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**Datasheet for the decision
of 3 April 2008**

Case Number: T 0486/04 - 3.3.03

Application Number: 92100562.5

Publication Number: 0496258

IPC: C08L 69/00

Language of the proceedings: EN

Title of invention:

Polymer composition containing a branched polycarbonate

Patentee:

IDEMITSU KOSAN CO., LTD.

Opponent:

THE DOW CHEMICAL COMPANY

Headword:

-

Relevant legal provisions:

EPC Art. 100(c), 123(2), 123(3)

EPC R. 80

RPBA 2007 Art. 12(2), 13(1)

Relevant legal provisions (EPC 1973):

EPC R. 57a, 67

RPBA 2003 Art. 10a(2), 10(b)1

Keyword:

"Amendments to a party's case after the statement of grounds
of appeal (not admitted)"

"Amendments - opposition proceedings"

"Amendments - broadening of claim (yes)"

"Reimbursement of appeal fee (no)"

Decisions cited:

G 0001/93, T 0472/88, T 1239/03

Catchword:

See Reasons 2. - 2.6.



Case Number: T 0486/04 - 3.3.03

DECISION
of the Technical Board of Appeal 3.3.03
of 3 April 2008

Appellant: IDEMITSU KOSAN CO., LTD.
(Patent Proprietor) 1-1, Marunouchi 3-chome
Chiyoda-ku
Tokyo 100-8321 (JP)

Representative: Gille Hrabal Struck Neidlein Prop Roos
Patentanwälte
Brucknerstrasse 20
D-40593 Düsseldorf (DE)

Respondent: THE DOW CHEMICAL COMPANY
(Opponent) P.O. BOX 1967
Midland
MI 48641 - 1967 (US)

Representative: Dossmann, Gérard
Bureau Casalonga & Josse
Bayerstrasse 71/73
D-80335 München (DE)

Decision under appeal: Decision of the Opposition Division of the
European Patent Office dated 17 December 2003
and posted 22 January 2004 revoking European
patent No. 0496258 pursuant to Article 102(1)
EPC 1973.

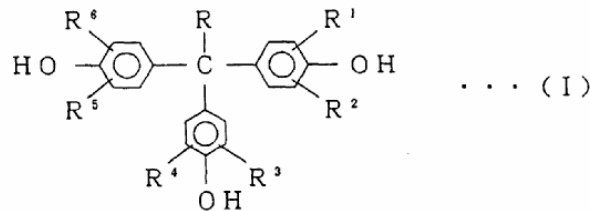
Composition of the Board:

Chairman: R. Young
Members: A. Däweritz
C. Brandt

Summary of Facts and Submissions

I. The grant of European patent No. 0 496 258 in respect of European patent application No. 92 100 562.5, filed on 15 January 1992 and claiming the priority of four earlier JP applications (22660/91, 22661/91, 22662/91 and 22663/91) of 24 January 1991, was announced on 20 June 2001 (Bulletin 2001/25). The patent was granted with nine claims, Claim 1 reading as follows:

1. A polycarbonate resin composition consisting essentially of (A) 1 to 99% by weight of a branched polycarbonate having a branched nucleus structure derived from a branching agent represented by the general formula (I):



wherein R is a hydrogen atom or an alkyl group having 1 to 5 carbon atoms, and R¹ to R⁶ are hydrogen atoms, alkyl groups having 1 to 5 carbon atoms or halogen atoms, respectively, a viscosity average molecular weight of 15,000 to 40,000, and an acetone-soluble matter of not more than 3.5% by weight, and (B) 99 to 1% by weight of one polymer selected from the group consisting of styrene resin, polyamide resin, polyolefin resin, and rubber-like elastomer.

The remaining dependent Claims 2 to 9 related to elaborations of the claimed composition.

In this decision, any reference to passages in the patent in suit as granted will be given underlined in squared brackets, eg [Claim 1]. References in underlined *italics* concern passages in the application as filed, eg page 1, lines 5 to 10. "EPC" refers to the revised text of the EPC 2000, the previous version is identified as "EPC 1973".

II. On 20 March 2002, a Notice of Opposition was filed with reference to the grounds for opposition under Articles 100(a), 100(b) and 100(c) EPC 1973 and with further reference to Articles 52(1), 54, 56, 83 and 123(2) EPC 1973, ie the Opponent raised objections of extension beyond the content of the application as

filed, of insufficient disclosure, of lack of novelty and of lack of inventive step. In the Notice of Opposition, thirteen documents were cited, including

D12: EP-A-0 400 478.

These documents were supplemented during the opposition proceedings by three further documents, including

D15: WO-A-90/10674 (submitted by the Opponent with its letter dated 17 November 2003).

III. In the decision announced at the end of oral proceedings on 17 December 2003 and issued in writing on 22 January 2004, the Opposition Division rejected the objections of extension beyond the content of the application as originally filed, of insufficiency of disclosure and of lack of novelty.

The assessment of inventive step was based on D12 as the closest piece of prior art. The problem to be solved with respect to this document was seen in the provision of compositions on the basis of branched polycarbonate that have improved mouldability, in particular blow mouldability.

