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**Datasheet for the decision
of 8 April 2014**

Case Number: T 1142/12 - 3.3.03
Application Number: 05021885.8
Publication Number: 1772486
IPC: C08L23/04
Language of the proceedings: EN

Title of invention:

Polyethylene composition for injection moulding with improved stress crack/stiffness relation and impact resistance

Applicant:

Borealis Technology Oy

Headword:

Relevant legal provisions:

EPC Art. 4, 6, 10, 10(1), 10(2), 10(2)(a), 10(2)(b), 18(1),
18(2), 84, 112(1)(a), 113(1)
EPC R. 70a, 70b, 71, 72

Keyword:

Remittal with order to hold oral proceedings in Munich instead
of The Hague - Board has no competence to take decision
relating to the venues of oral proceedings
Referral of question to the Enlarged Board of Appeal - (no,
Board not competent)
Clarity of claims - (no)
Reimbursement of appeal fee - (no)

Decisions cited:

T 1012/03, T 0689/05, T 0933/10, T 0032/82

Catchword:

The question of the venue of oral proceedings is a matter of organisational nature which belongs to the management of the Office pursuant to Art.10 (2) EPC.

When not acceding to a request for holding oral proceedings in Munich instead of The Hague, the Examining Division does not take a decision but only expresses the way the EPO is managed.

Consequently, that issue is not subject to appeal, nor can the Board refer a question on the venue of oral proceedings to the Enlarged Board of Appeal.



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Case Number: T 1142/12 - 3.3.03

D E C I S I O N
of Technical Board of Appeal 3.3.03
of 8 April 2014

Appellant: Borealis Technology Oy
(Applicant) P.O. Box 330
06101 Porvoo (FI)

Representative: Kador & Partner
Corneliusstrasse 15
80469 München (DE)

Decision under appeal: **Decision of the Examining Division of the
European Patent Office posted on 29 December
2011 refusing European patent application
No. 05021885.8 pursuant to Article 97(2) EPC.**

Composition of the Board:

Chairwoman: B. ter Laan
Members: M. C. Gordon
C. Vallet

Summary of Facts and Submissions

I. The appeal lies from the decision of the examining division announced on 15 December 2011 and posted on 29 December 2011 refusing European application number 05021885.8.

II. Claims 1, 4 and 9 of the application read as follows:

"1. A polyethylene composition wherein
(i) the composition has an MFR₂ of 0.05 to 100g/min,
(ii) the environmental stress crack resistance ESCR measured in hours according to ASTM 1693, condition B and E-modulus EM measured according to ISO 527-2:1993 in MPa satisfy the following relation:

$$\text{ESCR} \geq -\text{EMh/MPa} + 1150 \text{ h.}$$

4. A polyethylene composition according to any of the preceding claims comprising
(A) a fraction of copolymer of ethylene with one or more alpha-olefins, with a weight average molecular weight M_w of 300,000 g/mol or more.

9. A polyethylene composition according to any of the preceding claims comprising
(B) a first ethylene homo- or copolymer fraction, and
(C) a second ethylene homo- or copolymer fraction wherein fraction (B) has a lower average molecular weight than fraction (C).

III. In a previous decision of the Board, T 933/10 of 25 January 2011, the decision of the Examining Division of 8 December 2009 refusing the application was set aside on the grounds of Art. 113(1) EPC because the decision was not reasoned. This lack of reasoning related to the refusal of the Examining Division to

accede to the request of the applicant to hold oral proceedings in Munich rather than the Hague. Furthermore the Board found that an argument, namely the fact that the patent activities of Borealis Technology Oy were all concentrated in Munich, had not been taken into account by the examining division.

IV. Following remittal to the first instance, in the decision that forms the subject of the present appeal, the request of the applicant to hold oral proceedings in Munich rather than in The Hague was refused on the grounds that according to Art. 18(2) EPC oral proceedings were to be held before the Examining Division itself and consequently had to be held at the location of the Examining Division to which the case was assigned. In the present case the responsible Examining Division was located in The Hague. This decision was supported with reference to decision T 1012/03, Art. 10(1), (2)(a) and (b) EPC.

