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**Datasheet for the decision
of 19 April 2023**

Case Number: T 2916/19 - 3.3.03

Application Number: 07791177.4

Publication Number: 2045274

IPC: C08F10/02, C08F4/654

Language of the proceedings: EN

Title of invention:

ETHYLENE POLYMER PARTICLE, METHOD FOR PRODUCING THE SAME, AND
MOLDED ARTICLE USING THE SAME

Patent Proprietor:

Mitsui Chemicals, Inc.

Opponents:

Celanese International Corporation
Asahi Kasei Chemicals Corporation

Relevant legal provisions:

EPC Art. 54(2), 111(1)
RPBA 2020 Art. 11
RPBA Art. 12(4)

Keyword:

Novelty - state of the art

Objection raised during the opposition proceedings and
submitted with the statement of grounds of appeal

Appeal decision - remittal to the department of first instance
(yes)

Decisions cited:

G 0001/92, T 1833/14, T 0231/15



Beschwerdekammern

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Case Number: T 2916/19 - 3.3.03

D E C I S I O N
of Technical Board of Appeal 3.3.03
of 19 April 2023

Appellant: Celanese International Corporation
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Decision under appeal: **Interlocutory decision of the Opposition
Division of the European Patent Office posted on
30 August 2019 concerning maintenance of the
European Patent No. 2045274 in amended form.**

Composition of the Board:

Chairman D. Semino
Members: O. Dury
 W. Ungler

Summary of Facts and Submissions

- I. The appeal of opponent 1 lies from the interlocutory decision of the opposition division concerning maintenance of European Patent No. 2 045 274 in amended form according to the claims of the main request filed with letter of 30 March 2015 and a description adapted thereto.
- II. Said main request corresponds to the main request dealt with in decision T 231/15 (taken by the same Board in a different composition), in which that request was held to meet the requirements of Article 123(2) EPC as well as the ones of sufficiency of disclosure. The case was then remitted to the department of first instance for further prosecution.
- III. The following documents were, among others, cited in the decision under appeal:
- E1: Uehara et al., Structural characterization of ultrahigh-molecular-weight polyethylene reactor powders based on fuming nitric acid etching, *Polymer*, 1998, vol. 39, number 24, pages 6127-6135;
D3: EP-A-0 410 384
- IV. As far as relevant to the present decision, the following conclusions were reached in the decision under appeal:
- The subject-matter of claim 1 of the main request was novel over the disclosure of E1;

- The subject-matter claimed was inventive when document E1 was taken as the closest prior art. In that respect, sample 1 of E1 was closer to the problem posed than samples 3 and 5 and constituted therefore a better starting point.

For these reasons, the patent amended on the basis of the main request was held to meet the requirements of the EPC.

- V. Opponent 1 (appellant) lodged an appeal against that decision.
- VI. With their rejoinder to the statement of grounds of appeal the patent proprietor (respondent) filed several sets of claims as 1st to 14th auxiliary requests.
- VII. The parties were summoned to oral proceedings and a communication pursuant to Article 15(1) RPBA 2020 indicating specific issues to be discussed at the oral proceedings was then sent to the parties.
- VIII. With letter of 20 March 2023 the appellant submitted the following document:
 - D16: ScienceDirect, first page of E1 together with a list of scientific publications citing E1
- IX. With letter of 28 March 2023, opponent 2 (party to the proceedings as of right pursuant to Article 107, second sentence, EPC) indicated that they would not attend the oral proceedings.
- X. With letter of 12 April 2023 the respondent submitted the following document:

D17: Journal of Industrial and Engineering
Chemistry, 20, 2014, pages 1804-1811

XI. Oral proceedings were held on 19 April 2023 in the presence of the appellant and the respondent, as announced.

XII. **The final requests of the parties were as follows:**

(a) The appellant requested that the decision of the opposition division be set aside and the patent be revoked.

(b) The respondent requested that the appeal be dismissed (main request) or, in the alternative, that the patent be maintained in amended form according to any of the 1st to 14th auxiliary requests filed with their rejoinder to the statement of grounds of appeal. At the end of the oral proceedings before the Board, the respondent further requested that, should the case be remitted to the opposition division for further prosecution, the Board instruct the opposition division to deal with the case in accelerated manner and to limit discussion on the documents on file.

