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**Datasheet for the decision  
of 5 September 2017**

**Case Number:** T 0931/14 - 3.3.03

**Application Number:** 07703546.7

**Publication Number:** 1999170

**IPC:** C08F210/02, C09D123/08

**Language of the proceedings:** EN

**Title of invention:**  
AN EXTRUSION COATING COMPOSITION

**Patent Proprietor:**  
Saudi Basic Industries Corporation

**Opponent:**  
THE DOW CHEMICAL COMPANY

**Relevant legal provisions:**  
EPC Art. 54  
RPBA Art. 12(4), 13(1), 13(3)

**Keyword:**

Late-filed evidence - submitted with the reply to the statement of grounds of appeal - admitted (yes)

Late-filed arguments - submitted during the oral proceedings before the Board - admitted (no)

Novelty - main request and first to fourth auxiliary requests (no)

Late-filed requests - requests should have been filed in first instance proceedings - fifth to tenth auxiliary requests - admitted (no)



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Case Number: T 0931/14 - 3.3.03

**D E C I S I O N**  
**of Technical Board of Appeal 3.3.03**  
**of 5 September 2017**

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**Decision under appeal:** **Decision of the Opposition Division of the  
European Patent Office posted on 24 February  
2014 revoking European patent No. 1999170  
pursuant to Article 101(3) (b) EPC.**

**Composition of the Board:**

**Chairman** D. Semino  
**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 24 February 2014 revoking European patent No. 1 999 170.
- II. Claim 1 of the granted patent read as follows:
- "1. Use of a composition comprising a copolymer of ethylene and a co monomer copolymerisable therewith in extrusion coating applications on a substrate characterised in that the polymerisation of ethylene and a co monomer takes place in a tubular reactor at a peak temperature between 300°C and 350°C and wherein the co monomer is a bifunctional  $\alpha$ ,  $\omega$ -alkadiene."
- III. A notice of opposition against the patent was filed, in which the revocation of the patent in its entirety was requested.
- IV. The contested decision was based on a main request (granted patent) and on the first to the fourth auxiliary requests filed with letter dated 11 October 2012. Claim 1 of the first to the fourth auxiliary requests differed from granted claim 1 in that the following feature was added at the end of the claim (directly after " $\alpha$ ,  $\omega$ -alkadiene"):
- ", characterised in that co monomer is applied in an amount between 0.01 mol % and 0.5 mol % relative to the total amount of monomer" (first auxiliary request);
- ", characterised in that the bifunctional  $\alpha$ ,  $\omega$ -alkadiene is 1, 4-hexadiene, 1, 7-octadiene, 1, 9-decadiene and/or 1, 13-tetradecadiene" (second

auxiliary request);

", characterised in that the bifunctional  $\alpha$ ,  $\omega$ -alkadiene is 1, 4-hexadiene, 1, 7-octadiene, 1, 9-decadiene and/or 1, 13-tetradecadiene, characterised in that the co monomer is applied in an amount between 0.01 mol % and 0.5 mol % relative to the total amount of monomer" (third auxiliary request);

", wherein the reactor inlet pressure ranges between 100 MPa and 350 MPa" (fourth auxiliary request).

V. In the contested decision the following documents were *inter alia* referred to:

D1: WO 93/08 222

D4: Oxford Advanced Learner's Dictionary of Current English, A. S. Hornby, 1974, page 160

D5: Extrusion: The Definitive Processing Guide and Handbook, 2005, page 465

D6: Internet excerpt on extrusion coating, 1 page, undated

D7: US 3 795 540

D8: US 3 586 756

D9: Zetabon S262, Technical Datasheet, The Dow Chemical Company

D10: <http://dow.com/amplify/fab/resins.htm>, AMPLIFY Functional Polymers, Internet excerpt dated 28 January 2014, 2 pages

In that decision, the opposition division *inter alia* held that:

- Claim 1 of each of the main request (granted patent) and of the first to the fourth auxiliary requests was not novel over D1. The reasoning of

the opposition was based on the fact that the copolymer prepared in example 15 of D1 fell under the definition according to granted claim 1 and that D1 mentioned the use of such polymers for extrusion e.g. of cable insulating material or cable sheathing, which was encompassed by the term "extrusion coating applications" specified in granted claim 1. Also, the feature(s) of claim 1 of each of the first to the fourth auxiliary requests which were added to granted claim 1 were satisfied by example 15 of D1.

- Documents D7 to D9, which were late-filed, were admitted to the proceedings "as they may be relevant for one reason or the other" (section 1 of the reasons).

