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**Datasheet for the decision
of 21 April 2023**

Case Number: T 0879/21 - 3.3.09

Application Number: 16700584.2

Publication Number: 3245172

IPC: C08J9/00, C08J9/16, C04B28/00,
C08J9/20

Language of the proceedings: EN

Title of invention:

EXPANDABLE VINYL AROMATIC POLYMER GRANULATE AND EXPANDED VINYL
AROMATIC POLYMER FOAM COMPRISING GEOPOLYMER COMPOSITE AND ITS
USE THEREIN

Patent Proprietor:

Synthos S.A.

Opponent:

versalis S.p.A.

Headword:

Geopolymer composite/SYNTHOS

Relevant legal provisions:

EPC Art. 111, 114(2)
EPC R. 76(2)(c), 116(1)
RPBA 2020 Art. 11

Keyword:

Opposition division's discretion to admit documents exercised according to wrong principles and in unreasonable manner
Remittal of the case to the opposition division

Decisions cited:

T 1271/13

Catchword:



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Case Number: T 0879/21 - 3.3.09

D E C I S I O N
of Technical Board of Appeal 3.3.09
of 21 April 2023

Appellant: versalis S.p.A.
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Decision under appeal: **Decision of the Opposition Division of the
European Patent Office posted on 12 April 2021
rejecting the opposition filed against European
patent No. 3245172 pursuant to Article 101(2)
EPC.**

Composition of the Board:

Chairman A. Haderlein
Members: A. Veronese
W. Sekretaruk

Summary of Facts and Submissions

- I. The appeal was filed by the opponent against the opposition division's decision to reject the opposition filed against the European patent.
- II. With its notice of opposition, the opponent had requested revocation of the patent in its entirety on the grounds under Article 100(a) (lack of novelty and lack of inventive step) and 100(b) EPC.
- III. The documents submitted during the opposition proceedings included:
- D14: Declaration by Mr Filip Kondratowicz, dated 2 March 2020
- D15: Declaration by Mr Felisari, dated 23 December 2020, titled: "Thermal conductivity and mechanical compression strength of EPS sheets containing geopolymers composite comprising coke"
- D16: Declaration by Mr Felisari, dated 23 December 2020, titled: "Scanning electron microscopy (SEM) with energy dispersive X-ray spectrometry (EDS) of geopolymers composite"
- D17: Declaration by Mr Felisari, dated 23 December 2020, titled: "Sedimentation experiment of geopolymers composite comprising coke in styrene"
- D18: Declaration by Mr Rodriguez-Perez
- D19: R. A. Campo-Arnaiz et al., Journal of Polymer Science: Part B: Polymer Physics, vol. 43, 2005, 1608-17
- D20: WO 2008/141 767 A2

D21: Notices from the EPO President dated
16 October 2020 and 16 December 2020, Official
Journal EPO, 2020, A115 and A139

D22: Declaration by Mr Kondratowicz, dated
26 February 2021

IV. In its decision, the opposition division found that:

- the ground for opposition under Article 100(b) EPC was sufficiently substantiated in the notice of opposition and was thus admissible
- D15 to D17, filed by the respondent, and D18 to D21, filed by the appellant, were not to be admitted into the opposition proceedings
- the claimed invention was sufficiently disclosed; the patent provided sufficient information for preparing a geopolymer composite incorporating athermanous material and an expanded foam comprising the geopolymer composite having the claimed thermal conductivity
- the claimed subject-matter was novel and involved an inventive step over the cited prior art

V. With its statement of grounds of appeal, the appellant filed further documents.

VI. With its reply to the statement setting out the grounds of appeal, the proprietor (respondent) filed further documents.

VII. The appellant's arguments relevant for the decision may be summarised as follows.

- The opposition division applied the wrong criteria when deciding not to admit the experimental reports D15 to D17 filed by the opponent (now appellant) into the opposition proceedings. Thus, this decision had to be reversed.
- The claimed invention was insufficiently disclosed. D15 to D18 showed that, relying on the information in the patent, the skilled person would not have been able to prepare the composite material and the foam defined in the claims as granted.
- The claimed subject-matter was not novel and did not involve an inventive step over the cited prior art. D15 to D17 showed that the claimed composite performed worse than the material of the prior art.
- The case had to be remitted to the opposition division for it to decide, applying the correct criteria, on the admission of D15 to D17 and, if necessary, the other documents filed during the opposition (D18 to D22) and appeal proceedings. This was necessary to arrive at a fully informed decision on the patentability requirements.