(c) The party as of right did not file any requests during the appeal proceedings.

XIII. Claim 1 of the **main request** read as follows:

"1. Ethylene polymer particles having:

(I) an intrinsic viscosity $[\eta]$ in the range of 5 dl/g to 30 dl/g,

(II) a degree of crystallinity of 80% or more, and

(III) a shape with a breadth of 0.1 μm to 3 μm and a length of 2 μm to 20 μm on the surface of the particles;

wherein the proportion of particles with a particle diameter of 355 μm or more is 1.5 wt% or less of the total particles and the average particle diameter is 100 μm to 300 μm ."

XIV. The appellant's arguments, in so far as they are pertinent for the present decision, may be derived from the reasons for the decision below. They are essentially as follows:

(a) Document E1 constituted an enabling disclosure of the ethylene polymer particles disclosed therein as samples 1, 3 and 5. Therefore, said samples belonged to the state of the art.

(b) The objection of lack of inventive step based on D3 as the document constituting the closest prior art was never withdrawn and should be admitted into the proceedings.

(c) Should the question of lack of inventive step based on D3 as the document constituting the closest prior art have to be discussed, a remittal to the opposition division would be appropriate.

XV. The respondent's arguments, in so far as they are pertinent for the present decision, may be derived from the reasons for the decision below. They are essentially as follows:

- (a) Document E1 did not constitute an enabling disclosure of the ethylene polymer particles disclosed therein as samples 1, 3 and 5. Therefore, said samples did not belong to the state of the art and the appellant's novelty and inventive step objections based on samples 1, 3 and 5 of E1 were moot.
- (b) The objection of lack of inventive step based on D3 as the document constituting the closest prior art was not maintained in opposition and should be not admitted into the proceedings.
- (c) Should the objection of lack of inventive step based on D3 as the document constituting the closest prior art have to be discussed as a consequence of a substantial procedural violation, a remittal of the case to the opposition division was acceptable.
- (d) In view of the circumstances of the case, should the case be remitted for further prosecution, the opposition division should be instructed to deal with the case in an accelerated manner and to limit the discussion to the documents on file.

Reasons for the Decision

Main request

1. The operative main request is identical to the main request dealt with in the decision under appeal and allowed by the opposition division.

2. Objections based on E1 - Enabling disclosure

2.1 The appellant raised objections of lack of novelty and of lack of inventive step against claim 1 of the main request, which were all based on samples 1, 3 and/or 5 of document E1. It was not in dispute between the parties that document E1 was published before the priority/filing date of the patent in suit. However, the respondent was of the opinion that samples 1, 3 and 5 of E1 did not belong to the state of the art because E1 did not constitute an enabling disclosure as to how to (re)produce said samples without undue burden (rejoinder: points 36 to 46; see also letter of 6 July 2021: page 8, first paragraph to page 10, first paragraph). Therefore, it has to be assessed if E1 constitutes an enabling disclosure for the ethylene polymer particles prepared therein as samples 1, 3 and/or 5.

2.2 In that respect, it is noted that such an objection was already put forward during the opposition proceedings but that the opposition division did not deem necessary to deal with it (decision under appeal: paragraph bridging pages 11 and 12). The opposition division further indicated that "the new argument was admitted into the procedure" (minutes of the oral proceedings held on 6 June 2019: page 2, sixth paragraph; see also the decision under appeal: page 12, end of second paragraph). In this regard, it is however unclear to the Board why and on which basis the opposition division held that "the lack of enablement of a prior art document should not be contested/discussed in opposition proceedings" (decision under appeal: page 12, second paragraph, first sentence; see also section 46 of the rejoinder).

2.3 Regarding the issue of enabling disclosure, it is established case law that a disclosure can only be regarded as having been made available to the public, and therefore as comprised in the state of the art pursuant to Article 54(2) EPC, if the information given therein to the skilled person is sufficient to enable them, at the relevant date of the document, to practise the technical teaching which is the subject of the document, taking into account also the general knowledge at that time in the field to be expected of him (Case Law of the Boards of Appeal of the EPO, 10th edition, 2022, I.C.4.11).

