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D E C I S I O N
of 7 November 2005

Case Number: T 0117/02 - 3.3.03
Application Number: 93907617.0
Publication Number: 632819
IPC: C08F 10/00, C08F 4/64
Language of the proceedings: EN

Title of invention:

Addition polymerization catalysts comprising reduced oxidation state metal complexes

Patentee:

The Dow Chemical Company

Opponent:

ExxonMobil Chemical Patents Inc.

Headword:

-

Relevant legal provisions:

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

Keyword:

"Substantial procedural violation (yes)"
"Remittal to first instance"
"Reimbursement of the appeal fee"

Decisions cited:

G 0004/92, J 0020/85, T 0986/93

Catchword:

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Case Number: T 0117/02 - 3.3.03

D E C I S I O N
of the Technical Board of Appeal 3.3.03
of 7 November 2005

Appellant: ExxonMobil Chem. Pat. Inc.,
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Respondent: THE DOW CHEMICAL COMPANY
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Decision under appeal: Decision of the Opposition Division of the
European Patent Office dated 14 November 2001
and posted 28 November 2001 rejecting the
opposition filed against European patent
No. 632819 pursuant to Article 102(2) EPC.

Composition of the Board:

Chairman: R. Young
Members: W. Sieber
H. Preglau

Summary of Facts and Submissions

I. The mention of the grant of European patent No. 0 632 819, in respect of European patent application no. 93 907 617.0, based on International application PCT/US93/02584, filed on 19 March 1993 and claiming US priorities of 26 March 1992 (US 857886), 4 September 1992 (US 941014) and 21 January 1993 (US 8003), was published on 2 September 1998 (Bulletin 1998/36). The granted patent contained 22 claims, whereby Claim 1 read as follows:

"A composition useful as an addition polymerization catalyst comprising:

(i) a metal complex corresponding to the formula:
 $Cp_aZY)_bML_c$, wherein:

a is 1 or 2; b is 0 or 1; c is 1 or 2;

the sum of a, b and c is 3;

Cp independently at each occurrence is a cyclopentadienyl group π -bound to M, or a hydrocarbyl, silyl, halo, halohydrocarbyl, hydrocarbylmetalloid or halohydrocarbylmetalloid substituted derivative of said cyclopentadienyl group, said Cp containing up to 50 nonhydrogen atoms, and, when a is 2, optionally both Cp groups may be joined together by a bridging group;

L independently each occurrence is hydride, halo, or a monovalent anionic ligand selected from covalently bonded hydrocarbyl, silyl, amido, phosphido, alkoxy, aryloxy, and sulfido groups optionally being further substituted with amine, phosphine, ether, and thioether; mixtures thereof;

said ligand having up to 50 nonhydrogen atoms, with the proviso that in at least one occurrence L is a stabilizing ligand comprising an amine, phosphine, ether, or thioether functionality able to form a coordinate-covalent bond or chelating bond with M, or except when a is 2, comprising an ethylenic unsaturation able to form an η^3 bond with M;

M is a metal of Group 4 of the Periodic Table of the Elements in the +3 oxidation state;

when b is 1:

Y is a linking group comprising nitrogen, phosphorus, oxygen or sulfur covalently bonded to M and Z through said nitrogen, phosphorus, oxygen or sulfur atom;

Z is a divalent moiety comprising a member of Group 14 of the Periodic Table of the Elements having up to 30 nonhydrogen atoms;

Cp, Z and Y form a ligand moiety consisting of -Cp-Z-Y-; and

(ii) an activating cocatalyst but excluding activating cocatalysts that comprise an oxidizing agent capable of oxidizing the metal M, which activating cocatalyst is selected from the group consisting of aluminium alkyls, i.e. no alkylaluminium halides, alkylalumoxanes, and boron compounds of the formula R''_3B , wherein R'' independently each occurrence is selected from hydrogen, silyl, hydrocarbyl, halohydrocarbyl, alkoxide, aryloxy, amide, or combinations thereof, or R''_3B is triphenylboron, halogenated triphenylboron or fluoro

substituted triarylboron, said R"" having up to 30 nonhydrogen atoms."

The remaining claims are not of importance for this decision and consequently they will not be considered in further detail.

II. A notice of opposition was filed on 2 June 1999 by Exxon Chemical Patents Inc. (now ExxonMobil Chemical Patents Inc.) requesting revocation of the patent in its entirety on the grounds of Article 100(a) EPC (lack of novelty and lack of inventive step) and Article 100(b) EPC (lack of sufficiency of disclosure). *Inter alia*, the following document was cited:

D4: EP-A-0 495 375.