With regard to this technical problem, the Opposition Division took the view that blow mouldability of linear or branched polycarbonate could, according to D15, be improved by adding rubber and that the subject-matter according to [Claim 1] (Main Request) did not, consequently, involve an inventive step. Moreover, three Auxiliary Requests additionally filed by the Patent Proprietor during the opposition proceedings were found to share the fate of the Main Request,

because none of them was considered to contain further distinguishing features contributing to inventive step.

Based on these findings, the Opposition Division, therefore, revoked the patent in suit for the reason of lack of inventive step. Claim 1 of the first Auxiliary Request was additionally objected to as being unclear (Article 84 EPC).

IV. On 19 March 2004, a Notice of Appeal was filed against this decision by the Patent Proprietor/Appellant requesting maintenance of the patent in suit as granted. The prescribed fee was paid on the same date.

V. With its Statement of Grounds of Appeal (SGA) received on 21 May 2004 (and corrected with a letter dated 25 May 2004), however, the Appellant filed six amended sets of claims (Main Request and Auxiliary Requests 1 to 5, respectively) replacing all previous requests on file and disputed the reasons for the revocation of the patent in suit given in the decision under appeal.

In the amended Main Request, Claim 1 had been modified in two respects: (i) the concentration ranges of the two Components (A) and (B) had been narrowed and (ii) Component (B) had been limited to "styrene resin". In the amended Auxiliary Requests 1, 3 and 5, the definition of Component (A) had further been specified in terms of process features of two processes suitable for its manufacture and, in Auxiliary Requests 2 to 5, the styrene resin (B) had further been specified, ie in Auxiliary Requests 3 and 5, in addition to the above amendment of the definition of component (A).

VI. The Respondent, in its reply letter dated 4 February 2005, raised objections under Article 84, 54 and 56 EPC

1973 against the modified claims of these amended requests, maintained its objection under Article 100(b) EPC 1973 and disputed the arguments of the Appellant. Thus, it argued that the scope of "styrene resin" was unclear, because of the possible content of styrene in the polymers of other previous options of component (B).

VII. On 21 March 2007, the parties were summoned for oral proceedings on 28 June 2007. This hearing was, however, postponed until 19 September 2007 (a new summons of 12 April 2007) for a reason in accordance with the Notice of the Vice-Presidents DG2 and DG3 concerning oral proceedings before the EPO (OJ EPO 2000, 456).

VIII. In preparation for the hearing, the Appellant replaced, in a letter dated 4 July 2007, the requests, which had been filed with the SGA, by twenty-four new requests.

(1) According to the new Main Request of the Appellant, the decision under appeal should be set aside and the opposition should be rejected. In the twenty-three new Auxiliary Requests of 4 July 2007, various amendments to the claims were suggested, concerning the two components (A) and (B) and the optional presence of further components such as fillers and additives. Whilst the first eleven Auxiliary Requests were again directed to compositions as such, the further twelve auxiliary requests were limited to use claims.

(2) Furthermore, the Appellant requested that D15 be disregarded, which had, despite its very late filing (one month before the hearing on 17 December 2003; section II, above), been admitted by the Opposition Division into the proceedings under Article 114(1) EPC 1973 (section III, above). In the opinion of the Appellant, the fact that it had served as a basis for

the revocation of the patent in suit constituted a substantial procedural violation. Therefore, the Appellant requested reimbursement of the appeal fee.

(3) Furthermore, the Appellant disputed all the objections and arguments of the Respondent (section VI, above) and filed additional comparative examples.

IX. For a reason in accordance with the Notice of the Vice-Presidents DG2 and DG3 (cf. section VII, above), the hearing was again postponed until 22 November 2007 (a new summons dated 7 August 2007).

X. The new requests as referred to in section VIII(1), above, were further supplemented, with a further letter of the Appellant dated 13 November 2007, by four additional auxiliary requests, to be inserted and added, respectively, as Auxiliary Requests 12, 13, 26 and 27 (all the new auxiliary requests will be referred to in this way as Auxiliary Requests 1 to 27 herein below, instead of addressing them as the "First Auxiliary Request" to the "Twenty-seventh Auxiliary Request" as on the sheets submitted by the Appellant).

XI. The Respondent reacted to these arguments and requests of the Appellant in a letter dated 15 November 2007.

(1) In particular, it requested that neither the new Main Request and the new Auxiliary Requests 1 to 5, 12 to 19, 26 and 27, nor the additional comparative examples be admitted, because they had been filed unacceptably late, namely more than two years after the Respondent's reply to the SGA dated 4 February 2005, and it argued that the "Appellant should not be permitted to return to what it has previously renounced, particularly at this late stage of the proceedings"

(Respondent's letter, page 2, under the heading "*The main request ... under Article 114(2) EPC*").

In other words, the reinstatement of blends of PC with polyamide resins, polyolefin resins and rubber-like elastomers, which had no longer been encompassed by the claims submitted with the SGA, should not be admitted.

(2) Additionally, the Respondent took the view, that none of the new auxiliary requests complied with Article 100(c) EPC 1973, because of the replacement of the original term "comprising", as originally disclosed in Claim 1, by the expressions "consisting essentially of" or "consisting of" in their respective Claims 1.