Oral proceedings before the Examining Division were held on 15 December 2011 at the EPO branch at The Hague in the absence of the applicant.

V. The decision underlying the present appeal was taken on the basis of the same claims as those underlying the earlier decision, namely the set of claims filed with letter dated 10 June 2008.

In this set of claims, claim 1 differed from claim 1 as originally filed in that:

- in part (i) the lower value of MFR_2 was specified as being 0.5 instead of 0.05;
- in part (ii) it was specified that the E-Modulus EM was measured "on injection moulded samples";

- a further feature (iii) specifying the density of the composition as 945 kg/m^3 or higher had been introduced.

Claim 9 differed from claim 9 as originally filed by specifying additionally for fractions (B) and (C) the feature: "which are different from fraction (A)".

The claims underlying the decision were found not to meet the requirements of Art. 84 EPC because claim 1 was directed to a polyethylene composition having certain properties (density, melt index) which was further characterised by a parameter - ESCR (environmental stress crack resistance) - that related not to the polyethylene itself but to an injection moulded article. The presence of two different entities in the claim rendered it unclear. Further according to the description and the examples an ultra-high molecular weight polyethylene was blended with a bimodal polyethylene base resin. The different characteristics of the two polymers were not defined in the claim. Consequently the claim was directed to a problem, not however to the technical means for its solution.

Furthermore the application was found not to meet the requirements of Art. 54 and 56 EPC. The details of these findings are not of relevance to the present decision.

- VI. On 13 February 2012 the applicant lodged an appeal against the decision, the prescribed fee being paid on the same date.
- VII. The statement of grounds of appeal was filed on 2 May 2012. The appellant focused on the procedural

aspects (location of the oral proceedings) and provided only brief arguments with respect to the substantive objections underlying the decision under appeal. Five documents were submitted in support of the procedural arguments.

In the statement of grounds of appeal the appellant stated that all requests from the earlier appeal case T 933/10 were maintained, viz.:

Main request:

That the decision under appeal be set aside and that the case be remitted to the Examining Division for further prosecution on the basis of the set of claims and the description underlying the appealed decision with the order to conduct oral proceedings at the EPO in Munich.

Auxiliarily:

That the following question concerning an important point of law be referred to the Enlarged Board of Appeal in accordance with Art. 112(1) (a) EPC:

"Can a request by a party to conduct oral proceedings at the EPO in Munich instead of at the branch office in The Hague be denied?".

Auxiliarily:

That the decision under appeal be set aside and the case be granted on the basis of the set of claims and the description underlying the appealed decision.

Further request:

That the appeal fee be reimbursed.

VIII. On 18 February 2013 the Board issued a communication setting out its provisional view on the matter of the

- location of the oral proceedings. Furthermore the Board addressed the matter of Art. 84 EPC and indicated that this requirement of the EPC was not satisfied by the operative claims.
- IX. In a written submission of 28 June 2013 the appellant provided further submissions which were restricted to the issue of the location for oral proceedings.
- X. On 6 August 2013 the Board issued a summons to attend oral proceedings. In a communication dated 23 January 2014 the Board noted that the appellant had omitted to address the substantive matters raised in the previous communication.
- XI. In letters dated 3 March 2014 and 2 April 2014 the appellant provided further submissions on the issue of the location for oral proceedings before the examining division. Furthermore it was indicated that the objections with respect to clarity raised by the Board were disagreed with and that no objections had been raised to the effect that the description of the application would not provide all details necessary to produce the claimed composition.
- XII. Oral proceedings were held before the Board on 8 April 2014. Following discussion, the appellant modified the order of its requests by reversing the main request and the first "auxiliarily" request (see point VII above).
- XIII. The arguments of the appellant can be summarised as follows whereby the listing of the points is derived from that laid out by the appellant on the occasion of the oral proceedings:

a) *Request concerning location of the oral proceedings*

The appellant considered that he was entitled to have his request for oral proceedings to be held in Munich instead of in The Hague granted. It was not argued that the summons to attend oral proceedings in The Hague was in violation of the EPC. Considerations as to on what authority, e.g. a directive of the President of the Office, the invitation to oral proceedings in The Hague had been issued were not of relevance in the present case.

