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D E C I S I O N
of 29 October 2003

Case Number: T 0520/01 - 3.2.7

Application Number: 91202896.6

Publication Number: 0479393

IPC: B65D 1/02

Language of the proceedings: EN

Title of invention:

Method of blow moulding a returnable polyester biaxially oriented container

Patentee:

CONTINENTAL PET TECHNOLOGIES, INC.

Opponents:

CONSTAR INTERNATIONAL Holland B.V.
Rexam Aktiebolag
PEPSICO, Inc.

Headword:

-

Relevant legal provisions:

EPC Art. 84, 100(b), 112(1)(3)
EPC R. 55(c)

Keyword:

"Re-introduction of grounds in appeal proceedings - not allowed"
"Claims not supported by the description"
"Patent revoked"
"Referral to the Enlarged Board of Appeal (no) - a decision on the appeal could be rendered without an answer to the proposed question"

Decisions cited:

G 0009/91, G 0010/91, G 0003/98, T 0986/93, T 0274/95,
T 1070/96

Catchword:

1. Where a ground of opposition, here insufficiency, was expressly not maintained in opposition oral proceedings by the only party which had relied on the ground and the Opposition Division did not deal with the ground in their decision the re-introduction of the ground in appeal proceedings constitutes a fresh ground which, following Opinion G 10/91 by analogy, requires the permission of the proprietor.

2. Where a ground, here novelty, was substantiated within the opposition period and the party which raised the ground neither appears at the opposition oral proceedings nor withdraws the ground the Opposition Division has to deal with the ground in their decision. The ground may then be taken up by other appellants in subsequent appeal proceedings.

3. A request for a referral under Article 112 EPC to the Enlarged Board of Appeal must be refused if a decision can be reached on the basis of grounds other than those grounds to which the proposed question was related, cf. decision G 3/98, point 1 of the reasons.



Case Number: T 0520/01 - 3.2.7

D E C I S I O N
of the Technical Board of Appeal 3.2.7
of 29 October 2003

Appellant I: PEPSICO, Inc.
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Respondent: CONTINENTAL PET TECHNOLOGIES, INC.
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Decision under appeal: Interlocutory decision of the Opposition
Division of the European Patent Office posted
23 March 2001 concerning maintenance of
European patent No. 0479393 in amended form.

Composition of the Board:

Chairman: C. Holtz
Members: P. O'Reilly
H. Felgenhauer

Summary of Facts and Submissions

I. Appellants I and II (Opponents III and II respectively) filed appeals against the decision of the Opposition Division to maintain amended the European Patent No. 0 479 393.

II. Opposition was filed by Opponents I, II and III against the patent as a whole and based on Article 100(a) EPC (lack of novelty and lack of inventive step) and Article 100(c) EPC (added subject-matter).

The Opposition Division held that the subject-matter of claim 1 of the auxiliary request was novel and involved an inventive step.

III. The appellants requested that the decision under appeal be set aside and the patent be revoked. They also requested that the following question should be submitted to the Enlarged Board:-

"Unter welchen Umständen ist ein während eines Einspruchsverfahrens in zulässiger Weise geltend gemachter Einspruchsgrund

a) zu dem während der mündlichen Verhandlung vor der Einspruchsabteilung von der Einsprechenden keine weiteren mündlichen Ausführungen gemacht werden, oder

b) der während der mündlichen Verhandlung vor der Einspruchsabteilung von der Einsprechenden nicht mehr aufrecht erhalten wird, oder

c) der während der mündlichen Verhandlung vor der Einspruchsabteilung von der Einsprechenden ausdrücklich zurückgenommen wird,

im Einspruchs-Beschwerdeverfahren (wieder) zuzulassen?"

The respondent requested that the decision under appeal be set aside and the patent be maintained in amended form in accordance with the main request filed during oral proceedings before the Board on 29 October 2003, or alternatively, in accordance with the auxiliary request also filed during the oral proceedings before the Board on 29 October 2003. The respondent further requested during the oral proceedings to file a new auxiliary request.

