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**Datasheet for the decision
of 29 April 2014**

Case Number: T 0936/12 - 3.3.03

Application Number: 03809744.0

Publication Number: 1558651

IPC: C08F6/00, C08F6/28, C08L23/00

Language of the proceedings: EN

Title of invention:
POLYMER TREATMENT

Patent Proprietor:
INEOS Manufacturing Belgium NV

Opponents:
SABIC Petrochemicals B.V.
Zeppelin Systems GmbH
BASF SE

Headword:

Relevant legal provisions:
EPC R. 99(2), 101(1)
EPC Art. 108
RPBA Art. 12(4), 13(1)

Keyword:

Admissibility of appeal - form of appeal

Late-filed request -

request could have been filed in first instance proceedings (yes)

Late-filed request -

request not examined by the opposition division (yes)

Late-filed request - request clearly allowable (no)

Decisions cited:

G 0008/91, G 0009/91, G 0010/91, G 0001/99, J 0022/86,

J 0010/11, T 0162/97, T 0717/01, T 1705/07, T 0356/08,

T 1067/08, T 0936/09, T 2193/09

Catchword:



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Case Number: T 0936/12 - 3.3.03

D E C I S I O N
of Technical Board of Appeal 3.3.03
of 29 April 2014

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Representative:

Decision under appeal: **Decision of the Opposition Division of the
European Patent Office posted on 14 February
2012 revoking European patent No. 1558651
pursuant to Article 101(3) (b) EPC.**

Composition of the Board:

Chairman B. ter Laan
Members: O. Dury
 R. Cramer

Summary of Facts and Submissions

I. The appeal by the patent proprietor lies against the decision of the opposition division posted on 14 February 2012 revoking European patent No. 1 558 651, based on application No. 03 809 744.0, corresponding to the international application PCT/EP2003/012041 published as WO 2004/039848.

II. The application as filed contained 14 claims, of which claims 1, 3, 4, 8, 9, 13 and 14 read as follows:

"1. A process for the separation of volatile material from particulate polymer which has been substantially freed from unreacted monomer in an earlier separation step, comprising

(a) feeding the particulate polymer to a purge vessel and causing it to move through the vessel in substantially plug-flow mode,

(b) heating the particulate polymer in the purge vessel to a temperature greater than 30°C but insufficiently high to cause the particles to become agglomerated, and/or maintaining the polymer at a temperature in this range in the purge vessel,

(c) feeding gas to the purge vessel to remove volatile material therefrom, removing the particulate polymer from the purge vessel,

wherein substantially all of the heating of the particles which occurs in the purge vessel is accomplished by preheating the gas fed into the purge vessel."

"3. Process according to claim 1 or 2, wherein at least a portion of the gas fed to the purge vessel enters the vessel at one or more points located closer to the top of the vessel than to the bottom."

"4. Process according to claim 3 wherein at least 80% of the total gas flow entering the vessel does so at said one or more points located closer to the top of the vessel."

"8. Process according to any preceding claim wherein part of the gas entering the purge vessel is discharged directly into the middle of the vessel at the same level as the point of entry of the gas entering at one or more points located closer to the top of the vessel."

"9. Process according to claim 8, wherein the mass flow of gas discharged directly into the middle of the vessel is 20-40% of that discharged into the side of the vessel at the same level."

"13. Process according to any preceding claim, wherein at least a portion of the gas fed to the purge vessel is at least partially preheated using heat from the particulate polymer."

"14. Process according to claim 13, wherein said portion of the gas fed to the purge vessel is preheated by passing it through the purge vessel prior to contacting it with the particulate polymer."

