

**Internal distribution code:**

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

**Datasheet for the decision  
of 5 December 2013**

**Case Number:** T 0935/12 - 3.3.03

**Application Number:** 02718358.1

**Publication Number:** 1381634

**IPC:** C08F6/00

**Language of the proceedings:** EN

**Title of invention:**

POLYMER TREATMENT FOR SEPARATING VOLATILE MATERIAL

**Patent Proprietor:**

Ineos Sales (UK) Limited

**Opponents:**

Borealis AG  
Coperion GmbH  
Zeppelin Silos & Systems GmbH  
THE DOW CHEMICAL CO.  
Total Research & Technology Feluy  
SABIC Petrochemicals B.V.  
Basell Poliolefine Italia S.r.l.

**Headword:**

**Relevant legal provisions:**

EPC R. 99(2), 101(1)  
EPC Art. 104(1), 108  
RPBA Art. 12(4), 13(1)

**Keyword:**

Admissibility of appeal - form of appeal  
Late-filed request - request could have been filed in first  
instance proceedings (yes) - request not examined by the  
opposition division (yes) - request clearly allowable (no)  
Apportionment of costs - (no)

**Decisions cited:**

T 0717/01, G 0001/99, G 0009/91, G 0010/91, J 0022/86,  
T 0162/97, T 2193/09, J 0010/11, G 0008/91, T 1705/07,  
T 0356/08, T 1067/08, T 0936/09

**Catchword:**



**Beschwerdekammern  
Boards of Appeal  
Chambres de recours**

European Patent Office  
D-80298 MUNICH  
GERMANY  
Tel. +49 (0) 89 2399-0  
Fax +49 (0) 89 2399-4465

Case Number: T 0935/12 - 3.3.03

**D E C I S I O N**  
**of Technical Board of Appeal 3.3.03**  
**of 5 December 2013**

**Appellant:** Ineos Sales (UK) Limited  
(Patent Proprietor) Hawkslease Chapel Lane  
Lyndhurst  
Hampshire SO43 7FG (GB)

**Representative:** Smith, Julian Philip Howard  
Mathisen & Macara LLP  
Communications House  
South Street  
Staines-upon-Thames  
Middlesex, TW18 4PR (GB)

**Respondent:** Borealis AG  
(Opponent 1) IZD Tower  
Wagramerstrasse 17-19  
1220 Wien (AT)

**Representative:** Salminen, Hannu  
Borealis Polymers Oy  
P.O. Box 330  
FIN-06101 Porvoo (FI)

**Respondent:** Coperion GmbH  
(Opponent 2) Theodorstrasse 10  
70469 Stuttgart (DE)

**Representative:** Hofmann, Matthias  
Rau, Schneck & Hübner  
Patentanwälte  
Königstrasse 2  
90402 Nürnberg (DE)

**Respondent:** Zeppelin Silos & Systems GmbH  
(Opponent 3) Leutholdstrasse 108  
88045 Friedrichshafen (DE)

**Representative:** Riebling, Peter  
Patentanwalt  
Postfach 31 60  
88113 Lindau (DE)

**Respondent:** THE DOW CHEMICAL CO.  
(Opponent 4) 2030 Dow Center  
Midland, Michigan 48674 (US)

**Representative:** Marsman, Hermanus Antonius M.  
V.O.  
Johan de Wittlaan 7  
2517 JR Den Haag (NL)

**Respondent:** Total Research & Technology Feluy  
(Opponent 5) Zone Industrielle C  
7181 Seneffe (BE)

**Representative:** Leyder, Francis  
Total Research & Technology Feluy  
Zone Industrielle C  
7181 Seneffe (BE)

**Respondent:** SABIC Petrochemicals B.V.  
(Opponent 6) P.O. Box 5151  
6130 PD Sittard (NL)

**Representative:** Bootsma, Jan P.C.  
Sabic Corporate Patent Group  
Geleen Office  
P.O. Box 3008  
NL-6160 GA Geleen (NL)

**Respondent:** Basell Poliolefine Italia S.r.l.  
(Opponent 7) Via Pergolesi 25  
20124 Milano (IT)

**Representative:** Colucci, Giuseppe  
Basell Poliolefine Italia S.r.l.  
Intellectual Property  
P.le G. Donegani 12  
44100 Ferrara (IT)

