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D E C I S I O N
of 19 July 2005

Case Number: T 0023/02 - 3.3.3

Application Number: 95306430.0

Publication Number: 704483

IPC: C08L 23/10

Language of the proceedings: EN

Title of invention:

Method for producing a polyolefin composition and method for producing a polyolefin film

Patentee:

Sumitomo Chemical Company Limited

Opponent:

Borealis A/S
Grace GmbH

Headword:

-

Relevant legal provisions:

EPC Art. 123(2)(3)

Keyword:

"Amendments - Article 123(2) and Article 123(3)"

Decisions cited:

G 0001/93; T 0201/83; T 0108/91; T 1110/03;

Catchword:

-



Case Number: T 0023/02 - 3.3.3

D E C I S I O N
of the Technical Board of Appeal 3.3.3
of 19 July 2005

Appellant:
(Opponent 01)

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Decision under appeal:

Interlocutory decision of the Opposition
Division of the European Patent Office dated
24 October 2001 and posted 16 November 2001
concerning maintenance of European patent
No. 704483 in amended form.

Composition of the Board:

Chairman: R. Young
Members: W. Sieber
C. Heath

Summary of Facts and Submissions

I. The mention of the grant of European patent No. 0 704 483, in respect of European patent application no. 95 306 430.0, filed on 13 September 1995 and claiming a JP priority of 13 September 1994 (219119/94), was published on 12 August 1998 (Bulletin 1998/33). The granted patent contained 10 claims, whereby independent Claims 1 and 6 read as follows:

"1. A method for producing a polyolefin composition, comprising the step of:

a) mixing

i) 100 parts by weight of polyolefin particles (I) having an average particle diameter of from 500 to 1300 μm and containing not more than 10% by weight of fine particles having a particle diameter of 300 μm or less and

ii) from 0.05 to 0.6 parts by weight of inorganic fine powder (II) having an average particle diameter of from 1 to 4 μm and an apparent specific gravity of from 0.2 to 0.5 g/cm^3 (all particle diameters being as measured by laser diffraction technique, and apparent specific gravity as measured by the method of JIS K6220/6.8); and

b) melt-kneading the mixture.

6. A method for producing a polyolefin film comprising the steps of:

a) mixing

i) 100 parts by weight of polyolefin particles (I) having an average particle diameter of from 500 to 1300 μm and containing not more than 10% by weight of fine particles having a particle diameter of 300 μm or less and

ii) from 0.05 to 0.6 parts by weight of inorganic fine powder (II) having an average particle diameter of from 1 to 4 μm and an apparent specific gravity of from 0.2 to 0.5 g/cm^3 (all particle diameters being as measured by a laser diffraction technique, and apparent specific gravity as measured by the method of JIS K6220/6.8);

b) melt-kneading the mixture; and

c) melt-extruding the polyolefin composition to form the polyolefin film."

Claims 2 to 5 and 7 to 10 were dependent claims directed to elaborations of the method according to Claim 1 and 6, respectively.

II. Notices of opposition were filed by:

(a) Borealis A/S (opponent 01) on 11 May 1999, and

(b) Grace GmbH (opponent 02) on 12 May 1999.

The opponents requested revocation of the patent as a whole based on Article 100(a) EPC (lack of inventive step; opponent 01 and 02) and based on Article 100(b)

EPC (opponent 02). Furthermore, the ground of Article 100(c) was introduced into the proceedings by the opposition division (minutes of the oral proceedings, point 2), although opponent 02 filed this ground only after expiry of the 9 months opposition period. The oppositions were supported - *inter alia* - by the following documents:

D5: "Sylobloc[®] S 200 Anti-Blocking Aid", Product Information, Grace Davison, 5 April 1994 and;

E4: A. Rawle, "The Importance of Particle Size Analysis in the Pharmaceutical Industry".

