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**Datasheet for the decision
of 29 October 2021**

Case Number: R 0009/20

Appeal Number: T 0151/17 - 3.3.03

Application Number: 11004001.1

Publication Number: 2404766

IPC: C08L23/20, B60C1/00, C08L53/00,
C08L53/02, B60C5/14

Language of the proceedings: EN

Title of invention:

Polymer sheet for inner liner and pneumatic tire using the same

Patent Proprietor:

Sumitomo Rubber Industries, Ltd.

Opponent:

MICHELIN Recherche et Technique S.A.

Headword:

-

Relevant legal provisions:

EPC Art. 112a(2)(c), 113(1), 123(2)
EPC R. 106

Keyword:

Petition for review - clearly unallowable
Fundamental violation of right to be heard (no)

Decisions cited:

R 0001/08; R 0015/12; R 0008/13; R0016/13

Catchword:

-



**Große Beschwerdekammer
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Case Number: R 0009/20

D E C I S I O N
of the Enlarged Board of Appeal
of 29 October 2021

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(Patent Proprietor)

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Decision under review:

**Decision T 0151/17 of the Technical Board of
Appeal 3.3.03 of the European Patent Office of
26 February 2020.**

Composition of the Board:

Chairman:

I. Beckedorf

Members:

D. Rogers

A. Ritzka

Summary of Facts and Submissions

- I. The petition for review ("Petition") concerns appeal proceedings T 0151/17 of Board of Appeal 3.3.03 (hereafter "the Board"). The appeal was lodged by the opponent against the decision of the opposition division to reject the opposition and to maintain the patent as granted. The Petitioner is the proprietor of the patent and was the respondent before the Board.
- II. Oral proceedings were held before the Board on 26 February 2020. At the end of the oral proceedings the Chairman of the Board announced that the decision under appeal was set aside and that the patent was revoked.
- III. At the beginning of the oral proceedings before the Board the requests of the Petitioner (who was then the respondent) were that the appeal be dismissed, or alternatively that the decision under appeal be set aside and the patent be maintained upon the basis of any of auxiliary requests 1 to 8 filed with the letter of 22 July 2016 before the opposition division.
- IV. The Petition concerns a claim that the Petitioner's right to be heard was not respected, in particular that the Petitioner was not heard as regards whether a feature in claim 1 of auxiliary request 8 complied with the requirements of Article 123(2) EPC. The written submissions of the opponent contained added matter objections regarding a feature that had been deleted from claim 1 of auxiliary request 8 and its oral submissions at the oral proceedings before the Board concerned added matter objections to a feature that had

been added to claim 1 of auxiliary request 8. The Petitioner's right to be heard case turns upon this last added matter issue.

- V. The wording of claim 1 of auxiliary request 8 is set out below. The feature upon which this case hinges is underlined:

"A polymer sheet for an inner liner, including an SIBS layer containing a styrene-isobutylene triblock copolymer, and an SIS layer containing a styrene-isoprene-styrene triblock copolymer, said SIBS layer having a thickness more than or equal to 0.05 mm and less than or equal to 0.6 mm, wherein the content of the SIBS in the SIBS layer is more than or equal to 60% by mass and less than or equal to 99.5% by mass, said SIS layer having a total thickness more than or equal to 0.05 mm and less than or equal to 0.2 mm, and said SIBS layer, and said SIS layer containing more than or equal to 0.5% by mass and less than or equal to 40% by mass of a polymer obtained by polymerization of a monomer unit having 4 carbon atoms, wherein said polymer obtained by polymerization of a monomer unit having 4 carbon atoms is composed of at least one of polybutene and polyisobutylene".

- VI. In the written proceedings before the Board, the appellant-opponent raised objections against auxiliary requests 5 to 8 upon the basis of Article 123(2) EPC. None of these objections directly concern the issues in question and so will not be set out in detail. The

added matter objections against claim 1 of auxiliary request 8, and that are of relevance to this case, were all made orally, and for the first time, at the oral proceedings before the Board.

- VII. The minutes of the oral proceedings before the Board record that auxiliary requests 1 to 8 were discussed. The minutes state that the Board considered these auxiliary requests to be in the proceedings.
- VIII. The minutes also record that whether auxiliary request 8 complied with the requirements of Article 123(2) EPC was discussed with the parties. The Board concluded that auxiliary request 8 did not meet the requirements of the EPC, without giving any further details at the oral proceedings.
- IX. The arguments of the opponent-appellant made at the oral proceedings regarding added matter and claim 1 of auxiliary request 8 are set out on pages 7 to 8 of the Board's decision. The Board summarized these arguments at the bottom of page 7 as follows:

"...In particular, the combination of the range defining the amount in SIBS was selected from a preferred range within the description without the corresponding ranges being defined for the other features. There was no basis for the characterization of the polymer sheets by the content of SIBS in the SIBS layer without also limiting the other features disclosed at the same level of preference in the application as filed..."