2.3.1 In that regard, it was common ground that document E1 deals with the preparation of ultrahigh molecular weight polyethylene particles (UHMW-PE), which are prepared using "a high-activity Ziegler catalyst" at various temperatures (E1: page 6128: section EXPERIMENTAL/Materials; table 1; figure 1; page 6134: section CONCLUSIONS). In particular, reference is made in E1 to UHMW-PE particles prepared as samples 1 to 5 (table 1; figures 1 and 6-9; section "SEM observations, starting on page 6131). In that respect, the sole passages of E1 relied upon by the appellant regarding the preparation process of these samples is the section EXPERIMENTAL/Materials on page 6128 of E1, which reads as follows:

"A series of nascent UHMW-PE reactor powders was prepared at the Nippon Oil Company Ltd. by the polymerization of ethylene in hexane at $T_{\text{poly}} = 20 - 90^{\circ}\text{C}$ and at an ethylene pressure of 11 atm, using a high-activity Ziegler catalyst. The temperature of the reaction medium was taken as T_{poly} . The viscosity-average molecular weight, M_v , of UHMW-PE was controlled by the addition of a small amount of

hydrogen gas, depending on T_{poly} . These samples had comparable M_v values of around 2×10^6 ."

2.3.2 Considering that E1 constitutes a written disclosure and not an alleged public prior use, the circumstances of the present case are not the same as the ones addressed in decisions G 1/92 (OJ EPO 1993, 377: see in particular the questions posed in section I) and T 1833/14 (reasons: section 1), which were both relied upon by the respondent (rejoinder to the statement of grounds of appeal: points 37-38). Nevertheless, the arguments put forward by the respondent are equally relevant for the written disclosure E1. Indeed, in view of the respondent's submissions, the question arose whether or not the skilled person would be able to prepare without undue burden any of samples 1, 3 and 5 of E1 in view of the very limited information provided in E1 regarding their preparation process, in particular regarding the catalyst system used, even taking into account common general knowledge (rejoinder to the statement of grounds of appeal: points 39-42 and 44-45 in section II).

2.3.3 Preparation of samples 1, 3 and 5 of E1

a) Regarding the question of the (re)production of samples 1, 3 and 5 of E1 and as indicated in the first paragraph of section 1.6 of decision T 1833/14, which is fully endorsed by the present Board, it is generally known in the field of polymers and it was not contested by the appellant that the nature of the catalyst system, the type of reacting system and the process conditions significantly affect the properties of the produced polymer. In particular, in the polymer field, in which products and compositions are often defined by means of parameters, the requirements of sufficiency of

disclosure is analysed with particular care and is considered to be met in such cases if the application or the patent, when necessary supported by the common general knowledge, discloses the method of preparation of the polymers (in particular by means of the catalyst system, the type of reacting system and the process conditions) which results in products and compositions with the required parameters. The same criteria must therefore apply to the reproducibility without undue burden of a product disclosed in a written disclosure used as a prior art such as the disclosure related to samples 1, 3 and 5 of E1.

b) However, in the present case, the information provided in E1 regarding the preparation of samples 1, 3 and 5 is very limited (see citation in section 2.3.1 above). In particular, the sole information regarding the nature of the catalyst used is that it should be a "high activity Ziegler catalyst", which is a very broad definition encompassing a multitude of catalyst systems (in view of the absence of any further limitation of that disclosure regarding e.g. the nature of the active metal, the cocatalyst and/or catalyst support, if any).