VI. The patent proprietor (appellant) appealed the above decision. With the statement setting out the grounds for the appeal the appellant requested that the decision be set aside and the patent be maintained as granted (main request) or, in the alternative, that the patent be maintained in amended form according to any of the first to the seventh auxiliary requests filed therewith. The main request corresponded to the granted claims and the first to the fourth auxiliary requests included in claim 1 the same additional features as the corresponding requests on which the contested decision was based.

Claim 1 of the fifth to the seventh auxiliary requests read as follows (in the present decision additions as compared to granted claim 1 are indicated in **bold**):

"1. Use of a composition comprising a copolymer of ethylene and a co monomer copolymerisable therewith in

extrusion coating applications on a substrate, **wherein the substrate is paper, board, cloth or aluminium,** characterised in that the polymerisation of ethylene and a co monomer takes place in a tubular reactor at a peak temperature between 300°C and 350°C and wherein the co monomer is a bifunctional  $\alpha$ ,  $\omega$ -alkadiene."  
(fifth auxiliary request)

"1. Use of a composition comprising a copolymer of ethylene and a co monomer copolymerisable therewith in extrusion coating applications on a substrate, **and wherein the extrusion coating application is liquid packaging cartons, aseptic packaging, food packaging, tapes, paper board cups, food carton stock, frozen food and dual oven able trays, pouches, multi wall bags, release papers or photographic papers,** characterised in that the polymerisation of ethylene and a co monomer takes place in a tubular reactor at a peak temperature between 300°C and 350°C and wherein the co monomer is a bifunctional  $\alpha$ ,  $\omega$ -alkadiene."  
(sixth auxiliary request)

"1. Use of a composition comprising a copolymer of ethylene and a co monomer copolymerisable therewith in extrusion coating applications on a substrate, **wherein the substrate is paper, board, cloth or aluminium and wherein the extrusion coating application is liquid packaging cartons, aseptic packaging, food packaging, tapes, paper board cups, food carton stock, frozen food and dual oven able trays, pouches, multi wall bags, release papers or photographic papers,** characterised in that the polymerisation of ethylene and a co monomer takes place in a tubular reactor at a peak temperature between 300°C and 350°C and wherein the co monomer is a bifunctional  $\alpha$ ,  $\omega$ -alkadiene."  
(seventh auxiliary request)

Also, the following documents were submitted:

- D11: Extrusion Coating - A Process Manual,  
B.H. Gregory, 2010, pages 5, 6 and 174
- D12: WO 2013/078018
- D13: EP 1 616 887
- D14: EP 2 123 707
- D15: US 2010/0221528
- D16: EP 2 631 268

VII. In its reply to the statement of grounds of appeal the respondent (opponent) requested that the appeal be dismissed or, if necessary, that the case be remitted to the department of first instance to deal with the issue of inventive step. Also, the following documents were filed:

- D17: EP 1 735 382
- D18: WO 2008/098175
- D19: WO 2007/149639
- D20: EP 2 223 310
- D21: ISO definition of "extrusion coating"  
(<https://www.iso.org/obp/ui#iso:std:iso:472:ed-4:v1:en>)

The following documents were further cited:

- D22: US 2 308 638
- D23: US 4 588 546
- D24: EP 0 470 824

VIII. Issues to be discussed at the oral proceedings were specified by the Board in a communication dated 8 March 2017.



IX. With letter of 10 July 2017 the appellant filed the eighth to the tenth auxiliary requests and requested that D17 to D24 be not admitted to the proceedings.

Each of the eighth and the ninth auxiliary requests consisted in a single claim which was identical to claim 1 of the fifth and of the seventh auxiliary request, respectively.

Claim 1 of the tenth auxiliary request read as follows:

"1. Use of a composition comprising a copolymer of ethylene and a co monomer copolymerisable therewith in extrusion coating applications on a substrate **to enhance the web stability during the extrusion coating** characterised in that the polymerisation of ethylene and a co monomer takes place in a tubular reactor at a peak temperature between 300°C and 350°C and wherein the co monomer is a bifunctional  $\alpha, \omega$ -alkadiene."

X. Oral proceedings before the Board were held on 5 September 2017 in the presence of both parties.

XI. The appellant's arguments, insofar as relevant to the decision, may be summarised as follows:

#### **Admittance of documents**

(a) In its decision to admit documents D7 to D9 the opposition division did not use the well established standard of *prima facie* relevance. In that respect, considering that D7 and D8 were related to cable technology and not to extrusion coating in the sense of the patent in suit, they were not *prima facie* relevant. Also, the relevance of D9 was not established. Therefore, the

opposition division's decision regarding the admission to the proceedings of D7 to D9 should be overturned and D7 to D9 should not be admitted to the proceedings.

