

Internal distribution code:

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

**Datasheet for the decision
of 14 February 2023**

Case Number: T 1251/19 - 3.2.07

Application Number: 05821506.2

Publication Number: 1827797

IPC: B29C49/20, B29C51/12,
B60K15/03, B29L22/00, B29L31/30

Language of the proceedings: EN

Title of invention:

METHOD FOR MANUFACTURING A PLASTIC FUEL TANK WITH IMPROVED
CREEP STRENGTH

Patent Proprietor:

Plastic Omnium Advanced Innovation and Research

Opponent:

Kautex Textron GmbH & Co. KG

Headword:

Relevant legal provisions:

EPC Art. 113(1), 116(1), 123(2), 54
RPBA Art. 12(4)
RPBA 2020 Art. 15(1), 12(8)

Keyword:

Decision in written proceedings after withdrawal of all requests for oral proceedings
Main request and auxiliary request 1 - amendments - added subject-matter (yes)
Auxiliary request 2 - novelty - (yes)

Decisions cited:

Catchword:



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 1251/19 - 3.2.07

D E C I S I O N
of Technical Board of Appeal 3.2.07
of 14 February 2023

Appellant: Plastic Omnium Advanced Innovation and Research
(Patent Proprietor) Rue de la Fusée, 98-100
1130 Bruxelles (BE)

Representative: LLR
11, boulevard de Sébastopol
75001 Paris (FR)

Appellant: Kautex Textron GmbH & Co. KG
(Opponent) Kautexstr. 52
53229 Bonn (DE)

Representative: Richly & Ritschel Patentanwälte PartG mbB
Postfach 100411
51404 Bergisch Gladbach (DE)

Decision under appeal: **Interlocutory decision of the Opposition
Division of the European Patent Office posted on
4 April 2019 concerning maintenance of the
European Patent No. 1827797 in amended form.**

Composition of the Board:

Chairman I. Beckedorf
Members: A. Beckman
V. Bevilacqua

Summary of Facts and Submissions

- I. Both the patent proprietor and the opponent lodged an appeal within the prescribed period and in the prescribed form against the decision of the opposition division to maintain European patent No. 1 827 797 in amended form.
- II. The opposition was directed against the patent in its entirety and was based on all grounds for opposition pursuant to Article 100(a) to (c) EPC.
- III. In the present decision reference is made to the following documents:
- D1: DE 102 31 866 A1 and
D2: DE 2 256 945 A.
- IV. The opposition division found
- that the subject-matter of claim 1 of the main request did not meet the requirements of Article 123(2) EPC,
 - that the subject-matter of claim 1 of auxiliary request 1 did not meet the requirements of Article 123(2) EPC,
 - that the subject-matter of claim 1 of auxiliary request 2 met the requirements of Article 123(2) EPC, but was not novel over the disclosure of D2,
 - that the subject-matter of auxiliary request 3 did not meet the requirements of the EPC, whereas
 - the patent as amended according to auxiliary request 4 fulfilled the requirements of the EPC.
- V. In preparation for oral proceedings, scheduled at the parties' requests, the Board gave its preliminary

assessment of the case by means of a communication pursuant to Article 15(1) RPBA 2020 dated 3 February 2022. The Board indicated that the appeal of the opponent was likely to be dismissed, whereas the patent proprietor's appeal was likely to be partly allowed.

- VI. The opponent responded in substance to the Board's communication with letter dated 14 November 2022. With letter dated 9 February 2023, the opponent withdrew their request for oral proceedings and indicated not to attend the oral proceedings.

The patent proprietor filed a response with letter dated 10 February 2023. With letter dated 13 February 2023, also the patent proprietor withdrew their request for oral proceedings and informed the Board of their intention not to attend the oral proceedings.

- VII. The patent proprietor (appellant) requested

that the decision under appeal be set aside and that the patent be maintained in amended form on the basis of one of the sets of claims filed as main request and auxiliary requests 1 to 12 in opposition proceedings,

wherein the main request and auxiliary requests 1 to 4 were decided upon in the decision under appeal, whereby auxiliary request 4 was held by the opposition division to meet the requirements of the EPC.

The opponent (appellant) requested

that the decision under appeal be set aside and that the patent be revoked, and additionally,

that the decision of the opposition division to refuse the request for a different apportionment of the costs be set aside and that the costs of the second oral proceedings in opposition proceedings be awarded to the patent proprietor.

In the event that the auxiliary requests 5 to 12 become relevant or in the event that the Board comes to the conclusion that the main request or the auxiliary request 1 fulfils the requirements of Article 123(2) EPC, the opponent requested

that the case be remitted to the opposition division.

