new situation which gave rise to further problems due to the reinstatement of "at least one" in feature B) in combination with other amendments undertaken compared to the claims as granted. The case law referred to by the appellant predated the RPBA and hence was no longer applicable. Decision T 36/12 clarified that the readmission to the procedure of requests previously having been abandoned was a matter for the discretion of the Board. To admit the claims would not be consistent with the purpose of the appeal proceedings ("forum shopping").

b) *Allowability of the main and first to third auxiliary requests*

The main and first to third auxiliary requests relied upon a non-disclosed combination of features so that they did not comply with Article 123(2).

c) *Amissibility of the fourth and fifth auxiliary requests*

The patentee had withdrawn the requests now forming the fourth and fifth auxiliary requests with the letter of 16 April 2015. The appellant had not challenged the summary of pending requests presented by the Board at the commencement of the oral proceedings in which said requests were not referred to. The attempt to reintroduce those requests meant that they were late filed. The requests were furthermore not allowable and should not be admitted to the proceedings.

XV. The appellant requested that the decision under appeal be set aside and that the patent be maintained in amended form on the basis of the main request or in the alternative, on the basis of any of the first to third auxiliary requests, all requests filed with letter dated 16 April 2015, or on the basis of the fourth and fifth auxiliary request filed with the statement setting out the grounds of appeal as main request and auxiliary request.

XVI. The respondent (opponent) requested that the appeal be dismissed.

Reasons for the Decision

1. The appeal is admissible.

2. *Main request*

2.1 The formulation of claim 1 reintroduces wording - "At least" - that had been abandoned at the commencement of the opposition proceedings, namely in the response to the notice of opposition. The patent proprietor in its response to the notice of opposition did not advance any arguments in defence of the allowability of the deleted wording. The absence of any arguments in this respect is interpreted by the Board as indicating tacit acceptance on the part of the appellant that the objection raised (under Art. 100(c) EPC) in respect of the wording "At least one" was in fact correct.

2.2 Claims employing this wording played no further role in the opposition proceedings or in the appeal proceedings until the letter of 16 April 2015, after issue of the summons to oral proceedings.

The wording in question was (re)introduced in response to an objection pursuant to Art. 123(2) EPC raised by the Board in respect of the sets of claims submitted with the statement of grounds of appeal. Again no argumentation was advanced as to why the previously employed wording, i.e. that underlying the decision under appeal and present in the claims filed with the statement of grounds of appeal, met the requirements of Art. 123(2) EPC. Consequently again there appeared to be tacit acceptance on the part of the appellant that the objections raised, in this case by the Board, pursuant to Art. 123(2) EPC in respect of the sets of claims submitted with the statement of grounds of appeal were correct.

2.3 The effect of the amended wording is that component B is no longer "one propylene copolymer" but is "at least

one propylene copolymer" which is required to have a content of olefins other than propylene in a defined range. The effect of this change cannot be readily assimilated, in particular because it is ambiguous from the claim whether the specified content of olefins other than propylene applies to each "at least one" copolymer individually, or is the average over all of the "at least one" copolymers present, which interpretation would appear to be consistent with the wording at page 4 line 18-20 of the application, corresponding to paragraph [0018] of the patent. Consequently the effect of the amendment is to introduce further complexity to the case.

- 2.4 A number of other objections had also been raised by the Board against the claims as submitted with the statement of grounds of appeal, namely that the subject-matter thereof was the result of a plurality of selections from the disclosure of the application as filed, which combination was not disclosed in the application with the consequence that Art. 123(2) EPC was not complied with.

The appellant in its response to the Board's communication, apart from giving the basis for the newly introduced features, restricted itself to stating that the subject-matter of operative claim 1 was a combination of features from five of the originally filed claims with two further limitations to narrower ranges taken from the description. Thus the appellant, by its own statement, provided confirmation of the position of the Board that the claim was the result of a plurality of selections from the disclosure of the application as originally filed.

The appellant however did not argue, let alone demonstrate, that the preliminary opinion of the Board had been incorrect, i.e. that the specific combination of features claimed was directly and unambiguously disclosed in or derivable from the application as originally filed.

- 2.5 According to Art. 13(3) RPBA amendments sought to be made after oral proceedings have been arranged should not be admitted if they give rise to issues which the Board or the other party cannot reasonably be expected to deal with without adjournment of the oral proceedings. The admissibility of such late-filed requests to the procedure is a matter for the discretion of the board (Art. 13(1) EPC).

A criterion for admissibility is that the late filed requests should be *prima facie* clearly allowable (c.f. "Case Law of the Boards of Appeal", 7th Edition Section IV.E.4.4.2).

