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**Datasheet for the decision
of 17 September 2025**

Case Number: T 0807/23 - 3.3.03

Application Number: 15734675.0

Publication Number: 3166789

IPC: B32B27/32, C08F210/06,
C08F2/00, C08J5/18, C08L23/14,
B32B27/08, B32B27/18

Language of the proceedings: EN

Title of invention:

PROPYLENE RANDOM COPOLYMER FOR FILM APPLICATIONS

Patent Proprietor:

Borealis GmbH

Opponent:

Basell Poliolefine Italia S.r.l.

Relevant legal provisions:

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

Keyword:

Inventive step - state of the art
Remittal - (yes)

Decisions cited:

G 0001/23, G 0001/92, T 1833/14



Beschwerdekammern

Boards of Appeal

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Case Number: T 0807/23 - 3.3.03

D E C I S I O N
of Technical Board of Appeal 3.3.03
of 17 September 2025

Appellant: Basell Poliolefine Italia S.r.l.
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Representative: LyondellBasell
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Respondent: Borealis GmbH
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Representative: Maiwald GmbH
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Decision under appeal: **Decision of the Opposition Division of the
European Patent Office posted on 6 March 2023
rejecting the opposition filed against European
patent No. 3166789 pursuant to Article 101(2)
EPC.**

Composition of the Board:

Chairman D. Semino
Members: M. Barrère
L. Basterreix

Summary of Facts and Submissions

I. The appeal of the opponent lies from the decision of the opposition division rejecting the opposition against European Patent number 3 166 789.

II. Claim 1 as granted read as follows:

"1. Propylene random copolymer (R-PP) with ethylene having

(a) an ethylene content in the range of 5.3 to 9.0 wt.-%;

(b) a melt flow rate MFR2 (230°C) measured according to ISO 1133 in the range of 0.8 to 25.0 g/10min;

(c) a melting temperature T_m as determined by DSC according to ISO 11357 of from 128 to 138°C and a xylene cold soluble fraction (XCS) in the range of 9.0 to 18.0 wt.-%; and

(d) a relative content of isolated to block ethylene sequences (I(E)) in the range of 45.0 to 69.0 %, wherein the I(E) content is defined by equation (I)

$$I(E) = \frac{f_{PEP}}{(f_{EEE} + f_{PEE} + f_{PEP})} \times 100 \quad (I)$$

wherein

I(E) is the relative content of isolated to block ethylene sequences [in %];

fPEP is the mol fraction of propylene/
ethylene/propylene sequences (PEP) in the
sample;
fPEE is the mol fraction of propylene/
ethylene/ethylene sequences (PEE) and of
ethylene/ethylene/propylene sequences (EEP)
in the sample;
fEEE is the mol fraction of ethylene/
ethylene/ethylene sequences (EEE) in the
sample
wherein all sequence concentrations being
based on a statistical triad analysis of
¹³C-NMR data."

- III. The following document was *inter alia* cited in the decision of the opposition division:
- D11: technical data sheet for the commercial product Borclear RB709CF from Borealis AG dated 27 September 2010
- IV. The contested decision, as far as it is relevant to the present appeal, can be summarised as follows:
- document D11 was not state of the art within the meaning of Article 54(2) EPC and therefore irrelevant for the matter of inventive step.
- V. The opponent (appellant) filed an appeal against said decision.
- VI. The statement of ground of appeal was followed by a rejoinder of the patent proprietor (respondent) and a communication under Rule 15(1) RPBA indicating the Board's preliminary opinion. Both parties filed additional submissions after the communication (see

letter of the respondent dated 14 august 2025 and letter of the appellant dated 8 September 2025).

VII. Oral proceedings were held before the Board on 17 September 2025.

The appellant requested that the decision under appeal be set aside and that the case be remitted to the opposition division for further examination of the ground of inventive step on the basis of D11 (Borclear RB709CF) as state of the art under Article 54(2) EPC.

The respondent requested dismissal of the appeal and maintenance of the patent as granted (main request). In the alternative, the respondent requested maintenance of the patent in amended form on the basis of one of the first to eighth auxiliary requests filed during opposition proceedings. The respondent further requested that, should the Board come to the conclusion that document D11 was a suitable starting point for the assessment of the inventive step, the case be remitted to the opposition division for further examination of the ground of inventive step.

VIII. The parties' submissions, in so far as they are relevant to the present decision, can be derived from the reasons for the decision set out below. They essentially concerned the conditions of the remittal to the opposition division.