III. The granted patent was based on 13 claims, claim 1 reading as follows (addition as compared to original claim 1 in **bold**):

"1. A process for the separation of volatile material from particulate polymer which has been substantially freed from unreacted monomer in an earlier separation step, comprising

(a) feeding the particulate polymer to a purge vessel and causing it to move through the vessel in substantially plug-flow mode,
(b) heating the particulate polymer in the purge vessel to a temperature greater than 30°C but insufficiently high to cause the particles to become agglomerated, and/or maintaining the polymer at a temperature in this range in the purge vessel,
(c) feeding gas to the purge vessel to remove volatile material therefrom, removing the particulate polymer from the purge vessel,
wherein substantially all of the heating of the particles which occurs in the purge vessel is accomplished by preheating the gas fed into the purge vessel, **and at least a portion of the gas fed to the purge vessel enters the vessel at one or more points located closer to the top of the vessel than to the bottom.**"

- IV. Three oppositions against the patent were filed, in which it was requested that the patent be revoked on the grounds pursuant to Art. 100(a) EPC (both novelty and inventive step).
- V. The contested decision was based on a main request and eleven auxiliary requests submitted by letter of 13 January 2012, which were held not to satisfy the requirements of Art. 123(2) EPC and Art. 123(3) EPC, in particular because
- claim 1 of each of the main request and auxiliary requests I to V contained the feature "using an inert gas" (Art. 123(2) EPC);
 - claim 1 of each of the main request and auxiliary requests I to XI contained the feature "in a first separation step using an inert gas" (Art. 123(2) EPC);

- the expression "a process for the separation of volatile material from particulate polymer which has been substantially freed from unreacted monomer in an earlier separation step" according to granted claim 1 had been modified in claim 1 of each of the main request and auxiliary requests I to XI to "a process for the separation of volatile material from particulate polymer, comprising substantially freeing the particulate polymer from unreacted monomer in a first separation step" (Art. 123(3) EPC).

At the end of the oral proceedings held on 24 January 2012, the opposition division did not allow the patent proprietor to file an additional "new main request based on granted claims" (see section 23 of the reasons of the contested decision and the last three paragraphs on page 3 of the minutes of the oral proceedings).

- VI. On 20 April 2012, the patent proprietor (appellant) lodged an appeal against the above decision. The prescribed fee was paid on the same day. In the statement of grounds of appeal filed on 25 June 2012, the appellant requested that the decision be set aside and that the patent be maintained in amended form according to either the main request or any of auxiliary requests 1-5, all filed therewith.

Claim 1 of the main request read as follows (additions as compared to claim 1 as filed are indicated in **bold**):

"1. A process for the separation of volatile material from particulate polymer which has been substantially freed from unreacted monomer in an earlier separation step, comprising

(a) feeding the particulate polymer to a purge vessel and causing it to move through the vessel in substantially plug-flow mode,
(b) heating the particulate polymer in the purge vessel to a temperature greater than 30°C but insufficiently high to cause the particles to become agglomerated, and/or maintaining the polymer at a temperature in this range in the purge vessel,
(c) feeding gas to the purge vessel to remove volatile material therefrom, removing the particulate polymer from the purge vessel,
wherein substantially all of the heating of the particles which occurs in the purge vessel is accomplished by preheating the gas fed into the purge vessel, **the rate of flow of gas through the particulate polymer is at least 80 litres per hour per square centimetre of cross section measured radially across the direction of flow of particulate polymer through the purge vessel, and at least 80% of the total gas flow entering the vessel does so at said one or more points located closer to the top of the vessel than to the bottom.**"

Claim 1 of each of auxiliary requests 1-5 were based on claim 1 of the main request, further amended by additional features.

VII. Replies to the statement of grounds of appeal were filed by letters of 7 January 2013 (respondent I), 30 October 2012 and 21 October 2013 (respondent II) and 8 January 2013 (respondent III).

In its letter of 21 October 2013, respondent II in particular argued that the appeal was to be held inadmissible and further requested an apportionment of

costs.

- VIII. On 20 December 2013 the Board issued a summons to oral proceedings. In a communication dated 7 January 2014 the Board set out its preliminary view of the case. Among other things, the issues of the admissibility of the appeal and the admissibility of the appellant's pending requests were addressed.
- IX. By letter dated 17 March 2014 the appellant filed a main request and an auxiliary request in replacement of all previous requests.