**Decision under appeal:** **Decision of the Opposition Division of the  
European Patent Office posted on 15 February  
2012 revoking European patent No. 1381634  
pursuant to Article 101(3)(b) EPC.**

**Composition of the Board:**

**Chairwoman:** B. ter Laan  
**Members:** O. Dury  
C. Brandt

## Summary of Facts and Submissions

I. The appeal by the patent proprietor lies against the decision of the opposition division posted on 15 February 2012 revoking European patent No. 1 381 634, based on application No. 02 718 358.1, corresponding to the international application PCT/GB2002/001794 published as WO 2002/088194.

II. Claims 1 and 7 of the granted patent read as follows:

"1. A process for the separation of volatile material from particulate polymer which has been substantially freed from unreacted monomer in an earlier separation step, comprising

- a) feeding the particulate polymer to a purge vessel, optionally causing it to move through the vessel in substantially plug-flow mode,
- b) heating the particulate polymer in the purge vessel to a temperature greater than 30°C but insufficiently high to cause the particles to become agglomerated, and/or maintaining the polymer at a temperature in this range in the purge vessel,
- c) feeding air to the purge vessel counter-current to the movement of the particulate polymer to remove volatile material therefrom,
- d) removing the particulate polymer from the purge vessel."

"7. A process as claimed in claim 1 wherein the quantity of volatile material (excluding water) present in the particulate polymer fed to the purge vessel is not greater than 500 ppm by weight."

III. Seven oppositions against the patent were filed, in which it was requested that the patent be revoked on the grounds pursuant to Art. 100(a) EPC (both novelty and inventive step) and Art. 100(b) EPC. The objection pursuant to Art. 100(b) EPC was in particular directed to the feature related to the volatile content specified in granted claim 7.

In reply to the oppositions, by letter of 26 May 2010 the patent proprietor filed a main and an auxiliary request, neither of which contained claims having the features of granted claim 7.

In section 4 of its preliminary opinion accompanying the summons to oral proceedings, the opposition division indicated in respect of Art. 83 EPC *inter alia* that "a person skilled in the art would not have any difficulties to rework the invention with respect to the volatile content (VOC)".

By letter of 25 November 2011 the patent proprietor filed a main request and auxiliary requests 1-4. All but auxiliary request 3 now contained claims having the features of granted claim 7. By letter of 16 January 2011 all those requests were replaced by a main request and eleven auxiliary requests, all of which contained claims having the features of granted claim 7.

At the beginning of the oral proceedings before the opposition division held on 25 January 2012, the patent proprietor replaced the twelve requests then pending by two requests as the main and an auxiliary request, which formed the basis of the appealed decision. The opposition division held that neither of those requests satisfied the requirements of Art. 83 EPC because of a

- lack of disclosure in respect of the features of granted claim 7 specified in the claims of those requests.
- IV. On 20 April 2012, the patent proprietor (appellant) lodged an appeal against the above decision. The prescribed fee was paid on the same day. In the statement of grounds of appeal filed on 25 June 2012, the appellant requested that the decision of the opposition division be set aside and that the patent be maintained in amended form according to either the main request or any of auxiliary requests 1-4, all filed therewith. None of those requests contained claims having the features of granted claim 7.
- V. Replies to the statement of grounds of appeal were filed by letters of 5 November 2012 (respondent I), 15 October and 5 November 2012 (respondent II), 29 October 2012 (respondent III), 9 January 2013 (respondent IV), 25 October 2012 (respondent V), 7 January 2013 (respondent VI) and 8 November 2012 (respondent VII).
- VI. In a communication accompanying the summons to oral proceedings issued on 31 May 2013 the Board set out its preliminary view of the case. Among other things, the issues of the admissibility of the appeal (Art. 108 EPC and Rule 99 EPC) and the admissibility of the pending requests of the appellant (Art. 12(4) RPBA) were addressed. Regarding the admissibility of the appeal, reference was made to decision T 717/01 of 14 January 2003 (not published in OJ EPO).
- VII. By letter dated 4 October 2013 the appellant filed a main request and an auxiliary request in replacement of all previous requests.