VIII. The respondent's arguments relevant for the decision may be summarised as follows.

- The opposition division's decision to admit the ground for opposition under Article 100(b) EPC was wrong. The arguments put forward in the notice of opposition concerned, at most, clarity issues.
- The opposition division's decision not to admit D15 to D17 was correct. These documents were filed at a late stage of the opposition proceedings. They

could have been filed earlier, in response to the filing of D14. The described tests were irrelevant, not being conducted according to the teaching of the patent, as explained in the expert declaration D22.

- If D15 to D17 were admitted, D18, D19, D21 and D22 filed by the patent proprietor (now respondent) in reply to D15 to D17 during the opposition proceedings and the documents filed by the respondent in reply to the statement of grounds of appeal should also be admitted. Conversely, the documents filed by the appellant with its grounds of appeal should not be admitted.

- Should the decision not to admit D15 to D17 be set aside, the case should be remitted to the opposition division for it to decide on the admission of the aforementioned documents. However, D20 should be excluded from any further consideration after remittal.

The requests

- IX. The **appellant** requested that the decision under appeal be set aside and that the patent be revoked.

- X. The **respondent** requested that the appeal be dismissed or, alternatively, that the patent be maintained on the basis of one of auxiliary requests A to F, filed by letter dated 2 March 2020 or, alternatively, on the basis of auxiliary request G, filed with the reply to the grounds of appeal.

Reasons for the Decision

1. *Sufficient substantiation of the ground for opposition (Article 100(b) EPC)*
- 1.1 The respondent argued that the ground for opposition under Article 100(b) should not have been admitted by the opposition division because this ground had not been substantiated in the notice of opposition. The objections presented in the notice related to the clarity of the claimed subject-matter, not sufficiency of disclosure.
- 1.2 These arguments are not convincing. Pages 4 to 9 of the notice of opposition set out the reasons why the opponent considered that the claimed invention was not sufficiently disclosed. The arguments presented were not limited to the clarity of the terms "geopolymer" and "geopolymer composite" or to a mere allegation that the claimed subject-matter was excessively broad.
- 1.3 In fact, the notice of opposition set out the reasons why the skilled person would not be able to prepare the claimed geopolymers using all the aluminosilicates mentioned in the patent. It also set out why a skilled person would not be able to prepare geopolymers encapsulating athermanous material by carrying out the process described in paragraph [0026] of the patent. Reasons were presented why the milling step specified in the patent would result in the destruction of the structure of the composite and afford a simple physical mixture of the relevant ingredients. Technical arguments were provided to substantiate this objection. Further arguments were set out why the skilled person

would not be able to prepare the foam defined in claim 6 as granted.

1.4 For these reasons, the board concludes that the ground for opposition under Article 100(b) EPC was effectively raised in the notice of opposition as required by Rule 76(2)(c) EPC and that the opposition division's division decision to deal with this ground was correct. Whether the objections under Article 100(b) EPC are strong and will finally succeed is not relevant for deciding whether this ground for opposition was substantiated and effectively raised in the notice of opposition.

1.5 *Admission of documents D15 to D17 and D18 to D21*

1.6 During the oral proceedings held on 3 March 2021, the opposition division decided not to admit into the opposition proceedings:

- D15 to D17, filed by the opponent (now appellant) with its letter dated 23 December 2020, the last day for making written submissions or amendments under Rule 116 EPC
- D18 to D21, filed by the proprietor, (now respondent) on 11 February 2021, in reply to the filing of D15 to D17

1.7 A board should only overrule the way in which a department of first instance exercised its discretion when deciding on the admission of late-filed submissions if it concludes that that department did so according to the wrong principles, without taking into account the right principles or in an unreasonable way, and has thus exceeded the proper limits of its

discretion (see "The case law of the boards of appeal" 10th edn., section IV.C.4.5.2).