Claim 1 of the main request reads as follows (addition as compared to claim 1 as filed are indicated in **bold**):

"1. A process for the separation of volatile material from particulate polymer which has been substantially freed from unreacted monomer in an earlier separation step, comprising

- (a) feeding the particulate polymer to a purge vessel and causing it to move through the vessel in substantially plug-flow mode,
- (b) heating the particulate polymer in the purge vessel to a temperature greater than 30°C but insufficiently high to cause the particles to become agglomerated, and/or maintaining the polymer at a temperature in this range in the purge vessel,
- (c) feeding gas to the purge vessel to remove volatile material therefrom, removing the particulate polymer from the purge vessel,

wherein substantially all of the heating of the particles which occurs in the purge vessel is accomplished by preheating the gas fed into the purge vessel **and at least a portion of the gas fed to the purge vessel is at least partially preheated using heat**

from the particulate polymer, and at least 80% of the total gas flow entering the vessel does so at said one or more points located closer to the top of the vessel than to the bottom."

Claim 2 corresponds to original claim 2, claims 3 to 10 to original claims 5 to 12 and claim 11 to original claim 14.

Claim 1 of the auxiliary request is based on claim 1 of the main request further amended by additional features with claims 2 to 9 corresponding to original claims 2, 6, 7, 10-12 and 14, respectively.

- X. Respondent I submitted further arguments by letter of 10 March 2014.

- XI. In a second communication issued by the Board on 14 April 2014, the parties were informed that in appeal case T 373/12 of 2 April 2014 (European application 05851833.3) a referral to the Enlarged Board of Appeal had been made that could be relevant for the present case.

- XII. Rejoinders to that second communication were filed by letter of 22 April 2014 (respondent II) and 26 April 2014 (respondent I).

- XIII. During the oral proceedings held on 29 April 2014 in the presence of all parties, respondent II withdrew its request for an apportionment of costs.

- XIV. The appellant's arguments relevant for the present decision may be summarised as follows:

Admissibility of the appeal

- a) The features that the department of first instance had held not to satisfy the requirements of Art 123(2) and 123(3) EPC had been removed from all requests filed on appeal, thus depriving the contested decision of its basis. Novelty and inventive step of the new requests had been discussed in the statement of grounds of appeal and a reasoning had also been provided to explain why the reading of the claims followed by the opposition division, in particular the preamble of claim 1, was wrong. Under these circumstances, the appeal was admissible.

Admissibility of the requests

- b) The feature "at least a portion of the gas fed to the purge vessel is at least partially preheated using heat from the particulate polymer" specified in claim 1 was already present in the fifth auxiliary request filed with the statement of grounds of appeal and also in the fifth auxiliary request presented at the oral proceedings before the opposition division.
- c) The feature specifying that at least 80% of gas flow entered nearer the top of the vessel had been present in at least the second to fifth auxiliary requests on which the contested decision was based. Said feature being part of granted claim 3 in the same context, in opposition appeal proceedings it was not open for an objection of lack of clarity.

- d) The feature that the rate of flow of gas through the particulate polymer should be at least 80 liters per hour, which was present in the requests filed with the statement of grounds of appeal, had been deleted in order to reply to the objections raised by the respondents and the Board. The operative main and auxiliary requests additionally differed from the requests filed with the statement of grounds of appeal in the addition of the features of granted claim 12. The operative main and auxiliary request not only aimed at removing the objections pursuant Art. 123(2) and 123(3) EPC on which the contested decision was based but also aimed at simplifying the issues to be dealt with in the current proceedings. Considering that, should those provisions of the EPC be satisfied, the file would have to be remitted to the first instance for further prosecution, the admission of those requests would not unduly prolong the proceedings.
- e) A fundamental aspect of the first-instance proceedings was that, according to the opposition division, the feature that the polymer had been pretreated to remove unreacted monomer was not part of the process defined in granted claim 1, with the consequence that only the steps defining the post-treatment were to be taken into account in respect of novelty. Although the appellant disagreed with that reading, attempts had been made to amend the granted claims in such a manner that it was clear that the pretreatment formed part of the claimed process. In that respect, the 19 requests filed during the first-instance proceedings amounted to three sets of claims only differing in one aspect. On appeal, the appellant