Whilst it had been clear that, in [Claim 1], the percentages of (A) and (B) had been based on the total weight of these two components, this limitation was, according to the Respondent, missing in the auxiliary requests, so that the percentages in the new Claims 1 would apply to the claimed composition as a whole.

The Respondent referred in this context, furthermore, to the jurisprudence, according to which "the expression 'consisting essentially of' used in the main request and in the even numbered auxiliary requests is generally interpreted to allow the presence of additional components (under certain conditions) and the odd-numbered auxiliary requests specify additional components that may be present. ... The result is new weight-percent ranges not disclosed in the application as originally filed" (letter: page 3, lines 12 to 18).

(3) Moreover, the Respondent disputed the validity of the view taken by the Examining Division at pre-grant oral proceedings on 23 March 2000, that "all the

examples (of the initial patent application) illustrate 'binary compositions of branched polycarbonate and only one further polymeric component selected from styrenic resins, polyamide, polyolefins or rubber-like-polymers, together with some additives' (page 3, lines 9-12, of the minutes ...)" (paragraph bridging pages 3 and 4 of the letter) and further argued that the amounts of the individual constituents used in the examples would not have resulted in a pure cross-linked PC, but rather in a mixture of a linear PC and a cross-linked PC (letter: pages 4 and 5).

(4) Moreover, the Respondent objected to each of the odd-numbered auxiliary requests under Rule 57a EPC 1973, because the replacement of the term "consisting essentially of" in [Claim 1] by "consisting of" together with a list of optional third components not previously set forth in the claims did not, in its opinion, address a ground for opposition.

(5) Additionally, the Respondent referred again to its previously raised objections under Articles 100(b) and 100(a) EPC 1973.

XII. In view of these arguments raising new issues, further postponement of the hearing scheduled for 22 November 2007 was requested by the Appellant in its letter of 20 November 2007.

XIII. In compliance with this request, the Board postponed the hearing until 3 April 2008 (fax dated 21 November 2007). Additionally, the Board sent out a Communication on 22 November 2007 to inform the parties of its preliminary, provisional view on the present case. Therein, the Board initially recalled the successive

filing of the different sets of claims and requests, as already mentioned herein above. It then continued:

"2. In view of the limitations contained in the requests mentioned ... above, the Respondent had not reiterated its previous ground for opposition under Article 100(c) EPC.

This situation changed, however, when the requests ... had been filed and, ..., the Respondent raised again objections under Article 100(c) EPC (letter dated 15 November 2007, page 3/7, line 3 to page 5/7, fourth last line).

...

2.2 Moreover, the Respondent referred to the minutes of oral proceedings held before grant and argued, that the reasons given by the Examining Division in those minutes for allowing the then third Auxiliary Request on the basis of the examples in the application in suit, had not been valid, because the examples did not, in the view of the Respondent, form a basis for the claims as granted, allegedly relating to "binary compositions".

3. This latter objection may be considered to relate to a situation dealt with by the Enlarged Board of Appeal in Decision G 1/93 (OJ EPO 1994, 541). Apparently, such a finding would be valid for all requests mentioned above, including the claims as granted.

...

6. In relation with the last objection raised by the Respondent, the following observations are furthermore added:

6.1 In the application text as originally filed, Claim 1 was directed to a composition comprising components (A) and (B), whereby the component (B) referred to 'at least one kind of polymer selected from the group consisting of styrene resin, polyamide resin, polyolefin resin, and rubber-like elastomer'.

The same wording can be found on page 13 of the original description (lines 9/10). Furthermore, as an introduction to passages referring to the amounts of individual component (B) to be used in the compositions ('... resin alone' and 'elastomer alone', respectively, on page 13, last paragraph and pages 14 and 15), it was said 'When Component (B) is composed of one kind of polymer, ...' (page 13, lines 21)

In the Summary of the Invention (pages 2 and 3 of the original text and on page 7, lines 4 to 6), reference was made to 'at least a polymer selected from the group consisting of ...'.

6.2 In the provisional opinion of the Board, the above formulations seen in their respective contexts are not equivalent to the formulation in Claim 1 of any one of the sets of claims on file, referring to a composition either essentially consisting of components (A) and (B) or consisting of components (A) and (B) and further optional components, whereby no mention is made of any limitations of the amounts in which these additional components may be present. In each of these requests component (B) has been formulated as referring to 'one polymer ...', eg 'one polymer selected from

styrene resin' (Claim 1 of the Sixth Auxiliary Request filed in July 2007, cf. ..., above).

Moreover, the numerous examples, each describing a combination of a specific polycarbonate and a particular second copolymer, in some examples in combination with a further component, do not, in the Board's present view, amount to a general disclosure of any conceivable polycarbonate within the definition of component (A) with any conceivable further polymer belonging to the groups of styrene resins, polyamide resins, polyolefin resins and rubber-like elastomers in the large ranges of weight percentages defined in each Claim 1.

"7. Any written submissions ...".