- (b) D17 to D24 were all related to wire coating and not to extrusion coating in the sense of the patent in suit. Therefore, those documents were *prima facie* not relevant and should not be admitted to the proceedings.

**Main request - Novelty**

- (c) The expression "extrusion coating" mentioned in granted claim 1 had a specific meaning and was not equivalent to "coating by extrusion" as held by the opposition division and the respondent. As shown in D4 to D6 and D10 to D16 (whereby D12 was in the name of the opponent) "extrusion coating" was directed to a specific process which involved an extruder from which a polymer film was extruded, a substrate onto which the polymer was to adhere to and a combination of pressure roll and chill roll in which the film and the substrate were pressed together. Such a process was in particular the sole process which was referred to in the patent specification, in which it was further stressed that features such as web stability, neck-in and draw down, which are all specific to the above indicated process, were important. Also the example of the patent specification was directed to such a process.
- (d) The passages of D1 retained by the opposition division and cited by the respondent were all related to wire coating applications, which was not

an "extrusion coating" in the sense of the patent in suit. In that respect, it was known in the art that "extrusion coating" in the sense of the patent in suit and "wire coating" were two different technical fields requiring different polymers, in particular in respect of long chain branching, amounts of unsaturation and/or elasticity. Therefore, the subject-matter of granted claim 1 was at least for that reason novel over D1.

- (e) Example 15 of D1 could not be reworked because essential parameters related to e.g. the reactor dimensions, pressure drop, initiator were missing. Therefore, said example 15 did not constitute an enabling disclosure and could not be relied upon for novelty.
- (f) Example 15 of D1 failed to disclose a "peak temperature" according to granted claim 1. Although reactor temperatures were mentioned in said example 15, there was no evidence on file that the "peak temperature" was meant. Although that argument was submitted for the first time during the oral proceedings it had already been put forward in writing during the examination phase and could not surprise the respondent, in particular because it had been cited on page 2 of the respondent's notice of opposition.

**First to fourth auxiliary requests - Novelty**

- (g) The comonomer amount according to claim 1 of each of the first and the third auxiliary requests was not directly and unambiguously disclosed in example 15 of D1. Considering that the processes used in examples 6 and 15 of D1 differed in

significant aspects, the comonomer amount of example 15 could not be derived from that of example 6 of D1, contrary to the opposition division's conclusion.

- (h) There was no evidence on file that the pressure disclosed in example 15 of D1 was the "reactor inlet pressure" according to claim 1 of the fourth auxiliary request.
- (i) For those reasons, the subject-matter of the first, the third and the fourth auxiliary requests was novel over D1.
- (j) The second auxiliary request was novel for the same reasons as for the main request.

**Fifth to seventh auxiliary requests - Admittance**

- (k) It was only with the reading of the contested decision, in particular section 3.1 of the Reasons, that the appellant understood that the opposition division held the interpretation of "extrusion coating" not to be limited to flat substrates. The fifth to the seventh auxiliary requests were therefore filed at the first opportunity. Besides, those requests neither brought additional complexity to the case nor constituted a fresh case. For those reasons, those requests should be admitted.

**Eighth and ninth auxiliary requests - Admittance**

- (l) The same arguments were valid as for the fifth and the seventh auxiliary requests, respectively.

**Tenth auxiliary request - Admittance**

(m) The provisional opinion of the Board on the interpretation of the feature "extrusion coating" was based on documents only provided with the respondent's reply to the statement of grounds of appeal. Therefore, only with the notification of the Board's communication the appellant became aware of the Board's position regarding those newly filed documents and the tenth auxiliary request had been submitted at the first opportunity. The subject-matter of the tenth auxiliary request was further easy to understand and did not complicate the case. Nor did it constitute a fresh case or would lead to adjournment of the arranged oral proceedings. Besides, its admission would contribute to the procedural efficiency.

The clarity issue submitted by the respondent was filed late and should not be admitted to the proceedings.

For those reasons, the tenth auxiliary request should be admitted to the proceedings.

XII. The respondent's arguments, insofar as relevant to the decision, may be summarised as follows:

**Admittance of documents**

(a) D7 to D9 were all relevant for establishing the meaning of the term "extrusion coating" according to granted claim 1. The opposition division was correct in admitting those documents and there was no reason to overturn its decision.

(b) Considering that D17 to D24 were all very relevant to determine the meaning of the term "extrusion coating", they should be admitted to the proceedings.

**Main request - Novelty**

(c) D1 disclosed compositions as defined in granted claim 1 and their use for extrusion e.g. of cable insulating material or cable sheathing.