IV. The independent claim of the main request reads as follows:

"1. A method of blow moulding a polyester biaxially oriented container (30), the method comprising the steps of:-

(a) providing an injection moulded polyester preform body (10) having an elongated body (16) for forming a container body and being closed at one end (20) and open at the opposite end, said preform open end having a threaded neck finish (12) and said elongated body having a portion (14) tapering in wall thickness adjacent said neck finish (12) for forming a container shoulder portion, said closed one end being defined by a bottom having a generally hemispherical outer surface; and

(b) stretch blow moulding the preform (10) to form a blow moulded biaxially oriented container (30) having

container body formed from the elongated body (16) of the preform (10) and comprising a transparent biaxially oriented sidewall, a neck finish (12) constituted by the neck finish of the preform and an extended shoulder portion (36) in the area adjacent the neck finish (12) and formed from the said portion (14) of the preform (10),

characterised in that the closed one end (20) of said preform body (16) comprises a cylindrical container base-forming flute portion (22) having a greater wall thickness relative to the wall thickness of said preform body (16) and in that in step (b) the preform (10) is blow moulded whereby in the container (30) a low orientation rigid integral champagne-type base (34) is formed from the fluted portion (22), the champagne-type base (34) including a chime area (40) having a peripheral contact radius and an unoriented recess central portion, the champagne-type base having a thickness greater than the thickness of the side wall, whereby the container (30) is returnable and suitable for refilling."

The independent claim of the auxiliary request reads as follows:

"1. A method of blow moulding a polyester biaxially oriented container (30), the method comprising the steps of:-

(a) providing an injection moulded polyester preform body (10) having an elongated body (16) for forming a container body and being closed at one end (20) and open at the opposite end, said preform open end having a threaded neck finish (12) and said elongated body having a portion (14) tapering in wall

thickness adjacent said neck finish (12) for forming a container shoulder portion, said closed one end being defined by a bottom having a generally hemispherical outer surface; and

(b) stretch blow moulding the preform (10) to form a blow moulded biaxially oriented container (30) having container body formed from the elongated body (16) of the preform (10) and comprising a transparent biaxially oriented sidewall, a neck finish (12) constituted by the neck finish of the preform and an extended shoulder portion (36) in the area adjacent the neck finish (12) and formed from the said portion (14) of the preform (10),

characterised in that the closed one end (20) of said preform body (16) comprises a cylindrical container base-forming flute portion (22) having a greater wall thickness relative to the wall thickness of said preform body (16) and in that in step (b) the preform (10) is blow moulded whereby in the container (30) a low orientation rigid integral champagne-type base (34) is formed from the **bottom and the** fluted portion (22), the champagne-type base (34) including a chime area (40) having a peripheral contact radius and an unoriented recess central portion, the champagne-type base having a thickness greater than the thickness of the side wall, whereby the container (30) is returnable and suitable for refilling."

V. The appellants argued in written and oral submissions essentially as follows:

(i) The ground of insufficiency was never abandoned by Appellant I. When the appellant in the oral proceedings before the Opposition Division

declared that the objection under Article 100(b) EPC was not maintained this did not mean that the ground was not longer in the proceedings. It merely meant that the appellant did not wish to speak orally to the ground. In case of doubt concerning a statement by a party the Opposition Division is obliged to clarify the request of the party. Moreover, the framework for appeal proceedings is not just the decision of the Opposition Division but the whole opposition proceedings. Even if the ground were considered to be withdrawn it still should be admitted into the appeal proceedings in view of decision T 274/95. The situation in the present case is similar to that in T 274/95. In that decision the re-introduction of a withdrawn ground was not considered to be a fresh ground in the sense of Enlarged Board of Appeal Opinion G 10/91.

(ii) With regards to the ground of lack of novelty this was dealt with in the decision of the Opposition Division and in the opposition proceedings and so can be addressed in appeal proceedings. Also, in this case the framework for appeal proceedings is the decision of the Opposition Division and the whole opposition proceedings.