XIV. In view of these remarks from the Board, the Appellant submitted further arguments in its letter dated 8 February 2008, wherein it disputed the arguments of the Respondent and the preliminary, provisional remarks of the Board.

(1) In particular, it contested the allegation of having filed the new requests (sections VIII(1) and X, above) late and quoted a passage from the "Case Law of the Boards of Appeal (Fifth edition 2006), VI.J.3.2.2(b)(i)" in support of its view, that it would have been entitled to reinstate its Main Request as presented in its Notice of Appeal (section IV, above).

(2) As regards the question of component (B) being "one polymer selected from ...", the Appellant referred to the following passages: ie page 13, line 9 and penultimate paragraph, each referring to "one kind of

polymer ...", page 13, last paragraph, page 14, paragraph 2 and third line from below, and page 15, paragraph 2, mentioning "styrene resin alone", polyamide resin alone", "polyolefin alone" and "rubber-like elastomer alone", respectively. Furthermore, the Appellant argued "Also all the examples are clearly related to a mixture of branched polycarbonate (...) and only one kind of further resin." (emphasis as on pages 17/18 and 26 of the letter).

XV. The Respondent confirmed, in its letter dated 14 February 2008, its hitherto presented argumentation and agreed to the observations in No. 6 of the above Communication (section XIII, above).

XVI. The oral proceedings were held as scheduled on the basis of the new requests as mentioned before in sections VIII, VIII(1) and X, above. Upon invitation by the Board in the course of the hearing, the Appellant submitted new consecutively numbered copies of the "new" Auxiliary Requests.

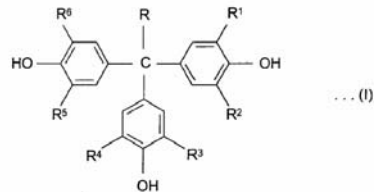
(1) As far as they played a role for the outcome of these proceedings, the essentials of the requests can be summarised as follows:

Claim 1 of the "new" Main Request, identical to [Claim 1], related to a composition "consisting essentially of" the two components (A) and (B) (cf. sections VIII(1) and I, above).

Claim 1 of Auxiliary Request 1 differed from this wording only in that the "consisting essentially of" wording had been replaced by the two formulations "consisting of (A) ... and (B) ... and "and optionally ... colorants", as quoted below:

"A polycarbonate resin composition consisting of

(A) 30 to 95 % by weight of a branched polycarbonate having a branched nucleus structure derived from a branching agent represented by the general formula (I):



wherein R is a hydrogen atom or an alkyl group having 1 to 5 carbon atoms, and R¹ to R⁶ are hydrogen atoms, alkyl groups having 1 to 5 carbon atoms or halogen atoms, respectively, a viscosity average molecular weight of 15,000 to 40,000, and an acetone-soluble matter of not more than 3.5 % by weight, and

(B) 70 to 5 % by weight of one polymer selected from the group of styrene resin, polyamide resin, polyolefin resin, and rubber-like elastomer,

and optionally inorganic fillers, additives selected from antioxidants of the hindered phenol type, phosphorus type and amine type, UV absorbers, external lubricating agents, flame retardants, mold release agents, antistatic agents, and colorants."

Likewise, each Claim 1 of all further odd-numbered auxiliary requests corresponded to the wording of the first claim of the directly preceding (higher-ranking) Auxiliary Request, but contained also the two formulations "consisting of" and ", and optionally ... colorants" as the replacement for the expression

"consisting essentially of". Thus, apart from the above replacement, the definitions of Components (A) and (B), respectively, in Claim 1 of Auxiliary Request 3 corresponded to those in Claim 1 of Auxiliary Request 2, etc.

Furthermore, in each of Auxiliary Requests 2 to 5, the structure of the respective first claim was changed to present each alternative of Component (B) separately, as exemplified herein below by Claim 1 of Auxiliary Request 2 (*in each alternative, the definition of the PC (A) was identical to that in Claim 1 of Auxiliary Request 1, as quoted above*):

"A polycarbonate resin composition consisting essentially of:

- (a) (A) 30 to 95 % by weight of a branched polycarbonate ... and

(B) 70 to 5 % by weight of one polymer selected from styrene resin; or
- (b) (A) 50 to 95 % by weight of a branched polycarbonate ... and

(B) 50 to 5 % by weight of one polymer selected from polyamide resin; or
- (c) (A) 70 to 95 % by weight of a branched polycarbonate ... and

(B) 30 to 5 % by weight of one polymer selected from polyolefin resin; or
- (d) (A) 40 to 99 % by weight of a branched polycarbonate ... and

(B) 60 to 1 % by weight of one polymer selected from rubber-like elastomer."

In Auxiliary Request 4, Claim 1 referred only to the above alternatives (a) and (d), and in Auxiliary Requests 3 and 5, each Claim 1 differed from Claim 1 of their respective preceding Auxiliary Requests 2 and 4 only by the formulation as used in all un-even numbered auxiliary requests, as mentioned above.

In Auxiliary Request 6, Claim 1 had been limited to the alternative (a) as in Claim 1 of Auxiliary Request 2.