The request to have the oral proceedings convened instead in Munich had been refused on non-existent grounds, or on grounds that did not apply or were not based on the EPC. The question to be addressed was whether the EPC provided a basis for refusing the request for relocation of the oral proceedings to Munich.

b) *Reasonableness of the request*

The applicant was based in Linz and the attorney firm, which was that principally employed by the applicant, was based in Munich. Considerations of convenience and minimising expense constituted a legitimate and reasonable justification for the request to hold oral proceedings in Munich instead of The Hague.

The question of location of oral proceedings arose as a result of amendments to the EPC. In EPC 1973 there had been territorial limitations on the acts carried out, i.e. search in The Hague and

examination in Munich. These restrictions had been removed in the revised EPC. Under the current situation the users of the system had no certainty concerning the venue of oral proceedings should these be convened. This was an aspect that affected the interface between the EPO and its users.

c) *The decision under appeal*

The decision was very brief on the question of the location of oral proceedings, provided no evaluation of the Articles of the EPC cited in the contested decision and it did not emerge from the decision why the request had been refused. It could be imagined that the refusal had its origins in a directive of the President pursuant to Art. 10(2) (b) EPC concerning the acts to be carried out in Munich and The Hague, e.g. that any request for a different location had to be refused. However there was no corresponding instruction of the President.

d) *Competency of the Board to address the question of location of oral proceedings*

The decision to refuse to hold the oral proceedings in Munich had been taken by an Examining Division, against which decision an appeal had been filed. Consequently the Board was competent to decide on this matter. This position was consistent with the findings of T 1012/03, T 689/05 and T 933/10, in all of which cases the respective Board had considered itself competent to rule on said issue. Any different conclusion regarding competency of the Board would result in

diverging case law leading to the need to refer the matter to the Enlarged Board.

If the Examining Divisions and the Boards were not competent to decide on the question of location of oral proceedings then in T 933/10 the Board would not have remitted the case on the grounds that the decision was not reasoned and had failed to take account of an argument of the applicant.

e) *Considerations on Art. 116 and 18(2) EPC*

Art. 18(2) EPC defined the organ before which oral proceedings were to be held but imposed no restriction on the geographical location of said organ. Consequently Art. 18 EPC could not provide a basis for refusing a request in respect of the location for oral proceedings.

f) *Art. 10(2) (b) EPC*

There existed no instruction or prescription by the President pursuant to Art. 10(2) (b) EPC concerning the treatment of requests for a change of location of oral proceedings, although said Article did empower the President to issue such an instruction. If such an instruction existed, it would be reasonable to expect this to have been made known to the public. It would be strange that if such an instruction existed it would be in the nature of an oral, unwritten instruction to staff of the Office. However from experience, it appeared that all such requests in respect of a change of location of oral proceedings had systematically been refused suggesting that some form of instruction to this effect had indeed been

in place.

- g) and
- h) In these two points the appellant discussed the findings of decisions T 1012/03 and T 933/10 in particular as to the issue related to the seat of the EPO.
- i) *The significance of the seat of the EPO*

According to Art. 6 EPC the seat of the organisation shall be Munich and the European Patent Office shall be located in Munich. It shall have a branch at The Hague. From this it followed that the Office had its seat in Munich, with a branch in The Hague. The consequence of this was that the users of the system were entitled, on request, to have oral proceedings at the seat of the Office even if initially the proceedings were convened for another location. Analogously there would be no reason to deny a request for an oral proceedings to be transferred to The Hague from Munich. Decisions T 1012/03 and T 689/05 emphasised that holding oral proceedings in the correct place was significant for compliance with Art. 113 and 116 EPC, i.e. having oral proceedings at the correct location influenced the right to be heard.