(d) The wording of granted claim 1 "extrusion coating applications" was to be read in its broadest sense, whereby the patent in suit contained no limitation regarding the definition of that expression. In particular, it was not allowable to read the wording of claim 1 in a limited manner based on the content of the description.

(e) It was further derivable from D17 to D20 (which all belonged to an entity within the same group as the appellant), as well as from D7, D8 and D21 to D24 that the term "extrusion coating" encompassed coating wires by extrusion. The fact that other documents disclosed that "extrusion coating" could have a more restrictive meaning did not change the fact that that term, in its broadest sense, encompassed wire coating applications.

(f) Parameters such as long chain branching, amount of unsaturation and elasticity were not reflected in granted claim 1 and could not confer novelty.

(g) The appellant's arguments regarding a lack of enablement as well as with respect to the lack of disclosure of the peak temperature in example 15 of

D1 were submitted for the first time during the oral proceedings before the Board. Those features had never been contested beforehand and those new objections took the respondent by surprise. It had always been the respondent's view that the reactor temperature mentioned in example 15 of D1 was the peak temperature. Therefore, those new lines of arguments should not be admitted to the proceedings or, should they be admitted, the case should be remitted to the first instance.

- (h) For those reasons, the subject-matter of granted claim 1 was not novel over D1.

**First to fourth auxiliary requests - Novelty**

- (i) The appellant's arguments regarding the comonomer amount according to claim 1 of the first and third auxiliary request and according to the reactor inlet pressure according to claim 1 of the fourth auxiliary request were submitted for the first time during the oral proceedings before the Board. Those features had never been contested beforehand and those new lines of defense took the respondent by surprise. Therefore, those new lines of argumentation should not be admitted to the proceedings or, should they be admitted, the case should be remitted to the first instance.
- (j) Example 15 of D1 was carried out using one of the comonomer now being specified in claim 1 of the second auxiliary request. Therefore, the second auxiliary request was not allowable for the same reasons as the main request.

- (k) Since the amendments made did not distinguish the subject-matter of the first, third and fourth auxiliary requests from that of the main request, those requests lacked novelty for the same reasons as the main request.

**Fifth to seventh auxiliary requests - Admittance**

- (l) Novelty over D1 had been objected to as early as in the notice of opposition and had been further objected to in the opposition division's summons to oral proceedings, whereby it was derivable that the opposition division considered that the term "extrusion coating" according to granted claim 1 encompassed "wire coating" according to D1. Therefore, the fifth to seventh auxiliary requests, which were filed to overcome the novelty objection over D1, should have been filed during the first instance proceedings. As a consequence, they should not be admitted to the proceedings pursuant to Article 12(4) RPBA.

**Eighth and ninth auxiliary requests - Admittance**

- (m) The same arguments were valid as for the fifth to seventh auxiliary requests.

**Tenth auxiliary request - Admittance**

- (n) The tenth auxiliary request should have been filed during the first instance proceedings for the same reasons as the fifth to the ninth auxiliary requests. Besides, in absence of any reference point for the enhancement now being specified in claim 1, the requirements of clarity pursuant to Article 84 EPC were not met and the tenth auxiliary



request was not clearly allowable. For those reasons, the tenth auxiliary request should not be admitted to the proceedings.

XIII. The appellant requested that the decision under appeal be set aside and that the patent be maintained as granted (main request) or, in the alternative, that the patent be maintained in amended form on the basis of any of the first to seventh auxiliary requests, filed with the statement setting out the grounds of appeal, or on the basis of any of the eighth to tenth auxiliary requests filed with letter dated 10 July 2017.

The respondent requested that the appeal be dismissed and, if necessary, that the case be remitted to the department of first instance to deal with the issue of inventive step.

## **Reasons for the Decision**

### **Admittance to the proceedings of D7 to D9 and D11 to D24**

1. The appellant requested that the opposition division's decision regarding the admission to the proceedings of D7 to D9 be overturned and that D17 to D24 be not admitted to the proceedings.
- 1.1 Regarding D7 to D9, it is derivable from section 1 of the reasons of the decision and from section 1.4 of the minutes of the oral proceedings that the issue of the relevance was considered by the opposition division. Therefore, it may not be concluded that the opposition division has exercised its discretion according to the

wrong principles or without taking into account the right principles (see Case Law of the Boards of Appeal of the EPO, 8<sup>th</sup> edition, 2016, IV.E.3.6). Also, the patent proprietor had the opportunity to take position on those documents (Article 113 EPC), as shown e.g. by their letter of 13 January 2014.