III. During prosecution of the case before the opposition division, an amended set of claims was filed by the proprietor (main request) which corresponded to Claims 1 to 10 as granted except that Claims 1 and 6 read as follows (amendments in bold):

"1. A method for producing a polyolefin composition, comprising the step of:

a) mixing

i) 100 parts by weight of polyolefin particles (I) having an average particle diameter of from 500 to 1300 μm and containing not more than 10% by weight of fine particles having a particle diameter of 300 μm or less (**all particle diameters being as measured by a laser diffraction technique**), and
ii) from 0.05 to 0.6 parts by weight of inorganic fine powder (II) having an average particle diameter of from 1 to 4 μm and an apparent

specific gravity of from 0.2 to 0.5 g/cm³ (all particle diameters being as measured by a **coulter counter/multizizer**) and apparent specific gravity as measured by the method of JIS K6220/6.8); and

b) melt-kneading the mixture.

6. A method for producing a polyolefin film comprising the steps of:

a) mixing

i) 100 parts by weight of polyolefin particles (I) having an average particle diameter of from 500 to 1300 µm and containing not more than 10% by weight of fine particles having a particle diameter of 300 µm or less (**all particle diameters being as measured by a laser diffraction technique**), and
ii) from 0.05 to 0.6 parts by weight of inorganic fine powder (II) having an average particle diameter of from 1 to 4 µm and an apparent specific gravity of from 0.2 to 0.5 g/cm³ (all particle diameters being as measured by a **coulter counter/multizizer**) and apparent specific gravity as measured by the method of JIS K6220/6.8);

b) melt-kneading the mixture; and

c) melt-extruding the polyolefin composition to form the polyolefin film."

IV. By an interlocutory decision which was announced orally on 24 October 2001 and issued in writing on 16 November

2001, the opposition division maintained the patent in amended form according to the proprietor's main request.

- (a) The opposition division held that the amendments in Claims 1 and 6 relating to the measurement of the particle diameters met the requirements of Article 123(2) EPC.

Furthermore, the opposition division found that the amendment of the mixing amounts of Comparative Example 4 (Table 4) and Comparative Example 5 (Table 2), ie an amendment made during the examination proceedings, was supported by the application as originally filed.

- (b) The measurement of the particle diameters as required in granted Claims 1 and 6 was obviously in contradiction to the patent specification. Therefore, the amendment to Claims 1 and 6 of the main request was considered to be a replacement of an inaccurate technical statement which did not infringe the requirements of Article 123(3) EPC following T 108/91 (OJ EPO 1994, 228). G 1/93 (OJ EPO 1994, 541) did not apply in the present case because the amendments to Claims 1 and 6 introduced during the examination proceedings were not made to provide novelty over the prior art but to meet a clarity objection raised by the examining division.
- (c) Novelty over the cited prior art was not contested by the opponents; in fact, novelty was not a ground of opposition.

(d) The claimed subject-matter also involved an inventive step over the cited prior art.

V. On 8 January 2002, opponent 01 (appellant) filed a notice of appeal against the above decision with simultaneous payment of the prescribed fee. In the statement of grounds of appeal, filed on 25 February 2002, opponent 01 (appellant) argued as follows:

(a) According to the claims as granted the average particle diameter of the inorganic fine powder (II) had to be measured by a laser diffraction technique whereas according to Claims 1 and 6 as maintained by the opposition division the measurement was effected by a Coulter counter/multi-sizer. Since, however, a change of the method of measurement resulted in a change of the claimed average particle diameter range (ie a range of 1 to 4 μm measured by Coulter counter corresponded to a range of 1.2 to 4.76 μm measured by laser diffraction), the amendment violated Article 123(3) EPC. In order to support this argument, opponent 01 (appellant) referred to D5 and submitted documents D9 and D10. D9 gave the particle size of Sylobloc S 200 by two different methods, namely according to Coulter counter with 2.3 to 2.9 μm and according to laser diffraction with 2.8 to 3.4 μm .

D9: "Sylobloc[®] S 200 Anti-Blocking Aid", Product Information, Grace Davison, 30 April 1996;
and

D10: Determination of Particle Size Distribution (PSD) and Average Particle Size (APS) Using a Malvern Mastersizer, 8 February 2002.

Furthermore, T 108/91 (*supra*) relied upon by the opposition division to justify the amendment of Claims 1 and 6 with respect to Article 123(3) EPC was not applicable in the present case. Finally, the amendment was also not allowable in view of G 1/93 (*supra*).