Claim 1 of the main request read as follows:

"1. A process for the separation of volatile material from particulate polymer which has been substantially freed from unreacted monomer in an earlier separation step, comprising

- a) preheating the particulate polymer in a preheating vessel to a temperature greater than 30°C but insufficiently high to cause the particles to become agglomerated,
- b) feeding the particulate polymer to a purge vessel and causing it to move through the purge vessel in substantially plug-flow mode,
- c) maintaining the particulate polymer in the purge vessel at a temperature greater than 30°C but insufficiently high to cause the particles to become agglomerated,
- d) feeding air to the purge vessel counter-current to the movement of the particulate polymer to remove volatile material therefrom,
- e) removing the particulate polymer from the purge vessel,

wherein the rate of flow of air through the purge vessel is 2-50 litres per hour per cm<sup>2</sup> of cross section measured radially across the direction of flow of particulate polymer through the purge vessel, and the plug flow mode of the particulate polymer is not disrupted thereby."

Claim 1 of the auxiliary request corresponded to claim 1 of the main request further amended by indicating in step b) that the polymer was fed "continuously" to a purge vessel and by adding additional features at the end of the claim, which are however not relevant for the present decision.



- VIII. The respondents submitted further arguments by letters of 10 October and 18 October 2013 (respondent I), 24 September and 16 October 2013 (respondent II), 23 October and 18 November 2013 (respondent III), 3 October 2013 (respondent IV), 5 November 2013 (respondent V), 3 October and 6 November 2013 (respondent VI) and 22 October 2013 (respondent VII).
- IX. Oral proceedings were held on 5 December 2013 in the presence of all parties.
- X. The appellant's arguments relevant for the present decision may be summarised as follows:

Admissibility of the appeal

- a) The feature of granted claim 7, which was held by the department of first instance not to satisfy the requirements of Art. 83 EPC, had been removed from all requests filed on appeal, thus depriving the contested decision of its basis. Novelty and inventive step of the new requests had been discussed in the statement of grounds of appeal, but only briefly, because those issues had not been decided upon in the contested decision. Under these circumstances, the appeal was admissible.

Admissibility of the requests

- b) A key factor determining the requests filed at the oral proceedings before the opposition division was that a closely related patent, EP 1 558 651, had been revoked at oral proceedings the day before by the same opposition division and with some of the same opponents. At the end of the oral

proceedings in that case, the opposition division had made it clear to the appellant that the twelve requests then pending in the present case would be refused for similar reasons, and it was suggested that new requests should be prepared and submitted accordingly. It was also made clear that many additional requests would not be permitted on the day. To help advance the proceedings, two new sets of claims were submitted on the day of the oral proceedings, both of which contained the subject-matter of granted claim 7, which had been held allowable under Art. 83 EPC in the provisional opinion of the opposition division.

On appeal the features of granted claim 7 were removed from the requests filed to further streamline the proceedings, and also, in order to define subject-matter that was novel and inventive over the documents cited in the first-instance proceedings, additional features taken from the description had been incorporated in the claims, including a feature limiting the preheating step (a) that had never been specified in any of the appellant's previous requests. Amendments to the requests filed with the statement of grounds of appeal were further made in reply to the communication of the board.

- c) The parameter "rate of flow of air" specified in claim 1 was clear since it was usual in the art and it could be determined without difficulty by the skilled person, generally on the basis of the flow rate in the inlet pipe, taking into account the cross-section of the main part of the purge vessel as well as the pressure and temperature profiles therein but not the polymer filling the

vessel.

- d) The respondents' objection concerning the disruption of the plug-flow mode was related to an alleged clarity issue in respect of the definition of "plug-flow mode". Said feature being part of the granted claims in the same context, in opposition appeal proceedings it was not open for an objection of lack of clarity.
- e) The range of 2-50 litres per hour per cm<sup>2</sup> was directly obtained from the combination of the ranges 2-10 and 10-50 litres per hour per cm<sup>2</sup> specified at the top of page 8 of the application as filed, taking into account the general teaching at the bottom of original page 7 that the plug-flow should not be disrupted.
- f) Considering the unusual circumstances of the case, the operative requests should be admitted.

#### Apportionment of costs

- g) Since it had not been shown why respondent III had incurred extra costs, the request for an apportionment of costs should be refused.