The Board is further not aware of any provisions of the EPC under which documents which were admitted to the proceedings by the opposition division and relied upon in the contested decision could be excluded from the proceedings at the appeal stage.

Under those circumstances, the appellant's request to overturn the opposition division's decision regarding the admission to the proceedings of D7 to D9 because the wrong principle had been used is rejected.

- 1.2 Documents D17 to D24 were all submitted together with the respondent's reply to the appellant's statement of grounds of appeal i.e. pursuant to Article 12(2) RPBA. All those documents were filed in support of the respondent's argumentation in respect of the meaning of the term "extrusion coating", which is a crucial issue of the contested decision on novelty. On the same issue the appellant filed documents D11 to D16 with the statement of grounds to support its understanding of the term. Under those circumstances, it is not justified not to admit to the proceedings any of those documents pursuant to Article 12(4) RPBA.

**Main request (patent as granted)**

2. Article 54 EPC

2.1 The sole objection raised by the respondent is in respect of D1, whereby the line of argumentation retained by the opposition division was followed i.e. the respondent argued that the copolymer prepared in example 15 of D1 fell under the definition according to granted claim 1 and further considered that D1 mentioned the use of such polymers for extrusion e.g. of cable insulating material or cable sheathing, which was encompassed by the term "extrusion coating applications" specified in granted claim 1.

2.2 Regarding the meaning of the term "extrusion coating", the question to be answered is if a wire coating according to D1 is encompassed by the expression "extrusion coating applications" according to granted claim 1, which was disputed by the parties.

In that respect, the patent in suit does not provide any limitation in respect of the definition of that term. Under those circumstances, the normal rule of claim construction is that the terms used in a claim should be given their broadest technically sensible meaning in the context of the claim in which they appear.

The Boards sees no technical reasons why wire coating accomplished by extrusion should not fall under the general term "extrusion coating".

Moreover, according to D21, the ISO definition of the term "extrusion coating" is "coating process in which a molten plastic is extruded continuously on to a moving

substrate". It makes no doubt that the extrusion of cable insulating material or cable sheathing according to D1 (see e.g. page 9, line 30 to page 11, line 3 and example 19) falls under that definition.

It may further be concluded from D17 (published as WO 2005/097900 before the priority date of the patent in suit; see paragraphs 33, 35, 36), D22 (claim 11; page 2, left column, line 25), D23 (column 1, lines 35-37) and D24 (claims 1, 4, 7, 12) that the term "extrusion coating" is used in the art to deal with wire coating applications. Also, it is derivable from D18 (claims 12, 13, 30, paragraphs 48, 71, 80, 83, 85, 88, 117, 195-199, 208, 210), D19 (middle of page 22) and D20 (claim 3) that also in the period around the priority/filing date of the patent in suit, the term "extrusion coating" was used in respect of wire coating application, in particular by the appellant.

In view of the above, the term "extrusion coating" specified in granted claim 1 is read as encompassing wire coating applications according to D1 and the fact that only properties such as web stability, neck in and draw down are mentioned in the patent in suit is not sufficient to limit the scope of claim 1, contrary to the appellant's view.

The fact that textbooks or other prior art documents such as D4 to D6 and D10 to D16, which were relied upon by the appellant, indicate that the term "extrusion coating" is also used with a more restricted meaning does not alter the above conclusion, in particular in view of D21 which provides the ISO definition for that term and further considering that numerous documents were relied upon by the respondent (i.e. not a single, isolated disclosure).

Under those circumstances, there is no reason to deviate from the literal reading of granted claim 1 according to which the term "extrusion coating applications", in its broadest sense, encompasses wire coating by extrusion according to D1.

2.3 As a consequence, the fact that "extrusion coating on flat substrates" and "wire coating" are two different technical fields which require different types of polymers, as argued by the appellant, is not relevant and cannot be used to distinguish the subject-matter of operative claim 1 from the disclosure of example 15 of D1. The same is valid regarding the appellant's argument according to which the polymers used in both types of applications must exhibit different properties such as long chain branching, amount of unsaturation and elasticity: since those features are neither explicitly, nor implicitly present in granted claim 1, they cannot confer novelty to the subject-matter of granted claim 1.

2.4 The appellant argued in addition that example 15 of D1 did not constitute an enabling disclosure and failed to disclose the "peak temperature" according to granted claim 1.

2.4.1 It was agreed to by the appellant during the oral proceedings before the Board that on appeal those lines of defense were raised for the first time during those oral proceedings. Therefore, those new lines of defense constitute amendments to the appellant's case pursuant to Article 13(1) RPBA and their admission to the proceedings is subject to the Board's discretion (Article 13(1) RPBA) and underlie the additional

stipulations of Article 13(3) RPBA.