Moreover, in the first claims of the subsequent Auxiliary Requests 8, 10 and 12, the definition of Component (B) was further modified to read

in Auxiliary Request 8:

"(B) 70 to 5 % by weight of one polymer selected from styrene resin, selected from polystyrene resin, high impact resistant polystyrene resin (HIPS), styrene-anhydrous maleic acid copolymer, and acrylonitrile-butadiene-styrene (ABS) resin."

in Auxiliary Request 10:

"(B) 70 to 5 % by weight of one polymer selected from styrene resin selected from polystyrene resin, styrene-anhydrous maleic acid copolymer, and acrylonitrile-butadiene-styrene (ABS) resin."

and in Auxiliary Request 12:

"(B) 70 to 5 % by weight of one polymer selected from acrylonitrile-butadiene-styrene (ABS) resin."

Furthermore, the first claims of Auxiliary Requests 14 to 27 also contained the same sequence of limitations/

structures concerning both components (A) and (B) as in the first claims of the Main request and of the Auxiliary Requests 1 to 13. However, they differed therefrom by the following two amendments: (i) instead of relating to "A polycarbonate composition consisting ...", they related to the "Use of a polycarbonate composition consisting ..." and (ii) they contained the additional feature ", for blow molding" at their end.

(2) In these proceedings, the discussion focussed essentially on the following questions:

- Was the complete or partial replacement of the requests, as submitted with the SGA (section V, above), by the "new" Main Request and the above "new" Auxiliary requests 1 to 27 (sections VIII(1) and X, above) admissible under the Rules of Procedure of the Boards of Appeal ("RPBA 2003", as published in OJ EPO 2003, 61 to 67, ie as they had been in force on the date of appeal and ever since, until RPBA 2007, as published in OJ EPO 2007, 536, came into force)?
- On which sets of claims would the Appellant wish to rely, if the above replacement was not admitted or if only some of the above "new" requests were admitted into the proceedings?
- Would those sets of claims admitted to these proceedings comply with Articles 123(2) and 123(3) and Rule 57a EPC 1973/Rule 80 EPC, respectively?

(3) In essence, at the hearing, both parties reiterated their previous arguments as submitted in writing. Therefore, only those points as presented during the

hearing, which have been of particular importance for this decision, will be summarised herein below.

(4) The Respondent's position with regard to the "new" requests could be summarised as follows:

- The Main Request and each of Auxiliary Requests 1 to 5 and 14 to 19 was either not admissible under Article 10a(2) RPBA 2003 or, if admitted, not allowable under Article 123(2) EPC, because the limitation of component (B) to "one polymer" contravened this Article.
- The odd-numbered Auxiliary Requests 7, 9, 11, 13, 21, 23, 25 and 27 were either not admissible under Rule 57a EPC 1973/Rule 80 EPC or, if admitted, not allowable under Article 123(3) EPC.
- Each of Auxiliary Requests 6 to 13 and 20 to 27 should be rejected because of the limitation of component (B) to "one polymer" contravening Article 123(2) EPC.

(5) In view of these objections, the Appellant, who took the opposite position to each of these issues, requested that, as a fall-back position, it should be allowed to return to the requests filed with the SGA in 2004 (section V, above), if none of the requests, as submitted in 2007 (section VIII, VIII(1) and X, above), was admitted into the proceedings.

(6) To the first question and the first objection in sections XVI(2) and XVI(4) (above), respectively, the Appellant took the view that it was entitled, on the basis of the request put forward in the Notice of Appeal (sections IV and XIV(1), above), to file a Main

Request directed to the patent in suit as granted, and subsidiary requests within the ambit of the patent as granted in order to overcome any objections, which might persist against this Main Request.

Moreover, it argued that the wording of each Claim 1 of Auxiliary Requests 2 to 5 and 16 to 19, having the structure as referred to in section XVI(1), above, with separately listed embodiments (a) to (d) (as quoted) or (a) and (b), respectively, was to serve, by returning in principle to the granted version, the sole purpose of preventing any valid objection of lack of clarity under Article 84 EPC/EPC 1973 as raised by the Respondent against the limitation to "styrene resin" in the previous amended Main Request (section VI, above).

(7) This argument was disputed by the Respondent, according to whom, it would have been possible to prevent or to overcome this objection in a different way.

Furthermore, the Respondent put emphasis on the fact, that not a single argument had been provided in the SGA challenging the decision under appeal with regard to any combination of (A) with a component (B) other than "styrene resin". Nor had the Appellant, with respect to the new requests, presented its complete case in the SGA as required by the RPBA (Article 10a(2) RPBA 2003). Therefore, the addition or reinstatement of features to claims extending beyond the claims as defended in the SGA (ie beyond claims including any component (B) other than styrene resin) would create a fresh case, which should not be admitted (section XVI(4), above: first point).

(8) The parties also took diverging positions concerning the question of whether the scope of the claims had been changed upon replacement of the expression "consisting essentially of" by "consisting of" with an additional list of optional further components in the odd-numbered auxiliary requests (section XVI(4), above: second point).