III. In the letter dated 14 September 2001, the opponent raised a further objection under Article 100(b) EPC, namely that the preferred activating cocatalyst tris-(pentafluorophenyl)boron was capable of oxidizing the metal M of the metal complex of subparagraph (i) of granted Claim 1, contrary to the requirement in subparagraph (ii) which excluded activating cocatalysts that comprised an oxidizing agent capable of oxidizing the metal M. To substantiate this argument, documents D9 and D10 were filed.

D9: *P. Brant et al.*, "In-situ X-Ray Absorption Spectroscopy of Olefin Polymerization Catalysts", Presentation at ACS Award Symposium. April 2001; and

D10: Statement of P. Brant, dated 14 September 2001.

Even if one accepted that a mixture of a complex of Ti^{3+} and this boron activator remained in the +3 oxidation state when kept in the solid form (as suggested by Figure 3 of the patent in suit), it was evident from D9 and D10 that the complex of Ti^{3+} was rapidly oxidized to +4 once the mixture was dissolved in toluene. Thus, the skilled person was confronted with a situation where the result of the oxidizing capacity of the activator depended on the conditions used. However, neither Claim 1 nor the patent specification defined the procedure or test with which it could unambiguously be determined whether or not a certain catalyst system was according to Claim 1. Thus, the skilled person would be unable to determine whether a cocatalyst fulfilled the requirements of Claim 1.

In the same letter, the opponent requested to introduce the new ground of opposition according to Article 100(c) EPC because, firstly, the amendment in subparagraph (i) of granted Claim 1 "**except when a = 2**" (Claim 1 as originally filed read "except when a = 1") contravened Article 123(2) EPC and, secondly, the wording in subparagraph (ii) "**but excluding activating cocatalysts that comprise an oxidizing agent capable of oxidizing the metal M**" represented a disclaimer over D4 which would only be allowable if the first and the second of the claimed priorities were valid so that D4 were a document to be considered under Article 54(3) EPC.

IV. At the oral proceedings held on 14 November 2001, the opposition division informed the parties that the new ground of opposition under Article 100(c) EPC and the late-filed arguments with respect to Article 100(b) EPC

(including D9 and D10) would not be introduced into the proceedings.

According to the minutes of the oral proceedings before the opposition division (cf point 1), "*[t]he Chairman opened the meeting and announced that the late filed arguments (letter dated 14.09.2001) form the Opponents regarding Art.100(c) and (b) EPC were disregarded under Art.114(1) and (2) since these were not prima facie relevant for the outcome of the decision*".

The reasons as to why the late filed ground of opposition under Article 100(c) EPC and the late filed arguments and evidence with respect to Article 100(b) EPC were *prima facie* not relevant were given in writing.

V. By a decision which was announced orally on 14 November 2001 and issued in writing on 28 November 2001, the opposition division rejected the opposition.

(a) According to point 1 of the decision, the late-filed ground of opposition according to Article 100(c) EPC and the late-filed objections under Article 100(b) EPC (including D9 and D10) were examined by the opposition division as required by Article 114(1) EPC but disregarded under Article 114(2) EPC, as they were found to be *prima facie* not relevant for the decision.

(i) As regards the expression "except when a = 2" in Claim 1, it was held that this amendment was not an amendment contrary to Article 123(2) EPC but a correction of an obvious error supported by the various

embodiments disclosed in the application as originally filed.

- (ii) The expression "but excluding activating cocatalysts that comprise an oxidizing agent capable of oxidizing the metal M" was not a disclaimer over D4 as a disclaimer over D4 must have been limited to an "oxidizing agent comprising a cationic oxidizer and a compatible noncoordinating anion A⁻". Moreover, the expression was a clarification in order to make clear that the cocatalyst should not oxidize the metal M to another oxidation state, which was implicitly supported by the general teaching of the application as originally filed.
 - (iii) Evidence (ie D9 and D10) showing that one of the explicitly listed cocatalysts in Claim 1 was able to oxidize the metal from the oxidation state +3 to +4 was irrelevant, as in that case the cocatalyst would not be part of the cocatalysts allowed by the definition of Claim 1. Whether or not a particular cocatalyst fell within the scope of Claim 1 or not was a question of clarity (Article 84 EPC).
- (b) The opposition division held that the claimed subject-matter met the requirements of Articles 83, 54 and 56 EPC.

VI. On 28 January 2002, the opponent (appellant) filed a notice of appeal against the above decision with simultaneous payment of the prescribed fee.