(iii) Claim 1 as amended specifies that the container is returnable and suitable for refilling. The term returnable merely indicates a capability of being returned. Suitable for refilling implies that the container may be cleaned and refilled. From the description of the patent this is defined as retaining its aesthetic and functional performance

over five to ten complete refill loops. More specifically the problems of shrinkage and crack failures have to be avoided. The claim does not however specify the temperature and crystallinity levels to be used to achieve a viable container. It is stated in the description that an aim of the invention is to provide a refillable PET container. The description moreover only relates to PET containers so that the skilled person would be unable to extend the teaching to all types of polyester containers. There is therefore no support for the claim in the description. In addition the expressions "low orientation", "rigid", "returnable" and "refillable" are unclear. The amendments to claim 1 do not therefore comply with Article 84 EPC.

- (iv) It would be appropriate to submit a question to the Enlarged Board of Appeal concerning the non-maintenance of the objection of insufficiency and a re-introduction of this ground into the appeal proceedings as this is an important point of law.
- (v) The respondent should not be given any further opportunity to file auxiliary requests at this late stage of the proceedings since he has already had sufficient opportunity.

The appellants also presented arguments with regards to Articles 100(c) and 123(2) EPC, and with regards to lack of novelty and lack of inventive step. These arguments are no longer relevant to the decision.

VI. The respondent argued in written and oral submissions essentially as follows:

- (i) Since Appellant II did not raise the ground of opposition under Article 100(b) EPC and Appellant I did not maintain the ground the appellants are not adversely affected by the decision of the Opposition Division which did not deal with this ground. Enlarged Board of Appeal Opinion G 10/91 does not allow the re-introduction of grounds. At the oral proceedings before the Opposition Division there was no doubt that the ground was withdrawn and not just that the opponent did not want supplement his written submission by an oral submission. The respondent does not approve of the introduction of this fresh ground of opposition into the appeal procedure.

- (ii) The ground of lack of novelty was only raised by Opponent I who has not filed an appeal. Opponent I only filed the ground against claim 1 as granted. Opponent I did not attend the oral proceedings before the Opposition Division and did not raise the ground against claim 1 as amended. Opponents II and III indicated in the oral proceedings that they did not dispute the novelty of claim 1 as amended. Therefore the novelty of claim 1 as amended was never examined in the opposition proceedings. Since Opponents II and III did not dispute the novelty they are not adversely affected by the decision of the Opposition Division as to novelty. Enlarged Board of Appeal Decision G 7/95 restricts the examination of novelty in appeal proceedings in the context of

inventive step to the novelty of the claims in view of the closest prior art. The respondent does not approve of the introduction of this fresh ground of opposition into the appeal proceedings.

- (iii) The expression suitable for refilling is clear. None of the features mentioned by the appellants as being essential are in fact essential. The crystallinity and other parameters are not essential as they relate only to PET, the preferred embodiment, and would be different for other polyesters. The correct definition of refillable is that given by the Opposition Division, i.e. the container is returned to the provider, cleaned and then refilled. The number of refill loops is not relevant. The reference in the description to the aim of the invention being to provide a PET container is not a limitation.
- (iv) The respondent considers that the proposed question to the Enlarged Board could be appropriate since this is an important point of law. The question should not however be limited to oral proceedings but should include written proceedings.
- (v) In order to overcome the ground under Article 84 EPC the respondent wishes to file a second auxiliary request in which the expression "suitable for refilling" would be deleted.

The respondent also presented arguments refuting the grounds under Articles 100(c) and 123(2) EPC, and refuting the grounds of lack of novelty and

lack of inventive step. These arguments are no longer relevant to the decision.

Reasons for the Decision

1. *Admissibility of the ground of insufficiency*

1.1 The ground of insufficiency under Article 100(b) EPC was substantiated during the period for opposition by Opponent III (Appellant I). At the start of the oral proceedings before the Opposition Division the Opposition Division asked the opponents to state their requests. According to the minutes of the oral proceedings Opponent III requested revocation *inter alia* on the basis of Article 100(b) EPC against the auxiliary request. After the main request of the proprietor (maintenance of the patent as granted) was rejected the Opposition Division asked Opponent III to present his arguments with respect to Article 100(b) EPC. According to the minutes Opponent III "announced that his objection according to Article 100(b) was not maintained." In the section of their decision on facts and submissions the Opposition Division noted in paragraph 2c that Opponent III had raised grounds under Article 100(b) EPC. Then in paragraph 9 reference was made to the oral proceedings with the remark that "For further details see the contents of the minutes." In the reasons for the decision the Opposition Division stated that "The objections with respect to Article 83 EPC, raised by Opponent III, were withdrawn during the oral proceedings." The Opposition Division made no further comment on this ground in their decision.

