

Internal distribution code:

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

**Datasheet for the decision
of 20 January 2021**

Case Number: T 0319/18 - 3.3.03

Application Number: 12707346.8

Publication Number: 2683771

IPC: C08L23/12, B29C45/00, B65D1/02,
C08L23/14

Language of the proceedings: EN

Title of invention:
POLYOLEFIN-BASED CONTAINERS

Patent Proprietor:
Basell Poliolefine Italia S.r.l.

Opponent:
Borealis AG

Relevant legal provisions:
EPC Art. 56
RPBA Art. 12(2)
RPBA 2020 Art. 12(3), 13(1), 13(2), 25(1), 25(3)

Keyword:
Inventive step - (no) - main request
Fifth auxiliary request - admitted - (no) - complete case not
presented with rejoinder; subsequent explanations not taken
into account - no "exceptional circumstances"

Decisions cited:

T 0596/08, T 0933/09, T 1752/09, T 1732/10, T 1533/13



Beschwerdekammern

Boards of Appeal

Chambres de recours

Boards of Appeal of the
European Patent Office
Richard-Reitzner-Allee 8
85540 Haar
GERMANY
Tel. +49 (0)89 2399-0
Fax +49 (0)89 2399-4465

Case Number: T 0319/18 - 3.3.03

D E C I S I O N
of Technical Board of Appeal 3.3.03
of 20 January 2021

Appellant:

(Opponent)

Borealis AG
IZD Tower
Wagramerstrasse 17-19
1220 Wien (AT)

Representative:

Lux, Berthold
Maiwald Patentanwalts- und
Rechtsanwaltsgesellschaft mbH
Elisenhof
Elisenstraße 3
80335 München (DE)

Respondent:

(Patent Proprietor)

Basell Poliolefine Italia S.r.l.
Via Pontaccio 10
20121 Milano (IT)

Representative:

LyondellBasell
c/o Basell Poliolefine Italia
Intellectual Property
P.le Donegani 12
44122 Ferrara (IT)

Decision under appeal:

**Decision of the Opposition Division of the
European Patent Office posted on 14 December
2017 rejecting the opposition filed against
European patent No. 2683771 pursuant to Article
101(2) EPC.**

Composition of the Board:

Chairman D. Semino
Members: M. C. Gordon
 A. Bacchin

Summary of Facts and Submissions

- I. The appeal lies from the decision of the opposition division posted on 14 December 2017 rejecting the opposition against European patent number 2 683 771.
- II. The patent was granted with a set of 7 claims, whereby claim 1 read as follows:

"A container comprising a polyolefin composition comprising:

- A) from 59 wt% to 84 wt%, of a propylene homopolymer having isotactic pentads (mmmm) measured with by [sic] ¹³C-NMR higher than 96%,
 - B) from 16 wt% to 41 wt%, of a copolymer of propylene and ethylene with from 30 wt% to 44wt%, of ethylene derived units;
- the sum A) + B) being 100;
the composition having an MFR L (Melt Flow Rate according to ISO 1133, condition L, i.e. 230°C and 2.16 kg load) comprised between 72 and 100 g/10 min."

Claims 2-6 were directed to preferred embodiments of the container of claim 1 and claim 7 to a process for the preparation of a container.

A notice of opposition against the patent was filed in which revocation of the patent on the grounds of Article 100(a) EPC (lack of novelty, lack of inventive step) was requested.

The following documents, *inter alia* were relied upon by the opponent:

D1: WO-A-2010/082943
D2: WO-A-2010/078485.

An objection of lack of novelty due to public prior use was raised, supporting documents being submitted. The further details of this objection are not relevant for the present decision.

III. According to the decision under appeal the subject-matter claimed was novel.

D1 did not disclose the required isotactic pentad content and the objection of lack of novelty due to public prior use was held not to have been proven.

Regarding inventive step in respect of D1 the distinguishing feature was the content of isotactic pentads. Whilst the skilled person could have modified the catalyst of D1 in order to achieve this, there was no incentive in D1 to do so in the expectation of achieving better impact properties.

IV. The opponent (appellant) filed an appeal against the decision, maintaining objections of lack of novelty in respect of D1 and the public prior use and objections of lack of inventive step in respect of the teachings of D1.

A further document:

D21: extract from the textbook "Polypropylene Handbook", Carl Hanser Verlag 2005

was submitted.

- V. The patent proprietor (respondent) replied to the appeal.

Together with the rejoinder five sets of claims forming first to fifth auxiliary requests were submitted.

