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**Datasheet for the decision
of 12 October 2012**

Case Number: T 1062/09 - 3.3.03
Application Number: 99907726.6
Publication Number: 1062248
IPC: C08F 2/38, C08F 220/12,
C09D 157/00
Language of the proceedings: EN

Title of invention:
Polymer Composition

Patentee:
Lucite International UK Limited

Opponent:
BASF SE

Headword:
-

Relevant legal provisions:
EPC Art. 112, 123(2)
RPBA Art. 12(4)

Keyword:
"Added subject-matter - yes (main request, first-fifth
auxiliary requests)"
"Late filed requests- not clearly allowable- not admitted to
procedure"
"Referral of a question to the Enlarged Board of Appeal- (no)-
no divergent application of law"

Decisions cited:
R 0011/11, T 0144/09, T 0848/09

Catchword:
-



Case Number: T 1062/09 - 3.3.03

DECISION
of the Technical Board of Appeal 3.3.03
of 12 October 2012

Appellant: Lucite International UK Limited
(Patent Proprietor) Queens Gate, 15-17
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Southampton
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Representative: Walsh, David Patrick
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Respondent: BASF SE
(Opponent) Carl-Bosch-Strasse 38
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Representative: BASF SE
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Decision under appeal: Decision of the Opposition Division of the
European Patent Office dated 16 February 2009
and posted 19 March 2009 revoking European
patent No. 1062248 pursuant to
Article 101(3)(b) EPC.

Composition of the Board:

Chairman: B. ter Laan
Members: M. C. Gordon
C.-P. Brandt

Summary of Facts and Submissions

- I. The appeal by the patent proprietor lies from the decision of the opposition division announced on 16 February 2009 and posted on 19 March 2009 revoking European patent number EP-B1-1 062 248 (granted on European patent application number 99 907 726.6, derived from international application number PCT/GB1999/000617, published under the number WO 1999/046301).
- II. The patent was granted with a set of 18 claims, whereby claim 1 read as follows:
- "A method of preparing a branched polymer comprising mixing together a monofunctional monomer having one polymerisable double bond per molecule with from 0.3-100% w/w (of the weight of the monofunctional monomer) of a polyfunctional monomer having at least two polymerisable double bonds per molecule and from 0.0001-50% w/w (of the weight of the monofunctional monomer) of a chain transfer agent and optionally a free-radical polymerisation initiator and thereafter reacting said mixture to form a polymer, wherein the weight average molecular weight (Mw) of the branched polymer is in the range 2000-200,000."
- Claims 12, 17 and 18 were independent claims whereby claim 12 was directed to a branched polymer, and claims 17 and 18 to methods of preparing a branched polymer.
- III. A notice of opposition against the patent was filed on 20 April 2005 in which revocation of the patent on the grounds of Art. 100(a) EPC, (lack of novelty, lack of

inventive step), Art. 100(b) EPC and Art. 100(c) EPC was requested.

IV. The decision of the opposition division was based on a set of 19 claims filed at the oral proceedings held before the opposition division. Claim 1 of this set of claims read as follows (differences compared to claim 1 as granted being indicated in **bold**):

"1. A **non-solution** method of preparing a **soluble** branched polymer comprising mixing together a monofunctional monomer having one polymerisable double bond per molecule with from 0.3-100% w/w (of the weight of the monofunctional monomer) of a polyfunctional monomer having at least two polymerisable double bonds per molecule and from 0.0001-50% w/w (of the weight of the monofunctional monomer) of a chain transfer agent and optionally a free-radical polymerisation initiator and thereafter reacting said mixture to form a polymer **such that the conversion of monomer to polymer is >90% and** wherein the weight average molecular weight (Mw) of the branched polymer is in the range 2,000-200,000."

Claim 2 of this set was newly introduced compared to the patent as granted and read as follows:

"A method as claimed in claim 1, wherein the polyfunctional monomer is in the range 0.5-100% w/w (of the weight of the monofunctional monomer)."

Other claims were also amended. The details of these amendments are however not of relevance to the present decision.

The decision held that the claims did not satisfy the requirements of Art. 123(2) EPC. In essence, the opposition division found that the feature of the conversion being >90% had only been disclosed in connection with the feature "one-step polymerisation" and "in the absence of solvent", which features were not present in claim 1, resulting in an unallowable generalisation. Accordingly the patent was revoked.

- V. On 6 May 2009 the patent proprietor lodged an appeal against the decision, the prescribed fee being paid on the same date.

The statement of grounds of appeal was submitted on 22 July 2009, accompanied by a main request and five sets of claims forming first to fifth auxiliary requests.

Claim 1 of the main request was identical to claim 1 of the request underlying the decision of the opposition division.

Claim 1 of the first auxiliary request specified additionally that the reaction was carried out in a one step polymerisation. Thus the corresponding part of the claim read:

"...and thereafter reacting said mixture **in a one step polymerisation** to form..." (Board's emphasis).

