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**Datasheet for the decision
of 7 October 2020**

Case Number: T 0560/20 - 3.2.05

Application Number: 12821396.4

Publication Number: 2739454

IPC: B29C65/00

Language of the proceedings: EN

Title of invention:

Polymer blend membranes

Applicant:

Arkema, Inc.

Headword:

Relevant legal provisions:

EPC Art. 111(1), 113(1)

EPC R. 103(1)(a)

RPBA 2020 Art. 11

Keyword:

Substantial procedural violation (yes)

Remittal to the department of first instance (yes)

Reimbursement of appeal fee (yes)

Decisions cited:

Catchword:



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Case Number: T 0560/20 - 3.2.05

D E C I S I O N
of Technical Board of Appeal 3.2.05
of 7 October 2020

Appellant: Arkema, Inc.
(Applicant) 900 First Avenue
King of Prussia, PA 19406 (US)

Representative: Bandpay & Greuter
30, rue Notre-Dame des Victoires
75002 Paris (FR)

Decision under appeal: **Decision of the Examining Division of the
European Patent Office posted on 7 October 2019
refusing European patent application No.
12821396.4 pursuant to Article 97(2) EPC.**

Composition of the Board:

Chairman P. Lanz
Members: B. Spitzer
C. Brandt

Summary of Facts and Submissions

- I. The applicant appealed the decision of the examining division dated 7 October 2019 refusing European patent application No. 12 821 396.4 for lack of inventive step.
- II. The documents referred to during the examination and appeal proceedings include the following:
- D1: US 2006/0178480 A1;
- D2: US 2008/0156722 A1;
- D3: FU LIU ET AL: "Progress in the production and modification of PVDF membranes", JOURNAL OF MEMBRANE SCIENCE, ELSEVIER, vol. 375, no. 1, 7 March 2011 (2011-03-07), pages 1-27, XP028209253, ISSN: 0376-7388, DOI: 10.1016/J.MEMSCI.2011.03.014 [retrieved on 2011-03-12];
- D4: WANG D ET AL: "Porous PVDF asymmetric hollow fiber membranes prepared with the use of small molecular additives", JOURNAL OF MEMBRANE SCIENCE, ELSEVIER, vol. 178, no. 1-2, 15 September 2000 (2000-09-15), pages 13-23, XP004214366, ISSN: 0376-7388, DOI: 10.1016/S0376-7388(00)00460-9;
- D5: WO 2011/010690 A1.
- III. The appellant (applicant) requests that the decision be set aside, that the case be remitted to the department of the first instance for further prosecution and the appeal fee be reimbursed due to a substantial procedural violation. Alternatively, the appellant

requests that a patent be granted based on the claims according to the main request or any of auxiliary requests 1 to 4, all filed with the statement setting out the grounds of appeal.

IV. Claim 1 according to the request filed on 29 November 2018, on which the contested decision is based, reads as follows:

"A process for forming a porous membrane consisting of the steps of:

- forming a blended polymer solution by admixing:
 - a. from 30 to 70 weight percent of a polyvinylidene fluoride having a weight average molecular weight higher than 580,000 g/mole, as measured by size exclusion chromatography, and
 - b) from 70 to 30 weight percent of a lower molecular weight PVDF having a weight average molecular weight between 150,000 and 550,000 g/mole, as measured by size exclusion chromatography,
 - c) and from 0 to 40 weight percent of other additives, with a solvent,
- solvent casting said blended polymer solution onto a substrate,
- placing the cast polymer into a non-solvent for the polymer, leading to the separation of the polymer gels and phase, and
- removing the solvent to produce a porous membrane, wherein the pores in the membrane have a bubble point diameter of from 0.0118 micrometers to 0.137 micrometers (microns), as measured by capillary flow porometer, using a PMI capillary flow porometer and using a perfluoropolyether wetting liquid, and wherein said porous [sic] membrane is from 75 to 150 micrometers (microns) thick."

V. The examination proceedings leading to the decision under appeal may be summarised as follows:

In its written communications dated 11 August 2017 and 28 May 2018, the examining division raised objections based on Article 84 EPC, Article 123(2) EPC, Article 54 EPC with respect to document D5, and Article 56 EPC with respect to a combination of document D1 or D2 with document D3 or D4.

By letters dated 10 December 2015, 6 February 2018 and 29 November 2018, the appellant filed arguments and amended sets of claims at least partly overcoming the objections raised.