c) However, it is derivable from the information provided in the patent in suit and from the evidence relied upon for the assessment of sufficiency of disclosure in decision T 231/15 (see in particular sections 3.4.1 and 3.4.2 of the reasons; it is reminded here that decision T 231/15 was taken in the first appeal related to the patent in suit) that the nature of the catalyst system and the mode of preparation thereof are crucial in order to obtain ethylene polymer particles satisfying specific parameters/having specific properties. For instance, comparative example 1 of the patent in suit is directed to the

preparation of ethylene polymer particles using a catalyst similar to the one used in the examples of the patent in suit illustrative of the subject-matter claimed but failed to lead to polymers having a degree of crystallinity as defined in claim 1 of the main request (see table 1 as well as paragraphs 127, 128, 174 and 175 of the patent in suit). Under these circumstances, the fact that the skilled person may be aware from their common general knowledge that the nature of the catalyst system is crucial for the properties of the obtained polymers is not sufficient: what would be required in order to be able to (re)produce samples 1, 3 and 5 of E1 in a reliable manner is more precise information regarding the catalyst (and/or its preparation process, which was shown to be of importance in section 3.4.2 of T 231/15) effectively used. Therefore, the appellant's argument that the skilled person would be aware that the choice of internal donor and its amount/ratio to titanium was crucial cannot overcome the lack of information provided in E1 in that regard (appellant's letter of 20 March 2023: page 5, fourth paragraph).

d) In the Board's view, the reference to common general knowledge in the present technical field regarding the importance of the nature of the catalyst system indicated in section a) above together with both comparative example 1 of the patent in suit and the evidence relied upon for the assessment of sufficiency of disclosure in decision T 231/15 indicated in section c) above constitute serious doubts substantiated by verifiable facts supporting the objection of lack of enablement raised by the respondent against samples 1, 3 and 5 of E1. Therefore, the appellant's concerns in that regard are not persuasive (letter of 20 March 2023: page 4, last two

paragraphs).

e) It was also not shown by the appellant that the skilled person would know from common general knowledge how to complement the information of E1 in order to prepare samples 1, 3 and 5 of E1 as disclosed therein with a good chance of success.

f) Furthermore, it was also not shown that said - missing - information was available to the public.

f1) In that regard, the appellant argued that E1 was a scientific publication which had been subjected to peer review and that D16 showed that E1 had been cited in numerous other publications articles (letter of 20 March 2023: bottom of page 3 to middle of page 5). This showed that the content of E1 was correct and enabled, so the appellant.

However, the fact that E1 was cited several times in subsequent scientific articles constitutes no evidence that the skilled person was in the position, at the priority/filing date of the patent in suit, to prepare samples 1, 3 and/or 5 in a reliable manner on the basis of the teaching of E1, if needed complemented by common general knowledge. In particular, it was not shown that said samples 1, 3 and 5 were effectively prepared in any of the publications citing E1. To the contrary, the respondent showed with D17 that the reference to E1 in at least one of these publications was not even related to the preparation of said samples (respondent's letter of 12 April 2023: points 16-18).

f2) During the oral proceedings before the Board,

the appellant argued that, if necessary, the skilled person could always have asked the authors of E1 for any missing information regarding the preparation of samples 1, 3 and 5.

However, that argument is not supported by any evidence and, since it relates to information which was not shown to be made available to the public before the relevant date, is purely speculative. Therefore, it is rejected already for that reason.

f3) Considering that even if, to the appellant's benefit, their arguments based on D16 were to be admitted into the proceedings, they would be rejected by the Board for the reasons given above, there is no need for the Board to decide on the admittance of D16 and of the appellant's submissions based thereon, which was objected to by the respondent (letter of 12 April 2023: point 11). The same is valid regarding D17, which is a document cited in D16 and which was filed by the respondent in reaction to the filing of D16.

h) In view of the above, the disclosure of E1 is not sufficient for the skilled person to be able to prepare reliably any of samples 1, 3 and 5 as disclosed therein.

i) It is further noted that in the present case, the appellant argued in respect of sufficiency of disclosure that, even with knowledge of the information provided by the patent in suit regarding the preparation process the skilled person would not have enough guidance in order to prepare in a reliable manner a UHMW-PE having specific properties. However, the information provided by the patent in suit is much

more detailed than the one of E1: not only does the patent in suit contain general information, in particular regarding the catalyst system, but it also provides various teachings regarding preferred components and options as well as five examples illustrating the subject-matter being claimed, which includes a detailed description of the preparation of the catalyst system used (see section 3.2 of the reasons of T 231/15 and paragraphs 127-128 of the patent in suit). Therefore, in the present case, it is agreed with the respondent (rejoinder: points 39-42) that the line of argumentation provided by the appellant in respect of sufficiency of disclosure of the patent in suit (even if it was eventually not successful: see section 3 of the reasons of T 231/15) confirms the conclusion reached in section h) above.