Claim 1 of the second auxiliary request differed from the main request by inclusion of the feature "in the absence of solvent as diluent". The corresponding part of the claim thus read as follows:

"...thereafter reacting said mixture to form a polymer **in the absence of solvent as diluent...**".

Claim 1 of the third auxiliary request included the two additional features noted for the first and second auxiliary requests, the corresponding part of the claim reading as follows:

"...thereafter reacting said mixture **in a one step polymerisation in the absence of solvent as diluent to form a polymer...**"

Claim 1 of the fourth auxiliary request differed from claim 1 of the second auxiliary request by specifying reaction "in the absence of solvent", omitting the wording "as diluent".

Claim 1 of the fifth auxiliary request differed from claim 1 of the third request by omitting the term "as diluent".

All sets of claims contained claim 2 as noted for the set of claims considered by the opposition division.

The appellant made a further submission with a letter dated 8 May 2012, accompanied by further documents.

- VI. The opponent - now the respondent - replied with a letter dated 4 December 2009. *Inter alia* it was requested not to admit any of the requests newly filed with the statement of grounds of appeal to the procedure. A further submission, containing additional documents was made with letter dated 21 November 2011.

- VII. On 1 August 2012 the Board issued a summons to attend oral proceedings. In a communication dated 14 August 2012 the Board stated that the admissibility of the requests filed with the statement of grounds of appeal would, if necessary, be discussed at the oral proceedings. Further, in view of the decision of the opposition division it was intended to restrict scrutiny to the matters of Art. 123(2) EPC and, as appropriate, Art. 84 and 123(3) EPC.
- VIII. By letters bearing the dates 13 August 2011 [sic] and 14 September 2011 [sic] received on 13 August 2012 and 14 September 2012 respectively, the respondent requested dismissal of the appeal in analogy to Petition R 11/11 (14 November 2011), which petition had been in respect of decision T 144/09 (4 May 2011). All auxiliary requests were deemed to be inadmissible. Furthermore, none of the requests met the requirements of Art. 123(2) EPC.
- IX. By letter dated 14 September 2012 the appellant argued in favour of the admissibility of the requests filed with the statement of grounds of appeal, invoking T 848/09 (7 October 2011).
- X. Oral proceedings were held before the Board on 12 October 2012.

During the course of the oral proceedings, after discussion of the requests submitted with the statement of grounds of appeal, the appellant presented three further auxiliary requests, numbered 6 to 8. Claim 1 of all of these was identical to claim 1 of the fifth auxiliary request as submitted with the statement

of grounds of appeal, i.e. included the features "one step", "absence of solvent" and "conversion of monomer to polymer is >90%".

Claim 2 had been deleted from all of the newly filed auxiliary requests.

The auxiliary requests 6 to 8 differed from each other in amendments to the higher numbered claims, the details of which are not of relevance to this decision.

XI. The arguments of the appellant can be summarised as follows:

- (a) The patent proprietor had been taken by surprise by the objection raised by the opponent during the oral proceedings before the opposition division in respect of the omission of the term "absence of solvent" from claim 1. In the written procedure objections had been raised with respect to the features "conversion of monomers" and "one step" but not against the feature "absence of solvent".

It had not been possible during the time available to consider all the ramifications of incorporating "absence of solvent" into the claim. In particular, it was not clear in what way "non-solution method" differed from "absence of solvent", the concern being that the presence of both terms in the claim might lead to confusion as to the meaning of the claim as a whole.

The new requests had been filed at the earliest possible stage of the proceedings, i.e. with the

statement of grounds of appeal after having had sufficient time to carefully consider and formulate these. The filing of requests to take account of this unexpected turn of events only on appeal was within the normal course of proceedings, as followed from T 848/09, reasons 1. The present case differed from that considered in T 144/09, underlying R 11/11, since in the present case an appropriate formulation of a request to overcome the objection raised was not immediately evident.

- (b) The term "absence of solvent" meant the absence of a solvent both for the monomer and for the polymer. In suspension polymerisation although the medium does not serve as solvent for the polymer, the monomer may be slightly soluble therein. Such a reaction would comply with the definition of "absence of solvent", but it was necessary to consider the reaction as a whole. The term "solvent" was furthermore not to be equated with the continuous phase of a suspension polymerisation. Such interpretation would result in limitation of the claim to bulk polymerisation. On the contrary, page 1 of the application clarified that what was meant by non-solution method was bulk or dispersion polymerisation.
- (c) The basis for the subject matter of claim 2 was page 6 lines 9-12 of the application as filed. Several examples provided support for the lower limit of 0.5 % w/w. Further examples supported the generalisation of this to higher values.

- (d) As the first claim of the sixth to eighth auxiliary requests submitted during the oral proceedings before the Board was identical to claim 1 of the fifth auxiliary request which had already been admitted to the proceedings, the question of non-admissibility could not arise in respect of the sixth to eighth auxiliary requests. These requests met the requirements of clarity for the reasons discussed in respect of the main request.