On 7 October 2019 the examining division issued a decision refusing the application due to lack of inventive step starting from document D5 in combination with the common general knowledge of a person skilled in the art. In the grounds for the decision, it was held in particular that the subject-matter of claim 1 was new vis-à-vis documents D1 to D5, but lacked inventive step starting from document D5 in combination with the common general knowledge. The examining division argued that the subject-matter of claim 1 differed from document D5 in that document D5 did not disclose the thickness of the first membrane layer. Document D5 disclosed the thickness of the resin layer as 400 μm , i.e. the thickness of the first and second porous layers. Under the assumption that both porous layers had the same thickness, a thickness of 200 μm resulted for the porous membrane, which was very close to the upper range of 150 μm as claimed in claim 1. As this feature was not related to any particular effect, the objective technical problem to be solved was the selection of an appropriate thickness. The skilled

person would prepare a membrane with the claimed thickness without technical difficulties. Moreover, document D1 taught the thickness of a membrane in the range of 5 to 800 μm .

VI. The appellant's submissions at the appeal stage concerning the procedural issues of the examination proceedings may be summarised as follows.

The examining division had violated the appellant's right to be heard enshrined in Article 113(1) EPC because the refusal of the application was based on a new ground that had never been raised before, namely that the subject-matter of claim 1 did not involve an inventive step in the light of document D5 in combination with the common general knowledge of the person skilled in the art. In its previous communications the examining division had relied on document D5 only in the context of an objection of lack of novelty of the subject-matter of claim 1.

Since the objection of lack of inventive step vis-à-vis document D5 in combination with the common general knowledge was raised for the first time in the decision under appeal, the appellant did not have any opportunity to present its comments in this regard. This violated the appellant's right to be heard and amounted to a substantial procedural violation, which justified the reimbursement of appeal fee.

Reasons for the Decision

1. Alleged violation of the right to be heard
- 1.1 The right of parties to a fair trial is a generally recognised procedural principle under Article 125 EPC,

and is to be observed in all proceedings before the European Patent Office. The predictability and verifiability of all state actions are indispensable elements of the rule of law and the respect of fundamental procedural rights. The right to be heard under Article 113(1) EPC requires that the *ratio decidendi* of decisions by the European Patent Office may only be based on grounds or evidence on which the parties concerned have had an opportunity to present their comments.

The right to be heard enshrined in Article 113(1) EPC requires that those involved be given an opportunity to present comments on the facts and considerations pertinent to the decision, and also to have those comments considered.

A decision which is based on a ground on which the party had no opportunity to present its comments, and/or which fails to take into account the arguments submitted by a party, contravenes Article 113(1) EPC and constitutes a substantial procedural violation (see Case Law of the Boards of Appeal of the European Patent Office, 9th edition 2019, III.B.2.3.1).

- 1.2 In the case in hand, the reasons for the impugned decision are limited to the finding of lack of inventive step of the subject-matter of claim 1 of the main request on file in view of document D5 in combination with the common general knowledge. In the decision, the examining division essentially held that the subject-matter of claim 1 differs from document D5 in the thickness of the first membrane layer. As this difference is not related to any particular effect, the objective technical problem to be solved is the selection of an appropriate thickness. The skilled

person would prepare a membrane with the claimed thickness without technical difficulties. The subject-matter of claim 1 is therefore not based on an inventive step.

- 1.3 The board agrees with the appellant that the examining division had not raised this objection before. In its previous communications, document D5 had been cited as novelty-destroying, while the issue of inventive step had been discussed on the basis of document D1 or D2 in combination with document D3 or D4.

In consequence, the appellant had no opportunity to present its comments on the sole ground on which the impugned division is based. This contravened the appellant's right to be heard enshrined in Article 113(1) EPC and constitutes a substantial procedural violation.

2. Remittal of the case

- 2.1 Article 11 of the Rules of Procedure of the Boards of Appeal in the version of 2020 (RPBA 2020) provides that a case shall not be remitted to the department whose decision was appealed for further prosecution, unless special reasons present themselves for doing so. As a rule, fundamental deficiencies which are apparent in the proceedings before that department constitute such special reasons.

- 2.2 In the present case, the substantial procedural violation identified above constitutes a special reasons. In addition, the appellant as the party concerned by the procedural violation explicitly requests the remittal of the case.

The board thus exercises its discretion under Article 111(1) EPC and Article 11 RPBA 2020 to set the decision aside and remit the case to the examining division for further prosecution. In this regard, the board observes that it would appear appropriate for the examining division to consider the appellant's further arguments presented in its statement of grounds of appeal before drawing a conclusion concerning the question of inventive step.

3. Reimbursement of the appeal fee

Since the decision is set aside, and in view of the substantial procedural violation established in point 1. above, the appeal fee is to be reimbursed in accordance with Rule 103(1) (a) EPC.

Order

For these reasons it is decided that:

1. The decision under appeal is set aside.
2. The case is remitted to the examining division for further prosecution.
3. The request for reimbursement of the appeal fee is allowed.

The Registrar:

The Chairman:



N. Schneider

P. Lanz

Decision electronically authenticated