XI. The respondents' arguments relevant for the present decision may be summarised as follows:

#### Admissibility of the appeal

- a) In the statement of grounds of the appeal the appellant had not explained why the contested decision was wrong. Furthermore, by filing requests that did not contain the feature objected

to by the department of first instance under Art. 83 EPC, they indirectly admitted that the decision of the opposition division was correct, which was contrary to the findings of decisions G 1/99 (OJ EPO 2001, 381), G 8/91 (OJ EPO 1993, 346), G 9/91 (OJ EPO 1993, 408) and G 10/91 (OJ EPO 1993, 420), according to which the purpose of appeal proceedings was mainly to give the losing party the possibility of challenging the decision of the opposition division on its merits. Consequently, the requirements of Art. 108 EPC together with Rule 99(2) EPC were not met and the appeal was to be held inadmissible. Reference was further made to decisions J 22/86 (OJ EPO 1987, 280), T 162/97 of 30 June 1999 and T 2193/09 of 13 July 2010 (both not published in OJ EPO).

- b) Since the main request and the auxiliary requests filed with the statement of grounds of appeal should not be admitted to the proceedings under Art. 12(4) RPBA, the appeal had been filed with no admissible requests and was inadmissible.

#### Admissibility of the requests

- c) Each of the appellant's requests filed before the opposition division on or after 25 November 2011 either involved added matter or included a feature that had been objected to as lacking sufficient disclosure. The appellant should have expected that a decision on those issues might lead to revocation of the patent in suit. In that respect, the preliminary opinion of the opposition division was not binding. The appellant had not justified why the requests filed with the statement of grounds of appeal or those filed with letter of

4 October 2013 had not been presented or maintained before the opposition division.

Considering that requests based on similar claims had been filed during the written procedure before the opposition division but had not been pursued, the proprietor's conduct was not compatible with procedural economy.

- d) At the EPO it was standard practice to consider proceedings independently from each other. Since in the present case some of the respondents were not involved in the related case (EP 1 558 651), the appellant's arguments relying on "unusual circumstances" should be rejected.
- e) The appellant should not be allowed to put forward a "fresh case" on appeal and shift at will the proceedings from the first to the second instance, as the appellant had done in the present case. The opposition division had had no opportunity to decide upon the requests now pending. Reference was made to decisions T 1705/07 of 10 June 2010, T 356/08 of 7 July 2009, T 1067/08 of 10.02.11 and T 936/09 of 1 March 2012 (none of them published in OJ EPO).
- f) Moreover, the operative requests were not clearly allowable, e.g. for the following reasons:

- Added matter

The amendment of claim 1 requiring that the plug-flow mode should not be disrupted amounted to an undisclosed disclaimer, excluding local fluidisation as disclosed in D7 (Pittenger et

al., Polymer Engineering and Science, September 1999, Vol. 39, No. 9, 1802-1811 ). Such a disclaimer was not allowable because D7 was not an accidental anticipation.

The range for the rate of flow of air defined in claim 1 was not directly and unambiguously derivable from the application as filed.

- Clarity

The patent in suit did not disclose how the rate of flow of air was to be determined and in particular did not define which cross-section of the purge vessel had to be considered and whether or not the polymer particles should be taken into account.

The requirement that the plug-flow mode should not be disrupted implied a relatively uniform residence time of the polymer, which was not in line with the subject-matter of claim 6.

The feature "and the plug-flow mode ... is not disrupted thereby" constituted a result-to-be-achieved formulation that was not clear, in particular when read in combination with the requirement that the particulate polymer should move in "substantially plug-flow mode" according to step b).

- g) For those reasons, the requests filed with the statement of grounds of appeal or those submitted with letter of 4 October 2013 should not be admitted to the proceedings.

#### Apportionment of costs

- h) Respondent III argued that the appellant's conduct was not compatible with Art. 12(4) RPBA, which justified an apportionment of costs regarding the travel expenses.

XII. The appellant (patent proprietor) requested that the decision under appeal be set aside and that the patent be maintained in amended form according to either the main request or the auxiliary request, both requests filed with letter dated 4 October 2013.

Respondents 1, 3 and 4 requested that the appeal be held inadmissible.

All respondents requested the dismissal of the appeal.

Respondent 3 requested an apportionment of costs.