2.3.4 Burden of proof

a) It was in dispute between the parties whether the burden of proof regarding enablement of samples 1, 3 and 5 of E1 was on the appellant/opponent or on the the respondent/patent proprietor (see e.g. appellant's letter of 2 March 2021: page 9, penultimate paragraph; respondent's letter of 6 July 2021: paragraph bridging pages 9 and 10; the arguments were further developed in subsequent written submissions and at the oral proceedings before the Board).

a) In that respect, according to established case law, each party bears the burden of proof for the facts it alleges (Case Law, *supra*, III.G.5.1.1). In the present case, the Board considers that since the appellant/opponent raised objections based on the disclosure of samples 1, 3 and 5 of E1, the burden of proof primarily resides on them to show that said samples of E1

effectively belong to the state of the art for the patent in suit.

b) Also, according to established case law, the need for an enabling disclosure of a prior art document is in conformity with the principle expressed in Article 83 EPC, i.e. the requirements of sufficiency of disclosure are identical for a prior art document and a patent (see Case Law, *supra*, I.C.4.11, in relation to T 206/83 - OJ EPO 1987, 5 - and T 1437/07).

In that respect, as outlined in section 2.3 above, it is concluded in the present case that the skilled person would not be in a position to prepare samples 1, 3 and/or 5 of E1 on the basis of the information provided in E1, even when taking into account common general knowledge. As already indicated in section 2.3.3.d above, the Board is satisfied that there are in the present case serious doubts supported by verifiable facts that E1 constitutes an enabling disclosure for samples 1, 3 and 5 thereof. Therefore, the Board considers that, in the circumstances of the present case, the burden of proof for establishing enablement of samples 1, 3 and 5 of E1 is on the appellant.

2.3.5 The appellant put forward that the respondent's objection that E1 was not enabling should be rejected because the respondent argued the contrary during the opposition proceedings, whereby reference was made to page 2, last paragraph of the minutes dated 19 November 2014 and pages 5-8 of the patent proprietor's letter of 30 March 2015 (appellant's letter of 2 March 2021: page 10, second paragraph).

However, the passage of the minutes relied upon by the appellant are related to arguments put forward by the

respondent to demonstrate that the patent in suit was sufficiently disclosed, whereby the reference to E1 was made to show that certain parameters were usual in the art ("The shape with a certain breadth and length was also no unusual parameter as could be seen from E1").

In addition, the Board agrees with the respondent's view that the statements made in their letter of 30 March 2015 which were relied upon by the appellant are related to their argument according to which the skilled person could obtain from E1 information on how to influence e.g. the crystallinity of a ultrahigh molecular weight ethylene polymer, which was not equivalent to a teaching that enabled a skilled reader to actually reproduce the samples of E1, as the nature of the catalyst and the synthesis conditions were not disclosed in E1 (respondent's letter of 6 July 2021: page 9, fourth paragraph). Therefore, said statements of the respondent cannot be equated with acknowledging that the teaching of E1 enabled the skilled person to reproduce the materials disclosed therein, in particular samples 1, 3 and 5.

Also, the Board is satisfied that the same conclusion is equally valid regarding the reference made by the appellant to the respondent's statements in section III and IV on page 7 of their submission of 30 March 2015 (appellant's letter of 20 March 2023: page 5, third paragraph).

For these reasons, the appellant's arguments did not convince.

2.4 In view of the above, E1 does not constitute an enabling disclosure of the ethylene polymer particles prepared therein as samples 1, 3 and/or 5. In view of

this, said samples were not available to the skilled person at the priority/filing date of the patent in suit and do not belong to the state of the art.