The patentee however did not discharge the burden of showing that the subject-matter of the late filed claims clearly was *prima facie* allowable at least to the extent of Art. 123(2) EPC. On the contrary, the submissions made in respect thereof appeared to confirm the preliminary opinion of the Board that said claim was the result of multiple selections from the original disclosure, without however demonstrating that the resulting subject matter was either explicitly or implicitly directly and unambiguously derivable from the application as originally filed.

- 2.6 A further matter to be considered in deciding on the admissibility of the claims is the complexity arising

from the amendment of the wording of part B) of claim 1 to read "at least one", as discussed above.

2.7 Regarding the argument of the appellant that the case law allows considerable freedom upon revocation in formulating requests, including reverting to the claims of the patent as granted, the Board observes that such latitude does not release a patent proprietor from the requirement, set out in the Rules of Procedure, that any late filed claims be *prima facie* clearly allowable and do not introduce further complexity to the case.

2.8 Under these circumstances and in particular considering that the initial challenge to "At least one" during the opposition proceedings had not been resisted to any extent, the Board considers it appropriate to exercise its discretion not to admit the late filed request to the procedure.

3. *First to third auxiliary requests*

Since all of the first to third auxiliary requests, in addition to the amendment consisting in replacing "At least one" in feature B) similarly contain a combination of features taken from different parts of the original application, it has not been shown that those requests are *prima facie* clearly allowable.

Consequently the first to third auxiliary requests are not admitted to the proceedings.

4. *Fourth and fifth auxiliary requests (main and auxiliary request as filed with the statement of grounds of appeal).*

4.1 In the letter of 16 April 2015 the appellant stated:
"We wish to maintain the patent on the basis of a further amended set of claim [sic], which is attached as Annexes 1a and 1b. Annex 1a is a clean copy of the new Main Request [...]". Further references were made to the "new" main request and to "new" auxiliary requests in the letter.

On page 2, 4th paragraph, of the letter it was stated that "[The board regarded] the previous Main Request...".

There was no indication from the wording of the letter that the requests filed with the statement of grounds of appeal were to be upheld. On the contrary, the use of the adjectives "new" and "previous" in relation to the requests filed with the letter of 16 April 2015 and with the statement of grounds of appeal respectively, clearly indicated that the intention of the appellant was no longer to maintain the requests filed with the statement of grounds of appeal but to replace these *in toto* with the sets of claims attached to the letter.

4.2 The submissions made by the appellant at the outset of the oral proceedings did not give any grounds to conclude that the above interpretation was incorrect.

On the contrary, when, in the introduction to the oral proceedings, the Chairman recited the requests and invited the parties to confirm these, the appellant indicated assent with the statement that maintenance on the basis of one of the sets of claims filed with the letter of 16 April 2015 was requested and raised no objection to the absence of any mention of the sets of claims filed with the statement of grounds of appeal from the sets of requests being pursued.

4.3 The only interpretation consistent with the wording of the letter of 16 April 2015 and the submissions of the appellant at the commencement of the oral proceedings, was that the sets of claims submitted with the statement of grounds of appeal were no longer pursued, i.e. had *de facto* been withdrawn and were no longer part of the appellant's case on appeal.

4.4 In seeking to reintroduce these claims at an advanced stage of the oral proceedings the appellant was therefore seeking to effect a further change to the case presented before the Board.

As said claims had been withdrawn prior to the oral proceedings the attempt to reintroduce them constituted a - further - change to the case presented on appeal, which change happened at a late stage of the proceedings before the Board - namely at an advanced stage of the oral proceedings. Admissibility thereof to the proceedings is thus subject to the stipulations indicated above, in particular that such claims be *prima facie* clearly allowable.

4.5 Objections pursuant to Art. 123(2) EPC had been raised against both these requests by the Board in its communication. In its response (16 April 2015) the appellant did not comment on, let alone challenge, the objections made in respect of the omission of the wording "at least [one]" but instead furnished amended claims replacing those submitted with the statement of grounds of appeal (see above, point (X)).

Under these circumstances the Board has no grounds for coming to the conclusion that its assessment that the claims according to the requests submitted with the statement of grounds of appeal did not meet the

requirements of Art. 123(2) EPC, was incorrect.

The consequence is that the late filed auxiliary requests 4 and 5 are not prima facie clearly allowable, and consequently are not to be admitted to the proceedings.

Order

For these reasons it is decided that:

The appeal is dismissed.

The Registrar:

The Chairwoman:



B. ter Heijden

B. ter Laan

Decision electronically authenticated