XIII. The Board announced its decision at the end of the oral proceedings.

### **Reasons for the Decision**

1. Admissibility of the appeal

1.1 According to Rule 101(1) EPC an appeal is to be held inadmissible if it does not satisfy the provisions of *inter alia* Art. 108 and Rule 99(2) EPC.

Article 108, third sentence, EPC reads: "Within four months of notification of the decision, a statement setting out the grounds of appeal shall be filed in accordance with the Implementing Regulations."

According to Rule 99(2) EPC, "In the statement of grounds of appeal the appellant shall indicate the reasons for setting aside the decision impugned, or the extent to which it is to be amended, and the facts and evidence on which the appeal is based."

Regarding the requirements to be met by the statement of grounds of appeal, Art. 12(2) RPBA, although it is not directly related to the (in)admissibility of the appeal, further requires that the statement of grounds of appeal "shall set out clearly and concisely the reasons why it is requested that the decision under appeal be reversed, amended or upheld, and should specify expressly all the facts, arguments and evidence relied on".

1.2 In the present case, in each of the requests filed with the statement of grounds of appeal the appellant deleted the feature that had been considered insufficiently disclosed by the opposition division. Although it is not explicitly stated in the statement of grounds of appeal, upon reading the contested decision and the statement of grounds of appeal it is immediately apparent that by that amendment the appellant deprived the contested decision of its basis.

1.3 According to consistent case law (Case Law of the Boards of Appeal of the EPO, 7th Edition, 2013, IV.E.2), in order to comply with Art. 108 EPC,

(a) the written statement setting out the grounds of appeal should set out fully the reasons why the



appeal should be allowed and the decision under appeal should be set aside. In that respect, the statement setting out the grounds of appeal must enable the Board to understand immediately why the decision is alleged to be incorrect and on what facts the appellant bases its arguments;

- (b) exceptionally, where the written statement does not contain such full reasons, the requirement for admissibility may be regarded as satisfied if it is immediately apparent upon reading the decision under appeal and the written statement of grounds that the decision should be set aside (see e.g. J 22/86, OJ EPO 1987, 280: Headnote I and last paragraph of section 2 of the reasons; J 10/11 of 3 December 2012, not published in OJ EPO: section 2.1 of the reasons).

1.4 The main and four auxiliary requests filed together with the statement of grounds of appeal did not contain the features objected to in the appealed decision. Therefore, it is immediately apparent that the basis for that decision no longer exists. Hence, the present case corresponds to case (b) indicated above. Also, the filing of new requests without the features that had been objected to implicitly constitutes the reason why the appellant is of the opinion that the impugned decision should be set aside.

1.5 Apart from the new requests the appellant also submitted reasons justifying the patentability of those sets of claims, also in respect of novelty and inventive step - albeit in a general manner - even though the latter issues had not formed part of the contested decision. Therefore, the appellant's requests can be considered as a *bona fide* attempt not only to

remove the objections on which the contested decision was based but also to explain why the new claims complied with the requirements of the EPC.

1.6 The respondents argued that in order to be admissible an appeal had to deal with the reasons given in the contested decision.

1.6.1 However, the respondents neither identified any provisions of the EPC supporting that argument nor did they show that any of the provisions of the EPC forbade the submission by the patent proprietor/appellant - in particular together with the statement of grounds of appeal - of new requests depriving the contested decision of its basis, even if in doing so he indirectly agreed with the findings of the department of first instance. Such practice is in agreement with consistent case law (Case Law of the Boards of Appeal of the EPO, 7th Edition, 2013, IV E.2.6.5.b) which justifies the expectation of the appellant that its appeal would be held admissible.

1.6.2 The respondents' argument relating to decisions G 8/91, G 9/91, G 10/91 and G 1/99 relies upon a sentence according to which "The purpose of the appeal procedure inter partes is mainly to give the losing party the possibility of challenging the decision of the Opposition Division on its merits" (see e.g. G 9/91: Reasons, section 18). In that respect, the use of the term "mainly" already indicates that it cannot be derived from that sentence that the *only* purpose of the appeal is to challenge the contested decision. Furthermore, that passage of G 9/91 deals with the introduction of fresh grounds of opposition in appeal and is not directly related to the issue at stake in the present case. Therefore, the respondents' argument

cannot be not followed.