2.5 Therefore, the appellant's objections of lack of novelty and of lack of inventive step in view of E1, for which it remained undisputed (in particular at the oral proceedings before the Board) that they were all based on samples 1, 3 and/or 5 thereof, are rejected.

3. Admittance of the objection of lack of inventive step starting from D3 as the closest prior art

3.1 In their rejoinder to the statement of grounds of appeal, the respondent requested that the objection of lack of inventive step starting from D3 as the closest prior art which was submitted by the appellant in their statement of grounds of appeal be not admitted into the proceedings (rejoinder: points 28-33).

3.2 Considering that this objection was submitted with the appellant's statement of grounds of appeal, its (non)admittance is regulated by the provisions of Article 12(4) RPBA 2007 (see Article 25(2) RPBA 2020), which reads as follows:

"Without prejudice to the power of the Board to hold inadmissible facts, evidence or requests which could have been presented or were not admitted in the first instance proceedings, everything presented by the parties under (1) shall be taken into account by the Board if and to the extent it relates to the case under appeal and meets the requirements in (2)".

3.3 In that respect, it was not in dispute between the parties that said objection was already raised in

writing by the opponents in the course of the opposition proceedings. In particular, D3 was explicitly held to constitute the closest prior art (among other documents, included E1, which had been relied upon by the opponents) in the preliminary opinion of the opposition division dated 16 October 2018 (section 2.2, see in particular the first and fifth paragraphs). However, the opponent's objection of lack of inventive step based on D3 was found to be not convincing (preliminary opinion: page 4, section 2.2, sixth to eleventh paragraphs).

Nevertheless, said objection of lack of inventive step starting from D3 as the closest prior art was further pursued by the appellant in their written submission filed in reaction to said preliminary opinion (see appellant's letter of 4 April 2019: page 2, last paragraph to page 6, first paragraph; see also opponent 2's letter of 5 April 2019: top of page 2 and page 12, fifth paragraph to page 13, second paragraph).

Under these circumstances, it makes no doubt that an objection starting from D3 as the closest prior art was raised in writing by the appellant and was still pending at the beginning of the oral proceedings before the opposition division held on 6 June 2019.

3.4 In view of this, the question arises if said objection was effectively withdrawn/abandoned by the opponents at the oral proceedings held on 6 June 2019 before the opposition division, which was in dispute between the parties.

3.4.1 In that respect, the appellant put forward at the oral proceedings before the Board that at no time in the proceedings that objection had been explicitly

withdrawn. That statement remained undisputed. Also the Board could find no trace of the contrary in the minutes of the oral proceedings held on 6 June 2019.

3.4.2 Therefore, it is necessary to consider whether the procedural conduct of the appellant at the oral proceedings before the opposition division is to be interpreted unambiguously as meaning that the objection has been abandoned.

a) In that regard, according to the minutes of the oral proceedings held on 6 June 2019, the question of which document constituted the closest prior art was debated during such oral proceedings. Whereas both opponents considered that E1 was closer than D3 (and was for that reason to be considered as the closest prior art), the patent proprietor held that D3 was the closest prior art, albeit E1 could also be considered as a reasonable starting point for the assessment of inventive step (minutes: page 2, last paragraph and page 3, first four paragraphs). However, the opposition division decided that "D1" (sic) was the closest prior art and the assessment of inventive step was discussed with the parties on that basis only (minutes: page 3, last paragraph to page 5, third paragraph).

b) The following statement was then made in the minutes (page 5, fourth paragraph): "After a break (15.05 to 15.25) the Chairman gave the opinion that claim 1 of the main request was inventive and that D13 was admitted into the procedure". Thereafter, the discussion continued regarding further claims of the main request and the adaptation of the description, before the proceedings were closed.