- (b) As regards inventive step, the claimed subject-matter was obvious over the cited prior art cited during the opposition proceedings.

VI. The arguments of the proprietor (respondent) presented in its counterstatement dated 9 September 2002 may be summarized as follows:

- (a) The alleged difference between a Coulter counter measurement in the range of 1 to 4 μm and a laser diffraction range of 1.2 to 4.76 μm was based on a paper example in E4 completely unrepresentative of a real inorganic powder. E4 could not be used to predict any quantitative difference between a range of diameters as measured by Coulter counter method and laser diffraction method.

As regards D9, this document referred to an "old value" of 2.3-3.4 μm , measured with a coulter counter. However, it was not explained what this "old value" was. It could be that the particle size range had in fact changed.

As regards T 108/91 (*supra*), the case of this decision was very similar to the present case. Furthermore, Claims 1 and 6 as maintained by the opposition division were allowable under G 1/93 (*supra*).

- (b) JP-A-57-3840, mentioned on page 2 of the patent in suit, was considered to represent the closest state of the art. A translation thereof was filed as D11.

D11: English translation of JP-A-57-3840.

VII. In a communication, issued on 22 March 2005 accompanying a summons to oral proceedings, the salient issues to be discussed at the oral proceedings were identified by the board as being firstly, Article 123(3) EPC with respect to Claims 1 and 6 as maintained by the opposition division, secondly, inventive step whereby D11 appeared to be the closest prior art, thirdly, the relevance of D11 for novelty (subject to the proprietor's agreement to introduce this new ground into the proceedings), and fourthly Article 123(2) EPC with respect to the amended figures for Comparative Examples 4 and 5.

VIII. By letter dated 15 June 2005, the proprietor (respondent) submitted amended pages 7 and 9 for its main request (claims as allowed by the opposition division) whereby on pages 7 and 9 Comparative Examples 4 and 5 had been deleted, a 1st auxiliary request (claims as granted) and a 2nd auxiliary request including an amended page 3.

The claims of the 2nd auxiliary request corresponded to the claims of the main request except that the upper limit of the range for the average particle diameter of the inorganic fine powder (II) in Claims 1, 4, 6 and 9 had been amended to 2.7 µm.

Furthermore, arguments as to the allowability of these requests were provided. In this context, the following further documents were submitted:

D12: "Spectrex" article dated 1988 (Abstract no. 19588 and larger abstract);

D13: "Family of Syloid[®]" issued by Fuji-Davison Chemical Ltd., dated 6 December 1991; and

D14: Extract from "Concise Encyclopaedia of Chemical Technology", Kirk-Othmer, John Wiley & Sons (1985).

D12 in particular was filed to demonstrate that the results of Coulter counter and laser diffraction methods were equivalent and not statistically different.

IX. In its further submissions dated 16 June 2005 and 8 July 2005, opponent 01 (appellant) elaborated on aspects relating to Article 123(3) EPC with respect to the claims of the main request. Furthermore, there was no doubt that the claims as granted (1st auxiliary request) did not meet the requirements of Article 123(2) EPC because the application as filed did not disclose a laser diffraction technique for the measurement of the average particle diameter of the inorganic fine powder (II). The amendment in the claims of the 2nd auxiliary request also violated Article 123(2) EPC

because an individual value for the average particle diameter had been taken out of its originally disclosed context in order to create a new range.

X. Opponent 02 (party as of right) informed the board with letter dated 1 July 2005 that it would not attend the oral proceedings.

XI. On 19 July 2005, oral proceedings were held before the board where opponent 02 (party as of right) was not represented. Because it had been duly summoned, however, the oral proceedings were continued in its absence in accordance with Rule 71(2) EPC.

The issues discussed at these oral proceedings related to the allowability of the requests of the proprietor (respondent) with respect to Article 123(3) and/or Article 123(2) EPC whereby both parties basically relied on their written submissions.

(a) The proprietor (respondent) emphasized that the correction as presented in the main request did not violate Article 123(3) EPC so that the patent could be maintained on the basis of the main request.

