

Internal distribution code:

- (A) [-] Publication in OJ
- (B) [-] To Chairmen and Members
- (C) [-] To Chairmen
- (D) [X] No distribution

**Datasheet for the decision
of 6 September 2016**

Case Number: T 1738/13 - 3.3.03

Application Number: 05808420.3

Publication Number: 1812485

IPC: C08F297/08, C08L23/06,
C08L23/08

Language of the proceedings: EN

Title of invention:

POLYETHYLENE MOLDING COMPOSITION FOR COATING STEEL PIPES

Patent Proprietor:

Basell Polyolefine GmbH

Opponents:

Borealis Technology OY
THE DOW CHEMICAL COMPANY

Relevant legal provisions:

RPBA Art. 13(1), 13(3)
EPC Art. 100(b)
EPC R. 80

Keyword:

Late-filed evidence - admitted (no)

Sufficiency of disclosure - Main request (no) - First auxiliary request (yes)

Amendment occasioned by ground for opposition - First auxiliary request (yes)



Beschwerdekammern
Boards of Appeal
Chambres de recours

European Patent Office
D-80298 MUNICH
GERMANY
Tel. +49 (0) 89 2399-0
Fax +49 (0) 89 2399-4465

Case Number: T 1738/13 - 3.3.03

D E C I S I O N
of Technical Board of Appeal 3.3.03
of 6 September 2016

Appellant:
(Patent Proprietor)

Basell Polyolefine GmbH
Brühler Strasse 60
50389 Wesseling (DE)

Representative:

Basell Polyolefine GmbH
Intellectual Property
Bldg. C657, 2nd floor
Industriepark Höchst
65926 Frankfurt/Main (DE)

Respondent:
(Opponent 1)

Borealis Technology OY
P.O.Box 330
06101 Porvoo (FI)

Representative:

Kador & Partner
Corneliusstraße 15
80469 München (DE)

Respondent:
(Opponent 2)

THE DOW CHEMICAL COMPANY
2030 Dow Center
Midland, Michigan 48674 (US)

Representative:

Boult Wade Tennant
Verulam Gardens
70 Gray's Inn Road
London WC1X 8BT (GB)

Decision under appeal:

**Decision of the Opposition Division of the
European Patent Office posted on 11 June 2013
revoking European patent No. 1812485 pursuant to
Article 101(3) (b) EPC.**

Composition of the Board:

Chairman D. Semino
Members: D. Marquis
 C. Brandt

Summary of Facts and Submissions

- I. European Patent No. 1 812 485 was granted on the basis of 10 claims, claims 1 and 5 reading as follows:

"1. A polyethylene molding composition which has a multimodal molar mass distribution and has a density at a temperature of 23°C in the range from 0.94 to 0.95 g/cm³ and an MFI_{190/5} in the range from 1.2 to 2.1 dg/min and comprises from 45 to 55% by weight of a low molecular weight ethylene homopolymer A, from 30 to 40% by weight of a high molecular weight copolymer B of ethylene and another olefin having from 4 to 8 carbon atoms and from 10 to 20% by weight of an ultra high molecular weight ethylene copolymer C, where all percentages are based on the total weight of the molding composition."

"5. The polyethylene molding composition according to one or more of claims 1 to 4 which has a notched impact toughness AFM (-30°C) in the range from 3.5 to 4.5 kJ/m² and a notched impact toughness ACN (+23°C) in the range from 12 to 16 kJ/m² and has an environmental stress cracking resistance (FNCT) in the range from 150 to 250 h."