2.4.2 In that respect, the novelty objection based on example 15 of D1 had already been raised by the respondent in the notice of opposition and continuously defended afterwards, so that the patent proprietor was well aware of that objection. Therefore, there is no apparent reason why those new lines of defense could not have been filed earlier either during the opposition or the appeal proceedings, in particular when filing the statement of grounds of appeal, which would have satisfied the stipulations of Article 12(1)b) and 12(2) RPBA according to which the appellant should present its complete case in its statement of grounds of appeal.

2.4.3 Besides, according to the case law, it is a matter for each party himself to submit all facts, evidence, arguments and requests relevant for the enforcement or defence of his rights as early and completely as possible, in particular in *inter partes* proceedings in order to act fairly towards the other party and, more generally, to ensure due and swift conduct of the proceedings (Case Law, *supra*, IV.E.4.1.2 and 4.1.4). By waiting until the last possible moment to submit those additional lines of defense, namely the day of the oral proceedings before the Board, the appellant has not acted fairly towards the respondent and has not ensured an efficient conduct of the proceedings.

In the present case, it is further the Board's view that those new lines of defense, which put into question for the first time the question of the enablement of example 15 of D1 and of the meaning of the reactor temperature disclosed therein, are related to new and complex technical issues which had not been

addressed in the proceedings yet. In that respect, although it is correct that during the examination process the applicant (now appellant) had argued that example 15 of D1 did not disclose a peak temperature according to granted claim 1 (letter of 15 May 2009, page 2: see "essential differences between D1 and the present application"), the opponent (now respondent)'s view according to which the temperature of 325°C disclosed in example 15 of D1 was the reactor peak temperature (notice of opposition: page 2, first sentence of the last paragraph) was not contested either during the opposition proceedings (both in writing or during the oral proceedings) or during the written phase of the appeal proceedings. The appellant has further not reacted in writing to the Board's communication, which had been sent well in advance of the oral proceedings (about six months), in which it was indicated that the respondent's view was that the copolymer prepared in example 15 of D1 felt under the definition according to granted claim 1 (see section 8.1).

Under those circumstances, it is credible that the respondent was taken by surprise by the appellant's new lines of defense, and was not in a position to defend its case at the oral proceedings before the Board so that admitting those new lines of defense would have required an adjournment of the oral proceedings, which goes against the stipulations of Article 13(3) RPBA.

2.4.4 For those reasons the Board finds it appropriate to exercise its discretion by not admitting into the proceedings the new lines of defense according to which example 15 of D1 did not constitute an enabling disclosure and failed to disclose the "peak temperature" according to granted claim 1

(Article 13(1) and (3) RPBA).

- 2.5 In view of the above, the appellant's argumentation provides no reason to overturn the opposition division's decision according to which the subject-matter of granted claim 1 is not novel over D1.

**First and fourth auxiliary requests**

3. Claim 1 of each of the first and fourth auxiliary requests differs from claim 1 of the main request in that a specific range of the amount of the comonomer and a specific range of "reactor inlet pressure", respectively, is mentioned therein. The appellant argued that neither such a comonomer amount nor such an inlet pressure was directly and unambiguously disclosed in example 15 of D1.
- 3.1 However, it was acknowledged by the appellant during the oral proceedings before the Board that said lines of defense were submitted for the first time on appeal during the oral proceedings. Therefore, those new lines of defense constitute amendments to the appellant's case pursuant to Article 13(1) RPBA and their admission to the proceedings is in particular subject to the Board's discretion (Article 13(1) RPBA).
- 3.2 In that respect, it is noted that the comonomer amount feature was already discussed during the first instance proceedings, in particular during the oral proceedings before the opposition division (see point 6 of the minutes) and that the "reactor inlet pressure" feature was not objected to during the first instance proceedings, in particular not during the oral proceedings before the opposition division (see point 7.1 of the minutes), which was not contested by the



appellant during the oral proceedings before the Board.

It was further explained in section 3.2 of the contested decision why the opposition division considered that said features were satisfied by example 15 of D1. Those conclusions were never contested in the written phase of the appeal proceedings, in particular neither in the statement of grounds of appeal (see section 4.2) nor in the appellant's last submission (dated 10 July 2017). The appellant further did not react to the Board's communication in which it was indicated that "in respect of novelty, no argument was submitted by the appellant to refute the opposition division's conclusion according to which the amendments made in granted claim 1 in each of the first to fourth auxiliary requests did not further distinguish the subject-matter being claimed from D1" (see section 10).