VIII. Claim 1 of the main request reads as follows:

"Method for manufacturing a plastic fuel tank with improved creep strength, whereby:

- a) a plastic parison comprising two distinct parts (1,2) is inserted into an open two cavity mould;
- b) a core is inserted inside the parison, the said core bearing at least part of a reinforcing element (3) capable of securing, meaning creating a link between, the two distinct parts of the parison (1,2);
- c) the parison is pressed firmly against the mould cavities by blowing through the core and/or creating suction behind the cavities;
- d) the reinforcing element (3) or a part of the reinforcing element is fixed to at least one of the distinct parts of the parison (1,2) using the core;

- e) the core is withdrawn;
- f) the mould is closed again, bringing its two cavities together in such a way as to grip the two parts of the parison (1,2) around their periphery in order to weld them together;
- g) a pressurized fluid is injected into the mould and/or a vacuum is created behind the mould cavities in order to press the parison firmly against the mould cavities;
- h) the mould is opened and the tank is extracted, wherein:
 - the mould cavities are closed on to the core -i.e. delimit a sealed region on either side of the core- during steps c) and d), these cavities bearing the parison, the core being in contact with the parison which is therefore sandwiched between the core and the mould cavities; and
 - the two distinct parts of the parison of the tank are connected by the reinforcing element or by a part of the reinforcing element during step f) or after step h)."

IX. Claim 1 of auxiliary request 1 differs from claim 1 of the main request in that the following features have been added at the end of claim 1:

"the connection after step h) being realized when the reinforcing element is chosen among a functional element which is voluminous enough to extend from one wall to the other or at least one rod made in two parts equipped with a clip-fastening device, the parts, not clip-fastened to one another, being fixed facing one another on a part of the parison each."

X. Claim 1 of auxiliary request 2 differs from claim 1 of auxiliary request 1 in that the following features have been added at the end of claim 1:

"and the shrinkage of the tank after release from the mould being enough for the two parts to clip-fasten of their own accord and/or external pressure being applied to the walls of the tank in order to perform/enhance the clip-fastening."

XI. As auxiliary requests 3 to 12 do not form part of this decision, it is unnecessary to reproduce their wording here.

XII. The lines of argument of the parties are dealt with in detail in the reasons for the decision.

Reasons for the Decision

1. Procedural matters

1.1 The present proceedings are governed by the revised version of the Rules of Procedure which came into force on 1 January 2020 (Articles 24 and 25(1) RPBA 2020), except for Article 12(4) to (6) RPBA 2020 instead of which Article 12(4) RPBA 2007 remains applicable (Article 25(2) RPBA 2020).

1.2 The present decision is taken in written proceedings without holding oral proceedings. Both parties were informed of the Board's preliminary opinion that the decision under appeal could be set aside and that the patent could be maintained in amended form on the basis of the set of claims filed as auxiliary request 2.

After both parties had withdrawn their requests for oral proceedings (Article 116(1) EPC), none of the parties filed any further substantive submission.

- 1.3 The principle of the right to be heard according to Article 113(1) EPC has been observed since the parties' submissions have been fully taken into account. In view of the fact that the case is ready to be decided on the basis of the reasoned findings of the opposition division and of the parties' written submissions, the Board cancelled the oral proceedings arranged for 14 February 2023 and issues this decision in written proceedings on the basis of the parties' mutual written submissions, which also includes the opponent's letter of 14 November 2022. The withdrawal of the parties' requests for oral proceedings, however, does not give rise to reimbursing the appeal fee because it was declared after the expiry of the time-limit provided for in Rule 103(4) (c) EPC.

2. *Main request - Article 123(2) EPC*

- 2.1 The following points were all considered by the Board in its preliminary opinion (point 8 thereof), to which neither party substantively responded by filing counter-arguments. The Board therefore sees no reason to deviate from its original opinion, but confirms it as expressed in points 2.2 to 2.7 below.
- 2.2 The patent proprietor contested the reasoned finding of the decision under appeal that the requirements of Article 123(2) EPC with respect to the feature of claim 1 of the main request that

"the two distinct parts of the parison of the tank are connected by the reinforcing element or by a part of

the reinforcing element during step f) or after step h)"

were not fulfilled (see decision under appeal, pages 4 to 5).