- II. Two notices of opposition were filed against the granted patent requesting revocation of the patent on the grounds of Article 100(a) EPC (novelty and inventive step) as well as Article 100(b) EPC. During opposition proceedings the following documents inter alia were cited:
- D1: US-B1-6,713,561
D5: US-A-4,975,485

III. The decision of the opposition division announced at the oral proceedings on 8 May 2013 revoking European patent No. 1812485 pursuant to Article 101(3)(b) EPC was based on the main request (set of claims as granted), the first auxiliary request filed with letter of 14 February 2011 and the second to fourth auxiliary requests filed with letter of 8 March 2013. The claims of the first auxiliary request were identical to the claims as granted. The claims of the second auxiliary request corresponded to the claims as granted with the difference that claim 5 had been deleted. The claims of the third auxiliary request differed from the granted claims in that claim 1 corresponded to claim 1 as granted in which additionally the viscosity number VN overall, measured in accordance with ISO/R 1191 in decalin at a temperature of 135°C was specified to be in the range of from 260 to 340 cm³/g. The claims of the fourth auxiliary request differed from the granted claims in that claim 1 corresponded to claim 1 as granted in which additionally the viscosity number VN overall, measured in accordance with ISO/R 1191 in decalin at a temperature of 135°C was specified to be in the range of from 280 to 320cm³/g.

The decision of the opposition division, as far as relevant to the present decision, can be summarised as follows:

a) Claim 1 of the main request was not sufficiently disclosed because the patent in suit did not provide sufficient guidance to allow the skilled person to produce the claimed composition having a melt flow index (MFI_{190/5}) in the narrow range of 1.2 to 2.1 dg/min. The adjustment of the hydrogen concentration during polymerisation was not described

in the patent in suit. The composition produced in the sole example disclosed in the patent in suit reportedly had a melt flow index of 1.1 dg/min, outside the claimed range, so that the patent did not contain an example representing the claimed invention. Also, D1 showed that a very similar process to that used in the patent in suit resulted in a composition having a melt flow index well outside the range of 1.2 to 2.1 dg/min. That conclusion also applied to claim 1 of all auxiliary requests.

b) Claim 5 of the main request was not sufficiently disclosed because the patent in suit did not provide sufficient guidance to allow the skilled person to produce the claimed composition having a environmental stress crack resistance (FNCT) in the range of 150 to 250 h. The patent in suit did not identify a single set of measuring conditions allowing the determination of the FNCT. The patent in suit also lacked any information about the polymerisation process parameters that had to be adjusted to produce a composition having an FNCT within the claimed range.

- IV. The patent proprietor (appellant) lodged an appeal against that decision and filed a statement of grounds in which it was requested that the contested decision be set aside and that the patent be maintained as granted or on the basis of first to third auxiliary requests included therein (corresponding to the second to fourth auxiliary requests filed before the opposition division).
- V. With their replies to the statement setting out the grounds of the appeal, the opponents 1 and 2 (respondent I and II) requested that the appeal be

dismissed and filed arguments relating to the objections of the appellant.

- VI. In a communication according to Article 15(1) RPBA in preparation for oral proceedings, the Board summarised the points to be dealt with and provided a preliminary view concerning the main and auxiliary requests and the possibility of remittal to the department of first instance for further prosecution.
- VII. After receiving the communication, the appellant provided further arguments based inter alia on document D5 with letter of 5 August 2016 and filed with the same letter new documents D15 (US-A-2003/0114594), D16 (ENCYCLOPEDIA OF POLYMER SCIENCE AND ENGINEERING, Volume 6, pages 435 and 477-478, John Wiley & Sons, 1986) and D17 (US-A-4469853) with letter of 24 August 2016 as well as D20 (WO-A-2013/045663) with letter of 1 September 2016.
- VIII. Respondent I provided further arguments with letter of 5 August 2016 as well as a new document D20 (renumbered as D21: B. Hagstrom in "The Polymer Processing Society, Extended Abstracts & Final Programme, August 19-21, 1997, Conference of Polymer Processing, Gothenburg, Sweden) with letter of 1 September 2016.
- IX. Respondent II provided further arguments as well as new documents D18 (Utracki, L. A. and Kamal, M. R. (1982), Melt rheology of polymer blends. Polym Eng Sci, 22: 96-114) and D19 (Utracki, L. A. (1983), Melt flow of polymer blends. Polym Eng Sci, 23: 602-609) with letter of 30 August 2016.
- X. Oral proceedings were held on 6 September 2016.