Claim 1 of the fifth auxiliary request read as follows, differences compared to claim 1 as granted being indicated in **bold**:

"A container **for food** comprising a polyolefin composition comprising:

A) from **more than 67%** [*sic*] to **less than 81 wt%**, of a propylene homopolymer having isotactic pentads (mmmm) measured with by ¹³C-NMR higher than 96%,

B) from **more than 19%** [*sic*] to **less than 33 wt%** of a copolymer of propylene and ethylene with from **more than 35 wt% and less than 40 wt%**, of ethylene derived units;

the sum A) + B) being 100;

the composition having an MFR L (Melt Flow Rate according to ISO 1133, condition L, i.e. 230°C and 2.16 kg load) comprised between **73** and **92 g/10 min.**"

No explanation of the amendments made in the light of how these were directed to overcoming the objections raised in the statement of grounds of appeal was provided.

- VI. On 2 June 2020 the Board issued a summons to oral proceedings.

In a written communication according to Article 15(1)

RPBA 2020 the Board set out its preliminary view of the case.

The objections of lack of novelty with respect to D1 and in the light of the alleged public prior use were not found convincing.

Regarding inventive step it had to be decided whether D1 could be considered to represent the closest prior art. In the case that D1 were to be so considered, then it appeared that there was no evidence of a technical effect associated with the sole distinguishing feature, namely the mmmm pentad content. This would then have to be considered as an arbitrary modification, in particular in the light of the evidence of D2 demonstrating that the claimed range was not exceptional.

It was noted that the respondent had provided neither explanations nor argumentation in respect of the auxiliary requests, leading to the question of whether these were to be admitted to the proceedings.

- VII. With letter of 5 October 2020 the appellant made further submissions.
- VIII. With letter bearing the date 19 October 2020, submitted with electronic communication of 19 November 2020 the respondent provided information and arguments relating to the auxiliary requests.
- IX. With letter of 18 December 2020 the appellant took position on the submissions made in respect of the auxiliary requests.

X. Following a further round of submissions on procedural matters the Board informed the parties by communication of 11 January 2021 that the oral proceedings would be conducted, with the parties' agreement, as a "mixed mode" video conference.

XI. Oral proceedings were held before the Board on 20 January 2021.

At the commencement of the oral proceedings the appellant withdrew the objection of lack of novelty based on the disclosure of D1. The first to fourth auxiliary requests were not maintained by the respondent.

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

(a) Main request - inventive step

D1 could be seen as the closest prior art. The document addressed two main fields, namely food use and automotive applications. In respect of the former D1 related to containers and cups whereby cups were also a form of container. Regarding car parts, it was observed that in use these were exposed to low temperatures, under which circumstances low temperature impact properties were of significance. This in turn confirmed that the compositions of D1 exhibited low temperature impact resistance meaning that the teaching of D1 was aligned with and relevant to the technical problem underlying the patent in suit.

The distinguishing feature was the pentad content of the homopolymer phase.

The data of the patent did not show any effect to arise from this feature. Thus the objective problem had to be formulated as the provision of an alternative or further composition. This problem had been solved by defining - on the strength of the available evidence arbitrarily - a pentad content for the composition. It was known from general knowledge of the field, for example Handbook D21, that such pentad contents could routinely be obtained with the type of catalyst employed in D1.

(b) Fifth auxiliary request - admittance

The Rules of Procedure required that the complete case be presented with the statement of grounds of appeal and the reply thereto. However all that the respondent had done was to indicate the amendments made but with no indication of how these were directed to overcoming the objections raised in the statement of grounds of appeal. Nor was it made credible that the amendments were self-explanatory in the light of the objections raised such that no further elucidation was needed.

The explanation subsequently provided with submission received 19 November 2020 was filed only after the summons to oral proceedings and, since no exceptional circumstances according to Article 13(2) RPBA 2020 had been shown to exist it was not to be taken into account. The fact that the amendment constituted a combination of granted claims was not enough to satisfy the requirements of Article 13(2) RPBA 2020.

XIII. The arguments of the respondent, insofar as relevant to the decision, can be summarised as follows:

(a) Main request - inventive step

D1 did not represent the closest prior art. The patent was directed to the provision of containers for refrigerated and frozen products, i.e. to containers which were necessarily employed in a low temperature environment. D1 was of far more general scope whereby food containers were but one of a number of possible uses to which the compositions could be put. The reference to automotive components as an example of low temperature use was not particularly relevant in the context of the technical field of the patent.

To the extent that D1 were considered to represent the closest prior art it was confirmed at the oral proceedings that no further submissions on inventive step would be made.