The Respondent argued in this respect that the formulation as used eg in Claim 1 of Auxiliary Request 1 (see section XVI(1), above) would allow to add any amount of the further optional components to the composition. However, this would, according to case law, extend the scope of the claimed composition beyond the scope of [Claim 1] containing the expression "consisting essentially of" (A) and (B). Moreover, this possibility to add any amounts of a further component changed, in the Respondent's opinion, also the meaning of the percent ranges in Claim 1 of these requests due to the absence of any definition of the basis for these percentages (cf. section XI(2), above, in particular its paragraph 2).

By contrast, the Appellant referred to passages referring to expressions such as "of the total amounts of Components (A) and (B)" eg on page 13, lines 8/9 and last line to page 14, line 1, page 14, lines 13/14 and last line to page 15, line 1 to demonstrate that the allegations concerning the percentages had been wrong. It additionally expressed its willingness to insert this clause "of the total amount of Components (A) and (B)" into each claim, where and when deemed necessary by the Board.

With regard to the above objection under Article 123(3) EPC, the Appellant then pointed out that this issue had never been addressed before and, moreover, took the view that both formulations would be equivalent and would, for the skilled reader, have the same meaning and scope, because the further components were not necessarily present, so that the scope of Claim 1 in each of these requests would correspond directly or at most to [Claim 1].

In view of this position of the Appellant, the Respondent saw two conceivable interpretations for each Claim 1 in question. Either, if the Appellant's position was valid, the amendment would not have been occasioned by a ground for opposition and, therefore, these requests would not be admissible under Rule 57a EPC 1973, or, if its own position was correct, the amendment would contravene Article 123(3) EPC.

(9) The third issue listed in section XVI(4), above, concerning the question of whether the replacement of "at least one kind of polymer selected from ..." disclosed in an open-worded claim ("comprising" in Claim 1) by "one polymer selected from ..." in a self-contained claim ("consisting essentially of" or "consisting of") in [Claim 1] and in the new Claims 1 of each new Auxiliary Request contravened Article 123(2) EPC was discussed in great detail.

(10) The Appellant disputed the preliminary, provisional view taken by the Board in the Communication (section XIII, above, No. 6.2) on the basis of the formulation on in the Summary of the Invention on pages 2 and 3 and page 7, paragraph 2, where reference had been made to "at least a polymer selected from the

group consisting of styrene resin, polyamide resin, polyolefin and rubber-like elastomer". Furthermore, it relied also on the wording as used in Claim 1, on page 13, paragraphs 3 and 4, where mention was made of "one kind of polymer", on the passages starting in the last paragraph of page 13, referring for each the alternative separately to "When Component (B) is composed of ... alone", and to each of the examples wherein one specific PC had been combined with a specific polymer of each kind of component (B).

In its opinion, the formulations used in these passages clearly supported the wording of "one polymer" as used in the present Claims 1 and as already accepted by the Examining Division before grant. The examples would have described "the same as what is claimed now".

Particular emphasis was put by the Appellant on the argument that the formulation "(at least) a polymer" would clearly include and also mean "one polymer (alone)" and, therefore, would have disclosed "one polymer" as opposed to "two polymers".

(11) By contrast, the Respondent argued along the lines as represented by the preliminary, provisional view taken by the Board in the above Communication. In particular, it pointed out that the expression "one kind of polymer selected from the group of ..." meant, in its view, that at least "one family" (= one kind) of those groups of polymers had to be present, but did not refer to a particular, single polymer. Nor would the reference to "at least a polymer" clearly and unambiguously have pointed to "one (single) polymer", in particular in the context with the possibility to

add further components to the composition, as confirmed by the use of "comprising" in Claim 1.

Moreover, the Respondent argued that the disclosure in the examples, each of which disclosed a specific combination of two specific polymers, could not be generalised to the combination of the class/family of polycarbonates as defined in each Claim 1 as Component (A), with one polymer selected from a class or family of polymers conceived in the claim as possible Component (B). Rather, this generalisation would have led to a violation of Article 123(2) EPC.

(12) When the parties indicated that they did not wish to add further comments to the issues discussed, the debate was closed on these issues and it was indicated that the deliberation could lead to a final decision on these points.

XVII. At this point, the valid requests of the parties were as follows:

The Appellant requested that the decision under appeal be set aside and the opposition be rejected or, in the alternative, that the patent in suit be maintained on the basis of any one of the Auxiliary Requests 1 to 27 as filed during the oral proceedings. Additionally, it requested the reimbursement of the appeal fee.

The Respondent requested that the appeal be dismissed.

Reasons for the Decision

1. The appeal is admissible.

2. The RPBA in the version in force on the date of the filing of the appeal (here: 19 March 2004; cf. section XVI(2), above) set out in Article 10a(2): "The statement of grounds of appeal and the reply shall contain a party's complete case. They shall set out clearly and concisely the reasons why the decision under appeal is challenged or supported ..." and in Article 10b(1): "Any amendment to a party's case after it has filed its grounds of appeal or reply may be admitted and considered at the Board's discretion. The discretion shall be exercised in view of inter alia the complexity of the new subject-matter submitted, the current state of the proceedings and the need for procedural economy." The essentials of these regulations have not been changed. The jurisprudence referred to by the Appellant (section XIV(1), above) relates, however, to an older superseded, and therefore no longer applicable version of the RPBA.
- 2.1 As set out in the above Facts and submissions, in particular, sections IV and V, above, the claims as granted had been replaced by amended claims limited to the presence of "styrene resin" as Component (B) of the claimed composition.
- 2.2 As further shown in sections VIII, VIII(1) and X, above, these amended claims were then again replaced by the broader claims of a total of 24 different "new" requests, after the first summons to oral proceedings had been sent out, more than three years after the filing of the SGA. Moreover, as argued by the Respondent (section XVI(6), above), the SGA did not contain a single argument challenging the decision under appeal with regard to any combination of (A) with a Component (B) other than "styrene resin".