XI. The arguments of the appellant, as far as relevant to the present decision, can be summarised as follows:

Admittance of evidence filed in appeal

D15 to D17 as well as D20 related to the discussion of sufficiency of disclosure. They were filed in response to arguments of the opponents relating to the parameters of the polymerisation process needed to adjust the melt flow index. The late filed documents were relevant to the question posed and they did not introduce any new issues in appeal. These documents should therefore be admitted into the appeal proceedings.

Main Request and first auxiliary request - Sufficiency of disclosure

The patent in suit disclosed all the parameters of the polymerisation process that were necessary to adjust the melt flow index of the claimed composition. Among these parameters was the hydrogen pressure in the individual polymerisation reactors of the three stage process. The control of the hydrogen pressure was part of the common general knowledge of the skilled person. It was also known that increasing the hydrogen pressure during polymerisation had the effect of lowering the molecular weight of the polymer produced and hence meant that the melt flow index was increased. In addition, the patent in suit taught that the polymerisation had to be performed in a narrow range of temperatures. Example 1 disclosed a combined set of conditions under which the three stage polymerisation could be conducted. The melt flow index of the composition produced in example 1 of the patent in suit was 1.09 dg/min, only slightly outside the claimed

range. The skilled person relying on his common technical knowledge, however, knew how to modify the polymerisation process of example 1 in order to provide a composition that had a melt flow index inside the claimed range. A comparison of the polymerisation process conditions of the patent in suit with those disclosed in the examples of D1 did also provide additional guidance on how to adjust the hydrogen pressure in the three reactors so that a targeted melt flow index was obtained. Claim 1 was therefore sufficiently disclosed.

The purposive selection of the components and process conditions leading to the composition according to claim 1 of the contested patent resulted in a product with an environmental stress cracking resistance FNCT within the range of claim 5. Examples 1 and 3 of D1 as well as parts of D5 provided a guidance on how to arrive at the claimed range of FNCT. On the basis of the patent in suit and the common general knowledge, the skilled person was also able to choose the correct measuring conditions and in particular the temperature under which the measurement was performed in order to determine the FNCT characterising the composition produced. Claim 5 was therefore sufficiently disclosed.

First auxiliary request - Rule 80 EPC

The deletion of claim 5 from the set of claims as granted was a reaction to a ground of opposition. First auxiliary request was therefore admissible under Rule 80 EPC.

XII. The arguments of the respondents, insofar as relevant to the present decision, can be summarised as follows:

Admittance of evidence filed in appeal

D15 to D17 as well as D20 did not provide any new insight on the matter of sufficiency of disclosure. Their admittance into the proceedings was not justified by any new issue not already addressed by the opposition division. These documents could thus have been filed with the statement setting out the grounds of the appeal. Also, the filing of these documents so late in appeal was contrary to the requirements of Article 12(2) RPBA so that they should not be admitted into the appeal proceedings. The same applied to the arguments based on document D5. D18, D19 and D21 were filed in response to the arguments of the appellant based on D15 to D17 and D20. They should therefore be admitted into the proceedings if the documents filed by the appellant were admitted.

Main Request and first auxiliary request - Sufficiency of disclosure

There was no guidance in the patent in suit on how the parameters of the polymerisation process had to be adjusted so that the composition had a melt flow index within the range of claim 1. The patent in suit indicated that the molecular mass could be regulated in each stage by metering hydrogen but it did not indicate what amounts of hydrogen was suitable in any or all of the stages. Even if it was known that hydrogen could generally be used to control the molecular weight of polyethylene and hence its melt flow index, the relationship was significantly more complex for multimodal polyethylene compositions since the melt flow index of each individual polyethylene component produced after the first reactor could not be directly measured. There was no generally accepted formula for

determining the final melt flow index value based on the melt flow index of each individual polyethylene component. Furthermore, it was not taught how the amount of hydrogen used in each polymerisation stage influenced the melt flow index of the composition. The skilled person did not find the necessary guidance in the patent in suit to repeat the example of the patent in suit such that the melt flow index was in the claimed range. Example 1 provided details of an ethylene polymerisation process but the melt flow index of the composition was not disclosed (neither was the density which was another requirement of claim 1). While one skilled in the art might have reasonably assumed that Example 1 of the patent in suit provided at least one process by which the required melt flow index could be obtained, on repeating it, he would allegedly find a value of 1.09 dg/min that did not fall within the scope of claim 1.