- 1.7 The respondents also argued that the appeal was inadmissible because all the requests filed with the statement of grounds of appeal should not be admitted to the proceedings pursuant to Art. 12(4) RPBA.

However, the admissibility of an appeal should not be confused with the strength of an appellant's case. The requests filed with the statement of grounds of appeal serve to define the legal and factual framework of the appeal. The very filing of such requests is in the present case sufficient to render the appeal admissible, even if those requests are at a later stage not admitted to the proceedings or refused for not being allowable.

- 1.8 In decision T 2193/09 of 13 July 2010, cited by the respondents, the examining division had not accepted the submission of new requests according to Rule 137(3) EPC. The applicant had lodged an appeal and submitted the same requests without explaining why he considered the examining division wrong in refusing their submission. The Board decided that the appeal was not motivated and therefore inadmissible. Decision 2193/09 thus deals with a different factual situation than the present case and is not relevant here.

- 1.9 In decisions J 22/86 and T 162/97, also relied upon by the respondents, it was held that the admissibility of the appeal should be evaluated on the basis of the statement of grounds of the appeal and the content of the appealed decision. The present decision does not depart from those findings.

1.10 For those reasons, the requirements of Art. 108 EPC, Rule 99(2) EPC and Art. 12(2) RPBA are satisfied and the appeal is admissible.

2. Admissibility of the requests

2.1 Considering that the main purpose of the appeal proceedings is to give the losing party the possibility of challenging the decision of the opposition division on its merits, the appeal proceedings are largely determined by the factual and legal framework of the case of the preceding opposition proceedings; the parties have only limited scope to amend the subject of the dispute in second-instance proceedings (see Case Law of the Boards of Appeal of the EPO, 7th edition, 2013, IV.E.4.1.2 to 4.1.4). Although the filing of new submissions by a party is not precluded in appeal proceedings, a party is not entitled to have a request that could have been filed in first-instance proceedings admitted in the appeal proceedings. The submissions of late-filed requests is subject to the Board's discretion. These principles are reflected in the provisions of Art. 12(4) and 13(1) RPBA.

It follows from the above that the admissibility of the operative main and auxiliary requests has to be assessed.

2.2 As can be seen from the file history given in section III of the present decision, in the written phase of the opposition proceedings the appellant had filed several sets of claims in which the features of granted claim 7 were not present, so that the insufficiency objection in that respect was rendered moot. However, although he had been aware of the insufficiency issue, the appellant nevertheless decided not to pursue those

requests but rather filed two requests again containing the features of granted claim 7, at the beginning of the oral proceedings before the opposition division. In doing so, the appellant/patent proprietor has voluntarily waived the opportunity of filing, during the opposition proceedings, the requests now pending, e.g. as further auxiliary requests, for instance

- in reply to the summons to oral proceedings of the opposition division; or
- at the beginning of the oral proceedings before the opposition division; or
- at the latest during the oral proceedings before the opposition division after the two requests then pending had been refused pursuant to Art. 83 EPC.

2.3 There is no evidence on file that the opposition division in any way restricted the possibility for the patent proprietor to file additional requests either at the beginning of the oral proceedings (both requests submitted at the beginning of the oral proceedings were admitted to the proceedings by the opposition division) or after refusal of the two requests then pending.

In the related case (EP 1 558 651) referred to by the appellant, the patent had been revoked because the pending requests did not satisfy the requirements of Art. 123(2) and 123(3) EPC. Even if it were considered, to the appellant's benefit, that that decision had motivated the patent proprietor in the present case to file new requests at the beginning of the oral proceedings before the opposition division, the patent proprietor should have been aware that the opposition division would have to assess whether or not the feature "volatile content of not greater than 500 ppm by weight" of granted claim 7 fulfilled the

requirements of Art. 83 EPC, since such an objection had been raised and pursued in writing by the opponents during the whole of the proceedings. The fact that the opposition division had given a positive preliminary opinion in that respect cannot change the situation. The patent proprietor should have expected that the patent might be revoked on that ground during the oral proceedings before the opposition division, in particular considering that section 11 of the preliminary opinion made clear that its findings were not binding and could be reversed in the course of the proceedings.