- 2.3 Therefore, any broadening of the scope of the claims to encompass further compositions beyond those included in the amended requests, which had been submitted with the SGA, constituted, in the Board's view, a fresh case at a very late stage of the proceedings.
- 2.4 Having taken all these facts and findings into account, the Board has consequently come, in application of RPBA 2003/RPBA 2007, to the conclusion, not to admit the new Main Request, which had a significantly broader scope than the Main Request as submitted with the SGA.
- 2.5 These findings have equally been valid for each of Auxiliary Requests 1 to 5 and 14 to 19 (cf. section XVI(1), above).
- 2.6 Consequently, the Board, after deliberation, informed the parties of the decision on the basis of Article 10b(1) RPBA 2003/Article 13(1) RPBA 2007 neither to admit the new Main Request nor the new Auxiliary Requests 1 to 5 or 14 to 19 in the proceedings, because the scope of their Claims 1 extended beyond a combination of the PC of Component (A) and a styrene resin as Component (B) and, thus, constituted a fresh case filed at too late a stage of the procedure.
3. As set out in sections XVI(1) and XVI(8), above, each Claim 1 according to the remaining odd-numbered Auxiliary Requests 7, 9, 11, 13, 21, 23, 25 and 27 related to a composition consisting of the branched PC Component (A) and Component (B), both within particular weight percentages, and optionally the same further ingredients as listed in the last paragraph of Claim 1 of Auxiliary Request 1, quoted in section XVI(1), above.

According to the Appellant's letter dated 4 July 2007, page 2, first paragraph, the new Auxiliary Request 1 was filed with the purpose to overcome any objection based on D15, which in contrast to the binary system according to the patent in suit disclosed a ternary or even a quaternary PC resin system. This argument would also appear to be valid for the other odd-numbered auxiliary requests. Consequently, the Board accepts that these auxiliary requests were occasioned by a ground for opposition (Rule 57a EPC 1973/Rule 80 EPC).

3.1 However, the Board cannot share the Appellant's view (section XVI(8), above) that the present wording "consisting of ... and optionally ...", mentioned in section 3, above, instead of "consisting essentially of ..." would not extend the scope of the claims beyond [Claim 1], the broadest claim in the granted version of the patent in suit (Article 123(3) EPC), because, as also argued by the Respondent, none of Claims 1 of the above requests contains a limitation to the amount of the optional additional components.

3.2 According to established jurisprudence, the expression "consisting essentially of" has a particular meaning, as explained in the Decision T 0472/88 of 10 October 1990 (not published in OJ EPO), No. 3 of the reasons: "In the Board's view the term 'consisting essentially of' means that in addition to those components which are mandatory ... other components may also be present in the composition, *provided that the essential characteristics of the composition are not materially affected by their presence.*" (emphasis added).

3.3 This latter proviso would not, in the Board's view, be met if, although still within the wording of the

respective claims, certain amounts of an optional component were incorporated into the composition. Thus, to give just one example, reference can be made to an inorganic filler such as glass fibres (page 16, line 5/§ [0038]), the influence of which on fluidity of GF reinforced polymer compositions is well-known (cf. eg the fluidity values in [Examples 1 and 13]). The fact, that compositions without any third component were also encompassed by the claims, does not invalidate the above reason for the decision on this issue.

- 3.4 It follows that no Claim 1 of any one of Auxiliary Requests 7, 9, 11, 13, 21, 23, 25 and 27 (cf. the second item in section XVI(4), above) complies with Article 123(3) EPC. Consequently, these requests are refused.
4. With regard to the third item in section XVI(4), above, reference must be made to the preliminary, provisional view communicated by the Board to the parties on 22 November 2007 (section XIII, above). As pointed out therein, the application had referred in a number of passages to "at least one kind of polymer " or "at least a polymer" which were selected from some generic groups of polymers (the Respondent interpreted the term "kind" as "family"), but it had never referred anywhere to "one polymer". Moreover, the Board had expressed therein some doubts about whether the examples in the application could provide a proper basis for the combinations of components (A) and (B) as defined in each Claim 1 of all the valid requests then on file, some of which are those still to be decided on.
- 4.1 Contrary to the findings of the Examining Division in the minutes of pre-grant proceedings (as referred to in

section XI(3), above), that the examples would provide a proper basis for the compositions according to [Claim 1] (limited to the use of "one polymer"), the Board takes the view, as indicated in the Communication, that a particular blend of two individual polymeric components in specific amounts as disclosed in a given example does not provide an appropriate basis for a combination of two polymer components defined only in generic terms, as in the present wording of those claims still at stake (Auxiliary Requests 6, 8, 10, 12, 20, 22, 24 and 26).