The composition of example 3 of D1 was produced under conditions that were close to those used in the example of the patent in suit, but its melt flow index and density differed significantly. That comparison showed that the skilled person was not taught what parameters he had to adjust to provide a composition according to claim 1 of the patent in suit. Therefore, since neither the patent in suit nor the common general knowledge provided one skilled in the art with a guidance on how to obtain the required melt flow index claim 1 was not sufficiently disclosed.

The patent in suit did not indicate which of the two sets of conditions given in the patent in suit for the measurement of the environmental stress cracking resistance FNCT had to be used in the context of claim 5. The value obtained for the FNCT depended substantially from the method used and the skilled

person had no way of guessing which one had to be used. There was also no guidance in the patent in suit on which parameters of the polymerisation process or of the polyethylene composition had to be adjusted and how it had to be adjusted in order to obtain a composition fulfilling the combination of requirements as set out in claim 5. Claim 5 was not sufficiently disclosed.

First auxiliary request - Rule 80 EPC

There was no reason for the cancellation of the whole of claim 5 in the set of claims of the first auxiliary request in view of the objection of sufficiency being relevant only for the environmental stress cracking resistance, so that that modification was not allowable under Rule 80 EPC.

- XIII. The appellant requested that the decision under appeal be set aside and that the case be remitted to the opposition division for examination of the grounds of opposition under Article 100(a) EPC on the basis of the patent as granted (main request) or, alternatively, on the basis of either of the first to third auxiliary requests, filed with the statement setting out the grounds of appeal.
- XIV. The respondents requested that the appeal be dismissed, or, alternatively, if the Board finds that any of the requests meet the requirement of sufficiency of disclosure, that the case be remitted to the opposition division for consideration of the remaining grounds of opposition.

Reasons for the Decision

1. Admittance of evidence filed in appeal
 - 1.1 A number of new documents were filed by the appellant almost three years after the statement of grounds of appeal and after the communication according to Article 15(1) RPBA was sent by the Board (D5 and D15 with letter of 5 August 2016, D16 and D17 with letter of 24 August 2016 and D20 with letter of 1 September 2016). Several documents were filed in reply by the respondents (D18 and D19 with letter of 30 August 2016 and D21 with letter of 1 September 2016). These documents were filed by the parties in support of arguments relating to the melt flow index (MFI) of polyethylene compositions and to their process of preparation. These documents opened a new discussion between the parties about the relevance of their content to the claimed subject matter. It must then be established whether these documents could have been produced earlier and whether their introduction at such a late stage of the appeal proceedings is justified.
 - 1.2 D5 is a US patent document from 1990 relating to trimodal polyethylene compositions having broad molecular weight distribution and obtained in the presence of a Ziegler catalyst. D5 was cited and used in the notice of opposition of the then opponent 1 (respondent I) so that D5 was already part of the opposition procedure. The Board sees therefore no legal basis to exclude that document nor any arguments based on it from the appeal procedure.