Therefore, it cannot be considered that the proceedings before the department of first instance were unusual and that the appellant was prevented from filing the operative requests in the first-instance proceedings.

2.4 Furthermore, the subject-matter defined in claim 1 of the operative main request had been claimed neither in the granted patent nor in any of the appellant's previous requests, either in opposition or in appeal proceedings. Claim 1 in particular contains a preheating step (a), limited in terms of temperature, that is based on a passage of the description that was not present in any of the previous requests. The subject-matter of claim 1 of the main request therefore constitutes, already for that reason, new subject-matter that had never been examined by the first instance ("fresh case").

2.5 Apart from its late filing, the operative main request also raises complex issues in respect of its allowability.

2.5.1 Should the operative main and auxiliary requests be admitted, new issues concerning e.g. added subject-matter and clarity would have to be discussed for the first time in the appeal proceedings.

- (a) Regarding added subject-matter, claim 1 of the main request corresponds to the preferred embodiment specified on page 4, lines 3-16, of the application as filed, further amended
- by insertion of the word "unreacted" before "monomer" in line 2 of claim 1; and
  - by insertion of the feature "wherein the rate of flow of air through the purge vessel ... is not disrupted thereby".

The allowability under Art. 123(2) EPC of claim 1 of the main request was not addressed in the opposition proceedings and was objected to by the respondents, in particular in relation to the disclaimer. In addition, although no objection had been raised by the respondents in respect of the claims depending on said claim 1, the question would also have arisen whether or not the subject-matter defined in those dependent claims is directly and unambiguously derivable from the application as filed.

- (b) Regarding clarity, claim 1 of the main request was amended (as compared to granted claim 1) *inter alia* by inserting the feature "wherein the rate of flow of air ... through the purge vessel". Since that feature did not form part of the granted claims, it would have had to be assessed whether or not it satisfies the requirements of Art. 84 EPC (see section 19 of the reasons of decision G 9/91).

It is questionable if that parameter is clearly defined, taking into account that the nature of the "cross-section" to be considered is not specified in the patent in suit and that, according to paragraph [0019] and to the figure of the patent in suit, the purge vessel may have varying cross-sections. It is further not indicated at which location(s) in the purge vessel that condition should be satisfied, and various reasonable possibilities could be contemplated, e.g. in the whole vessel, or only at its larger or smaller section. In that respect, no information how that parameter is to be determined is provided in the patent in suit, in particular not in the example.

2.5.2 The same considerations apply to the auxiliary request, which contains the same passages.

2.5.3 In these circumstances, the operative main and auxiliary requests constitute subject-matter to be dealt with for the first time at a very late stage of the appeal proceedings. The admission of either the main request or the auxiliary request would have put the respondents in a worse position than if the requests had been submitted before the opposition division. Should those requests now be admitted, the subject-matter of those requests would be dealt with only by the Board, meaning the loss of one instance, or the case would have to be remitted to the department of first instance. Such a prolongation of the proceedings is incompatible with procedural economy and would deprive the respondents and the public of legal certainty about the validity of the patent in suit.



- 2.6 For these reasons the main and the auxiliary requests are not admitted to the proceedings (Art. 12(4) and 13(1) RPBA).
3. Since none of the requests of the appellant is admissible, the appeal has to be dismissed.
4. Apportionment of costs
  - 4.1 Under Art. 104(1) and Rule 88(1) EPC each party to the opposition proceedings shall bear the costs it has incurred, unless decided differently for reasons of equity. In that respect, Art. 16(1) RPBA mentions an abuse of procedure as a possible reason for ordering payment of costs.
  - 4.2 The appellant's filing of new sets of claims together with the statement of grounds of appeal is in line with long-standing practice before the EPO's Boards of Appeal (see section 1.2 above). Although in the present case none of the appellant's requests was admitted to the proceedings, it cannot be concluded either that the appellant has made an abuse of the proceedings or acted in bad faith, or that extra costs have been occurred because of the appellant's conduct. Therefore, the request for an apportionment of costs is refused.

**Order**

**For these reasons it is decided that:**

1. The appeal is dismissed.
2. The request for an apportionment of costs is refused.

The Registrar:

The Chairman:



E. Goergmaier

B. ter Laan

Decision electronically authenticated