X. The arguments of the Petitioner regarding added subject-matter and claim 1 of auxiliary request 8 are set out on page 10 of the Board's decision. The Board summarized these arguments as follows:

"Claim 1 of auxiliary request 8 was based on claims 2 and 3 as originally filed as well as on paragraphs 40 and 56 of the A1 publication which disclosed the preferred amount in SIBS in the SIBS layer."

XI. Both parties addressed, in their oral submissions before the Board, added subject-matter and the amount of SIBS in the SIBS layer feature (the "Added Feature").

XII. The written decision of the Board deals with auxiliary request 8 in para 3.4. The Board notes that the description is the source of the amendment, (the amendment being the definition of the content of the SIBS polymer in the SIBS layer), made to claim 1 of auxiliary request 8. The Board goes on to say that the description defines other features of the polymer sheets. All of these features are at the same level of preference - see para 3.4.3. The Board thus identified in this para 3.4.3 the Article 123(2) EPC issue as being whether there was a basis for the definition, in claim 1 of auxiliary request 8, of the specified content of the SIBS copolymer in the SIBS layer in isolation from the other disclosed features that had the same level of preference.

XIII. The Board answered the above question in the negative. It found that the limitation of the content of the SIBS copolymer in the SIBS layer to a specific range was partly associated with an improvement of the

vulcanization adhesive strength with the carcass or insulation. This was set out on page 9 of the application as filed. This amendment as such thus had a basis, this feature could be selected in isolation from the other features that were expressed to have the same level of preference because of its technical effect. The Board however found that page 12, lines 11-14 of the application as filed, disclosed that such an improvement in vulcanization strength also required the content of SIS in the SIS layer to be below 99.5%. This feature was not found in claim 1 of auxiliary request 8, hence the requirements of Article 123(2) EPC were not complied with.

XIV. In its Petition, the Petitioner claims that a fundamental violation of the right to be heard had taken place. It was only in a position to recognise this once the written decision had been issued. The reasons given in the written decision as to why claim 1 of auxiliary request 8 did not comply with Article 123(2)EPC were based on arguments that had never been put forward by the opponent-appellant in its written submissions.

XV. The Petitioner further states that at the oral proceedings before the Board, no discussion took place concerning Article 123(2) EPC in connection with a technical effect (see page 6/25 of the Petition). The Petitioner supports this statement by referring to pages 7 and 8 of the Decision which set out the opponent's arguments on added matter and claim 1 of auxiliary request 8 (and which are quoted above para IX).

- XVI. The Petitioner argues (page 8/25 of the Petition) that at the oral proceedings before the Board, after the Board admitted the auxiliary requests into the proceedings, it also stated (as recorded in the minutes) that it "... could consider any arguments relating to these requests presented for the first time during the oral proceedings as late filed and inadmissible."
- XVII. Despite the above statement, the opponent raised an argument in regard to Article 123(2) EPC and the Added Feature for the first time during the oral proceedings. In the light of this statement, the Petitioner considers that it could not have expected such a new argument to have been taken into account by the Board.
- XVIII. Further the Petitioner argues, (page 9/25 of the Petition), that the new argument of the opponent, besides being unexpectedly admitted into the proceedings, was not even the argument that the Board used to reach its decision. The opponent's new argument related to the same level of preference of the features disclosed in the application as filed, the Board's decision related to the common technical effect of certain features. Thus the Board developed its own argument on this point and did not provide the Petitioner with any possibility to comment on this.
- XIX. The Petitioner has in the section of its Petition "V. Comparison to Case Law" referred to case R 16/13 of 8 December 2014. The Petitioner argues that this case supports its view that the failure by the Board to bring to its attention the Board's view on the common technical effect of certain features constitutes a violation of the right to be heard.

- XX. The Petitioner has provided extensive arguments as to why the Board's conclusion on added subject-matter of claim 1 of auxiliary request 8 is wrong (pages 10/25 to 12/25, 17/25 to 19/25).
- XXI. The Petitioner also argues that the decision is not based on a ground (see pages 15/25 to 17/25).
- XXII. The Enlarged Board issued a communication setting out its preliminary view of the case. The Petitioner filed a reply under cover of a letter dated 6 May 2021 (hereafter "Reply") to the Enlarged Board's communication and made further submissions at the oral proceedings before the Enlarged Board.
- XXIII. As regards the issue of added matter and claim 1 of auxiliary request 8, in its Reply and at the oral proceedings, the Petitioner argued that the opponent only ever advanced the argument that four features were at the same level of preference and that the Petitioner had only selected one of them for claim 1 of auxiliary request 8. At no point had the opponent ever suggested that there was a technical link between these features. The Petitioner argued that this was set out in para 3.4.3 of the Decision. In para 3.4.4 of the Decision, the Board had not followed this argument from para 3.4.3 of the Decision, but had rather found a technical link between two of these four features, an argument never advanced by the opponent and that the Petitioner only found out about when it received the Decision - see para 3.4.4 of the Decision. The Board had also not put any emphasis on the technical effect described in

the specification constituting a "same level of preference".