- 1.8 The board considers that in the current case, the opposition division exercised its discretion using the wrong criteria and in an unreasonable manner when deciding not to admit the aforementioned documents.
- 1.9 On page 5 of the decision under appeal, when deciding on the admission of D15 to D17, the opposition division argued, in the first place, that two scenarios could be foreseen, namely:
- "if the opponents arguments in D15-D17 *do not go beyond* what has already been argued in the notice of opposition they are not more relevant than what already is on file"
 - "If the opponents arguments provided in D15-D17 *do go beyond* what has been submitted in the notice of opposition these arguments and evidence are late filed and the proprietor is not given a fair and expedient chance to respond"
- 1.10 As submitted by the respondent, the implementation of this approach would inevitably result in any new submission being inadmissible. In fact, this approach pre-empts any possibility to have considered new arguments or facts submitted in preparation for the oral proceedings until the date set under Rule 116(1) EPC. This is unreasonable and not in line with the established case law.
- 1.11 Under established case law, when exercising its discretion to admit late-filed documents, the opposition division should determine their relevance.

Prima facie relevance should the principal factor governing admissibility of late-filed documents (see Article 114(2) EPC and "The case law of the boards of appeal", 10th edn., sections IV.C.4.5.1 and IV.C.4.5.3).

1.12 The opposition division decided that D15 to D17 were not "*prima face* relevant", giving the following reasons on page 6 and 7 of its decision.

- D15 had been filed to provide evidence that certain foams according to the invention could not be prepared. However, since this allegation had already been raised in the notice of opposition under Article 100(b) EPC, D15 did not carry more weight than the submissions already on file.
- D16 and D17 were filed to provide evidence that milling destroys the geopolymer composite. This issue could be relevant for assessing sufficiency, novelty and inventive step. However, since these objections had already been brought forward in the notice of opposition, D16 and D17 were not more relevant than the submissions already on file.

1.13 The board does not agree with the opposition division's assessment of *prima face* relevance.

1.14 In the notice of opposition, the opponent set out the technical reasons why it considered that the process described in the patent did not afford the claimed geopolymer composite. The opponent noted that the size of the particles of the starting materials used to prepare the tested products and that of the particles observed after milling was substantially identical. This showed that any composite possibly formed in the

first steps of the process was destroyed during the subsequent milling step. This meant that the process afforded a simple mixture of geopolymer and athermanous material in powder form, not a "composite".

- 1.15 The notice of opposition also set out the reasons why the foams defined in claim 6 as granted could not be prepared. It was argued that these foams would have a thermal conductivity lower than that of air and that this was technically impossible.
- 1.16 Furthermore, it was explained why these issues were relevant in the examination of the requirements of sufficiency of disclosure, novelty and inventive step.
- 1.17 In its communication issued in preparation for the oral proceedings, the opposition division did not address the technical arguments set out in the notice of opposition. The submission on the size of the particles obtained after the milling step was ignored. The thermal conductivity of the materials making up the foam of claim 6 was not taken into account either. A declaration from a technical expert (D14) filed by the patent proprietor in reply to the notice of opposition addressing these issues was also not considered.
- 1.18 The opposition division expressed, however, the preliminary opinion that the opponent's objections were not supported by any evidence and therefore not convincing (see points 6.3 to 6.6 of the communication).
- 1.19 The opponent's letter dated 23 December 2020 and the annexed experimental reports D15 to D17 address the opposition division's preliminary opinion as well as the content of D14, filed by the patent proprietor. D15

to D17 describe tests determining the thermal conductivity, density and sedimentation properties of relevant materials and provide electron microscopy images of products allegedly according to the claimed invention. These documents aim to show that:

- in the case of D15, certain foams having the density specified in granted claim 6 could not be prepared and that other foams allegedly according to the invention performed worse than those of the closest prior art. Consequently, the claimed invention was not sufficiently disclosed and did not involve an inventive step over the prior art
- in the case of D16 and D17, geopolymer composites allegedly according to the invention could not be prepared following the teaching of the patent because the milling step destroyed the composite structure, affording a simple mixture of particles of geopolymer and athermanous material. Consequently, the claimed invention was not sufficiently disclosed

1.20 It is readily apparent that by filing D15 to D17, the opponent tried to overcome the opposition division's preliminary finding that the objections set out in the notice of opposition were not supported by evidence. The evidence provided clearly goes beyond the submissions in the notice of opposition.

