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**Datasheet for the decision
of 28 November 2023**

Case Number: T 1677/21 - 3.3.03

Application Number: 07862596.9

Publication Number: 2089466

IPC: C08K7/14, C08L77/00, B65D1/00

Language of the proceedings: EN

Title of invention:
POLYAMIDE HOUSINGS FOR PORTABLE ELECTRONIC DEVICES

Patent Proprietor:
DuPont Polymers, Inc.

Opponent:
Solvay Specialty Polymers USA, LLC

Relevant legal provisions:
EPC Art. 111(1), 113(1), 116(1) sentence 2, 19(2)
EPC R. 103(1) (a), 111(2)
RPBA 2020 Art. 11, 12(6)

Keyword:

Right to be heard - opportunity to comment (no) - substantial procedural violation (yes)

Reimbursement of appeal fee - equitable by reason of a substantial procedural violation (yes)

Late-filed evidence - should have been submitted in first-instance proceedings (no) - admitted (yes)

Remittal to the department of first instance (yes) - to be considered by a differently composed opposition division (no)

Decisions cited:

G 0005/91, T 1105/96, T 0071/99, T 0246/08, T 2475/17



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Case Number: T 1677/21 - 3.3.03

D E C I S I O N
of Technical Board of Appeal 3.3.03
of 28 November 2023

Appellant: DuPont Polymers, Inc.
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Respondent: Solvay Specialty Polymers USA, LLC
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Decision under appeal: **Decision of the Opposition Division of the
European Patent Office posted on 27 July 2021
revoking European patent No. 2089466 pursuant to
Article 101(3) (b) EPC.**

Composition of the Board:

Chairman D. Semino
Members: M. Barrère
A. Bacchin

Summary of Facts and Submissions

- I. The appeal of the patent proprietor lies against the decision of the opposition division revoking European Patent number 2 089 466.
- II. The following documents were *inter alia* cited in the decision of the opposition division:
- D7: JP-A-2006/045390
D7a: Machine translation of D7
D11: WO 2006/122602 A1
- III. The contested decision, as far as it is relevant to the present appeal, can be summarised as follows:
- requests for postponement of the oral proceedings were not allowed;
 - the subject-matter of granted claim 1 did not involve an inventive step over D11 in combination with D7a. The same conclusion applied to claim 1 of auxiliary requests III to XII;
 - auxiliary requests I and II were not admitted into the proceedings and the request to file a further auxiliary request was rejected.
- IV. The patent proprietor (appellant) filed an appeal against said decision. With the statement of grounds of appeal, the appellant filed five sets of claims as auxiliary requests 1 to 5.

V. With the rejoinder to the statement of grounds of appeal, the opponent (respondent) filed the following document:

D7b: Human translation of D7

VI. The parties were summoned to oral proceedings and a communication pursuant to Article 15(1) RPBA indicating specific issues to be discussed at the oral proceedings was then sent to the parties. In view of the preliminary opinion expressed therein, the parties were informed that the Board intended, *inter alia*, to remit the case to the opposition division for further prosecution and to order the reimbursement in full of the appeal fee (point 10.1 of the communication). The exact wording of the Board's preliminary intention is repeated below:

"... the Board intends to:

(i) set aside the contested decision,

(ii) admit document D7b into the proceedings and remit the case to the opposition division for further prosecution (see Article 116(1), second sentence, EPC referred to above under point 8.),

(iii) dismiss the appellant's request to order a change of the opposition division and

(iv) order the reimbursement in full of the appeal fee."

VII. With letter dated 27 October 2023, the appellant withdrew its request for oral proceedings under the condition that the Board maintains its preliminary

opinion, in particular that a written decision as summarised in point 10.1 of the Board's communication be issued.

VIII. By letter dated 16 November 2023, the respondent stated that they did not consider oral proceedings to be necessary if the Board were to issue a written decision in accordance with point 10.1 of said communication. Oral proceedings were requested only if the Board intended to deviate therefrom.

IX. In view of these letters the Board cancelled oral proceedings.

X. The requests of the parties, as resulting from the written submissions, were as follows:

(a) The appellant requested that the decision under appeal be set aside and that the patent be maintained as granted, or, in the alternative, that the patent be maintained in amended form on the basis of one of auxiliary requests 1 to 5 filed with the statement of grounds of appeal.