1.3 D15 and D20 are patent applications from 2003 and 2013 respectively. These documents relate to the preparation of melt blended high density polyethylene compositions and were submitted with the sole purpose of confirming the existence of a logarithmic formula correlating the melt flow index of a polymer blend with the melt flow index of its single components. D16 and D17 are documents from 1986 and 1984 relating to the control of the hydrogen concentration in the course of an HDPE polymer preparation so as to adjust the MFI as well as the molecular mass of the polymer. Thus, D15, D16, D17 and D20 relate to the calculation and the adjustment of the MFI in the course of a multimodal polyethylene polymerisation, two issues that had already been discussed by the parties at oral proceedings before the opposition division on 8 May 2013 (see Minutes of the oral proceedings before the opposition division dated 11 June 2013, page 3) and cannot be seen as new issues raised in the communication of the Board or in arguments of the respondents in appeal. The appellant therefore knew that these issues had been contentious since at least the oral proceedings on 8 May 2013 and as a result could and should have submitted D15, D16, D17 and D20 at the latest with the statement of the grounds of appeal instead of waiting until a few weeks before the oral proceedings before the Board.

1.4 D18, D19 and D21 are documents from 1982, 1983 and 1997 respectively. They relate to the melt rheology of polymer blends and reveal that several models can be used to estimate the melt flow properties of polymer blends. These documents were filed by the respondents in order to establish that the melt flow index of multimodal polyethylene compositions did not necessarily add in a log fashion (see letter of respondent 2 of 30 August 2016, first paragraph on page

2 and letter respondent 1 of 1 September 2016, first paragraph on page 2). D18, D19 and D21 therefore relate to the same issue of correlation of the MFI by way of a logarithmic formula that had already been discussed by the parties at oral proceedings before the opposition division on 8 May 2013. These documents therefore could and should have been provided by the respondents at the latest in their respective replies to the statement of grounds of appeal, even more so since respondent II himself refuted the use of a logarithmic formula to calculate the MFI of a bimodal polyethylene composition in his reply to the statement of grounds of appeal (last paragraph, page 2).

- 1.5 As no justification can be seen for filing all these documents at such a late stage and in view of the fact that each filing causes further filings by the opposing party as a reaction to a new situation, therefore complicating the procedure and giving rise to the right to further reactions at a stage at which the procedure should come to an end, the Board finds it appropriate in particular in view of the need for procedural economy to exercise its discretion under Article 13(1) RPBA by not admitting documents D15 to D21 into the proceedings. This is all the more appropriate as admittance of these documents and their use during oral proceedings would have implied a great risk of a request of adjournment in view of the new procedural situation (Article 13(3) RPBA).

Main request

2. Revision of the decision on sufficiency of disclosure
- 2.1 Lack of sufficiency of disclosure of the melt flow index (MFI_{190/5}) in claim 1 and of the environmental

stress cracking resistance (FNCT) in claim 5 were the two reasons for the revocation of the patent in suit. In particular the opposition division came to the conclusion that the patent lacked sufficiency of disclosure because the skilled person did not find in the specification which process parameter(s) the skilled person could use and how he could adjust them so that the MFI_{190/5} as defined in claim 1 falls into the claimed range and because the patent failed to disclose an example illustrating the invention claimed. Also, the opposition division found that the patent in suit did not provide sufficient guidance as to the measures that have to be taken to prepare a polyethylene composition which exhibited the properties required in claim 5.

- 2.2 In the present case the Board is of the view that the melt flow index defining the composition of claim 1 is sufficiently disclosed.
- 2.3 The specification of the patent in suit first discloses in paragraph 14 that the claimed composition "is obtained by polymerization of the monomers in suspension at temperatures in the range from 70 to 90°C, a pressure in the range from 2 to 10 bar and in the presence of a highly active Ziegler catalyst composed of a transition metal compound and an organoaluminum compound. The polymerization is a three-stage polymerization, i.e. it is carried out in three successive stages, with the molar mass being regulated in each stage by means of added hydrogen.". That passage therefore provides general information concerning the process parameters and conditions necessary to perform the polymerisation relating to the claimed composition. It also teaches the reader that alongside the usual process parameters available to the

skilled person (temperature, pressure, catalyst), the metering of the hydrogen pressure in the reactors in the course of the three stages polymerisation is paramount to the adjustment of the polyethylene molecular weight. Since the molecular weight of polyethylene is known to be inversely proportional to its melt flow index, as confirmed by all parties to the oral proceedings, the Board finds that the skilled reader would have concluded from that passage that the melt flow index of the composition could be adjusted by metering the hydrogen pressure in the course of polymerisation.

