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**Datasheet for the decision  
of 9 July 2019**

**Case Number:** T 0899/17 - 3.3.09

**Application Number:** 05732451.9

**Publication Number:** 1735150

**IPC:** B32B27/08, B32B27/32

**Language of the proceedings:** EN

**Title of invention:**

MULTI-LAYER FILMS HAVING IMPROVED SEALING PROPERTIES

**Patent Proprietor:**

Jindal Films Americas LLC

**Opponents:**

Taghleef Industries LLC  
Treofan Germany GmbH & Co. KG

**Headword:**

Fundamental deficiency - lack of reasoning

**Relevant legal provisions:**

EPC R. 111(2)  
RPBA Art. 11

**Keyword:**

Remittal to the department of first instance - fundamental deficiency in first instance proceedings (yes)  
Reimbursement of appeal fee

**Decisions cited:**

T 0493/88, T 0278/00, T 0897/03, T 2282/17

**Catchword:**

The reasons for the failure of auxiliary requests which were skipped in the discussion during the oral proceedings before the opposition division in favour of more promising lower-ranking auxiliary requests and which were explicitly not withdrawn by the patent-proprietor have to be set out in the written decision.



**Beschwerdekammern**  
**Boards of Appeal**  
**Chambres de recours**

Boards of Appeal of the  
European Patent Office  
Richard-Reitzner-Allee 8  
85540 Haar  
GERMANY  
Tel. +49 (0)89 2399-0  
Fax +49 (0)89 2399-4465

Case Number: T 0899/17 - 3.3.09

**D E C I S I O N**  
**of Technical Board of Appeal 3.3.09**  
**of 9 July 2019**

**Appellant:** Jindal Films Americas LLC  
(Patent Proprietor) 411 Pegasus Parkway  
LaGrange, GA 30240 (US)

**Representative:** Barker Brettell LLP  
100 Hagley Road  
Edgbaston  
Birmingham B16 8QQ (GB)

**Appellant:** Taghleef Industries LLC  
(Opponent 1) Jebel Ali Industrial Area 1  
Dubai (AE)

**Representative:** Kutzenberger Wolff & Partner  
Waidmarkt 11  
50676 Köln (DE)

**Appellant:** Treofan Germany GmbH & Co. KG  
(Opponent 2) Bergstrasse  
66539 Neunkirchen (DE)

**Representative:** Mai Dörr Besier  
European Patent Attorneys  
European Trademark Attorneys  
Patentanwälte  
Kreuzberger Ring 64  
65205 Wiesbaden (DE)

**Decision under appeal:** Interlocutory decision of the Opposition  
Division of the European Patent Office posted on  
7 February 2017 concerning maintenance of the  
European Patent No. 1735150 in amended form.

**Composition of the Board:**

**Chairman**            W. Sieber  
**Members:**            A. Veronese  
                             D. Prietzel-Funk

## **Summary of Facts and Submissions**

- I. This appeal case concerns the interlocutory decision of the opposition division dated 7 February 2017, where it was decided that the European patent 1 735 150 could be maintained in amended form on the basis of auxiliary request 10 submitted during the oral proceedings before the opposition division under Article 101(3)(a) EPC. According to point 14 of the decision, it was based on a main request (claims as granted), auxiliary request 3, auxiliary request 10 (old; filed during the written procedure) and auxiliary request 10 (new; filed during the oral proceedings before the opposition division).
- II. The patent proprietor and both opponents filed an appeal against this decision, submitted their statements setting out the grounds of appeal and requested oral proceedings on an auxiliary basis.
- III. The patent proprietor requested that the decision under appeal be set aside and that the patent be maintained as granted or on the basis of auxiliary requests 1 to 14 submitted with the letter setting out the grounds of appeal or of auxiliary requests 15 to 18 submitted with the letter dated 3 November 2017.
- IV. Opponents 1 and 2 requested that the decision under appeal be set aside and that the patent be revoked in its entirety.
- V. During the admissibility check, the board became aware of a substantial deficiency in the first instance proceedings which appeared to be fundamental in the sense of Article 11 RPBA. In particular, the impugned

decision failed to give reasons in relation to a number of auxiliary requests then on file.

- VI. In a communication dated 16 July 2018, the board informed the parties about its view and noted that it was minded to remit the case to the department of first instance and to order reimbursement of the appeal fees. It invited the parties to inform it whether they would withdraw their respective auxiliary requests for oral proceedings such that the board was able to deliver a written decision on remittal.
- VII. Until 6 March 2019 all parties agreed to proceed as proposed and withdrew their auxiliary requests for oral proceedings.
- VIII. Opponent 2 withdrew its opposition with letter dated 30 April 2019 and requested to reimburse the appeal fee.
- IX. The patent proprietor and opponent 1 requested that the decision under appeal be set aside and that the case be remitted to the opposition division for further prosecution and that the respective appeal fees be reimbursed.