In addition, the appellant requested reimbursement of the appeal fee. In the event that the present case is remitted to the department of first instance, it was requested that an opposition division be entrusted, where all members who participated in the first instance proceedings were excluded.

(b) The respondent requested dismissal of the appeal.

The respondent further requested that:

document D7b be admitted into the proceedings and the appellant's request to entrust a different opposition division be rejected.

XI. Claim 1 as granted read as follows:

"1. A portable electronic device housing comprising a polyamide composition comprising a melt-mixed blend of (A) at least one thermoplastic polyamide and (B) at least one fibrous reinforcing agent having a non-circular cross section, wherein the thermoplastic polyamide is selected from the group consisting of polyamide 6,6; polyamide 4,6; polyamide 6,10; polyamide 6,12; polyamide 11; polyamide 12; polyamide 9,10; polyamide 9,12; polyamide 9,13; polyamide 9,14; polyamide 9,15; polyamide 6,16; polyamide 9,36; polyamide 10,10; polyamide 10,12; polyamide 10,13; polyamide 10,14; polyamide 12,10; polyamide 12,12; polyamide 12,13; polyamide 12,14; polyamide 6,14; polyamide 6,13; polyamide 6,15; polyamide 6,16; and copolymers and mixtures of these polymers, wherein the thermoplastic polyamide (A) comprises 30 to 75 weight percent of the polyamide composition."

The remaining granted claims as well as the claims of auxiliary requests 1 to 5 are not relevant to this decision.

XII. The appellant's submissions, in so far as they are pertinent to the present decision, may be derived from the reasons for the decision below. They were essentially as follows:

(a) Reimbursement of the appeal fee

The appeal fee should be refunded due to fundamental procedural violations, in particular in relation to the discussion on document D7a.

(b) Admittance of document D7b

D7b was late-filed and should not be admitted into the proceedings.

(c) Change of the composition of the opposition division

In the event of a remittal of the case to the department of first instance, the composition of the opposition division should be changed.

XIII. The respondent's submissions, in so far as they are pertinent to the present decision, may be derived from the reasons for the decision below. They were essentially as follows:

(a) Reimbursement of the appeal fee

The appellant should have studied in detail the content of document D7a before the oral proceedings.

(b) Admittance of document D7b

D7b should be admitted into the proceedings.

(c) Change of the composition of the opposition division

The composition of the opposition division should not be changed.

Reasons for the Decision

1. Decision in written proceedings
 - 1.1 The appellant withdrew its request for oral proceedings on the condition that a decision as summarised under point 10.1 of the Board's preliminary opinion is issued. The respondent requested oral proceedings only in case the Board intended to deviate therefrom.
 - 1.2 In its preliminary assessment of the case, which had been communicated to the parties, the Board has fully taken into account the parties' submissions. Since the Board, following its preliminary assessment, issues a decision as summarised under point 10.1 of the communication under Article 15(1) RPBA, the principle of the right to be heard according to Article 113(1) EPC has been observed without the need to hold oral proceedings.
2. Reimbursement of the appeal fee
 - 2.1 The appellant requests that the appeal fee be reimbursed because of fundamental procedural violations (see pages 18 to 20 of the statement of grounds of appeal). The reasons therefore are the following:
 - 2.1.1 Violation of the right to be heard (Article 113(1) EPC)

According to the appellant, the decision to revoke the patent is essentially based on the disclosure of D7 and in particular on the table in paragraph [0047]. However, said table is in Japanese and it was not

provided in an official language of the EPO. The appellant could therefore not be expected to understand the content of the table. Despite the requests of the appellant, the opposition division (i) did not postpone the oral proceedings and (ii) did not allow the appellant to file further auxiliary requests.

The denial of these requests amounted to a violation of the proprietor's right to be heard, in breach of Article 113(1) EPC.

2.1.2 Inadequate reasoning of the decision (Rule 111(2) EPC)

The decision of the opposition division refers to paragraphs [0044] to [0048] of D7a to conclude that "*example 1 of D7a has improved warpage/curvature, surface smoothness and impact strength as compared to comparative example 2*". The appellant holds that this conclusion cannot be derived from these paragraphs of D7a.