continued to contest the reading of the claims applied by the opposition division and gave the reasons for its view in the statement of grounds of appeal. The requests filed together with the statement of grounds of appeal were therefore mostly based on granted claims or on claims as originally filed, with the addition of a subsidiary feature concerning the rate of flow of gas.

Further requests had been filed at a later stage in order to take into account of the objections raised by the respondents in their reply to the statement of grounds of appeal as well as the issues identified in the first communication of the Board. In addition, the conclusions drawn in the closely related case T 935/12, which had been dealt with by the present Board in a different composition, in particular regarding the clarity of the parameter concerning the "rate of flow of gas" specified in the requests filed with the statement of grounds of appeal, had also been taken into account.

- f) The contested decision only dealt with the issues of Art. 123(2) and 123(3) EPC. The present appeal therefore should focus on those issues. Questions concerning other stipulations of the EPC, e.g. novelty or inventive step were irrelevant in respect of the admissibility of the operative requests.

- g) The subject-matter of claim 1 of the main request *prima facie* satisfied the requirements of Art. 123(2) and 123(3) EPC because it amounted to the simple combination of original claims or of

granted claims, respectively.

- h) Considering that the subject-matter now being claimed was based on granted claims, it could not be objected to for lack of clarity.

In addition, although the term "said" was not necessary in the expression "does so at said one or more points" present in claim 1 of each of the operative requests, it did not render the claims unclear.

- i) For those reasons, the requirements of Art. 12(4) RPBA were met and the operative requests should be admitted to the proceedings.

XV. The respondents' arguments relevant for the present decision may be summarised as follows:

Admissibility of the appeal

- a) According to respondent II, the appellant had not explained in the statement of grounds of appeal why the contested decision was wrong. Furthermore, by filing requests that did not contain the features objected to by the department of first instance under Art. 123(2) and 123(3) EPC, they indirectly admitted that the decision of the opposition division was correct, which was contrary to the findings of decisions G 1/99 (OJ EPO 2001, 381), G 8/91 (OJ EPO 1993, 346), G 9/91 (OJ EPO 1993, 408) and G 10/91 (OJ EPO 1993, 420), according to which the purpose of the appeal proceedings was mainly to give the losing party the possibility of challenging the decision of the opposition division on its merits. Consequently,

the requirements of Art. 108 EPC together with Rule 99(2) EPC were not met and the appeal was to be held inadmissible. Reference was further made to decisions J 22/86 (OJ EPO 1987, 280), T 162/97 of 30 June 1999 and T 2193/09 of 13 July 2010.

- b) Since the main request and the auxiliary requests filed with the statement of grounds of appeal should not be admitted to the proceedings under Art. 12(4) RPBA, the appeal had been filed with no admissible requests and was inadmissible.

Admissibility of the requests

- c) The appellant had not justified why the requests filed either with the statement of grounds of appeal or with letter of 17 March 2014 had not been presented before the opposition division.
- d) The operative main and auxiliary request should not be admitted to the proceedings because
- they had not been presented in the first instance proceedings;
 - they were not convergent with any of the requests previously on file;
 - they caused new objections e.g. in respect of added matter and/or clarity, which had never been dealt with before;
 - they raised new issues that went beyond the scope of the discussion as determined by the contested decision and/or the statement of grounds of appeal.
- e) The operative requests were not clearly allowable, e.g. for the following reasons:

Regarding Art. 123(2) EPC, the subject-matter now being claimed was not directly and unambiguously disclosed in the application as filed. In particular, the combination of original claims 1, 3, 4 and 13 was not suggested. In addition the expression "at least a portion of the gas fed to the purge vessel enters the vessel at one or more points..." had been replaced by "at least 80% of the total gas flow entering the vessel does so at said one or more points...", which had a different meaning.