In the alternative the patent could be maintained on the basis of the 1st auxiliary request, especially because the method of measurement was introduced during examination for clarity reasons and did not give the proprietor an unwarranted advantage. Taking furthermore into account that the claims as originally filed did not refer to a method of measurement at all, the incorrectly

added feature merely excluded protection for part of the subject-matter as covered by the application as originally filed but did not provide a technical contribution to the claimed invention.

As regards the new upper limit in Claims 1, 4, 6 and 9 of the second auxiliary request, this limit was explicitly disclosed in Examples 1 to 3, 6 and 7 of the patent in suit.

- (b) In connection with the 2nd auxiliary request, opponent 01 (appellant) referred to T 201/83 which was the relevant case law when amending a general range on the basis of a particular value described in a specific example.

XII. The requests of the parties were as follows:

- (a) Opponent 01 (appellant) requested that the decision under appeal be set aside and the patent be revoked in its entirety.

Furthermore, it requested not to allow D12 into the proceedings.

- (b) The proprietor (respondent) requested that the decision under appeal be set aside and that the patent be maintained:
 - on the basis of Claims 1-10 as filed on 23 August 2001 and headed "Main request", together with pages 1-6 and 8 as granted and pages 7 and 9 filed

on 15 June 2005 (main request); or, in the alternative,

- on the basis of the 1st auxiliary request with Claims 1-10 as granted together with pages 1-9 of the main request; or
- on the basis of the 2nd auxiliary request with Claims 1 to 10 as filed on 15 June 2005 together with pages 1-2 and 4-9 of the main request and page 3 as filed on 15 June 2005.

(c) Opponent 02 (party as of right) did not file any request.

Reasons for the Decision

1. The appeal complies with Articles 106 and 108 EPC and Rule 64 EPC and is therefore admissible.
2. *Admissibility of late filed document D12*
 - 2.1 Opponent 01 (appellant) requested that document D12 submitted by the proprietor with letter dated 15 June 2005 (section VIII, above) should not be admitted into the proceedings because of its lateness and insufficient relevance.
 - 2.2 However, D12 compares a laser particle counter manufactured by the company Spectrex with a Coulter counter, an issue which is highly relevant for the present case so that the argument of opponent 01 (appellant) alleging insufficient relevance of this

document is not convincing. Furthermore, the document was filed, as pointed out by the proprietor (respondent), in response to the board's communication annexed to the summons to oral proceedings where the relevance of this issue was addressed (section VII, above). Consequently, the board decided to admit D12 into the proceedings (Article 114(1) EPC).

3. *Main request*

3.1 The claims of the application as originally filed contain no reference to the method of measurement of the average particle diameter of the polyolefin particles (I) and the inorganic fine powder (II). The only reference to measuring the average particle diameter can be found at page 14, lines 5 to 23 of the application as originally filed where it is stated that the average particle diameter of the polyolefin particles (I) is measured by a laser diffraction technique and the average particle diameter of the inorganic fine powder (II) by a Coulter counter/multi-sizer. Thus, there is no doubt that the requirement in step a)ii) of granted Claims 1 and 6 that "**all particle diameters being as measured by a laser diffraction technique**" (section I, above) was added incorrectly before grant.

3.1.1 In order to overcome the objection against granted Claims 1 and 6 based on Article 100(c) EPC, the proprietor amended Claims 1 and 6 during the opposition procedure according to page 14 of the application as originally filed so that the average particle diameter of the polyolefin particles (I) has to be measured by a laser diffraction technique and the average particle

diameter of the inorganic fine powder (II) by a Coulter counter/multi-sizer. These amended claims not only underlay the decision under appeal (sections III and IV, above) but also form the basis of the present main request (section XII(b), above).

3.1.2 Since the amendment to Claims 1 and 6 is based on page 14, lines 5 to 23 of the application as originally filed, no objections under Article 123(2) EPC arise against the claims of the main request. Also opponent 01 (appellant) raised no objection in this respect.

3.2 However, opponent 01 (appellant) argued that the amendment of Claims 1 and 6 of the main request violated Article 123(3) EPC. The objection is based on the argument that a change in the method of measurement for the average particle diameter of the inorganic fine powder (II) is associated with a shift of the range required in Claims 1 and 6.