- 2.3 With their statement of grounds of appeal the patent proprietor argued that the decision was incorrect, as the application as originally filed clearly taught, with supporting examples, to provide the contested feature according to the claimed method. According to the patent proprietor this feature was directly and unambiguously derivable from the application as originally filed, in particular from the other features present in claim 1. In addition to the disclosure in the general context of the invention, it was disclosed in the numerous examples listed and referred to in their argumentation (see patent proprietor's statement of grounds of appeal, pages 4 to 8).
- 2.4 The Board is not convinced by the patent proprietor's argumentation. It is established case law of the Boards of Appeal that the content of an application cannot be considered to be a reservoir from which features pertaining to separate embodiments of the application can be combined in order to create a particular embodiment. A specific embodiment must be directly and unambiguously derivable from the application as originally filed (see CLB, *supra*, II.E.1.6.1).
- 2.5 It therefore needs to be assessed whether the application as a whole, directly and unambiguously, discloses an embodiment having the combination of features of claim 1.

2.6 The Board therefore follows the opponent that the examples cited by the patent proprietor cannot support the subject-matter of claim 1 since these examples either do not describe the connection of the parison by the reinforcing element or by a part of the reinforcing element in combination with a particular step of claim 1 or merely relate to different embodiments (see opponent's reply, point 2.1.1).

In this respect, contrary to the patent proprietor's view, it is to be acknowledged that the passages on page 8, lines 3 to 13, of the application as originally filed provide no basis for the contested feature that the two distinct parts of the parison of the tank are connected by a part of the reinforcing element during step f), as indicated by the opponent (see opponent's reply, point 2.1.1, middle of page 3).

Hence, none of the passages or examples of the application as originally filed presented by the patent proprietor in support of their argumentation discloses directly and unambiguously the contested feature as such and the subject-matter of claim 1, *i.e.* an embodiment having the combination of features of claim 1.

2.7 Thus, the patent proprietor did not convincingly demonstrate that the decision under appeal was incorrect in that the subject-matter of claim 1 of the main request does not fulfil the requirements of Article 123(2) EPC.

3. *Auxiliary request 1 - Article 123(2) EPC*

3.1 The following points were all considered by the Board in its preliminary opinion (point 9 thereof), to which

neither party substantively responded by filing counter-arguments. The Board therefore sees no reason to deviate from its original opinion, but confirms it as expressed in points 3.2 to 3.6 below.

- 3.2 The opposition division found that the subject-matter of claim 1 of auxiliary request 1 did not meet the requirements of Article 123(2) EPC since claim 1 of auxiliary request 1 does not define that shrinkage or external pressure is applied, as disclosed in claim 9 or on page 8, lines 7 to 9, of the application as published (see decision under appeal, page 8, 4th paragraph).
- 3.3 The patent proprietor contested the finding of the opposition division and argued that the feature added to claim 1 of auxiliary request 1 with respect to claim 1 of the main request was based *inter alia* on the passage on page 9, lines 15 to 18, of the application as published describing the possibility of using a rod made in two parts. This passage did not foresee any chronology for the clipping of the two parts of the rod. Furthermore, even if the addition in claim 1 was based on claim 9 or on the passage on page 8 lines 3 to 10, of the application as originally filed, the two clipping possibilities were implicitly present in claim 1. In the case of clipping after step h), this clipping could only take place in one of two ways: either it took place on its own, or an external intervention (by an operator or a machine) allowed this clipping. Consequently, these two possibilities were implicitly present in claim 1 (see statement of grounds of appeal, pages 23 to 24).
- 3.4 The Board is not convinced by the patent proprietor's argumentation. It is established jurisprudence that it

is normally not allowable to base an amended claim on the extraction of isolated features from a set of features originally disclosed only in combination, e.g. a specific embodiment in the description (see CLB, *supra*, II.E.1.9).

3.5 The patent proprietor does not show any passage or embodiment in the application as originally filed indicating that the specific method steps of applying shrinkage or external pressure are not disclosed solely in combination with the other features of claim 1 and that, thus, these method steps could be construed as optional in the claimed method.

3.6 Hence, the patent proprietor did not convincingly demonstrate that the decision under appeal was incorrect in that the subject-matter of claim 1 of the auxiliary request 1 does not fulfil the requirements of Article 123(2) EPC.

4. *Auxiliary request 2*

4.1 *Article 123(2) EPC*

4.1.1 The following points were all considered by the Board in its preliminary opinion (point 10.1 thereof), to which neither party substantively responded. The Board therefore sees no reason to deviate from its original opinion, but confirms it as expressed in points 4.1.2 to 4.1.6 below.

4.1.2 The opponent contested the finding of the opposition division that claim 1 meets the requirements of Article 123(2) EPC and argued that on page 8, lines 3 to 10, of the application as originally filed it was only disclosed that the "rods", *i.e.* not the

"reinforcing elements", may consist of two parts. It was not originally disclosed that they could consist of more than two parts. Furthermore, "rods" were specific embodiments of "reinforcing elements", and it was not disclosed in the original description that the embodiments on page 6, line 34 to page 8, line 2, and on page 8, lines 11 to 18, relating to "rods" also applied to "reinforcing elements" (see opponent's statement of grounds of appeal, point 4.1).