- 2.4 Besides, the example of the patent in suit (paragraphs 20 to 30) provides further guidance as to the process conditions to be considered for each stage of the process in the context of the three stage polymerisation disclosed. Thus, the example not only discloses details of the polymerisation like the Ziegler catalyst, its cocatalyst and its amount in the first reactor, the reactor temperatures in the three polymerisation stages, the amount of monomers used in each stage and the hydrogen pressure present in each polymerisation stage, but it also provides a description of how the three stage polymerisation was conducted. The specification of the patent in suit therefore contains a technical guidance that is specific to the three stage polymerisation used to prepare the claimed polyethylene composition with the desired melt flow index. In that respect, the teaching contained in D1 is consistent with that of the patent in suit. D1 discloses the preparation of trimodal polyethylene compositions comprising a low molecular weight ethylene homopolymer, a high molecular weight copolymer of ethylene and another olefin having from 4 to 10 carbon atoms and an ultra high molecular weight

ethylene homo- or copolymer (claim 1). As these polyethylene compositions are close to those of the patent in suit, the teaching provided in D1 is therefore relevant to the preparation of the compositions of the patent in suit. As in paragraph 14 of the patent in suit, the description of D1 indicates that the molecular weight of the polyethylene polymer produced in the successive three stages of the polymerisation can be regulated by metering hydrogen (column 3, lines 30-32). Besides, the four examples of D1 show that a three stage polymerisation can lead to polyethylene compositions with a melt flow index (Table 1: 0.3 to 1.07 dl/g) that is relatively close to the range of melt flow index of the patent in suit (1.2 to 2.1 dl/g), showing that three stage polymerisation of polyethylene resulting in a melt flow index close to the range in claim 1 is not an unexplored field to the skilled person.

- 2.5 The patent in suit therefore identifies the general process parameters that are paramount to the preparation of the polyethylene composition and teaches that hydrogen pressure can be raised or reduced in the course of polymerisation to adjust the melt flow index of the polyethylene composition produced. The example of the patent in suit provides a set of specific reaction conditions that can be used as a starting point to perform the preparation of the claimed polyethylene compositions. The fact that the melt flow index of the composition produced in that example (1.09 dl/g according to the appellant and not contested by the respondents) is slightly outside the claimed range (1.2-2.1 dl/g) is not relevant to the question of sufficiency of disclosure since the skilled person had at his disposal a set of initial conditions sufficient to perform a three stage polymerisation of polyethylene

and had the knowledge that by raising the hydrogen pressure during the polymerisation he would increase the melt flow index. That effect is also confirmed by the comparison between the example of the patent in suit and example 3 of D1; a higher value of melt flow index was obtained in the patent in suit (1.09 dl/g as compared to 0.3 dl/g in D1) as a consequence of an hydrogen pressure which was higher in the course of the polymerisation process (8% instead of 4.1% in the second stage and 2.5% instead of 1.1% in the third stage). Thus, it cannot be concluded that the patent does not disclose the invention disclosed in claim 1 in a manner sufficiently clear and complete for it to be carried out by a person skilled in the art. Regardless any mathematical relationship existing between the values of melt flow index of the individual polyethylene components produced in the course of the three stage polymerisation, the skilled person was nonetheless able to determine the hydrogen pressure needed to arrive at a melt flow index (MFI_{190/5}) according to claim 1 on the basis of simple experimental observations, his common general knowledge and an acceptable amount of trial and error.