- j) Applying the above consideration, the appellant argued mainly that oral proceedings had to be held at the seat of the EPO, because the seat of the EPO was the place of interaction between the Office and the users of the patent system. Any decision to hold oral proceedings elsewhere would

amount to a substantial procedural violation. This reasoning was based on Art. 4, 6 and 116 EPC and with reference to documents submitted with the statement of grounds of appeal. The appellant also argued that the reasons given in the contested decision, based on Art. 18(2) EPC, which stated that oral proceedings shall be held before the Examining Division itself, resulted from a misinterpretation of said Article which provided no indication as to the location of oral proceedings. The appellant further contended that the EPO was not free to decide where oral proceedings were to be conducted and therefore could not reject a reasoned request to hold oral proceedings in Munich. The appellant expressed the view that no provision or guideline existed that rendered it possible to hold oral proceedings in The Hague or indeed in any other place where the Office had an office. Nor was there any provision or guideline that obliged the Examining Divisions to reject a request for a change of venue. The appellant further considered that Art. 10(2)(b) EPC did not constitute a legal basis in this respect. This Article meant that the President of the EPO had the duty to manage the EPO. However, in discharging this duty, the President was bound by the Convention which laid down that the seat of the European Patent Office was in Munich.

k) *Referral to the Enlarged Board of Appeal*

Regarding the request for referral to the EBA, the appellant argued that the venue of oral proceedings was a point of law of fundamental importance. Thus legal certainty and a uniform application of the EPC were necessary for everyone

involved which, in its view, was not the case at present.

1) *Substantive issues*

With regard to the substantive issues, the appellant argued in writing that there was no clarity problem and that what was stated in the claim was clear and precise. The appellant did not avail himself, on being explicitly invited to do so, of the opportunity to elaborate on this aspect at the oral proceedings

XIV. The appellant requested:

Main request:

That the following question be referred to the Enlarged Board of Appeal in accordance with Art. 112 (1) (a):
"Can a request by a party to conduct oral proceedings at the EPO in Munich instead of at the branch office in The Hague be denied?"

First auxiliary request:

That the decision under appeal be set aside and the case be remitted to the department of first instance for further prosecution on the basis of the set of claims and the description underlying the appealed decision with the order to conduct oral proceedings in Munich.

Second auxiliary request:

That the decision under appeal be set aside and a patent be granted on the basis of the set of claims filed with letter of 10 June 2010 and the description as originally filed.

The appellant further requested that the appeal fee be reimbursed.

Reasons for the Decision

1. *Main request*

1.1 The appellant changed the order of its requests during the oral proceedings, as stated above. Nevertheless, the Board, taking into account that the solicited change of the order of consideration of the requests was of procedural nature, may decide upon the logical order in which to deal with the requests. In this respect, the situation diverges from that where substantive issues are at stake, under which circumstances the Board must follow the order of requests chosen by the parties, because this belongs to the principle of free disposition.

1.2 In the present case, the issue relating to the competence of the Board to decide upon the question of the venue of oral proceedings is to be dealt with first, for the reason that if the Board came to the conclusion that it had no competence in this respect, the Board would also have no competence in matters subsidiary thereto or associated therewith, for example the referral of a question to the Enlarged Board of Appeal on that issue.

2. *First auxiliary request*

2.1 The crucial issue to be considered first is to determine who has the power to decide on the location of oral proceedings, namely, whether such a decision is in the hands of the Examining Division or in the hands of the management of the EPO.

2.2 The reasoning followed by the appellant is based on the assumption that the Examining Division had the power to decide on such a matter, or at least that in particular cases, especially where the applicant presented a request to hold oral proceedings in Munich instead of in The Hague with good reasons, such a request could not be refused.

2.3 This question is obviously of particular importance because on its answer depends the determination of the which body is empowered to review such a decision.

2.3.1 If the Examining Division may decide on the location of oral proceedings on a case by case basis, then it would be obliged to justify its decision to refuse a request for oral proceedings in Munich on the basis of the provisions of the EPC, of the Rules or of the Guidelines and in consideration of the reasons given by the applicant. The reasoning on this issue would thus be part of the contested decision which would therefore be subject to appeal.

2.3.2 Alternatively, if the decision on the venue of oral proceedings was within the competence of the management of the EPO and was thus within the power of the President of the European Patent Office then any challenge to such a decision by a party would in fact be directed against a regulation adopted by the

President or somebody acting on his behalf, but not against a decision of the Examining Division and therefore would not fall within the competence of the Boards of Appeal.