In the statement of grounds of appeal, filed on 28 March 2002, the opponent (appellant) raised objections with regard to Article 100(c), Article 100(b) and Article 100(a)/Article 56 EPC. The arguments may be summarized as follows:

- (a) With respect to Article 100(c) EPC, the opponent (appellant) argued that it had not been allowed to present arguments in support of the objection raised under Article 100(c)/Article 123(2) EPC. Instead, the decision that this ground was not considered to be relevant had been announced directly after the opening of the oral proceedings before the opposition division. This contravened the provisions of Article 113(1) EPC.
- (b) The opponent (appellant) maintained its objections that the feature in subparagraph (i) of granted Claim 1 "except when a = 2" and the expression (disclaimer) in subparagraph (ii) "but excluding activating cocatalysts that comprise an oxidizing agent capable of oxidizing the metal M" contravened Article 123(2) EPC and prejudiced the maintenance of the patent as granted.
- (c) The objections raised in view of Articles 83 and 56 EPC are not of importance for this decision and consequently they will not be considered in further detail.

VII. With letters dated 19 August 2002 and 7 October 2005, the proprietor (respondent) submitted that the ground of opposition according to Article 100(c) was not mentioned in the notice of opposition and Article 114(2) EPC provided that the European Patent Office might disregard facts or evidence which were not submitted in due time by the parties concerned. Since the fresh ground of opposition was not *prima facie* relevant, the opposition division was correct in disregarding the argument made. The opposition division even did more and gave, despite the fact that it found the fresh argument *prima facie* not relevant, motivated reasons as to why the objections under Article 123(2) EPC would fail. Furthermore, the opposition division had correctly dealt with the matter of Article 123(2) EPC, for which reason the proprietor (respondent) requested the board to confirm the position of the opposition division on these points. On the other hand, it was of the opinion (letter dated 7 October 2005, page 1, last paragraph) that objections with regard to Article 100(c) EPC should not be part of the proceedings.

As regards the arguments relating to Articles 83 and 56 EPC, they are not of importance for this decision and consequently they will not be considered in further detail.

VIII. In a communication, issued on 14 October 2005, the board expressed its preliminary opinion that the course of action of the opposition division constituted a procedural violation (Article 113(1) EPC) which could result in the remittal of the case to the first instance.

The parties were also asked to clarify and/or formulate their requests with regard to the alleged procedural violation and with regard to the introduction to the new ground of opposition according to Article 100(c) EPC.

IX. In the letter dated 19 October 2005, the opponent (appellant) requested that the ground of opposition according to Article 100(c) EPC be introduced into the appeal proceedings, or, if the proprietor (respondent) would not agree to the introduction of the fresh ground of opposition, the case be remitted to the first instance to give the parties an opportunity to be heard on the objections under Article 100(c)/Article 123(2) EPC.

X. In the letter dated 25 October 2005, the proprietor (appellant) did not give its consent to introduce Article 100(c) EPC *de novo*.

XI. On 7 November 2005, oral proceedings were held before the board where the discussion focussed on the procedural violation that allegedly occurred at the oral proceedings before the opposition division. In this context, it was pointed out by the board that the procedural violation equally applied to the late-filed arguments with regard to Article 100(b) EPC (including D9 and D10).

The proprietor (respondent) did not dispute the course of action as set out in point 1 of the minutes of the oral proceedings before the opposition division. However, the opposition division was right in disregarding the fresh ground of opposition since it

was not *prima facie* relevant. The opponent should have provided the arguments with respect to the relevance of the fresh ground of opposition already in the letter where the fresh ground of opposition was mentioned for the first time.

The opponent (appellant) was of the opinion that the opposition division should have given it at least the opportunity at the oral proceedings to provide arguments as to why the late-filed submissions were *prima facie* relevant.

XII. The opponent (appellant) requested that the decision under appeal be set aside and the patent be revoked in its entirety.

The proprietor (respondent) requested that the appeal be dismissed.

Reasons for the Decision

1. The appeal complies with Articles 106 and 108 EPC and Rule 64 EPC and is therefore admissible.

2. *Article 113(1) EPC*

2.1 According to Article 113(1) EPC, "[t]he decisions of 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".

This provision is one of the most important guarantors for the parties to proceedings that proceedings before

the EPO will be conducted openly and fairly; it is of fundamental importance for ensuring a fair procedure between the EPO and parties conducting proceedings before it (G 4/92, OJ EPO 1994, 149; J 20/85, OJ EPO 1987, 102).

- 2.2 In the present case, the minutes of the oral proceedings before the opposition division do not contain an indication that the parties were heard on any formal or substantive aspect with regard to the late-filed ground of opposition according to Article 100(c) EPC or the late filed arguments and evidence according to Article 100(b) EPC. It is indeed apparent from point 1 of the minutes of the oral proceedings before the opposition division (point IV, above) that the opposition division announced its decision to disregard the late-filed ground of opposition and the late filed arguments and evidence according to Article 100(b) EPC immediately after opening the oral proceedings, ie without having heard the parties at all.