(b) Fifth auxiliary request - admittance

It was acknowledged that the explanations of the purpose of the amendments had been filed late. However the amendments were self-explanatory consisting of a limitation of the subject-matter of claim 1 to the subject-matter of a number of dependent claims as granted. It was stressed that the request itself had remained unchanged since its filing at the outset of the appeal procedure. Merely the explanation thereof had been filed subsequently.

- XIV. The appellant requested that the decision under appeal be set aside and that European patent No. 2 683 771 be revoked.
- XV. The respondent requested that the appeal be dismissed. In the alternative it requested that the decision under appeal be set aside and the patent be maintained on the basis of the fifth auxiliary request, as filed with the rejoinder to the statement of grounds of appeal.

Reasons for the Decision

1. Main request

1.1 Novelty

An objection of lack of novelty in respect of D1 was withdrawn at the outset of the oral proceedings.

Accordingly the finding of the decision under appeal that the subject-matter claimed was distinguished from the disclosure of D1 by the specified isotactic pentad content is not challenged.

Regarding the objection of lack of novelty in respect of a public prior use, in view of the following, it is not necessary for the Board to take a decision on this matter.

1.2 Inventive step

1.2.1 Technical field of the patent

According to claim 1 the patent in suit is directed to

a container comprising a polyolefin composition as defined. There is no feature in the claim which restricts the nature of the container in terms of its form, configuration, other properties or intended use.

According to paragraph 1 of the patent the invention:

"relates to containers, particularly containers for food, that can be advantageously used for refrigerated or frozen food".

This range of uses, i.e containers in general as well as more specifically for food and refrigerated/frozen food is repeated in paragraphs 8 and 9.

Thus, contrary to the position taken by the respondent the patent is directed to containers in general but is not limited either by the claims or the description specifically to containers for low temperature storage of foods, whether refrigerated or frozen.

This means that in identifying the document representing the closest prior art it is neither necessary nor appropriate to impose any particular restrictions in terms of the nature or properties of the container for example in terms of its suitability for particular fields of use such as refrigerated or frozen foods.

1.2.2 Closest prior art - suitability of D1

D1 is directed according to the title to a high melt flow propylene impact copolymer and a method for producing the same.

The major part of the document is related to the

process for producing the material.

Potential uses are discussed in paragraph 125 which emphasises as the two principal fields:

- automotive interior parts where low volatiles content is required;
- food contact applications such as cups and containers.

In the following sentence use for "many ordinary molded articles" and "general purpose articles" is additionally mentioned.

Thus D1 teaches two principal fields of use one of which is cups and containers for food. Hereby it is to be noted that cups are also a class of container.

This means that both D1 and the patent in suit relate generally to containers for food use.

Consequently the contention of the respondent that D1 does not relate to the same problem or technical field as the patent in suit is not correct.

This in turn means that D1 is suitable to serve as the closest prior art.

1.2.3 Distinguishing feature

It is not (no longer - see above) disputed that the subject-matter of operative claim 1 is distinguished from the disclosure of D1 by the defined isotactic pentad content.

1.2.4 Technical effect

The compositions of the sole inventive example and the two comparative examples of the patent all have the same pentad content (>96%) which is within the scope of the claims. Accordingly the examples are not suitable to show whether any technical effect is associated with the distinguishing feature.

This finding was not contested by the respondent.

1.2.5 Objective technical problem, its solution

Under these circumstances the only technical problem that can be formulated is the provision of further compositions based on those of D1.

The solution to this problem was the specification of an - on the strength of the available evidence - arbitrary value for the isotactic pentad content of the polypropylene homopolymer phase.

1.2.6 Obviousness

Handbook D21 provides a survey of the history of Ziegler-Natta catalysts. According to Table 2.1 on page 18, values of mmmm pentad content extending into the range claimed have been available since 1980.

Furthermore D2 relates to similar heterophasic polypropylene compositions to those of the patent. According to all of examples A-C thereof the propylene homopolymer had isotactic pentad contents above 96%, i.e. within the claimed range.

The references D21 and D2 thus demonstrate that the

value specified for the distinguishing feature is not exceptional but on the contrary is routinely obtained for such compositions.

The specification of a conventional value for a property of the composition of D1 constitutes an obvious and hence non-inventive solution to the problem of providing further compositions.

Consequently an inventive step is denied.

2. Fifth auxiliary request - admittance

The fifth auxiliary request, which had already been filed in opposition proceedings, was submitted with the rejoinder to the statement of grounds of appeal. Claim 1 of this request had been limited essentially by combining features of granted claims 2, 3 and 4.