- 2.4 Under the provisions of Art. 18(1) EPC the Examining Divisions are responsible for the examination of European patent applications.
- 2.5 Chapter IV of the Implementing Regulations relating to the examination by the Examining Division (R. 70a to 72 EPC) provides no indication as to the venue of oral proceedings.
- 2.6 The provisions of Art. 116(1) and (3) EPC relating to oral proceedings contain no mention as to where oral proceedings are to be held, nor do R. 115 and R. 116 EPC provide any such guidance.
- 2.7 As a matter of principle, in a democratic organisation, a given body cannot act outside its own sphere of competence as laid down by the applicable law, i.e. the EPC, otherwise its decision would be void.
- 2.7.1 Nowhere in the EPC can a provision be found suggesting that the Examining Divisions were entitled to decide on matters other than patent applications in accordance with the rules and principles laid down by the EPC.
- 2.7.2 As stated in decision T 1012/03, which is not contested by the appellant in his submissions in the present case, **the practical aspects of the organisation of oral proceedings are a matter relating to the management of the EPO, which lies under the power of the President of the EPO as provided by Art. 10(2) EPC** (see point 4 of

said decision).

Accordingly the Examining Divisions are clearly not allowed to take a decision, whatever this would be, on this matter.

- 2.7.3 The mere decisional power of the first instance bodies as well as the Boards of Appeal on this issue extends to the point at which the decision to hold oral proceedings in a specific case is taken. By contrast, the place, the room and even the date are of organisational nature.
- 2.8 The contested decision based its reasoning on Art. 18(2) EPC.
 - 2.8.1 Art. 18(2) EPC stipulates only **before whom** oral proceedings must be conducted, namely before the Examining Division. As correctly indicated by the appellant, this provision gives no indication as to the geographical location at which oral proceedings should be conducted and does not empower an Examining Division to take any decision in this respect.
 - 2.8.2 Therefore, the Examining Divisions have no authority according to the EPC to take a decision relating to where oral proceedings are to be held. The consequence is that that issue is not part of the substance of the decision taken by the Examining Division.
- 2.9 Under the provisions of Art. 21 EPC, the Boards of Appeal shall be responsible for the examination of appeals from decisions of the Receiving Section, the Examining Divisions and the Opposition Divisions, and the Legal Division.

- 2.9.1 The powers of the Boards of Appeal are thus confined to said defined area which does not include management matters.
- 2.9.2 Therefore the present Board has no power to challenge the contested "refusal of the request to hold oral proceedings in Munich instead of The Hague". This refusal was merely the expression of the way the EPO is organised whereby in the case that the Examining Division is located in The Hague, oral proceedings are to be held in The Hague and when the Examining Division is located in Munich, oral proceedings are to be held in Munich.
- 2.9.3 As a matter of general consideration, it may well be that users of the European patent system are dissatisfied with this aspect of the organisation of work within the EPO. However, means other than appeal proceedings have to be found to challenge that issue.
- 2.10 The respect of the separation of the powers within the European Patent Organisation is a matter of the utmost gravity for it is the first guarantee of a smooth running of this institution.
- 2.11 As regards the alleged *violation of the right to be heard*, the Board draws the attention of the appellant to the fact that oral proceedings were organised before the Examining Division. It is not disputed that the applicant was summoned in due time and in the appropriate and procedurally correct way. In accordance with R. 115(2) EPC oral proceedings were held in the absence of the party. Thus, no procedural violation occurred. As a matter of principle, expressed by long standing case law, the applicant who decides on his own volition not to attend oral proceedings cannot claim

that his right to be heard has been violated. He has merely, by his own action, deprived himself of the opportunity to present his case orally.

2.11.1 As stated in T 1012/03 (see points 49 and 59 of the reasons) and in T 0689/05 (see point 5 of the reasons), Art. 116 and 10(2) EPC form the legal basis for conducting oral proceedings in The Hague. Thus the argument of the appellant that a substantial procedural violation occurred, because under Art. 116 EPC the parties have not only a right to oral proceedings in general, provided it is requested, but also the right that their case be heard at the proper place, said proper place being Munich, must fail.