Concerning clarity, objections could be raised against claim 1 of the main request because it did not amount to the mere combination of granted claims 3 and 12. In that respect, the following issues arose:

- the subject-matter now being claimed was not supported by the description;
- in the absence of any antecedent for the "at said one or more points", the claimed subject-matter was not clear. Although that deficiency had been raised in the reply to the statement of grounds of appeal and in the first communication of the Board, it had not been removed from the operative requests;
- it was not clear whether the feature "80 % of the total gas flow" referred to mass or volume;
- the process now being defined in operative claim 1 of the main request comprised simultaneously heating the gas with the particles and heating the particles with the gas, which was self-contradictory and did not make any technical sense;

- the meaning of the term "total gas flow" was unclear, in particular in the light of Fig. 2 of the patent in suit;
- it was not clear whether or not the expressions "fed to the purge vessel" mentioned in granted claim 1 and "entering the vessel" according to claim 1 of the operative main request had the same meaning, in particular considering that gas was likely to enter the purge vessel together with the polymer particles.

f) The appellant should not be allowed to put forward a "fresh case" on appeal and shift at will the proceedings from the first to the second instance, as the appellant had done in the present case. The opposition division had had no opportunity to decide on the requests now pending. Reference was made to decisions T 1705/07 of 10 June 2010, T 356/08 of 7 July 2009, T 1067/08 of 10 February 2011 and T 936/09 of 1 March 2012.

g) For those reasons, the operative main and auxiliary request should not be admitted to the proceedings.

XVI. The appellant (patent proprietor) requested that the decision under appeal be set aside and the patent be maintained in amended form according to either the main request or the auxiliary request, both requests filed with letter dated 17 March 2014.

Respondents I and III (opponents 1 and 3) requested that the appeal be dismissed.

Respondent II (opponent 2) requested that the appeal be

declared inadmissible, and in the event that the appeal be declared admissible, that it be dismissed.

XVII. The Board announced its decision at the end of the oral proceedings.

Reasons for the Decision

1. Admissibility of the appeal

1.1 According to Rule 101(1) EPC an appeal is to be held inadmissible if it does not satisfy the provisions of *inter alia* Art. 108 and Rule 99(2) EPC.

Art. 108, third sentence, EPC reads: "Within four months of notification of the decision, a statement setting out the grounds of appeal shall be filed in accordance with the Implementing Regulations." According to Rule 99(2) EPC, "In the statement of grounds of appeal the appellant shall indicate the reasons for setting aside the decision impugned, or the extent to which it is to be amended, and the facts and evidence on which the appeal is based."

Regarding the requirements to be met by the statement of grounds of appeal, Art. 12(2) RPBA, although it is not directly related to the (in)admissibility of the appeal, further requires that the statement of grounds of appeal "shall set out clearly and concisely the reasons why it is requested that the decision under appeal be reversed, amended or upheld, and should

specify expressly all the facts, arguments and evidence relied on".

1.2 In the present case, in each of the requests filed with the statement of grounds of appeal the appellant had deleted the feature that had been considered to be incompatible with the requirements of Art. 123(2) and 123(3) EPC by the opposition division.

1.3 According to consistent case law (Case Law of the Boards of Appeal of the EPO, 7th Edition, 2013, IV.E. 2.6.3), in order to comply with Art. 108 EPC,

(a) the written statement setting out grounds of appeal should set out fully the reasons why the appeal should be allowed and the decision under appeal should be set aside. In that respect, the statement setting out the grounds of appeal must enable the Board to understand immediately why the decision is alleged to be incorrect and on what facts the appellant bases its arguments;

(b) exceptionally, where the written statement does not contain such full reasons, the requirement for admissibility may be regarded as satisfied if it is immediately apparent upon reading the decision under appeal and the written statement of grounds that the decision should be set aside (see e.g. J 22/86, OJ EPO 1987, 280: Headnote I and last paragraph of section 2 of the reasons; J 10/11 of 3 December 2012: section 2.1 of the reasons).