Under those circumstances and independently of the possible success of those features in conferring novelty to the subject-matter being claimed, the Board considers that the submission of those lines of defense at such a late stage of the proceedings in a case where the relevant issues were known from the very beginning of the appeal proceedings neither satisfies the requirements of Article 12(2) RPBA, according to which the appellant should submit a complete case in its statement of grounds of appeal, nor satisfies the requirements of fairness to the other party and the need for economy of the proceedings.

Moreover, in order to make an accurate analysis possible for the respondent, an adjournment of the oral proceedings would have been necessary, which is contrary to the stipulations of Article 13(3) RPBA.

For those reasons the Board finds it appropriate to exercise its discretion by not admitting into the proceedings the new lines of defense according to which example 15 of D1 failed to disclose either the comonomer amount or the reactor inlet pressure according to granted claim 1 of the first the fourth auxiliary requests (Article 13(1) and (3) RPBA).

- 3.3 In view of the above, the appellant's argumentation provides no reason to overturn the opposition division's decision according to which the subject-matter of the first and of the fourth auxiliary request is not novel over D1.

**Second auxiliary request**

4. Claim 1 of the second auxiliary request differs from claim 1 of the main request in that specific comonomers, in particular "1,9 decadiene", are mentioned therein.

Considering that example 15 of D1 was carried out using 1,9 decadiene as comonomer (D1: page 16, line 22), the amendment made cannot change the reasoning and the conclusion given for novelty in respect of the main request. Therefore, there is also no reason to overturn the opposition division's decision according to which the subject-matter of the second auxiliary request is not novel over D1.

**Third auxiliary request**

5. Claim 1 of the third auxiliary request differs from claim 1 of the main request in that the amendments made in claim 1 of each of the first and second auxiliary

requests were combined.

Considering that the appellant's new line of argumentation regarding the comonomer amount is not admitted to the proceedings and that one of the comonomer now being defined in claim 1 is also used in example 15 of D1, there is also no reason to overturn the opposition division's conclusion according to which the subject-matter of claim 1 of the third auxiliary request is not novel over D1.

#### **Fifth to seventh auxiliary requests**

6. Admittance

6.1 The respondent requested that the fifth to seventh auxiliary requests not be admitted to the proceedings because they should have been filed in the first instance proceedings.

6.2 Considering that the fifth to seventh auxiliary requests were submitted together with the appellant's statement of grounds of appeal they were filed pursuant to Article 12(2) RPBA and undergo the stipulations of Article 12(4) RPBA according to which the Board has the power to hold inadmissible requests which could have been presented in the first instance proceedings.

6.3 In that respect, the question has to be answered whether there are objective reasons why the appellant could have been expected to present its requests in the first instance proceedings (see Case Law, *supra*, IV.E. 4.3.2.c), i.e. if those requests should have been filed in the first instance proceedings.

- 6.4 In view of the amendments made in claim 1 of each of the fifth to the seventh auxiliary requests and of the appellant's argumentation in that respect (section 4.3 of the statement of grounds of appeal) it makes no doubt that those requests were filed in reply to the contested decision and aimed at overcoming the novelty objection over example 15 of D1 retained by the opposition division.
- 6.5 However, said objection in respect of D1 had been raised as early as in the notice of opposition and the issue regarding whether the term "extrusion coating" encompassed "wire coating" was at stake from the beginning of the opposition proceedings. Besides, the opposition division had provided a negative opinion on novelty in respect of D1 in its communication, which was sent well in advance of the oral proceedings (2 May 2013; oral proceedings held on 5 February 2014), whereby it was indicated that applications such as cable insulating material or cable sheathing by extrusion as taught in D1 were encompassed by the term "extrusion coating" according to granted claim 1 (see section 3.3). In addition, it could have been derived from the last two paragraphs of section 3.3 of said preliminary opinion that the opposition division considered that the subject-matter of the then pending first to fourth auxiliary requests, which are identical to the first to fourth auxiliary requests on which the contested decision is based, lacked novelty over D1. Therefore, the appellant should not have been surprised by the outcome of the oral proceedings in respect of those requests.

The fact that D7 and D8, which were filed on 20 December 2013 (i.e. after the preliminary opinion was sent but before the oral proceedings before the

opposition division was held), were also taken in consideration by the opposition division in the contested decision does not change the above facts because those documents only strengthened the opponent's line of argumentation but did not amount to a new objection.

Therefore, in the circumstances of the present case, it is concluded that the appellant could have been expected to submit the fifth to the seventh auxiliary requests already during the first instance proceedings.