Therefore the opposition division drew a conclusion which is either completely wrong or based on hindsight, thereby contradicting Rule 111(2) EPC.

2.2 The respondent pointed out that D7a, a machine translation of D7, was filed with the notice of opposition. However, the patentee neither objected before the oral proceedings that D7a was not suitable for use in the opposition proceedings nor filed an improved translation of D7 with the statement of grounds of appeal. Furthermore, the respondent considers that the appellant could have presented their arguments with regard to D7/D7a during opposition proceedings.

2.3 Under Rule 103(1) (a) EPC, the appeal fee shall be reimbursed in full where the Board of Appeal deems an appeal to be allowable, if such reimbursement is equitable by reason of a substantial procedural violation.

The right to be heard is a fundamental procedural right intended to ensure that no party is caught unawares by reasons given in a decision turning down its request on which it has not had the opportunity to comment. A decision which fails to take into account the arguments submitted by a party and which is based on a ground on which the party had no opportunity to present its comments, contravenes Article 113(1) EPC and constitutes a procedural violation (see Case Law of the Boards of Appeal, 10th edition 2022, in the following "Case Law", V.A.11.6.8).

Likewise the obligation to provide adequate reasoning in a decision in accordance with Rule 111(2) EPC is closely linked to the principle of the right to be heard under Article 113 EPC. A failure to do so is to be considered a procedural violation justifying the reimbursement of the appeal fee (see Case Law, V.A. 11.6.9 and III.K.3.4.2). The reasoning given in a decision has to enable the appellant and the Board of appeal to examine whether the decision was justified or not (see Case Law, III.K.3.4.3 and 3.4.4). In contrast, whether the reasons provided are convincing or whether a misinterpretation of a prior art document was made has nothing to do with a *procedural* violation, but it rather constitutes an error of judgement, which as such does not provide a basis for the reimbursement of the appeal fee.

Furthermore, the seriousness of a procedural violation derives from its adverse effects. In particular, a violation must have played a decisive part in the decision in order to be considered substantial (see Case Law, V.A.11.6.2). A procedural violation which would not have led to a different outcome of the proceedings is not a substantial procedural violation.

- 2.4 The first question to be answered by the Board is whether under the present circumstances the right to be heard of the appellant was infringed and, if yes, whether it was decisive for the decision.

In this respect, the Board agrees with the appellant.

- 2.4.1 It is first noted that the patent was revoked essentially for lack of inventive step starting from D11 as the closest prior art in combination with D7a (see contested decision, page 24, point III.5.; page 25, point VI.4.; page 26, points VII.2. and VIII.2. etc.).

In the reasoning of the opposition division, a central consideration was that D7a taught that the warpage, impact strength and surface appearance of a reinforced polyamide composition could be improved by using flat glass fibers instead of circular glass fibers (see decision, page 24, first and second paragraphs). This consideration is based on the comparison between example 1 and comparative example 2 and is derived from paragraphs [0044] to [0048] of D7a (emphases here and below added by the Board). On this basis, the opposition division concluded that it was obvious for the skilled person to replace the circular glass fibers of D11 by flat glass fibers as suggested by D7a.

2.4.2 However, such an extensive consideration of the examples of D7a was not addressed in the opposition division's preliminary opinion, nor elsewhere in the written proceedings by any party, but was thoroughly taken into account in the decision and apparently only during the oral proceedings. The Board also agrees with the appellant that the alleged teaching of D7a cannot be derived from paragraphs [0044] to [0048]. It is in particular pointed out that these paragraphs are silent about any comparison between example 1 and comparative example 2. Instead, paragraphs [0048] merely compares example 1 to comparative example 1 which both contain flat glass fiber or comparative example 2 to comparative example 3 which both contain circular glass fiber. A comparison between flat and circular glass fibers is however not present in D7a.