1.4 The main and five auxiliary requests filed with the statement of grounds of appeal did not contain the features objected to in the appealed decision. Therefore, it is immediately apparent that the basis

for that decision no longer exists. Hence, the present case corresponds to option (b) indicated above. Also, the filing of new requests without the features that had been objected to implicitly constitutes the reason why the appellant is of the opinion that the impugned decision should be set aside.

1.5 Apart from the new requests the appellant also submitted reasons justifying the patentability of those sets of claims, also in respect of novelty and inventive step. Therefore, the appellant's requests can be considered as a *bona fide* attempt not only to remove the objections on which the contested decision was based but also to explain why the new claims complied with the requirements of the EPC.

1.6 Respondent II argued that in order to be admissible an appeal had to deal with the reasons given in the contested decision.

1.6.1 However, respondent II neither identified any provisions of the EPC supporting that argument nor did he show that any of the provisions of the EPC forbade the submission by the patent proprietor/appellant - in particular together with the statement of grounds of appeal - of new requests depriving the contested decision of its basis, even if in doing so he indirectly agreed with the findings of the department of first instance. Such practice is in agreement with consistent case law (Case Law of the Boards of Appeal of the EPO, 7th Edition, 2013, IV E.2.6.5.b) which justifies the expectation of the appellant that his appeal would be held admissible.

1.6.2 The argument of respondent II relating to decisions G 8/91, G 9/91, G 10/91 and G 1/99, relies upon a

sentence according to which "The purpose of the appeal procedure inter partes is mainly to give the losing party the possibility of challenging the decision of the Opposition Division on its merits" (see e.g. G 9/91: Reasons, section 18). In that respect, the use of the term "mainly" already indicates that it cannot be derived from that sentence that the *only* purpose of the appeal is to challenge the contested decision. Furthermore, that passage of G 9/91 deals with the introduction of fresh grounds of opposition in appeal and is not directly related to the issue at stake in the present case. Therefore, the argument of respondent II cannot be followed.

- 1.7 Respondent II also argued that the appeal was inadmissible because all the requests filed with the statement of grounds of appeal should not be admitted to the proceedings pursuant to Art. 12(4) RPBA. However, the admissibility of an appeal should not be confused with the strength of an appellant's case. The requests filed with the statement of grounds of appeal serve to define the legal and factual framework of the appeal. The very filing of such requests is in the present case sufficient to render the appeal admissible, even if those requests are at a later stage not admitted to the proceedings or refused for not being allowable.

- 1.8 In decision T 2193/09, cited by respondent II, the examining division had not accepted the submission of new requests according to Rule 137(3) EPC. The applicant had lodged an appeal and had submitted the same requests without explaining why he considered the examining division wrong in refusing their submission. The Board decided that the appeal was not motivated and therefore inadmissible. Decision T 2193/09 thus deals

with a different factual situation than the present case.

1.9 In decisions J 22/86 and T 162/97, also relied upon by respondent II, it was held that the admissibility of the appeal should be evaluated on the basis of the statement of grounds of appeal and the content of the appealed decision. The present decision does not depart from those findings.

1.10 For those reasons, the requirements of Art. 108 EPC, Rule 99(2) EPC and Art. 12(2) RPBA are satisfied and the appeal is admissible.

2. Admissibility of the requests

2.1 Considering that the main purpose of the appeal proceedings is to give the losing party the possibility of challenging the decision of the opposition division on its merits, the appeal proceedings are largely determined by the factual and legal framework of the case of the preceding opposition proceedings; the parties have only limited scope to amend the subject of the dispute in second-instance proceedings (see Case Law of the Boards of Appeal of the EPO, 7th edition, 2013, IV.E.4.1.2 to 4.1.4). Although the filing of new submissions by a party is not precluded in appeal proceedings, a party is not entitled to have a request that could have been filed in first-instance proceedings admitted in the appeal proceedings. The submission of late-filed requests is subject to the Board's discretion. These principles are reflected in the provisions of Art. 12(4) and 13(1) RPBA.