XXIV. The Petitioner also argued in its Reply and at the oral proceedings that it maintained its case set out on page 15 of the Petition that the Decision is not based on a ground of evidence.

XXV. Oral proceedings took place before the Enlarged Board on 29 October 2021.

XXVI. The Petitioner requests that:

1. The decision under review is set aside and that the proceedings are re-opened; and
2. The fee for the Petition for Review is reimbursed; and
3. The members of the Board of Appeal that were participating in the decision under review are replaced.

Reasons for the Decision

Has the Petitioner complied with Rule 106 EPC?

1. The Enlarged Board considers this Petition to be a petition under Article 112a(2)(c) EPC. A petition under such a ground is only admissible if an objection in respect of the procedural defect was raised during the appeal proceedings and dismissed by the Board, except where such objection could not be raised during the appeal proceedings.

2. The Enlarged Board takes the view that the Petitioner's objection could not have been raised until the Petitioner had read the written decision of the Board.
3. The Petition is thus not clearly inadmissible.

Is the Petition allowable?

4. The Enlarged Board considers the Petition to be unallowable.
5. The Petitioner's case is that the Board violated its right to be heard as it had no opportunity to present arguments specifically addressing the issue of whether the limitation of the content of the SIBS copolymer in the SIBS layer to a specific range was partly associated with an improvement of the vulcanization adhesive strength with the carcass or insulation. This point was crucial to the Board's finding that claim 1 of auxiliary request 8 did not comply with Article 123(2) EPC.
6. It is uncontested that the compliance of claim 1 of auxiliary request 8 with Article 123(2) EPC was discussed at the oral proceedings before the Board. It is also apparent from the Board's communication sent in preparation of these oral proceedings that no restriction was placed upon the scope of such a discussion. The statement in the minutes that the Board "... could consider any arguments relating to these requests presented for the first time during the oral proceedings as late filed and inadmissible..." as such is only a reference to a general rule and does not constitute a restriction of a (potential) specific

argument. Moreover, it appears to be more of a restriction on the Petitioner than the opponent-appellant. This follows from the limited submissions in respect of added matter made on these auxiliary requests by the Petitioner during the written procedure. In any case the Petitioner has not suggested that the admission, during the oral proceedings, of arguments made by the opponent represents a violation of its right to be heard.

7. The statement on pages 7 to 8 of the Board's decision (see IX above) indicates that the opponent presented arguments on the issue of "whether the application as filed provided a basis for the definition in claim 1 of auxiliary request 8 of the specified content in SIBS copolymer in isolation to the other features disclosed in the application as filed" (see para 3.4.3, last sentence, of the Board's decision). Thus the opponent-appellant also used the "same level of preference" argument that it had used in writing against a deleted feature, (see page 12/13 of its Grounds of Appeal), against the inserted SIBS content feature found in the claim.
8. The Petitioner's arguments on auxiliary request 8 are set out on page 10 of the Board's decision. They are limited to identifying a basis for the amount of SIBS in the SIBS layer. This has not been contested by the Petitioner. It is thus clear that both parties were heard at the oral proceedings before the Board on the feature of claim 1 of auxiliary request 8 upon which the Board made its added matter decision.

9. The Petitioner considers that para 3.4.3 of the Decision confirms that the opponent only made an argument that four features of the patent were of the same level of preference, due to the use of the word "preferably" in the application, and that claim 1 of auxiliary 8 contained added matter because it took only one of these features, rather than all of them. The Petitioner considers that para 3.4.4, which sets out the Board's negative decision on added matter, did not follow or adopt this reasoning, but rather substituted the Board's own argument that two of these four features needed to be in claim 1 of auxiliary request 8 because of a common technical effect shared by these two features. This was completely different reasoning than that advanced by the opponent and the Petitioner was never given the chance to address it as it only discovered this reasoning in the written Decision of the Board.
10. Following a discussion of the specific added subject-matter issue set out in para 7 and 8 above, the Board came to the view that there was no basis for the definition in claim 1 of auxiliary request 8 of the specified content in SIBS copolymer in isolation to the other features disclosed in the application as filed.
11. The Board's reasons for coming to such a conclusion are set out in para 3.4.3 and 3.4.4 of the Decision. In para 3.4.3 the Board sets out the opponent's argument. It is apparent from 3.4.3 that the Board accepts that if all four features are of the same level of preference, then claim 1 of auxiliary request 8 contains added matter. In para 3.4.4 the Board addresses the opponent's argument. In order for the