- 4.1.3 The Board follows the patent proprietor's view that the objection under Article 123(2) EPC with respect to the term "parts of reinforcing element" was not raised in the opposition proceedings. The Board cannot share the opponent's view that this objection is discussed on page 10, 5th and 6th paragraph, of the decision under appeal (see letter of 24 March 2020, point 2.2.2), since this part of the reasons of the decision under appeal is directed to the discussion of Article 84 EPC. Thus, the Board follows the patent proprietor's view that the opponent's objection under Article 123(2) EPC has not been subject of the decision under appeal.
- 4.1.4 Since this objection has not been subject of the appealed decision, its admittance into the appeal proceedings depends on the Board's discretion under Article 12(4) RPBA 2007.
- 4.1.5 As the opponent does not give any justifying reasons why this new objection is submitted for the first time in appeal proceedings, the Board cannot admit it into the proceedings pursuant to Article 12(4) RPBA 2007 and in compliance with the patent proprietor's corresponding request (see patent proprietor's reply, page 2, 1st paragraph).

4.1.6 Since the opponent does not raise any admissible objection under Article 123(2) EPC and does not point out any incorrectness of the appealed decision under Article 123(2) EPC with respect to auxiliary request 2, the Board follows the finding of the opposition division that the subject-matter of claim 1 of the auxiliary request 2 fulfils the requirements of Article 123(2) EPC (see decision under appeal, page 11, 4th paragraph).

4.2 *Novelty - Article 54 EPC*

The opponent alleged that the subject-matter of claim 1 of the auxiliary request 2 was not novel over the disclosure of either D1 or D2 (see opponent's statement of grounds of appeal, point 4.2).

4.2.1 *Novelty vis-à-vis D1*

The following point was considered by the Board in its preliminary opinion (point 10.2.1 thereof), to which neither party substantively responded. The Board therefore sees no reason to deviate from its original opinion, but confirms it as expressed in point 4.2.1 below.

The opponent brought forward that D1 (paragraphs [0029] and [0039]) was novelty-destroying for the subject-matter of claim 1.

The Board cannot deduce from the opponent's argumentation that D1 discloses all the features of claim 1 and follows the patent proprietor's argumentation that D1 does at least not show steps b) and d) of claim 1 (see patent proprietor's statement of

grounds of appeal, page 15; reply, page 1, last paragraph).

The subject-matter of claim 1 is therefore new over the disclosure of D1.

4.2.2 *Novelty vis-à-vis D2*

The patent proprietor contested the finding of the opposition division that the subject-matter of claim 1 lacked novelty in view of the disclosure of D2.

The decision under appeal found that the method defined in claim 1 lacked novelty based on the consideration that claim 1 is merely related to a method for manufacturing tanks, while the stated use "for manufacturing a plastic fuel tank" was considered as not limiting the claimed method (see decision under appeal, page 12).

The opponent put forward that D2 (Figures 1 to 6; page 2, 5th paragraph; page 5, last paragraph; page 6, 2nd paragraph; page 7, 3rd Paragraph; end of page 9 to page 10, 1st paragraph) was novelty-destroying for the subject-matter of claim 1 (see opponent's statement of grounds of appeal, point 4.2; opponent's reply, point 2.3; and opponent's letter dated 14 November 2022, point 4.2). According to its title, D2 was already directed to a process for blow molding plastic articles and thus disclosed a tank within the meaning of claim 1 (see opponent's reply, point 2.1.2.1). The opponent further argued that a product manufactured by the method according to claim 1 was already to be regarded as a tank within the meaning of claim 1. Claim 1 did not define that certain features, such as certain plastic material or "tank-type" devices of some kind,

must be present. A product manufactured according to the features of claim 1 is therefore a tank. According to the wording of claim 1 step h) "the mould is opened and the tank is extracted" these steps and features are sufficient to obtain a tank within the meaning of claim 1. Therefore, any additional features not mentioned in claim 1 could not constitute the character of a tank (see opponent's letter dated 14 November 2022, point 4.2).

The Board is not convinced by the opponent's argumentation, since the subject-matter of claim 1 is directed to a method for manufacturing a plastic fuel tank and not to a product manufactured by the method according to claim 1.

Contrary to the decision under appeal and to the opponent's argumentation, the Board follows the patent proprietor's view (see patent proprietor's statement of grounds of appeal, point III.1).