Reasons for the Decision

1. Status of document D11

1.1 In the decision under appeal, the opposition division found that the data provided in D11 did not enable the skilled person to prepare the commercial product Borclear RB709CF disclosed in that document. Therefore, in view of G 0001/92 and T 1833/14, it was concluded that D11 was not state of the art within the meaning of Article 54(2) EPC (contested decision, page 12, first to fifth paragraph).

1.2 The reproducibility criterion was recently reassessed by the Enlarged Board of Appeal in decision G 0001/23. In that decision, the Enlarged Board of Appeal found that:

"I. A product put on the market before the date of filing of a European patent application cannot be excluded from the state of the art within the meaning of Article 54(2) EPC for the sole reason that its composition or internal structure could not be analysed and reproduced by the skilled person before that date.

II. Technical information about such a product which was made available to the public before the filing date forms part of the state of the art within the meaning of Article 54(2) EPC, irrespective of whether the skilled person could analyse and reproduce the product and its

composition or internal structure before that date." (see order)

1.3 In application of that decision, it is clear to the present Board that the reproducibility requirement is no longer a valid criterion to assess whether a product put on the market before the date of filing of the opposed patent or technical information about such a product is state of the art within the meaning of Article 54(2) EPC. This was also not disputed by the parties during the oral proceedings (minutes, page 2, first full paragraph).

1.4 Accordingly, the product Borclear RB709CF and the corresponding data sheet D11 are state of the art within the meaning of Article 54(2) EPC.

2. Remittal

2.1 In the decision under appeal the opposition division concluded that the objections under inventive step did not prejudice maintenance of the patent as granted. Specifically, the opponent's objection based on document D11 was not addressed on the merit because that document was not considered to be state of the art within the meaning of Article 54(2) EPC (contested decision, page 12, first to fifth paragraph). This part of the decision of the opposition division is the only one that remained contested by the appellant in appeal (see statement of grounds of appeal and letter dated 8 September 2025) and needed to be decided upon.

2.2 As noted above, the Board found that, in view of G 0001/23, D11 is now considered to be prior art under Article 54(2) EPC and therefore relevant for inventive step. It follows that a complete assessment of the

opponent's objection based on D11 as the closest prior art is necessary in order to decide on the case. In view of the fact that this assessment was not carried out in the contested decision and of the new legal situation deriving from G 0001/23, the Board finds it appropriate to exercise its discretion under Article 111(1) EPC to remit the case to the opposition division to deal with that issue (Article 11 RPBA).

2.3 While the appellant requested an immediate remittal to the opposition division to deal with the question of inventive step in the light of D11, the respondent argued that the Board should only remit the case if D11 is deemed a valid starting point to arrive at the subject-matter of claim 1. In other words, the respondent requested that the Board assess the suitability of D11 as the closest prior art before remittal. They justified this request on the basis that the opposition division had already concluded that D11 was not the closest prior art (contested decision, page 12, sixth paragraph). Furthermore, the respondent argued that if the opposition division were to decide that D11 was not suitable to be taken as the closest prior art, the case would be sent back to the Board, which would lead to a "ping-pong" effect between the two instances and unduly prolong the proceedings.

2.4 However, the Board found it appropriate not to deal with the question whether document D11 could be taken as the closest prior art for the following reasons:

2.4.1 Contrary to what the respondent suggests, this point was not addressed on its merits in the contested decision. The conclusion that D11 could not represent the closest prior art was based solely on the fact that this document was found not to belong to the prior art

within the meaning of Article 54(2) EPC. A full assessment of whether this document could be used as a starting point for the claimed invention was not carried out.

- 2.4.2 Moreover, decision G 0001/23 sets out further considerations regarding the use of non-reproducible prior art in relation to inventive step (see in particular points 92, 93, 95 and 96 of the reasons). As these considerations were not available to the parties and the opposition division at the time of the decision under appeal, the case should also be remitted to the opposition division so that it can consider whether D11 is suitable to be taken as the closest prior art in light of G 0001/23 after giving both parties the possibility to take position on the application of the decision of the Enlarged Board to the present case.
- 2.4.3 Although the Board should try to minimise the likelihood of a "ping-pong" situation between the first and second instances, this must be weighed against the parties' interest in having their case examined by two instances (which would not be possible if the Board had to consider the suitability of D11 as the closest prior art).
- 2.5 Under these circumstances, the Board found it appropriate to remit the case to the opposition division in order to deal with the opponent's objection of lack of inventive step based on D11 as document within the meaning of Article 54(2) EPC, including the question of the suitability of this document as the closest prior art.

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