The only explanation provided in said rejoinder was an indication of the claims of the granted patent from which the features had been derived. However no reasons were provided explaining why the amendments had been made and how they were intended to overcome the objections raised by the appellant.

An explanation was provided with the letter bearing the date 19 October 2020, received on 19 November 2020, after the Board had indicated in its preliminary opinion the lack of motivation with respect to the auxiliary requests.

2.1 Article 12(3) RPBA 2020 analogously to Article 12(2) RPBA 2007, which was the applicable provision at the time the rejoinder was filed, requires that the parties to appeal proceedings set out their complete case in

their initial submissions (statement of grounds of appeal and reply thereto). With respect to the filing of a new set of claims it is necessary to explicitly state the extent to which the amendments overcome the objections on which the decision under appeal was based and/or were raised by the opponent (see e.g. T 933/09, reasons 7; T 1533/13, reasons 1.6.2).

Unless the purpose of the amendments in respect of overcoming the prevailing objections is self-explanatory, in the situation where reasons explaining why the new claims overcome the outstanding objections are filed after the statement of grounds of appeal or the reply, these reasons constitute an amendment to the party's appeal case, which may be admitted into the proceedings only at the discretion of the Board.

According to Article 13(2) RPBA 2020, which is applicable in the present case under Article 25(1) and (3) RPBA 2020, amendments to a party's case made after notification of oral proceedings are not to be taken into account unless exceptional circumstances, justified by cogent reasons exist.

- 2.2 In the present case, the mere fact that the fifth auxiliary request was formally filed during the opposition procedure does not automatically render it part of the appeal case, since its admission had not been examined by the opposition division, due to the fact that the patent was maintained as granted.

As acknowledged by the respondent at the oral proceedings, the substantiation requirement of Article 12(2) RPBA 2007 was not complied with in respect of any of the auxiliary requests at the time when the reply to the statement of grounds of appeal was filed.

2.3 The respondent submitted that the purpose and effect of the present amendment was self-explanatory in the light of the findings of the decision and/or the submissions made by the appellant, such that no further elucidation was required.

However the respondent was unable to demonstrate that this condition applied. The Board considers that the amendments made are not self-explanatory in the sense that it is immediately apparent how they are directed to overcoming the inventive step objection over document D1. On the contrary they do not *prima facie* change the relevance of the examples in the patent (with respect to the examples in D1), which were found not sufficient to acknowledge the presence of an effect and therefore an inventive step over document D1 for the main request, so that the same objections would appear to apply to the fifth auxiliary request. As submitted by the appellant, it is also not evident why claim 2 as granted had been incorporated in claim 1 of the fifth auxiliary request, nor whether this constitutes an actual limitation of the subject-matter *versus* the prior art, since D1 already mentions containers for food.

It is established jurisprudence of the Boards of Appeal that requests that are not self-explanatory become effective only at the date on which they are substantiated (see e.g. T 1732/10, point 1.5 of the reasons).

This conclusion is not changed by the fact that the amendments consisted in the combination of granted claims.

Indeed the Board in agreement with the case law cannot follow the respondent's argument that the amendment is as such admissible as it merely constitutes a combination of granted claims (see e.g. T 1752/09, reasons 3.3 and T 569/08, headnote). Therefore also a mere combination of granted claims, which, as in the present case in the light of the particular objections raised, is not self-explanatory, does not satisfy the requirements of Article 12(2) RPBA 2007.

- 2.4 Consequently, the new submissions provided on 19 November 2020 constitute an amendment to the respondent's appeal case compared to that set out in the initial pleadings, the admission of which is subject to the discretion of the Board (Article 13(2) RPBA 2020).

In this context the respondent has not argued that "exceptional circumstances, justified by cogent reasons" for the late filing existed, nor can the Board identify any such circumstances.

- 2.5 In particular the Board's preliminary opinion cannot be regarded as a justification for the late substantiation of the auxiliary request, since it merely indicated the Board's non-binding view on the objections of lack of inventive step over D1 raised by the appellant in the statement of grounds of appeal and did not raise any new issues (see in particular point 7.2 of the communication). Thus there had been no change in the subject of the proceedings after the filing of the statement of grounds of appeal and the replies thereto.
- 2.6 In view of all the preceding considerations, the Board exercises its discretion not to take the fifth auxiliary request into consideration.

Order

For these reasons it is decided that:

1. The decision under appeal is set aside.
2. The patent is revoked.

The Registrar:

The Chairman:



B. ter Heijden

D. Semino

Decision electronically authenticated