It follows from the above that the admissibility of the operative main and auxiliary request filed with letter

of 17 March 2014 has to be assessed.

2.2 As explained by the appellant during the oral proceedings before the Board, the key aspect of the first instance proceedings resided in the reading of granted claim 1, in particular its preamble "which has been substantially freed from unreacted monomer in an earlier separation step", applied by the opposition division. In that respect, the opposition division had communicated its position to the parties in its preliminary opinion dated 20 December 2010 sent together with the summons to the oral proceedings and had kept the same line of argumentation throughout the proceedings. Together with its rejoinder to that communication, the appellant filed amended requests taking into account the preliminary opinion of the opposition division, as may be derived from its letter dated 24 November 2011 (see page 1 and the first paragraph of the section "Novelty"). Those requests were then replaced by the ones filed with letter of 13 January 2012 in order to take account of the respondents' submissions in respect of the allowability of the amendments pursuant Art. 123(2) EPC. Although those issues had therefore already been known to the appellant it is only at the very end of the oral proceedings before the opposition division held on 24 January 2012, that the appellant contemplated submitting a request based on granted claims, which request was not admitted to the proceedings by the opposition division in the exercise of its discretion.

On entry into the appeal phase, the appellant decided not to pursue the requests presented before the opposition division but instead submitted five new requests based on sets of claims that all contained a feature relating to the "rate of flow of gas", which

had been taken from the description of the patent specification. In that respect, the appellant should have been aware that it would have to be assessed whether or not the claims so amended fulfilled the requirements of the EPC, also in respect of Art. 84 EPC. By doing so, the appellant refrained from the opportunity to file requests based on granted claims, as contemplated during the oral proceedings before the opposition division. No justification why claims based on granted claims had not been filed with the statement of grounds of appeal was provided by the appellant, in particular during the oral proceedings before the Board.

The appellant argued that the operative main and auxiliary request were filed in reply to the first communication of the Board. However, the issues identified in said communication had not been raised *ex officio* but had already been objected to by the respondents in their reply to the statement of grounds of appeal. Therefore, that argument cannot be accepted.

Under these circumstances, it is concluded that there was no good reason that would have prevented the appellant from filing the operative requests either in the first instance proceedings or together with the statement of grounds of appeal or, at the very latest, in reply to the respondents' rejoinders to the statement of grounds of appeal.

- 2.3 Apart from their late filing, the operative requests also raise complex issues in respect of their allowability. Should the operative main and auxiliary request be admitted, new issues concerning e.g. added subject-matter and clarity would have to be discussed for the first time in the appeal proceedings.

2.3.1 Regarding added subject-matter, claim 1 of the main request corresponds to the combination of claims 1, 3, 4 and 13 as originally filed. The allowability under Art. 123(2) EPC of the subject-matter so defined was not addressed in the opposition proceedings and was objected to by the respondents, in particular because it would amount to a new combination of technical features that was not directly and unambiguously disclosed as such in the application as filed. In that respect, it is in particular noted that none of the examples of the patent in suit illustrates the subject-matter now being claimed. Also the combination of the features that "at least 80% of the total gas flow entering the vessel does so at said one or more points located closer to the top of the vessel than to the bottom" and that "at least a portion of the gas fed to the purge vessel is at least partially preheated using heat from the particulate polymer", was not explicitly disclosed in the application as filed and can only be arrived at after specifically combining original claims 4 (which refers to claim 3, which again refers to claim 1 or 2) and 13.

In addition, although no objection had been raised by the respondents in respect of the claims depending on said claim 1, the question would also arise whether or not the subject-matter defined in those dependent claims is directly and unambiguously derivable from the application as filed. For instance claims 6, 7 and 11 of the main request are directed to very specific technical features and it is questionable that the application as filed provides a direct and unambiguous support for the combination of those with the added features of claim 1.