2.6 By contrast, the Board is of the view that the environmental stress cracking resistance defining the composition of claim 5 is not sufficiently disclosed to a skilled person. Claim 5 requires the environmental stress cracking resistance (FNCT) of the polyethylene composition to be in the range of 150 to 250 h together with specific values of the notched impact toughness ACN at -30°C and at +23°C. That property of the polyethylene composition is disclosed in paragraphs 17, 19 and 30 of the patent in suit. None of these paragraphs, however, contains a teaching that could indicate how the FNCT of polyethylene compositions was

adjusted or even which process parameters influenced that property in the composition. Even if D1 discloses polyethylene compositions for which the environmental stress cracking resistance was measured (Table 1; SCR or stress cracking resistance), that document does not contain a teaching on the parameters that influence this property of the composition either. The environmental stress cracking resistance of polyolefins is also cited in D5 (column 1, lines 40-45) albeit only in reference to high versus low molecular weight polymers and in the context of a balance between rigidity and environmental stress cracking resistance, so that no teaching can be derived therefrom that is relevant to the subject matter of claim 5 of the patent in suit. As a result, the skilled person does not find in the patent in suit the guidance needed to adjust the FNCT of the claimed polyethylene composition. This is all the more problematic as the condition on the FNCT being within a very specific range is coupled in claim 5 to two further conditions on other mechanical parameters being within specific ranges with no indication on how they could be adjusted and it comes in addition to the other conditions already defined in claim 1. In addition, the argument of the appellant that the purposive selection of the parameters disclosed in claim 1 and in claim 5 would necessarily lead to an FNCT within the range of claim 5 is not supported by the disclosure of the patent in suit and must therefore fail. Also, the prior art cited in appeal proceedings does not provide a teaching relating to the adjustment of the FNCT in polyethylene compositions. It must thus be concluded that the patent does not disclose the invention disclosed in claim 5 in a manner sufficiently clear and complete for it to be carried out by a person skilled in the art.

- 2.7 The Board concludes that the main request is not sufficiently disclosed.

First auxiliary request

3. Rule 80 EPC

The Board cannot follow the argument of the respondent 1 against the admissibility of the first auxiliary request under Rule 80 EPC on the grounds that there was no apparent reason to cancel claim 5 as far as the features of notched impact toughness were concerned. Considering the negative decision taken by the opposition division on claim 5 alone, the amendment of the main request consisting in the deletion of claim 5 is an amendment of the claims that can be seen as being occasioned by a ground of opposition under Article 100 EPC, in the present case of claim 5, Article 100(b) EPC, since the amendment is aimed at removing the cause of the negative decision. In this respect it is not relevant whether the objection could be overcome by more limited amendments not resulting in the complete deletion of the claim, as it is up to the proprietor to decide how to amend the patent in order to overcome an objection on a ground of opposition. The first auxiliary request therefore meets the requirements of Rule 80 EPC.

4. Sufficiency of disclosure

Since the claims of the first auxiliary request correspond to the claims of the main request from which claim 5 was deleted, it is concluded that on the basis of the first auxiliary request, the patent discloses the invention in a manner sufficiently clear and

complete for it to be carried out by a person skilled in the art.

5. Remittal

5.1 Sufficiency of disclosure was the only ground of opposition discussed at the oral proceedings before the opposition division and it was the only ground of opposition upon which a decision was taken. All the parties present to these appeal proceedings requested the remittal of the case to the opposition division for consideration of the further grounds of opposition that had been raised by the two opponents in their notices of opposition (lack of novelty and lack of inventive step - Article 100(a) EPC).

5.2 Although the EPC does not guarantee the parties an absolute right to have all the issues in the case considered by two instances, it is well recognised that any party may be given the opportunity of two readings of the important elements of a case. The essential function of an appeal is to consider whether the decision issued by the first-instance department is correct. Hence, a case is normally referred back if essential questions regarding the patentability of the claimed subject-matter have not yet been examined and decided by the department of first instance (Article 111(1) EPC).

5.3 Taking all these facts into account including in particular the common request of all parties, the Board considers a remittal of the case to the opposition division for further prosecution as appropriate.

Order

For these reasons it is decided that:

1. The decision under appeal is set aside.
2. The case is remitted to the opposition division for further prosecution on the basis of the first auxiliary request, filed with the statement setting out the grounds of appeal.

The Registrar:

The Chairman:



B. ter Heijden

D. Semino

Decision electronically authenticated