3.3 Thus, the decisive question in the present case is whether changing the method of measurement for the average particle diameter of the inorganic fine powder (II) from a laser diffraction technique (Claims 1 and 6 as granted) to a Coulter counter/multi-sizer technique (Claims 1 and 6 of the main request) leads to an extension of the protection conferred (Article 123(3) EPC).

3.3.1 D9 is a product information on an amorphous silica designated Sylobloc[®] S 200 that could be used as the inorganic fine powder (II) in the patent in suit. Although published on 30 April 1996, ie after the

priority date of the patent in suit, D9 cannot be disregarded on the sole ground that it was post published because it was submitted in substantiation of an allegation of fact, namely as support of the argument of opponent 01 (appellant) that laser diffraction and Coulter counter lead to different values. Thus, the board accepts D9 as indirect evidence in analogy to T 1110/03 (OJ EPO 2005, 302).

D9 discloses for the particle size of the silica two different ranges measured with different methods, namely a range of 2.8 to 3.4 μm obtained by Malvern Mastersizer and an "old value" of 2.3 to 2.9 μm obtained by Coulter counter. The method referred to as "Malvern Mastersizer" is a laser diffraction method as can be seen from D10, in particular points 3 and 5.

Thus, it can be gathered from D9 that, for identical particles, the Coulter counter method leads to values for the particle size which are 0.5 μm smaller in comparison to the laser diffraction technique (about 20%). This means that a change of the method of measurement for the average particle diameter of the inorganic fine powder (II) from laser diffraction (Claims 1 and 6 as granted) to Coulter counter (Claims 1 and 6 of the main request) results in a shift of the ascertained particle size. For example, an inorganic powder having a particle size of 4.3 μm when measured by laser diffraction would be outside the scope of the claims as granted. However, such an inorganic powder would be within the scope of the claims of the main request when measured by Coulter counter, because the Coulter counter method would lead

for the same powder particles to a smaller average particle diameter, namely a value below 4 µm.

3.3.2 It follows from the above that the change of the method of measurement in Claims 1 and 6 of the main request is associated with a shift of the range of the average particle diameter, thereby covering particles which were not covered by the granted claims. Consequently, the Claims 1 and 6 of the main request have been amended in a way as to extend the protection conferred, contrary to Article 123(3) EPC.

3.3.3 The conclusion drawn from D9 that the laser diffraction and Coulter counter method define different average particle diameter ranges is supported by E4, a document which has been distributed, according to opponent 02, since about 1996 with the purchase of a Malvern laser diffraction instrument.

E4 explains the basic principles of particle size analysis. Particularly on page 1, right hand column, 3rd paragraph it is stated that

"It is important to understand the pitfalls of particle size analysis - in particular the reasons why different techniques will produce different results",

and further, on page 3, middle column, 1st complete paragraph

"Hence we must be aware that each characterisation technique will measure a different property of a particle (max. length, min. length, volume,

surface etc.) and therefore will give a different answer from another technique which measures an alternative dimension".

The Coulter counter method, which is explained from page 9 onwards, is based on an electrozone sensing and measures the volume of each particle divided by the number of particles thereby generating a mean diameter $D[3,0]$ (see also page 4, middle column, 2nd complete paragraph). On the other hand, the laser diffraction method, which is explained from page 10 onwards, relies on the fact that in the simplest analogy diffraction angle is inversely proportional to particle size generating the $D[4,3]$ or equivalent volume mean (see also page 4, middle column, 3rd complete paragraph).

As can be seen from the theoretical examples given for spheres with diameters of 1, 2 and 3 units on page 4, right hand column of E4, $D[4,3]$ is about 19% higher than $D[3,0]$, in fact a difference in the same order of magnitude as observed for the two methods in D9 (section 3.3.1, above). The criticism of the proprietor (respondent) in this connection that these examples are not real examples appears to be beside the point because even theoretical examples can be used to illustrate a general principle.

- 3.4 In its attempt to justify that the amendment of Claim 1 and 6 of the main request did not contravene the provisions of Article 123(3) EPC, the proprietor (respondent) argued that D9 could not demonstrate the alleged difference between laser diffraction and Coulter counter technique. On the contrary, D12 showed that laser diffraction and Coulter counter technique

gave the same results. Finally, the claims were not amended in such a way as to extend the scope of protection conferred when interpreted in the light of the description.