c) In view of the above, it is correct that, as put

forward by the respondent (rejoinder: point 28), at the oral proceedings held on 6 June 2019 before the opposition division, the opponents exclusively provided arguments against the presence of an inventive step on the basis of document E1 as the closest prior art and provided no inventive step attack based on D3 as the closest prior art. In particular, the opponents did not submit any objection starting from D3 after the opposition division indicated their opinion that E1 was the closest prior art. However, it cannot be derived from the minutes of the oral proceedings held on 6 June 2019 that the opponents explicitly indicated that they had no further objections regarding inventive step. In particular, it is not unusual that at that point in time, the opponents be asked whether they have any additional comments, objections or arguments. However, it is not recorded in the minutes (the accuracy of which was not contested) that such a procedural step took place. Therefore, in the circumstances of the present case and in the absence of an explicit withdrawal by the opponents of the objection of lack of inventive step starting from D3 as the closest prior art, the Board considers that said objection, which had been dealt with by the opposition division in their preliminary opinion and further objected to by the opponents in their subsequent written submissions, was still pending. In the Board's view, the fact that the opponents did not explicitly address of their own motion the question of inventive step starting from D3 as the closest prior art at the oral proceedings held on 6 June 2019 cannot be equated, in the present case, with an effective abandoning of that objection, contrary to the respondent's view (rejoinder: section 28, last sentence; letter of 6 July 2021: page 4, last two paragraphs and page 5, first paragraph). Indeed, the Board does not share the

view of the respondent that both opponents explicitly rejected D3 as closest prior art at the oral proceedings held on 6 June 2019 (letter of 12 April 2023: point 5). Rather, the Board understands from the minutes of these oral proceedings that the opponents considered that E1 was "closer" than D3, which does not mean that they held that D3 could not constitute another reasonable starting point for the assessment of inventive step. The Board further does not share the view of the respondent that the statements made by the opponents amounted to disqualifying the choice of D3 as a possible starting point (respondent's letter of 12 April 2023: point 6). Finally, the fact that the opponents, and in particular the appellant, did not object to the lack of a decision on that objection at the oral proceedings before the opposition division can also not be taken to their detriment as the opposition division announced an opinion on the inventiveness of claim 1 without mentioning any specific document, nor any specific objection (see statement in the minutes under point b) above).

d) Furthermore, the appellant stated that the opposition division informed the parties at the beginning of the discussion on inventive step that such a discussion had to be made only from the closest prior art, i.e. starting from one single document identified as the closest prior art. Thus, the appellant (then opponent 1) assumed that any submissions as regards the objection starting from D3, which was not considered to be the closest prior art by the opposition division, would not be accepted by the opposition division. Therefore, the appellant did not submit any further arguments in this respect. This appears credible to the Board because both lines of attack, i.e. starting from

E1 on the one hand and starting from D3 on the other, were addressed in the impugned decision (cf. Reasons, point 5.1) in order to determine the closest prior art, which would not have been necessary if the opposition division had considered the objection based on D3 to be abandoned. The Board therefore finds it credible that the opposition division proceeded from the legal view that the question of inventive step was to be discussed only by starting from the closest prior art in the sense of one single document. This also explains why the objection of lack of inventive step starting from D3 was not substantively dealt with in the decision under appeal. It is therefore understandable for the Board that, for this reason, the appellant refrained from making any further submissions on its objection of lack of inventive step starting from D3 at the oral proceedings before the opposition division. However, it is clear that in such circumstances such procedural conduct cannot be considered as abandoning the objection.

e) In view of the above, the Board concludes that there was no basis to infer that the objection of lack of inventive step starting from D3 as the closest prior art was no longer pending when the opposition division decided that the subject-matter of claim 1 of the main request involved an inventive step. In such a case, it would have been the duty of the opposition division to either clarify the procedural situation at that stage of the oral proceedings and/or to deal with that objection in the decision under appeal (at least in an abridged manner if, for instance, it were to be held that such an objection could not succeed because claim 1 of the main request differed from the disclosure of D3 in at least the same feature(s) as the ones identified for E1), which was not done. Indeed, it

is established case law that if the skilled person has a choice of several workable routes, i.e. routes starting from different documents (here E1 and D3), which might lead to the invention, the rationale of the problem and solution approach requires that the invention be assessed relative to all these possible routes, before an inventive step can be acknowledged (Case Law, *supra*, I.D.3.1, see in particular the paragraph related to T 1742/12). In that respect, the latter remark is a mere explanation why the Board considers that the opposition division should have either dealt with the objection in the decision or clarified the procedural situation at the oral proceedings of 6 June 2019 so as to remove any ambiguity regarding the objections put forward by the opponents which were still pending at the oral proceedings. This is, however, not an argument which is relevant for the question of the admittance of the objection which is in dispute between the parties. Therefore, the question of the admittance of that argument, which was objected to by the respondent (letter of 12 April 2023: point 9), is not relevant.