Claim 1 defines a method for manufacturing a plastic fuel tank. Claim 1 is directed to a method and thus belongs to the category of method or process claims that define their subject-matter in terms of physical activities (*cf.* G2/88, Reasons 2.2).

According to the established case law, where a claim is directed to a method, the use feature is a functional method feature comparable in category with the other features (steps) of the method. Where the stated purpose defines the specific application of the method, it requires certain additional steps which are not implied by or inherent in the other remaining steps defined in the claim, and without which the claimed method would not achieve the stated purpose. Thus, the

stated purpose represents a genuine technical limitation of the method and the claimed method must be applied in that manner (CLB, *supra*, I.C.5.2.5).

In the case at hand, a method for manufacturing a plastic fuel tank encompasses a functional step of the method, *i.e.* the claimed purpose "for manufacturing a plastic fuel tank" requires that the method actually be carried out by manufacturing a plastic fuel tank. The claimed purpose defines the specific application or use of the method, and such application or use in itself represents a limitation of the method.

D2 generally relates to the plastics molding art, and more specifically to a method of molding hollow articles of thermoplastic material (D2, page 1, 1st paragraph). In D2 there is no mention of use for manufacturing a plastic fuel tank.

Hence, since D2 does not disclose a method for manufacturing a plastic fuel tank, the subject-matter of claim 1 is novel over the disclosure of D2.

5. *Apportionment of costs*

5.1 The following points were all considered by the Board in its preliminary opinion (point 13 thereof), to which neither party substantively responded. The Board therefore sees no reason to deviate from its original opinion, but confirms it as expressed in points 5.2 to 5.6 below.

5.2 The opposition division found that the conditions for granting an apportionment of costs were not satisfied since the conclusions drawn by the opposition division with respect to auxiliary request 2 could not be

anticipated. The different objections had to be addressed with respect to the right to be heard of both the patent proprietor and the opponent (see decision under appeal, end of page 18 to page 19).

- 5.3 The opponent argued that the decision was incorrect, as the patent proprietor did not fulfil their procedural duty of care. This at least reckless fault of the patent proprietor was also causally responsible for the adjournment of the oral proceedings. Therefore, it was equitable that - in particular as the completely new auxiliary requests 3 and 4 were only introduced into the proceedings on the second day of the oral proceedings - the costs incurred by the opponent were to be charged to the patent proprietor (see opponent's statement of grounds of appeal, point 15).
- 5.4 It is established jurisprudence that apportionment of costs is justified if the conduct of one party is not in keeping with the care required, that is if costs arise from culpable actions of an irresponsible or even malicious nature (see CLB, *supra*, III.R.2).
- 5.5 The Board is not convinced by the opponent's argumentation and follows the patent proprietor's view that the auxiliary requests submitted late during the oral proceedings were filed in response to objections held by the opposition division for the first time in the oral proceedings, wherein the auxiliary request 3 was filed within the time limit set by the opposition division (see reply, point VI), as confirmed in the decision under appeal (see decision under appeal, end of page 13 to page 14, 1st paragraph). In respect of the fundamental principle of the right to be heard the opposition division admitted the auxiliary requests into the proceedings. The Board cannot identify any

irresponsible action of the patent proprietor prejudicing the timely and efficient conduct of oral proceedings or an abuse of procedure that would rectify the opponent's request. The late filing of the auxiliary requests was justified.

- 5.6 Hence, the Board disagrees that the cost should be apportioned differently for reasons of equity. The opponent's request for a different apportionment of costs is not granted.

6. *Conclusions*

While the patent proprietor did not convince the Board of the incorrectness of the opposition division's reasons finding that the main request and auxiliary request 1 contain added subject-matter contrary to the requirements of Article 123(2) EPC, the patent proprietor convincingly showed that the decision under appeal was incorrect in finding that the subject-matter of claim 1 of auxiliary request 2 was not novel, whereas the opponent has not convincingly demonstrated that the auxiliary request 2 is not allowable.

Since the opponent had not raised any other objections to the auxiliary request 2 than those discussed under point 4 above, the Board is in a position to decide on the present case and finds that the decision under appeal is to be set aside and that the patent is to be maintained in amended form on the basis of the set of claims according to auxiliary request 2.

Order

For these reasons it is decided that:

1. The appeal of the opponent is dismissed.
2. The decision under appeal is set aside.
3. The case is remitted to the opposition division with the order to maintain the patent with the following claims and a description to be adapted thereto:

Claims:

No. 1 to 9 according to the second auxiliary request received during oral proceedings of 7 March 2018.

The Registrar:

The Chairman:



G. Nachtigall

I. Beckedorf

Decision electronically authenticated