The proprietor (respondent) did not dispute that the parties had not been heard before the opposition division announced its decision.

- 2.3 Hence, the board is convinced that this course of action of the opposition division constitutes a substantial procedural violation (Article 113(1) EPC). In the board's view, the right to be heard should also be granted in case of a request to introduce late-filed submissions (here a new ground of opposition and new arguments and evidence) before the late-filed submissions are rejected.

The argument of the proprietor (respondent) that the opponent's reason as to why the late-filed submissions are relevant should have been in the letter where the new issues had been raised for the first time is not convincing, since parties may present their comments not only in writing but also orally during oral proceedings (Article 116(1) EPC).

- 2.4 Furthermore, it appears that the procedure of the opposition division violates Article 113(1) EPC also on a second level. Apart from giving the opponent no opportunity to present its case with respect to the request to introduce the late-filed submissions, the parties were not heard on the reasons as to why the late-filed submissions were not *prima facie* relevant. These reasons were the motive for the opposition division not to take the late-filed submissions into consideration.

For example, the reasoning that the expression "but excluding activating cocatalysts that comprise an oxidizing agent capable of oxidizing the metal M" in granted Claim 1 is not a disclaimer over D4 but a clarification based on the application as originally filed (point V(a)(ii), above) appears for the first time in the decision under appeal. The same applies to the reasoning with respect to the amendment "a = 2" (point V(a)(i), above) and the late-filed arguments and evidence according to Article 100(b) EPC (point V(a)(iii), above).

These reasons are neither derivable from the written submissions of the parties nor is there any indication

that they were presented at the oral proceedings by the opposition division. Accordingly, the decision under appeal is based on grounds and evidence on which the opponent (appellant) has not had an opportunity to present its comments, contrary to the requirements of Article 113(1) EPC.

- 2.5 It should be added at this juncture, that not hearing the parties with respect to the late-filed submissions may have led to a wrong discretionary decision of the opposition division pursuant to Article 114(2) EPC.

As pointed out in the decision under appeal, the expression "but excluding activating cocatalysts that comprise an oxidizing agent capable of oxidizing the metal M" in granted Claim 1 is neither a disclaimer over D4 nor explicitly disclosed in the application as originally filed. In fact, the only information a skilled person can derive from the application as originally filed is that the cocatalyst is not capable of changing the oxidation state of the metal in the complexes defined in subparagraph (ii) of Claim 1 (eg page 4, line 36 to page 5, line 1 of the application as filed). This information relates to the nature of the cocatalyst itself and is certainly not equivalent to the wording in granted Claim 1 that the cocatalyst does not comprise an oxidizing agent. Thus, on the face of the documents, ie D4 and the application as originally filed, it appears that the late-filed ground of opposition according to Article 100(b) EPC is **highly relevant** and the opposition division erred in deciding to disregard, under Article 114(2) EPC, this ground of opposition.

In this context, D9 and D10 appear also *prima facie* relevant. If it is true, as alleged by the opponent (appellant), that one of the boron cocatalysts of the formula R''_3B , namely tris(pentafluorophenyl)boron, is capable of oxidizing the metal M of the metal complex, then the "clarification" would exclude tris(pentafluorophenyl)boron from Claim 1 although this cocatalyst is disclosed as a preferred embodiment in the application as originally filed (eg page 11, lines 20-21 of the application as originally filed). In other words, the "clarification" would add information which was not present in the application as originally filed.

3. *Article 111(1) EPC*

3.1 The board is aware of decision T 986/93 (OJ EPO, 1996, 215) where it was held that a board of appeal is not barred from considering a belatedly submitted ground of opposition which had been disregarded by the opposition division pursuant to Article 114(2) EPC without the approval of the patentee if the board is of the opinion that the opposition division exercised its discretion in this respect wrongly (see points 2.1 to 2.5 of the reasons).

3.2 However, in view of the substantial procedural violations which have occurred in the present case, the board makes use of its power under Article 111(1) EPC to remit the case for further prosecution, especially as it sees no special reasons for doing otherwise (Article 10 of the Rules of Procedure of the Boards of Appeal). Nor were such special reasons brought forward by the parties.

4. Under these circumstances and since the appeal is successful to the extent that the decision under appeal is to be set aside, the board considers it equitable to reimburse the appeal fee (Rule 67 EPC).

Order

For these reasons it is decided that:

1. The decision under appeal is set aside.
2. The case is remitted to the first instance for further prosecution.
3. Reimbursement of the appeal fee is ordered.

The Registrar:

The Chairman:

E. Görgmaier

R. Young