- 3.4.1 As regards D9, the proprietor (respondent) submitted that the reference in D9 to an "old value" of 2.3 to 2.9 μm as measured by Coulter counter could mean that the particle size has in fact changed. This argument is, in the board's view, not convincing, because D9 is a product information of a specific commercial product issued by the manufacturer for this product. Normally, the data disclosed in such a product information relate to the product actually sold and not to some unspecified older product. Therefore, the board agrees with opponent 01 (appellant) that the term "old value" must refer to the measurement of the particles with an "old method", ie Coulter counter, whereas Malvern Mastersizer is the currently used, new method.

That the Coulter counter is indeed the old method for measuring the particle size of Sylobloc[®] S 200 is supported by D5, also a product information on Sylobloc[®] S 200 but published two years earlier (5 April 1004). D5 discloses the same values as D9 except that only one range for the particle size (2.3 to 2.9 μm) is given which is indicated to be measured by Coulter counter. Thus, the particle size of Sylobloc[®] S 200 was previously measured by the Coulter counter method which has been replaced two years later in D9 by a new method, ie Malvern Mastersizer.

- 3.4.2 D12 is an abstract from a poster published in 1988, in which a laser particle counter manufactured by the

company Spectrex is compared with a Coulter counter. The proprietor (respondent) relied in particular upon the statement in the Conclusion, line 6 that

"Results from both methods [laser and Coulter counter] were statistically the same".

Furthermore, it is stated in the abstract that

"The Kolmogorov-Simirnov test, used to compare the cumulative percent-frequency distributions, revealed no significant differences between the results of both methods".

However, there is no statement in D12 that the two different methods would indeed produce the same value for the average particle diameter. Moreover, it is conspicuous to the board that the size distribution graph for Sample 1 does in fact show a clear difference in the cumulative percentage for a phi size between 5 and 6.5. The phi size represents, according to the proprietor (respondent), the particle size whereby the board notes that the phi size bears no units and no data are given for a phi size below 5. The divergence for lower phi sizes raises the question how the range of the average particle diameter required in the patent in suit, namely 1 to 4 μm , would be influenced by the two different methods of measurement. However, this question cannot be answered by D12. Therefore, D12 cannot, in the board's view, invalidate the information provided by D9 which concerns exactly the particle sizes required in the patent in suit.

3.4.3 Finally, the proprietor (respondent) argued that opponent 01 (appellant) had wrongly assumed that Article 123(3) EPC was solely concerned with the scope of the claims. Under Article 69(1) EPC, the description and the drawings had to be used to interpret the claims. Since the specification of the granted patent clearly contained a direction to the skilled person as to the correct way of measuring the particle diameter, the scope of protection had not changed at all.

Although it is correct that Article 69(1) EPC, second sentence, states that the description and the drawings shall be used to interpret the claims, this cannot remedy the violation of Article 123(3) EPC in the present case. Claims 1 and 6 of the main request require the laser diffraction technique as the method of measurement for the average particle diameter of the inorganic fine powder (II). "Interpreting" could mean "further to explain or further to specify" the laser diffraction technique, but "interpreting" cannot mean to substitute an *expressis verbis* stated method of the claims by a different method mentioned in the description. This is not at all the aim of Article 69(1) EPC, second sentence. Therefore, this argument must fail.

3.5 The opposition division allowed the amendment to Claims 1 and 6 of the main request in view of T 108/91 (*supra*). However, the board cannot accept this argument for the following reasons.

3.5.1 Decision T 108/91 (*supra*) held that the replacement of an inaccurate technical statement, which is evidently inconsistent with the totality of the disclosure of the

patent, by an accurate statement of the technical features involved, did not infringe Article 123(3) EPC.

- 3.5.2 In the present case, however, there is no inaccurate technical statement as far as the measurement by laser diffraction is concerned. This is a usual method to determine the particle size and is in fact used in the patent in suit to determine the average particle diameter of the polyolefin particles (I) (page 4, lines 47 to 49). Nor is this statement evidently inconsistent with the totality of the disclosure of the patent. The only inconsistency is in the patent in suit on page 4, lines 53 to 55 which states that the average particle diameter of the inorganic fine powder is measured with a Coulter counter/multi-sizer.