Further considering that there was no surprising development of the case, that the objection retained by the opposition division was not particularly complicated to understand and/or different from the arguments put forward by the opponent in writing and that the amendments now made constitute a straightforward mean to address the opposition division's objection, the Board is further of the opinion that, in the present case, the appellant should have filed those requests in the first instance proceedings.

- 6.6 The appellant argued that it was only with the reading of the contested decision that they understood that the opposition division held the interpretation of "extrusion coating" not to be limited to flat substrates.

However, the opposition division had already stated in its preliminary opinion that they considered that the wire coating applications disclosed in D1 were encompassed by the feature "extrusion coating applications" according to granted claim 1 and that novelty over D1 was therefore denied i.e. the

opposition division adhered to the opponent (now respondent)'s objection of lack of novelty over D1. The fact that the appellant had already understood that the novelty objection submitted by the respondent was based *inter alia* on the reading of the term "extrusion coating" in a broader sense than made by the appellant is further derivable from their letters dated 11 October 2012 (section 5) and 4 December 2013 (section 4), the latter dealing exclusively with that issue as far as substantive issues are concerned.

In view of the above, the appellant's argument does not convince.

- 6.7 Under these circumstances, the board considers it appropriate to exercise its discretion pursuant to Article 12(4) RPBA and decides not to admit to the proceedings the fifth to the seventh auxiliary requests.

#### **Eighth to tenth auxiliary requests**

7. Admittance

- 7.1 The respondent requested that the eighth to the tenth auxiliary requests not be admitted to the proceedings.

- 7.2 Considering that the eighth to the tenth auxiliary requests were submitted after oral proceedings had been arranged, their admission to the proceedings is in particular subject to the Board's discretion (Article 13(1) RPBA) and underlies the additional stipulations of Article 13(3) RPBA.

- 7.3 The eighth and ninth auxiliary requests consist of a single claim which is identical to claim 1 of each of

the fifth and the seventh auxiliary requests, respectively. Since the fifth and the seventh auxiliary requests were not admitted to the proceedings because of their late filing, the eighth and ninth auxiliary requests, which were filed even later, must share the same fate in respect of admittance to the proceedings.

- 7.4 In view of the amendments made in claim 1 of each of the eighth to the tenth auxiliary requests it makes further no doubt that those requests also aimed at overcoming the novelty objection over example 15 of D1 retained by the opposition division. Therefore, those requests should have been filed in the first instance proceedings for the same reasons as for the fifth to the seventh auxiliary requests.
- 7.5 Regarding the tenth auxiliary request, the appellant argued that it was filed in reply to the Board's communication in which the Board's position was provided for the first time in respect of documents D17-D24 which were submitted in the respondent's reply to the statement of grounds of appeal.
- 7.5.1 However, no new objection was raised *ex officio* by the Board and no new line of argument was raised by the respondent as compared either to the opposition proceedings and/or their reply to the statement of grounds of appeal. Therefore, in circumstances of the present case, it was not shown that an unexpected development of the case may have justified the late filing of the tenth auxiliary request (see Case Law, *supra*, IV.E.4.4.12). Therefore, the appellant's argument is rejected.
- 7.5.2 It is further noted that claim 1 of the tenth auxiliary request differs from granted claim 1 in that the

feature "to enhance the web stability during the extrusion coating" was added.

Considering that that feature did not make part of the granted claims (which was not contested by the appellant at the oral proceedings before the Board), that feature may be examined for compliance with the requirements of Article 84 EPC (G 3/14: see e.g. catchword). However, in the absence of any reference point for the enhancement mentioned in claim 1, it does not appear that the skilled person is in a position to determine unambiguously when he is working within or outside the scope of claim 1. For that reason it is highly questionable if the tenth auxiliary request satisfies the requirements of Article 84 EPC. Admitting the tenth auxiliary request to the proceedings would thus have required to deal with a new issue for the first time at the oral proceedings, which runs counter to the need for procedural economy.

Since the tenth auxiliary request was filed with the appellant's submission dated 10 July 2017, i.e. about two months before the oral proceedings, it is not justified not to consider the respondent's concerns regarding clarity in order to decide on the admission to the proceedings of the tenth auxiliary request.

- 7.6 In view of the above, the Board finds it appropriate to exercise its discretion by not admitting into the proceedings the eighth to the tenth auxiliary requests (Article 13(1) RPBA).
8. None of the appellant's requests being allowable or admissible, the appeal has to be dismissed.



**Order**

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

The appeal is dismissed.

The Registrar:

The Chairman:



B. ter Heijden

D. Semino

Decision electronically authenticated