This is even valid for Claim 1 of Auxiliary Request 12 or Auxiliary Request 26, both relating to a combination of a branched PC as defined in component (A) and one polymer of any ABS-type and its use, respectively.

[Example 1], however, discloses only the combination of the particular PC "A-1" with the specific "ABS^{*3}", each having its own specific properties. The same is true for [Examples 3 and 4], wherein polycarbonates A-2 and A-3, respectively, had been combined with "ABS^{*3}".

However, not every polymer of the ABS type or "kind" or "family" (cf. § [0017], § [0018] and § [0020]) is identical to "ABS^{*3}", whilst it is agreed that the term "ABS" includes "ABS^{*3}".

Therefore, the use of this particular "ABS^{*3}" does not provide a proper basis under Article 123(2) EPC for the generalisation of the definition of Component (B) to any "one polymer selected from acrylonitrile-butadiene-styrene (ABS) resin", ie the ABS family. Nor does each of the individual polymers A-1, A-2 and A-3 (see Table 1-1) provide such a basis for the generalisation to the entire PC family of Component (A), let alone any

conceivable combination of both components in their generality.

Since, as shown above, Claim 1 of Auxiliary Request 12 does not have an appropriate basis under Article 123(2) EPC in the examples, this is valid all the more for each Claim 1 of any one of Auxiliary Requests 6, 8 and 10, and of each one of Auxiliary Request 20, 22, 24, in all of which the definition of Component (B) is even broader and encompasses further styrene resin "families" (cf. § [0017] to § [0020]). Hence, the conclusion in the Examining Division's decision on Article 123(2) EPC 1973, as quoted by the Respondent (section XI(3), above), cannot be agreed to.

- 4.2 Moreover, at the oral proceedings, another more general aspect of this issue was also intensively discussed, viz. that of whether the wording of "a polycarbonate resin composition comprising (A) ... and (B) ... at least one kind of polymer selected from ..." (Claim 1) or of "at least a polymer selected from ..." (at some instances of the description; cf. section XIII, above No. 6.1) would provide an appropriate basis under Article 123(2) EPC for the wording "one polymer selected from ..." as used in each Claim 1 of the all the requests of the Appellant.

In this context, one must not overlook that the expression "selected from" was not followed by a list of individual compounds, but by a reference to generic groups of different polymers. Moreover, Claim 1 and elsewhere in the application referred to the presence of at least one kind of polymer or at least a polymer of those generic groups, but nowhere to "one polymer". Nor does the indefinite article "a" in the context with

"at least a polymer selected from" a number of generic groups of polymers as disclosed in the application amount, in the Board's opinion and as agreed to by the Respondent, to the clear and unambiguous disclosure of "one polymer". This view is even further confirmed by the wording in each of Claims 5 to 8, which referred to polycarbonate resin compositions, wherein each component was present in certain amounts and Component (A) was "branched polycarbonate" and Component (B) was "styrene resin", "polyamide resin", "polyolefin" or "rubber-like elastomer", respectively, ie each referred to a generic class of substances.

In the Board's view, both expressions ("at least one kind of polymer" or "at least a polymer" being selected from the generic groups already mentioned) have the same meaning and amount to nothing more than only a general reference to a polymer class of any kind within the generic group(s), whereby the polymer class refers to a mandatory component of the claimed composition.

- 4.3 When amending the text of a patent application/patent specification, the Applicant/Patent Proprietor has, however, the obligation to demonstrate that the suggested amendment complies with Article 123(2) EPC. In this respect, the balance of probability is not, however, the appropriate standard. Rather, a more rigorous standard, equivalent to "beyond reasonable doubt", has, in the Board's opinion, to be applied whether the amendment complies with this Article (cf. T 1239/03 of 2 November 2006, in particular No. 3.3.3, as referred to in GRUR Int. 2007, 10, 859) The Appellant has not, however, discharged this burden.

- 4.4 It follows that the application text does not provide a clear and unambiguous basis for the formulation "one polymer selected from ..." as used in the first claim of any one of the requests still at stake, so that none of these requests meets the requirements of Article 123(2) EPC.
- 4.5 For these reasons, the Board has come to the conclusion that Auxiliary Requests 6, 8, 10, 12, 20, 22, 24 and 26 cannot be successful either.
5. As no further requests have been filed by the Appellant, the conditions for the fall-back position of the Appellant do not apply and none of the valid requests on the file has been successful, the revocation of the patent in suit by the Opposition Division cannot be reversed and the patent in suit cannot be maintained with any of the versions of claims maintained by the Appellant. Consequently the appeal cannot be successful.
6. Since the appeal is not, for the reasons given above, successful, the request for reimbursement of the appeal fee cannot be granted either (Rule 67 EPC 1973).

Order

For these reasons it is decided that:

1. The appeal is dismissed.

2. The request for reimbursement of the appeal fee is refused.

The Registrar:

The Chairman:

E. Görgmaier

R. Young