- 1.2 The Opposition Division did not make use of its *ex-officio* powers to continue the ground. This is shown by the fact that Opposition Division did not deal with the ground as to its merit in their decision. Since the only opponent who raised this ground did not maintain it in the oral proceedings the Board concludes that the ground under Article 100(b) EPC was no longer in the opposition proceedings at the end of the oral proceedings before the Opposition Division.
- 1.3 Appellant I has argued that the ground was never withdrawn but was merely not argued further orally. Furthermore, this appellant considered that in the case of an unclear declaration by a party the Opposition Division was obliged to clarify the statement but had omitted to do so in this case.
- 1.4 In the opinion of the Board the statement by Opponent III was quite clear, so that no further clarification was required by the Opposition Division. The opponent indicated that he did not maintain the "objection". In the opinion of the Board "objection" in this context can only mean ground. If the opponent had intended to maintain the ground without presenting further arguments then he would not have gone so far as to state that the objection was not maintained. He would have given some indication that no further arguments were to be presented. The minutes would have reflected this. As it is, the minutes give a clear indication that the ground or "objection" was not maintained.

1.5 Appellant I has not disputed the content of the minutes but rather their clarity and interpretation. Under the circumstances of the present case it is more likely than not that the Opposition Division had correctly understood the submission to mean that the ground of insufficiency was withdrawn.

Since the Board does not agree with the interpretation given by Appellant I, nor that there is any lack of clarity in the statement, the Board finds that the Opposition Division was correct in not dealing with the ground on its merits in their decision.

1.6 The ground of insufficiency has been relied upon by Appellants I and II in their appeal grounds, but the respondent has not agreed to the ground being examined. It is therefore necessary to consider whether this ground constitutes a fresh ground in the sense of Enlarged Board of Appeal Opinion G 10/91 which would require the permission of the proprietor for its introduction.

In Enlarged Board of Appeal Decision G 9/91 and Opinion G 10/91 (see point 18 of the decision/opinion) it is stated that the purpose of appeal proceedings is "mainly to give the losing party the possibility of challenging the decision of the Opposition Division on its merits". Further it is stated that it is not the purpose of appeal proceedings "to consider grounds for opposition on which the decision of the Opposition Division has not been based". From this it follows that it is not the purpose of appeal proceedings to consider a withdrawn ground on which a decision of the Opposition Division has not been based.

- 1.7 The Board is aware of a number of decisions by other Boards of Appeal related to this question. In decision T 986/93 a ground under Article 100(c) EPC was introduced into the opposition proceedings after the period of opposition, i.e. a late filed ground. The Opposition Division decided not to admit the ground on the basis that it was not *prima facie* relevant. The Board decided to admit the ground as the Board considered that it was entitled to review the decision of the Opposition Division not to admit the ground. Decision T 986/93 appears to confirm the decision of the Opposition Division as being the basis for appeal proceedings. In that case the decision of the Opposition Division to exercise discretion against admittance of the ground was a part of the decision being reviewed.
- 1.8 In Decision T 1070/96 the ground of insufficiency was introduced by an Opponent II during opposition proceedings and examined by the Opposition Division who referred to the ground in their decision. Only Opponent I filed an appeal so that the respondent (proprietor) argued that Opponent I was not entitled to use a ground which had only been raised by Opponent II. The Board considered that it was irrelevant which opponent raised the ground provided that the ground is dealt with in the decision. Again this decision is consistent with the view that the main basis for appeal proceedings is the decision of the Opposition Division.
- 1.9 In Decision T 274/95 the circumstances may seem similar to those of the present case. The Board admitted the ground into the appeal proceedings on the basis that

the ground had been fully argued pursuant to Rule 55(c) EPC and that the Opinion G 10/91 was concerned with grounds that had not been substantiated in accordance with Rule 55(c) EPC. As set out in point 11(c) of their decision, the Board considered that the ground was not sufficiently relevant to prejudice the maintenance of the patent which would justify rejection of the ground as inadmissible. In view of this, and the fact that the ground was considered to have "limited extent", the Board decided to admit the ground and then to reject the ground for substantive reasons. No remittal was necessary and the proceedings were not delayed. In this result T 274/95 differs from the present case.