Hence, in contrast to T 108/91 (*supra*), it is not immediately apparent from the description of the patent specification that what is defined in granted Claims 1 and 6 could not be that for which protection is sought and that the intended meaning must have been the equivalent of what is stated in this respect in amended Claims 1 and 6 of the main request. In addition and contrary to T 108/91 (*supra*), there is no need for an interpretation of the claim language as the requirement that "all particle diameters being as measured by a laser diffraction technique" is entirely clear to the skilled person.

- 3.6 No other conclusion is reached when taking G 1/93 (*supra*) into account.
- 3.6.1 Under point 9 of the reasons of the decision, it is explicitly stated that

"Article 123(3) EPC is directly aimed at protecting the interests of third parties by prohibiting any broadening of the claims of a granted patent, even if there should be a basis for such broadening in the application as filed".

Furthermore, it is stated under point 13 of the reasons

"Thus, if a limiting feature is considered to fall under Article 123(2) EPC, it cannot be maintained in the patent in view of Article 100(c) EPC, nor can it be removed from the claims without violating Article 123(3) EPC. Only if the added feature can be replaced by another feature disclosed in the application as filed without violating Article 123(3) EPC, can the patent be maintained (in amended form). ... In this sense, it must be admitted that Article 123(2) in combination with Article 123(3) EPC can operate rather harshly against an applicant, who runs the risk of being caught in an inescapable trap and losing everything by amending his application, even if the amendment is limiting the scope of protection. However, as submitted by the opponent, this hardship is not per se a sufficient justification for not applying Article 123(2) EPC as it stands in order to duly protect the interests of the public. Nor does it, in principle, matter, that such amendment has been approved by the Examining Division. The ultimate responsibility for any amendment of a patent application (or a patent) always remains that of the applicant (or the patentee)."

Hence, G 1/93 (*supra*) makes clear that there is no room for any amendment if the scope of protection is changed.

3.6.2 In the present case, the scope of protection is indeed changed because the average particle diameter defined by laser diffraction technique is different from an average particle diameter measured by Coulter counter, ie there is a shift in the particle diameter range depending upon the applied measuring method (section 3.3.1, above).

3.7 In summary, Claims 1 and 6 of the main request do not meet the requirements of Article 123(3) EPC. Consequently, the main request has to be refused.

4. *1st auxiliary request*

4.1 With the 1st auxiliary request, the proprietor (respondent) reverted to the claims as granted. Claims 1 and 6 as granted contain in step a)ii) the requirement that "***all particle diameters being as measured by a laser diffraction technique***" which was added incorrectly before grant (section 3.1, above). Thus, the issue of admissibility of the 1st auxiliary request boils down to the question as to whether this requirement is contrary to Article 123(2) EPC or not.

4.2 In view of the fact that the claims as originally filed contained no reference at all to a method of measurement for the average particle diameter, the proprietor (respondent) argued that the requirement in granted Claims 1 and 6, namely all particle diameters being as measured by a laser diffraction technique,

merely limited the protection conferred by the patent as granted by excluding protection for part of the subject-matter of the claimed invention as covered by the application as filed, ie excluding the possibility of measuring the average particle diameters with other methods, so that the public was not prejudiced by the amendment. Furthermore, the requirement was added to Claims 1 and 6 following a clarity objection by the examining division but did not provide a technical contribution to the claimed invention. Therefore, following the 2nd paragraph of the headnote of G 1/93 (*supra*), the patent could be maintained as granted including the requirement under dispute.