f) For these reasons, the circumstances of the present case do not allow to conclude that the objection of lack of inventive step starting from D3 as the closest prior art was unambiguously abandoned at the oral proceedings before the opposition division held on 6 June 2019.

3.4.3 In the Board's view, the mere fact that the appellant did not complain in their statement of grounds of appeal that the decision under appeal was deficient in that respect (since it did not address the question of inventive step starting from D3 as the closest prior art) cannot be seen as an evidence that said objection

was effectively abandoned, contrary to the respondent's view (letter of 12 April 2023: point 8).

3.4.4 As the objection of lack of inventive step starting from D3 as the closest prior art was neither explicitly withdrawn, nor unambiguously abandoned, this objection was in the proceedings before the opposition division at the time the decision under appeal was taken. As a consequence, its submission in the statement of grounds of appeal does not constitute an amendment to the appellant's case (see respondent's letter of 6 July 2021: page 5, second paragraph). Therefore, considering that the objection was put forward by the appellant in the statement of grounds of appeal pursuant to Article 12(1)(a) RPBA 2007 and that it was not argued that the substantiation of that objection did not satisfy the requirements of Article 12(2) RPBA 2007 (i.e. it was sufficiently substantiated), it cannot be held inadmissible and has to be taken into account by the Board pursuant to Article 12(4) RPBA 2007.

3.4.5 For these reasons, the respondent's request not to admit the objection of lack of inventive step starting from D3 as the closest prior art was rejected.

4. Remittal

4.1 It remained undisputed that the appellant's objection of lack of inventive step of claim 1 of the main request in view of D3 as the closest prior art was not dealt with in the decision under appeal. Since the Board arrived at the conclusion that said objection was in the proceedings when the decision under appeal was taken, said decision suffers from a substantial procedural violation in that it was concluded therein

that the operative main request fulfilled the requirements of the EPC albeit one of the opponents' objection of lack of inventive step was not dealt with, i.e. the opponents' objections and arguments were not properly taken into account. According to established case law, such a substantial procedural violation is to be equated with a fundamental deficiency in the sense of Article 11 RPBA 2020 (Case Law, *supra*, V.A.9.4.3), according to which in such circumstances the case is, as a rule, to be remitted to the opposition division for further prosecution (Case Law, *supra*, V.A.9.4.1). In that respect, none of the parties present at the oral proceedings before the Board expressed any concerns in that regard. Therefore, the case is to be remitted to the opposition division for further prosecution (Article 111(1) EPC).

5. Respondent's requests to instruct the opposition division
 - 5.1 At the oral proceedings before the Board, the respondent requested that, in view of the filing date of the application on which the patent in suit was based (2007) and taking into account that this would be the second remittal to the opposition division, the Board instruct the opposition division i) to deal with the present case in an accelerated manner and ii) to limit the further discussion to the documents on file.
 - 5.2 Regarding the request to instruct the opposition division to deal with the present case in an accelerated manner, the Board considers that the question when or at which pace the case is to be dealt with by the opposition division is a matter of managerial decisions to be taken by the department of first instance, whereby the Board is not empowered to

impose any timeline/time constraints to the department of first instance who will be in charge of the case. As an aside, it is noted that the respondent may at any time request accelerated proceedings (PACE programme, which may be done both at the opposition and appeal stages).

- 5.3 Regarding the request to instruct the opposition division to limit the further discussion to the documents on file, the Board considers that it cannot, in advance, decide to exclude from consideration any unknown and unforeseeable facts, pieces of evidence and/or submissions.
- 5.4 For these reasons, the respondent's requests were rejected.

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.

The Registrar:

The Chairman:



D. Hampe

D. Semino

Decision electronically authenticated