1.21 Accordingly, the opposition division's finding that D15 to D17 are not *prima facie* relevant because the allegations that the claimed composites and foams cannot be obtained and the objections of lack of disclosure, novelty and inventive step "were already brought forward in the notice of opposition" is

unreasonable. With this reasoning, the opposition division has *de-facto* not assessed the *prima facie* relevance of these documents.

- 1.22 If this approach were to be implemented, a party would lose the right to have any new evidence supporting an attack raised in the notice of opposition considered, irrespective of its *prima facie* relevance for the outcome of the proceedings.
- 1.23 The respondent has also argued that the decision not to admit D15 to D17 was correct because these documents were filed late, on the last date set by the opposition division under Rule 116 EPC to file submissions in preparation for the oral proceedings. Had these documents been admitted, the proprietor would not have been able to prepare a suitable response. As in case T 1271/13, this was contrary to a fair and expedient procedure. D15 to D17 should have been filed promptly in reply to the filing of D14, rather than shortly before the oral proceedings.
- 1.24 These arguments are not persuasive. The circumstances in T 1271/13 were different from those in the current case as an experimental report substantiating a new attack of lack of sufficiency of disclosure was filed one month before the oral proceedings and a corrected version of the report was filed only the day before the oral proceedings. In the case at hand, no new attack was raised with the new submissions, and the correct version of the documents was filed more than two months before the scheduled oral proceedings.
- 1.25 Furthermore, in the current case, it is apparent from the documents on file that the opponent requested that the oral proceedings before the opposition division be

postponed so it could carry out its own experiments in reply to the experimental report D14 filed by the patent proprietor. This request, as well as a later request from the patent proprietor to postpone the oral proceedings for it to address D15 to D17, was not granted by the opposition division. Thus, the opposition division refused the parties' requests for more time to prepare their cases and held the oral proceedings on the scheduled date. During the proceedings, D15 to D17 were eventually not admitted.

- 1.26 The opposition division could have decided to admit these documents without depriving the parties of their right to fair proceedings. It would, first, have had to give to the proprietor the opportunity to provide its response. It could then have considered that the objections raised by the opponent were not well founded and decided to reject the opposition during the oral proceedings. Alternatively, it could have arrived at the conclusion that, in view of D15 to D17, its preliminary opinion was to be reversed. In this case, if requested by the proprietor, it would have had to postpone the oral proceedings to give proprietor the opportunity to prepare a proper response to the new submissions.
- 1.27 For these reasons, the board concludes that the opposition division, when deciding not to admit D15 to D17, exercised its discretion without taking into account the correct principles and in an unreasonable way.
- 1.28 D18 to D22 were filed by the proprietor in reply to the filing of D15 to D17 and were also not admitted into the opposition proceedings by the opposition division. It was not disputed that the opposition division's

reasoning on the admissibility of these documents hinged solely on the decision not to admit D15 to D17. Therefore, the decision not to admit D18 to D22 was also made without taking into account the correct principles.

1.29 Finally, in view of these findings and considering that the case is to be remitted for further prosecution the board does not deem it expedient to rule on their admittance.

2. *Remittal of the case to the opposition division*

2.1 The board considers that since none of the aforementioned documents were taken into account by the opposition division, although they could be *prima facie relevant* for assessing whether the requirements of sufficiency of disclosure, novelty and inventive step, are fulfilled, the case is to be remitted to the opposition division for further prosecution (Article 111(1) EPC and Article 11 RPBA 2020).

2.2 The board agrees with the parties that it is appropriate to remit to the opposition division the task of determining, by applying the right principles, whether D15 to D17 and the other documents filed in cascade by the parties during the opposition and appeal proceedings should be admitted.

2.3 The respondent requested that since D20 was not admitted by the opposition division and no explicit request to have it admitted was made in appeal, the board should rule that this document not be considered in subsequent proceedings. The board does not agree. D20 is mentioned in D15 as a reference describing the method used for determining the thermal conductivity of

the relevant compounds. Its potential relevance is also discussed in the appellant's statement of grounds of appeal. Therefore, it would not be appropriate for the board to decide *a priori* that D20 is not to be considered in the proceedings after remittal.

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:



M. Schalow

A. Haderlein

Decision electronically authenticated