opponent to succeed, the Board would need to be convinced that there was no basis for choosing one of the four features that were expressed in the application to be of the same level of preference. The Board itself then advanced an argument in favour of the Petitioner and against the opponent, that is that the SIBS feature was associated with a technical effect and this would provide a basis for selecting it from the four features. However, one of the other of the four features was also required for this technical effect, hence the Board could not use this as a basis for selecting the SIBS feature on its own. Thus the opponent's "same level of preference" argument succeeded. This is apparent from reading para 3.4.5.

12. It thus appears to the Enlarged Board that the Board has addressed the issue of "same level of preference" in its decision and has followed the opponent-appellant's submissions on this point.
13. Decisions of a Board of Appeal may only be based on grounds or evidence on which the parties have had an opportunity to present their comments (Article 113(1) EPC). This implies that a party may not be taken by surprise by references in the reasons for the decision, to unknown grounds or evidence. Grounds or evidence under Article 113(1) EPC is to be understood as the essential legal and factual reasoning on which a decision is based (see also decision R 16/13 of 8 December 2014, reasons 3.3). A party has to have an opportunity to comment on the decisive aspects of the case.

14. On the other hand, a Board of Appeal must be able to draw its own conclusion from the discussion of the grounds put forward (see decision R 8/13 of 15 September 2015, reasons 2-1 and 2-2). Thus, the right to be heard does not go so far as to impose a legal obligation on a Board of Appeal to disclose in advance to the parties how and why, on the basis of the decisive issues under discussion, or at least those foreseeable as the core of the discussion, it will come to its conclusion. This is part of the reasoning given in the written decision (R 1/08 of 15 July 2008, reasons 3.1; R 15/12 of 11 March 2013).
15. It may well be that the Board did not disclose to the parties in advance all the elements of its analysis for arriving at the decision on this issue. However, in the light of the general principles developed in the case law as set out above, this cannot be seen as a violation of the Petitioner's right to be heard. The analysis provided by the Board in the written reasons does not appear to contain anything so surprising that the parties should have been informed about it beforehand. In this case the Board's reasoning is directly derivable from the opponent-appellant's argument, set out on pages 7 and 8 of the Board's decision, made in respect of the claim feature in issue. That the Board agreed with this argument is apparent from reading paras 3.4.3, 3.4.4, and 3.4.5 of the decision together.
16. In the light of the above, the Petitioner's claim that its right to be heard was violated is tantamount to imposing on a Board of Appeal a requirement that the parties are provided with the Board of Appeal's

detailed reasoning for its decision before the decision is announced, and with an opportunity to comment on this detailed reasoning.

Comparison with the case law - R 16/13

17. The Petitioner made submissions relating to the applicability of R 16/13 (supra) to the present case. The Enlarged Board considers that the present case can be distinguished over R 16/13. In R 16/13, the proprietor (and petitioner) had adopted a certain view of a document D11A both before the opposition division and the Board of Appeal that was central to its case on inventive step. The Board of Appeal had made no comments on this document during the appeal proceedings. The Board of Appeal's grounds for finding a lack of inventive step came from its own interpretation of D11A, an interpretation at odds with that of the petitioner, and not derived from any argument advanced by the opponent. At no point in the appeal proceedings had the Board of Appeal expressed a view on D11A.
18. In the present case the opponent put forward a case that claim 1 of auxiliary request 8 involved added subject-matter due to the added feature, see its argument as set out on pages 7 and 8 of the Board's decision. The Board followed the argument of the opponent and in the detailed reasons for doing so, explained that it found two features to be of the same level of preference because they were both associated with the same technical effect.
19. In the light of the above, the Enlarged Board does not consider that case R 16/13 assists the Petitioner.

Decision not Based on a Ground (Reason 2)

20. The Enlarged Board refers to the Petitioner's arguments set out on page 15/25 of its Petition. The arguments set out in this section do not appear to assist the Petitioner as they concern the Petitioner's view that the Board's decision is wrongly decided.
21. It follows from the above that no violation of the Petitioner's right to be heard can be established with regard to its allegations of surprise reasoning in the written decision. Hence, the Petition is clearly unallowable in this respect.

Order

For these reasons it is decided that:

The petition for review is unanimously rejected as being clearly unallowable.

The Registrar:

The Chairman:



N. Michaleczek

I. Beckedorf

Decision electronically authenticated