Even if, read strictly on its wording, G 10/91 does not apply to withdrawn grounds which were originally sufficiently substantiated, it has to be considered with regard to its general approach towards matter not examined at first instance being (re-)introduced at the appeal stage. An analogous application of the opinion therefore needs to be considered. When assessing whether the re-introduction of a withdrawn ground is allowable one important factor is the procedural results which could ensue. One likely effect would be that the case would have to be remitted to the first instance and the patentee would find himself again in exactly the same position as at the start of the original oral proceedings before the Opposition Division. The present Board considers that such a possibility is not in accordance with the view expressed in Opinion G 10/91 that the patentee should not face unforeseeable complications at a very late stage in the proceedings. Such a possibility would be an unreasonable burden on the patentee and an open door

to abuse. Whilst a procedural abuse by an opponent could be the subject of an award of costs this would not properly compensate for the many years wasted by the withdrawal of the ground, appeal proceedings, subsequent remittal to the first instance and the new first instance proceedings. All of these steps would have been involved in bringing the case back to the point reached at the start of the original oral proceedings before the Opposition Division. This procedural result is very similar, if not identical, to the concerns which led the Enlarged Board of Appeal to limit the introduction of grounds to those that had been substantiated as required by Rule 55(c) EPC. It should be borne in mind that decision G 9/91 and opinion G 10/91 were both based on the stated purpose of appeal proceedings being to review the grounds of the appealed decision. The present case would in the opinion of the Board have to be remitted, should this ground have been admitted.

In analogy with the reasoning in G 10/91 and for the reasons stated above, this Board concludes that the ground of insufficient disclosure is a fresh ground in the circumstances of the present case and cannot be admitted into the appeal proceedings in view of the lack of consent of the respondent.

2. *Admissibility of the ground of novelty*

2.1 Before the Opposition Division Opponent I (the other party) substantiated the ground of lack of novelty within the time limit for opposition. Opponents II and III also substantiated the ground of lack of novelty within the time limit for opposition. The respondent

filed an auxiliary request during the oral proceedings before the Opposition Division which was attended by Opponents II and III but not by Opponent I. After the main request of the proprietor (maintenance of the patent as granted) was rejected by the Opposition Division Opponents II and III, when asked by the Opposition Division regarding the auxiliary request, declared "that they did not dispute the novelty of the claims on file". In their decision the Opposition Division declared (see point 5 of the reasons for the decision) that "The subject-matter of claim 1 as amended must be considered as novel, since neither the documents considered during the examination of the patent in suit nor the newly cited ones show all of its features." The Opposition Division then considered the novelty ground of Opponent I and noted that none of the documents cited by that opponent disclosed all of the features of amended claim 1, citing as an example a feature which was not disclosed in the documents. The Opposition Division then concluded that "Therefore, amended claim 1 fulfils the requirements of Article 52 and 54 EPC with respect to novelty."

- 2.2 The ground of novelty was never withdrawn in any form by Opponent I. The fact that an auxiliary request was filed does not in the opinion of the Board place any requirement on an opponent to reconfirm that the ground still applies to the claims as amended in accordance with the request. Furthermore, the Opposition Division is entitled *ex-officio* to examine this ground. It is clear from their decision that the Opposition Division carried out such an *ex-officio* examination with respect to novelty, coming to the conclusion that the ground

did not prevent the maintenance of the patent as amended.

2.3 In accordance with Enlarged Board of Appeal Opinion G 10/91 the purpose of appeal proceedings is to give the losing party the chance to challenge the decision of the Opposition Division on its merits. The ground of lack of novelty was clearly part of the decision of the Opposition Division. Therefore, it is also open to the losing party, here the opponents, to challenge that part of the decision on its merits.