2.11.2 There is no contradiction between the above cited decisions and the reasoning in the present case. This Board is only drawing the logical and final consequence of the reasoning previously developed by other Boards. Nor is there any contradiction between decision T 933/10 and the present one. The Board in that case expected the Examining Division to have explained why and on which basis it had refused the request for change of venue of oral proceedings. Such reasons have been provided in the decision underlying the present appeal, even if the Board cannot entirely approve of said reasons. Nevertheless, due to the reference to decision T 1012/03, the decision under appeal at least made clear that the basis for refusal is to be found in Article 10(2) EPC.

2.12 The outcome as regards the competence of the Board to examine the present case could have been different if it were to be found that an organisational decision made by the President or someone acting on his behalf had lacked any basis in the EPC and if said decision

had led to infringement of substantial procedural rights of the parties. Yet this is clearly not the situation in the present case and accordingly no exception can be made to the principle that the Boards of Appeal have no power to review the way the management of the Examining Divisions of the EPO is conducted.

- 2.12.1 Furthermore, it needs to be underlined that **a decision by the present or indeed any Board ruling that oral proceedings had to take place in Munich, on the grounds that the seat of the European Patent Office is in Munich**, as argued by the appellant, **would not have any effect for the reason that the Board would have acted outside the limits of its power** as defined by the EPC, as already explained above.

3. *Request for referral to the Enlarged Board of Appeal*

The request for referral to the Enlarged Board of Appeal in accordance with Art.112(1)(a) is to be rejected for the reasons given above.

The question "*Can a request by a party to conduct oral proceedings at the European Patent Office in Munich instead of at the branch office in The Hague be denied?*" is, as already stated, related to an organisational matter beyond the scope of the power to decide of the Examining Divisions and hence of the Boards of Appeal.

As a consequence, the present Board is not empowered to decide on this issue, and correspondingly is not empowered to refer a question in respect thereof to the Enlarged Board of Appeal.

4. Substantive issues.

4.1 Article 84 EPC.

4.1.1 As noted by the Examining Division, claim 1 defines the subject-matter in terms of desiderata, i.e. required properties. The claim however fails to define the technical features, e.g. constitution of the polymers, necessary to attain these properties. Hence the claim does not meet the requirements of Art. 84 EPC. In this respect the Board directs attention to the findings of decision T 32/82.

4.1.2 This objection applies mutatis mutandis to claims 2 and 3 and claims 12-14 in their dependency on claim 1.

4.1.3 Claim 9 is dependent on all preceding claims, i.e. on claim 1 - which is directed only to a "polyethylene composition" - and also on claim 4 - which is directed to a polyethylene composition having a fraction designated "A" and having a defined molecular weight. In its dependency on claim 1 claim 9 lacks clarity since it relies in its definition on "Fraction A", which is not part of the subject matter of claim 1.

Further, depending on which of the higher ranked claims it is combined with, claim 9 relates to two different subject matters: In its dependency on claim 1 it relates to a composition having at least two components. In its dependency on claim 4 however it relates to a composition having mandatorily at least three components.

The scope of this claim thus cannot be determined with certainty and in an unambiguous way, meaning that it

does not meet the requirements of Art 84 EPC.

- 4.2 The substantive issues indicated above were raised in the Board's communication of 18 February 2013. The Appellant reacted to the raised objections in its submission of 3 March 2014 only to the extent of indicating that it disagreed with the assessment of the Board, (see section XI, above)
No further submissions on these matters were made (see section XIII.(k), above).

In the absence of any substantive arguments by the appellant, the Board sees no reasons to depart from its preliminary assessment with respect to the lack of clarity.

- 4.3 Since the operative claims of the application in suit do not meet the requirements of Art. 84 EPC the application has to be refused.

5. Reimbursement of the appeal fee.

Rule 103(1) EPC provides that the appeal fee shall be reimbursed in the event of an interlocutory decision or where the Board of Appeal deems an appeal to allowable, if such reimbursement is equitable by reason of a substantial procedural violation.

In the present case the appeal was not successful, so that there is no basis for reimbursement.

Order

For these reasons it is decided that:

1. The appeal is dismissed.
2. The request for reimbursement of the appeal fee is refused.

The Registrar:

The Chairwoman:



E. Goergmaier

B. ter Laan

Decision electronically authenticated