2.4.3 In the Board's view, the reasoning of the opposition division can only be followed, i.e. example 1 can only be compared to comparative example 2, if the table on page 8 of D7 is actually taken into consideration. This table, which was explicitly referred to by the opponent during the oral proceedings, is, however, absent in D7a and therefore not available in English (see contested decision, page 9, point I.3.3 of the Reasons and D7a, paragraph [0047]). This table was also addressed for the first time during the oral proceedings. For these reasons, the decision is based on facts and evidence on which the patentee had had no opportunity to present their comments because the patentee could not be expected to provide comments before the oral proceedings and the relevant facts were not provided in an official language of the EPO. This constitutes a violation of the appellant's right to be heard.

2.4.4 As a consequence of this first procedural violation, a further violation of the proprietor's right to be heard was committed by refusing the request to postpone the oral proceedings and to admit further auxiliary requests (see decision under appeal, points I.3.3 and I.7.2 of the Reasons). This is particularly the case in view of the fact that the proprietor has been deprived of the possibility of filing further auxiliary requests before they have been filed and even before the auxiliary requests already filed have been examined. It is established jurisprudence of the Boards of appeal that a refusal of consent to amend made in advance of any amendment being submitted is an unlawful exercise of discretion pursuant to Rule 137(3) EPC and is *ipso facto* a substantial procedural violation (see e.g. T 0246/08, point 3 of the Reasons and T 1105/96, points 1 and 4 of the Reasons). Before a decision can be taken on an auxiliary request (therefore also on its admittance), the main request and all preceding auxiliary requests must be examined and decided upon as long as such preceding requests have not been withdrawn, and are therefore still pending.

In view of the fact that the content of the table in D7 was decisive for the assessment of lack of inventive step, and that this became apparent only at the oral proceedings, the proprietor should have been given sufficient time to prepare its arguments after having been provided with a translation of the relevant part of the document and to file further auxiliary requests.

2.4.5 Furthermore, contrary to the respondent's view, the Board does not hold that the patentee should have raised an objection with regard to D7a before the oral proceedings. Indeed, the relevance of the table of D7 was never mentioned in the written proceedings leading

to the decision, not even by the then opponent. The patentee had therefore no reason to raise any objection as to the translation of D7.

- 2.4.6 Eventually, it was not disputed between the parties that the assessment of inventive step based on D11 in combination with D7a played a decisive part in the decision to revoke the patent and that a different outcome of the proceedings would have resulted from a different assessment of that issue.
- 2.5 In these circumstances, the decision to revoke the patent is based on a ground on which the patentee has not had an adequate opportunity to comment or to amend the patent, in breach of Article 113(1) EPC, which constitutes a substantial procedural violation. The appellant was obliged to file this appeal to ensure a hearing of counter-arguments, so that reimbursement of the appeal fee in full is clearly equitable (Rule 103(1)(a) EPC).
- 2.6 In view of the above, it is not necessary to decide on the second alleged issue raised by the appellant, i.e. whether the decision was adequately reasoned (in accordance with Rule 111(2) EPC).
3. Admittance of document D7b
 - 3.1 D7b is a new item of evidence filed by the respondent with the rejoinder to the statement of grounds of appeal. Its admission to the proceedings, which is contested by the appellant, is subject to the discretionary power of the Board in accordance with Article 12 paragraphs (4) to (6) RPBA.

3.2 This document is a human translation of document D7 including the translation of the table in paragraph [0047].

3.3 The admittance of D7b is contested by the appellant for the following reasons (see letter dated 29 October 2022, page 4, point 2.3):

D7b should have been submitted during opposition proceedings (given that the machine translation D7a was incomplete);

the respondent did not explain why this document could not be provided earlier.

3.4 For the Board, it is clear that document D7b, the human translation of D7, was filed to meet the appellant's criticism that the machine translation D7a was incomplete, and in particular that the table in paragraph [0047] of D7 was not translated. Considering that the accuracy of the translation of D7a was never disputed during the earlier proceedings, the respondent had no reason to file a human translation of D7 during the proceedings before the opposition division. The Board is furthermore of the view that this document should also be admitted to the proceedings in order to allow a proper revision of the appealed decision on the point which led to the substantial procedural violation.

3.5 Under these circumstances, the Board finds it appropriate to exercise its discretion under Article 12(6) RPBA by admitting document D7b into the proceedings.