2.4 The respondent has argued that the appellants were not adversely affected by the part of the decision dealing with novelty and hence were not entitled to use this ground in the appeal proceedings. However, the question of being adversely affected in the sense of Article 107 EPC relates to the tenor of the decision and not to the individual grounds. Grounds, or rather the reasons why grounds are or are not decisive for the outcome of a case, cannot gain any legal force. An opponent who considers that in a particular decision a finding of novelty was wrong whereas the finding of lack of inventive step was correct, is not adversely affected by the consequent decision to revoke the patent, i.e. the opponent cannot file an appeal against the part of the decision concerning lack of novelty.

2.5 Also, the argument of the respondent that the decision did not contain properly reasoned arguments on novelty, i.e. discussing individual documents, cannot be followed. The Opposition Division identified a particular feature of the amended claim which was not to be found in any cited prior art document. The

Opposition Division thus gave a short but clearly reasoned statement sufficient to show a party what might be required to overturn their decision.

2.6 Since the Board considers that the ground of lack of novelty was always in the opposition proceedings and was the subject of a decision by the Opposition Division the appellants are entitled to refer to the ground in appeal proceedings, without requiring the permission of the respondent.

3. *Article 84*

3.1 The discussion of the requirements of Article 84 turned around the term "refillable" as introduced into claim 1 in the opposition proceedings by way of amendment. In the introductory part of the description of the patent it is indicated that an aim of the invention is "to provide a method of blow moulding a refillable thermoplastic PET container having a thin-walled body which retains its aesthetic and functional performance over five to ten refill trips or loops." It is an essential aspect of the invention that the containers are refillable. In the description of the patent the problems associated with crack initiation and propagation in PET bottles exposed to caustic wash baths are mentioned, cf. page 3, lines 4 to 6. A further problem is that of volume deviation, cf. page 4, lines 36 to 40. The description reinforces the importance of the factors of cracking and thermal stability on page 5, lines 4 to 7. Further, with respect to PET containers it is explained in the description that thermal stability is obtained due to a technology that increases the percent crystallinity of

the PET morphology in blow molded containers, cf. page 5, lines 8 to 10. It is explained that the technology produces a 24-30% crystallinity and improved thermal stability compared to conventional non-returnable PET bottles, cf. page 5, lines 27 to 30.

3.2 The Opposition Division considered that the term refillable meant that the container is returned to the provider, cleaned and then refilled. In the opinion of the Board the term refillable also requires that the container must be capable of being subjected to a caustic wash at an elevated temperature and should be sufficiently thermally stable that it can reasonably be remarketed, i.e. its form, appearance and volume capacity should be close to the product as originally produced. In fact, for the consumer the refilled container should be as acceptable as a new container. This point was particularly made by Appellant II.

3.3 Claim 1 is directed to a polyester container. In the description reference is made in the very first line to polyester containers, cf. page 2 (first page of description), line 3. There is then a discussion of "a refillable plastic bottle", cf. lines 5 to 9. In lines 19 to 21 "polymer candidates" are discussed. A conclusion is drawn that "Of the polymers commercially available, PET offers the best balance of properties and cost/performance ratios", cf. lines 21 to 22. The next part of the description refers to non-returnable PET containers. A discussion of the nearest prior art document follows. It is then stated that "It is an aim of this invention to provide a method of blow moulding a refillable thermoplastic PET container having a thin-walled body which retains its aesthetic and functional

performance over five to ten refill trips or loops." Claim 1 is then recited as is claim 2. The detailed description which follows is solely concerned with the problems of PET containers.