2.3.2 Regarding clarity, the following issues would *inter alia* have to be dealt with:

- (a) the feature now specified in claim 1 concerning 80 % of the total gas flow does not specify if it is related to mass or volume, both of which make technical sense but may be significantly different, in particular in a purge vessel in which the pressure may vary. Although that (possible) clarity problem was present in granted claim 3, it is highlighted by the incorporation of that dependent claim in independent claim 1. Similar considerations apply in respect of the feature related to the preheating using heat from the particulate polymer, which formed part of granted claim 12 in the same context, but which also may lead to a lack of clarity of the subject-matter now being claimed: as argued by the respondents, the question arises how a process in which gas is used to heat the polymer particles and the polymer particles are at the same time used to heat the gas is to be understood. That possible lack of clarity of dependent claim 12 as granted is also highlighted by its insertion in independent claim 1. In respect of those issues, it would further have to be assessed whether or not the referral to the Enlarged Board of Appeal in appeal case T 373/12 of 2 April 2014 (European application 05851833.3) and related to the examination of clarity of amended claims following the insertion of (elements of) dependent claims as granted into an independent claim would be relevant for the present case;
- (b) it is questionable whether or not the subject-matter now being claimed is supported by the

description as stipulated in Art. 84 EPC;

(c) in the absence of any antecedent for the "said one or more points" (last two lines of claim 1), it is questionable whether or not the subject-matter of claim 1 satisfies the requirements of Art. 84 EPC. Although that issue had been identified in the first communication of the Board, nothing has been done by the appellant to address that deficiency.

2.3.3 The same considerations apply to the auxiliary request which contains the same passages.

2.3.4 For these reasons, the operative main and auxiliary request are not clearly allowable.

2.4 Claim 1 of each of the operative main and auxiliary request differs from the claims of the main and auxiliary requests 1-5 filed with the statement of grounds of appeal in that the feature "rate of flow of gas through the particulate polymer" has been replaced by the feature that the gas is preheated by using heat from the polymer. As a consequence, the present claim versions are not "convergent" - in the sense that they develop and increasingly limit the subject-matter being claimed in the same direction and/or in the direction of a single inventive idea - with any of the requests filed with the statement of grounds of appeal and/or, at the latest, in reply to the respondents' first submissions in order to overcome objections raised therein if considered necessary. By deleting said feature from the operative main and auxiliary request, the appellant actually defines a new object that has never been examined by the first instance.

In addition, in deciding only six weeks before the oral proceedings before the Board to limit the subject-matter being claimed by the feature "at least a portion of the gas fed to the purge vessel is at least partially preheated using heat from the particulate polymer", the appellant not only follows a new line of argumentation, but confronts both the respondents and the Board with a new factual situation which had never before been put forward. In that respect, no passage of the description of the patent in suit indicates that said feature would be in any way preferred or related to any technical effect and none of the examples of the patent specification illustrates the subject-matter now being claimed.

2.5 In these circumstances, the operative main and auxiliary request constitute subject-matter to be dealt with for the first time at a very late stage of the appeal proceedings. The admission of either the main request or the auxiliary request would put the respondents in a worse position than if the requests had been submitted before the opposition division. Should those requests now be admitted, the subject-matter of those requests would be dealt with only by the Board, meaning the loss of one instance, or the case would have to be remitted to the department of first instance. Such a prolongation of the proceedings is incompatible with procedural economy and would deprive the respondents and the public of legal certainty about the validity of the patent in suit.

2.6 For these reasons the main and the auxiliary request are not admitted to the proceedings (Art. 12(4) and 13(1) RPBA).

3. Since none of the requests of the appellant is admissible, the appeal has to be dismissed.

Order

For these reasons it is decided that:

1. The appeal is admissible.
2. The appeal is dismissed.

The Registrar:

The Chairman



E. Goergmaier

B. ter Laan

Decision electronically authenticated