### **Reasons for the Decision**

- 1. Procedural deficiency
  - 1.1 According to Rule 111(2) EPC, decisions which are open to appeal shall be reasoned. Only if a decision is adequately reasoned a party adversely affected by a decision of the department of first instance or a board of appeal is able to examine whether the decision was justified or not. Pursuant to the established

jurisprudence of the Boards of Appeal a decision of any of the departments of first instance of the EPO must contain, in logical sequence, those arguments which justify the order. In accordance with established case law (see e.g. T 0897/03, T 0278/00 and T 2282/17) a violation of Rule 111(2) EPC is considered a substantial procedural violation.

1.2 In the impugned decision the opposition division gave reasons for the failure of the main request, auxiliary request 3, auxiliary request 10 (old, though the latter was already replaced by auxiliary request 10 new) and the success of new auxiliary request 10. In the end of the written decision it said: "The proprietor maintained the remaining requests in the order they were filed". Those were auxiliary requests 1, 2 and 4 to 9, however any reasoning with regard to the failure of those (higher ranking) requests is missing in the decision.

1.3 After a proper discussion of the issues with the parties, the opposition division should have given reasons for all relevant requests on file pending before it, e.g. the main request (claims as granted) and auxiliary requests 1 to 10 (clearly no reasoning was required regarding lower-ranking auxiliary request 11 also on file). According to the minutes of the oral proceedings before the opposition division the main request was discussed and its subject-matter was not found patentable. On proposal of the patent proprietor the discussion went on with auxiliary request 3 (leaving out auxiliary requests 1 and 2), and then - again on the patent proprietor's proposal - with auxiliary request 10 (old) by skipping auxiliary requests 4 to 9, both requests discussed also not considered acceptable. Auxiliary request 10 was then

replaced by a new auxiliary request 10 which the opposition division finally found to meet the requirements of the EPC. According to the minutes, at the end of the oral proceedings the patent proprietor explicitly declared that it would not withdraw any of the auxiliary requests filed during the written procedure (see p.9 of the minutes). This concerned auxiliary requests 1, 2, 4 to 9 (and 11).

- 1.4 Since auxiliary requests 1, 2 and 4 to 9 were still pending the opposition division should have given reasons why it found them not to fulfil the requirements of the EPC, notwithstanding the patent proprietor's proposal to proceed with the more distant auxiliary requests 3 and 10. However this does not discharge the opposition division to deal with all pending auxiliary requests, in particular it should have set out the reasons why the higher-ranking auxiliary requests 1, 2 and 4 to 9 failed to meet the requirements of the EPC. It goes without saying that a decision against any of these requests may not be taken until the patent proprietor has been informed, with respect to each of these requests, of the reasons for not allowing them (Art. 113(1) EPC). The opposition division should have followed the Guidelines Part E.X. 2.9 according to which the reasons must set out the grounds for the non-allowability or non-admissibility of each request which ranks higher than the allowable request. This was not done here at least not in a written form.

## 2. Remittal to the department of first instance

- 2.1 Under Article 11 RPBA, a board may decide that a case is remitted to the department of first instance after it has found fundamental deficiencies in the first



instance proceedings. Such decision is subject to the discretion of the board concerned. A board remits a case to the department of first instance unless special reasons present themselves for doing otherwise.

The board sees no reason for such an exception. In view of the fact that the claims as granted as well as 18 (old and new) auxiliary requests are now pending the board is not in a position to find without undue investigation whether the requirements of the EPC are fulfilled regarding the subject-matter of each single request on file while not having full reasons why the opposition division did not find allowable some of the particular higher-ranking auxiliary requests then pending before it.

2.2 Even though the patent proprietor did not explicitly complain about a lack of reasoning in its statement setting out the grounds of appeal it is not for the board to reconstruct or to speculate about the possible reasons of a negative decision of first instance according to Rule 111(2) first sentence EPC.

2.3 Thus the board exercised its discretion to remit the case to the department of first instance.

3. Reimbursement of the appeal fees

It is also established case law of the Boards of Appeal that the failure to provide reasons pursuant to Rule 111(2) EPC constitutes a substantial procedural violation justifying reimbursement of the appeal fee - see section 7 of the reasons of T 493/88, pt.7 of the reasons (OJ EPO 1991, 380) as well as section IV.E.8.e(ii) of the Case Law of the Boards of Appeal of the European Patent Office, 8th Edition. Thus all

appeal fees paid are to be reimbursed.

## Order

### For these reasons it is decided that:

1. The decision under appeal is set aside.
2. The case is remitted to the opposition division for further prosecution on the basis of the claim requests on file at the oral proceedings of 25 November 2015.
3. The appeal fees paid by the patent proprietor, opponent 1 and opponent 2 are to be reimbursed.

The Registrar:

The Chairman:



M. Cañueto Carbajo

W. Sieber

Decision electronically authenticated