- 3.4 Polyesters include PET. The question arises therefore as to whether the claim has support in the description for the term "refillable" as applied to PET, i.e. does the claim include the features which may be essential to ensure that the PET container is refillable? A further question which arises is whether there is support for the term "refillable" as applied to polyesters other than PET.
- 3.5 From the description on page 4, lines 39 to 40 and page 5, lines 1 to 3 it is apparent that a maximum volume deviation is $\pm 1.5\%$ and that a deviation of 7.0% as obtained with conventional PET was not acceptable and hence such a container could not be described as refillable. Also, from the description it is clear that in order to produce a thermally stable, i.e. with maximum volume deformation of $\pm 1.5\%$, PET container it is necessary to ensure that the crystallinity is within particular limits. Only within these limits is the thermal stability achieved which is required for the container to be refillable. This essential feature of the range of crystallinity is missing from claim 1.
- 3.6 With respect to polyesters other than PET, it must first be noted that there is no information in the description regarding the application of the teaching of the patent to polyesters other than PET. The only mention of other polyesters is in a discussion in the introductory paragraphs where the conclusion is reached

that PET is the best. The particular description is then devoted exclusively to describing how the problems which arise with the use of PET may be overcome. There is no indication that the same problems, i.e. cracks and thermal instability, arise with other polyesters, nor is there any indications how they could be overcome. In the case of thermal instability the description explains how more recent PET technology has overcome the problem of thermal instability by increasing the crystallinity. However, there is no indication that this could have the same effect for other polyesters. For cracks propagation there is no indication that this is a problem with other polyesters. On the other hand, other polyesters may have problems other than those dealt with in the description of the present patent, without the solution to such problems being disclosed in the patent.

- 3.7 The respondent argued that it was not appropriate to add possibly essential features to the claim on the basis that each of the features discussed in the description would be different for polyesters other than PET. This means that the description deals only with the particular problems as regards to refillability which arise with PET and indicates the way that these problems are to be solved for PET. The disclosed solution, according to the respondent, will not apply to other polyesters. Claim 1 nevertheless specifies polyesters in general. The Board concludes therefore that claim 1 in its full breadth is not supported by the description and thus does not fulfil the requirements of Article 84 EPC. A claim which does not fulfil the requirements of Article 84 EPC cannot be maintained in view of Article 102(3) EPC.

3.8 The respondent referred in his submissions to a number of decisions of other Boards of Appeal concerning similar cases all being derived from the same parent application as the present patent. However, in each of those cases the features of the claim under discussion were, not surprisingly, different to those of the present case and in particular with respect to the features being considered for support in the description. None of the decisions concerned a refillable polyester container. It is not therefore necessary to make further reference to those decisions.

3.9 Since the term "refillable" is contained in both the main and auxiliary requests the Board concludes that neither request complies with Article 84 EPC.

4. *Request to refer a question to the Enlarged Board of Appeal*

4.1 During the oral proceedings the Board came to the conclusion that the ground of insufficiency was a fresh ground and did not admit the ground. Thereafter, Appellant I formulated a question to be put to the Enlarged Board of Appeal. Appellant II supported this request. Also, the respondent considered that the question was important enough to be referred to the Enlarged Board. However, the Board came to the conclusion that the patent could not be maintained on the basis of grounds other than those to which the question related, i.e. Article 84 as set out above. Since the admissibility of a referral under Article 112 EPC presupposes that an answer to the question is necessary for the referring Board to be able to decide

on the appeal (cf. G 3/98, point 1) the proposed referral in the present case must be refused.

5. *Request to file a further auxiliary request*

5.1 After being informed by the Board that the main and auxiliary requests did not comply with Article 84 EPC the respondent requested to file a further auxiliary request in which the words "and refillable" would be deleted. The Board notes that the arguments on which the ground under Article 84 EPC was based had been in the appeal proceedings from the start. The respondent thus had ample opportunity to consider filing such an auxiliary request. In the opinion of the Board oral proceedings are not the appropriate stage at which to file such a request. The request would have considerable implications since the claim would be broadened so that a question of *reformatio in peius* would arise. Furthermore, the claim was limited in this manner during the opposition proceedings in order to overcome a ground under Article 100(c) EPC. It is also clear that the proposed request contained a major amendment which did not arise from new matter discussed for the first time in the oral proceedings.

5.2 The Board therefore exercises its discretion not to allow the introduction of the proposed auxiliary request.

Order

For these reasons it is decided that:

1. The decision under appeal is set aside.
2. European patent No. 0 479 393 is revoked.
3. The request for referral of a question under Article 112 EPC to the Enlarged Board of Appeal is refused.

The Registrar:

The Chairman:

D. Spigarelli

C. Holtz