4.3 However, the board cannot accept this argumentation for the following reasons:

4.3.1 Firstly, the requirement incorrectly added before grant does not merely limit the protection conferred by the patent as granted by excluding protection for part of the subject-matter of the claimed invention as covered by the application as filed. Although the claims as originally filed contain no reference to a method of measurement for the average particle diameter this does not mean that any method could be used to determine this parameter. If anything, the claims raise doubts as to how the average particle diameter has to be determined, in particular because the skilled person would be aware of the fact that the method of measurement is of a decisive nature in particle size analysis (eg E4, section 3.3.3, above). Therefore, the skilled person would use the description and drawings EPC when deciding how the average particle diameter is to be measured. And from the description the skilled

person would learn that the average particle diameter of the polyolefin particles (I) is to be measured by laser diffraction whereas the average particle diameter of the inorganic fine powder (II) is to be measured with a Coulter counter/multi-sizer (page 14, lines 5 to 23 of the application as originally filed). Thus, when properly interpreted in the light of the original description, the claims as originally filed already contain restrictions as to the method of measurement for the average particle diameter of the various particles.

4.3.2 Secondly, the method of measurement for the average particle diameter does provide a technical contribution because it affects the actual value for this parameter (section 3.3.1, above). In such a case, an incorrectly added feature constitutes added subject-matter within the meaning of Article 123(2) EPC as can be seen from point 16 of the reasons of G 1/93 (*supra*):

"If such added feature, although limiting the scope of protection conferred by the patent, has to be considered as providing a technical contribution to the subject-matter of the claimed invention, it would, in the view of the Enlarged Board, give an unwarranted advantage to the patentee contrary to the above purpose of Article 123(2) EPC. Consequently, such feature would constitute added subject-matter within the meaning of that provision."

4.4 In view of the above, the requirement in granted Claims 1 and 6 that "**all particle diameters being as measured by a laser diffraction technique**" is to be

considered as subject-matter extending beyond the content of the application as filed. Granted Claims 1 and 6 containing this requirement cannot be maintained without violating Article 123(2) EPC or giving rise to a ground for opposition under Article 100(c) EPC.

4.5 Hence, the 1st auxiliary request is refused.

5. *2nd auxiliary request*

5.1 In Claims 1, 4, 6 and 9 of the 2nd auxiliary request, the upper limit of the average particle diameter of the inorganic fine powder (II) has been amended to 2.7 µm, ie Claims 1 and 6 refer now to a range of from 1 to 2.7 µm and Claims 4 and 9 to a range of from 1.5 to 2.7 µm.

5.2 There is no explicit disclosure in the application as originally filed for a range of from 1 to 2.7 µm or from 1.5 to 2.7 µm, respectively, for the average particle diameter of the inorganic fine powder (II). However, the proprietor (respondent) took the view that the amendment is supported by Examples 1 to 3, 6 and 7 of the application as originally filed which use an inorganic fine powder (II) with an average particle diameter of 2.7 µm.

5.2.1 When deciding on the question as to whether or not it is allowable to amend a generally disclosed range on the basis of a particular value disclosed in a particular example, the relevant case law is, as pointed out by opponent 01 (appellant), T 201/83 (OJ EPO 1984, 481). According to the headnote of this decision, an amendment of a concentration range in a

claim for a mixture, such as an alloy, is allowable on the basis of a particular value described in a specific example, provided the skilled man could have readily recognised this value as not so closely associated with the other features of the example as to determine the effect of that embodiment of the invention as a whole in a unique manner and to a significant degree.

5.2.2 In the present case, Examples 1 to 3, 6 and 7 use the same inorganic powder, namely the silica powder Syloid 55 having an average particle diameter of 2.7 μm and an apparent specific gravity of 0.33 g/cm^3 . This means that the average particle size of 2.7 μm disclosed in these examples is always associated with a specific gravity of 0.33 g/cm^3 and a specific type of inorganic fine powder, namely silica powder. There is no indication whatsoever in the application as filed that would allow the conclusion that the particular average particle diameter of 2.7 μm could be seen in a more general context. For example, there are no other examples using an inorganic fine powder with an average particle diameter of 2.7 μm but having a different apparent specific gravity or being a substance other than silica powder. Nor is there any general statement in this connection in the description which would justify the generalization of the particular value from these examples. Consequently, the subject-matter of Claims 1, 4, 6 and 9 does not meet the requirements of Article 123(2) EPC.

5.3 Claims 1, 4, 6 and 9 not meeting the requirements of Article 123(2) EPC, the 2nd auxiliary request has to be refused.

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:

E. Görgmaier

R. Young