4. Remittal

Under Article 11 RPBA, the presence of a substantial procedural violation constitutes a special reason for remitting the case to the department of first instance for further prosecution according to Article 111(2) EPC.

In this regard it is noted that the parties have no right to further oral proceedings before the department of first instance on the same issues (Article 116(1) EPC, second sentence). Therefore as regards the granted claims, the conclusions of the opposition division regarding added subject-matter, sufficiency of disclosure and novelty are not to be revised by the opposition division.

5. Request to change the composition of the opposition division - Suspected partiality of the opposition division

5.1 The appellant requested that the composition of the opposition division be changed for the following reasons:

(a) the opposition division made a high number of procedural errors,

(b) the attitude of the opposition division was biased and

(c) the decision had already been made before the oral proceedings (see page 21, point 7 of the statement of grounds of appeal and letter dated 29 October 2022, pages 18 and 19).

5.2 In that respect the present Board preliminarily notes that while the boards have no formal power to decide the composition of the opposition division (see T 0071/99, Reasons 4), they may still do so in case of a clear procedural error as to the composition of the division under Article 19(2) EPC, or if, in the presence of a violation of the right to be heard, it is concluded that the composition is the real cause of the violation of the right to be heard, and that such violation can only be remedied by a change of composition, i.e. in particular in a case where there is a legitimate concern that one or more members of the first instance body are biased. However, the mere fact that the right to be heard has been violated is not sufficient to justify such a concern of an objective fear of partiality (see also T 2475/17, Reasons 3.1.5). It is further recalled that the requirement of impartiality applies in principle also to employees of the departments of the first instance of the EPO taking part in decision-making activities affecting the rights of any party (G 5/91, Headnote 1.).

5.3 With regard to the present case, the Board however fails to find any circumstance supporting the objection of the suspected partiality of the opposition division, either in consideration of its composition under Article 19 EPC or of the behaviour of its members (see also Case Law, V.A.11.6.12), and therefore agrees with the respondent (see point 2.8 of the rejoinder to the statement of grounds of appeal). Indeed the appellant did not raise any objection of suspected partiality during the opposition proceedings.

5.3.1 First, in the Board's view, the use of an untranslated part of D7 for the first time at the oral proceedings to deny an inventive step was the main error, which

resulted in the chain of violations of the appellant's right to be heard during the oral proceedings.

5.3.2 Secondly, the Board has no reason to hold that this main error was intentional or that the opposition division was biased. While it is true that the opposition division indicated on several occasions its preliminary opinion (see points 3.3.1 to 3.3.3 and 4.1.1. of the minutes), this is a common practice which is used to streamline the discussion and make the oral proceedings more efficient. In any case, in the absence of other facts supporting the opposite, this practice is not an indication that the opposition division had already taken a decision before the oral proceedings and was not prepared to change it. As a matter of fact, although the opposition division indicated its negative preliminary opinion as far as auxiliary requests III to XII were concerned, the minutes of the oral proceedings show that these requests were nevertheless discussed in detail from 18:27 until the end of exceptionally long oral proceedings at 21:38 (see minutes, points 7.5 to 17.2). Furthermore, as pointed out by the respondent, with the summons to oral proceedings the opposition division indicated that they considered D2 to take away the novelty of granted claim 1 but came to the opposite conclusion during the oral proceedings (see communication accompanying the summons, point 4.1.2 and contested decision, page 19, first to fifth paragraphs). Last but not least, it is noted that the conclusion of the opposition division with regard to the objections under Article 100(a) (for lack of novelty), (b) and (c) EPC were in favour of the patentee (see points III.2. to III.4.1 of the decision).

5.3.3 Thus, the Board cannot recognise any bias of the opposition division in the conduct of the oral proceedings and has no reason to suspect, based on the present submissions, that the appellant would not have a fair re-hearing, should the case be remitted before the same opposition division. Under these circumstances, the Board has no elements to order a new composition of the opposition division after remittal.

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.
3. The request to order a change of the composition of the opposition division is rejected.
4. The appeal fee is reimbursed in full.

The Registrar:

The Chairman:



D. Hampe

D. Semino

Decision electronically authenticated