XII. The arguments of the respondent can be summarised as follows.

- (a) In analogy to case R 11/11 - T 144/09 none of the auxiliary requests submitted with the statement of grounds of appeal should be admitted to the proceedings. The appellant had been given sufficient opportunity to formulate amended requests on the occasion of the oral proceedings before the opposition division but had elected not to do so.

The conduct of the Board in admitting the requests was inconsistent with the findings of the Enlarged Board of Appeal in decision R 11/11 since the situation underlying that of the review case (T 144/09) and the present case was identical. The findings of T 939/09 and R 13/11 were also relevant.

Case T 848/09, invoked by the patent proprietor, was not relevant since it concerned submission of a request to address an objection pursuant to

Art. 56 EPC, not Art. 123(2) EPC. Clearly matters of inventive step required more complicated and detailed consideration than did matters pursuant to Art. 123(2) EPC which simply related to the question of whether a feature was present or not.

As the conduct of the Board was clearly divergent from the existing case law handed down by the Enlarged Board of Appeal in R 11/11 it was requested to submit the following three questions to the Enlarged Board of Appeal pursuant to Art. 112 EPC:

"Vorlagefrage an GBK nach Artikel 112:

- 1) Steht die Zulassung aller neuen Anträge (d.h. Hauptantrag und alle Hilfsanträge) im vorliegenden Beschwerdeverfahren im Widerspruch zu den Entscheidungen anderer BKs (etwa T 144/09, T 939/09) und im Widerspruch zu Entscheidungen der GBK (Etwa in R 11/11, R 13/11)?
- 2) Darf eine BK in einem Sachverhalt, der in allen wesentlichen Punkten gleich ist mit anderen Sachverhalten, die bereits zuvor von der GBK entschieden wurden, abweichen und zu einer anderen Entscheidung gelangen?
- 3) Darf eine BK neue, gegenüber dem Einspruch geänderte Haupt- und Hilfsanträge ins Verfahren zulassen, obwohl die Anträge bereits im Einspruch hätten eingereicht werden können, um dort einen Mangel nach Artikel 123(2) auszuräumen, wobei im Einspruchsverfahren:

- dieser Mangel und seine mögliche Behebung der Patentinhaberin von der Einspruchsabteilung erklärt worden ist,
 - zu dem die PI Bedenkzeit hatte
 - zu dem die PI Gelegenheit hatte, sich zu äussern, und
 - die PI Gelegenheit hatte, wenigstens einen neuen Antrag einzureichen, um den Mangel nach Artikel 123 auszuräumen?"
- (b) Regarding allowability of claim 2 of the main request pursuant to Art. 123(2) EPC the passage at page 6, lines 10-12 of the application as filed, cited by the appellant, disclosed the lower limit of 0.5 % w/w for simple monomers, and excluded reactive monomers or oligomers from this constraint. A corresponding restriction was however not present in claim 2.
- (c) Regarding the question of "non-solution method" and the feature "absence of solvent" there existed a question as to what a "solvent" was. As the patent contained no definition of what was meant by "solvent", there was no basis on which to establish the distinction between a solvent and a non-solvent and hence no basis for determining when a substance was to be considered a solvent or not.
- (d) Regarding admissibility of the requests submitted during the oral proceedings before the Board it was irrelevant that these were based on a set of claims which had already been admitted (auxiliary request 5). The claims of auxiliary requests 6 to

8 suffered from significant defects due to the unclarity of the term "solvent" and hence the meaning of the "absence" thereof. Furthermore the feature of >90% conversion was unclear as the basis therefor was not defined, nor was any method for measuring this given.

XIII. The appellant (patent proprietor) requested that the decision under appeal be set aside and the case be remitted to the opposition division for the remaining grounds of opposition to be heard on the basis of the main request or any of the auxiliary requests 1 to 5 all filed with the statement setting out the grounds of appeal filed on 22 July 2009 or on the basis of any of the auxiliary requests 6 to 8, filed during the oral proceedings of 12 October 2012.

XIV. The respondent (opponent) requested that the Appeal be dismissed and to refer to the Enlarged Board of Appeal the three questions filed during the oral proceedings of 12 October 2012.

Reasons for the Decision

1. The appeal is admissible.

Main request

2. Claim 2 of the main request specifies the content of polyfunctional monomer as being in the range of 0.5-100% w/w (of the monofunctional monomer). Claim 1 as originally filed specified a range of 0.3-100% w/w.

- 2.1 According to page 6, lines 10-12, of the application as filed the amount of polyfunctional monomer can be "preferably 0.3-25%, e.g. 0.5-10% based on the monofunctional monomer **when the polyfunctional monomer is a simple monomer, i.e. not a reactive oligomer or polymer.**" (Board's emphasis).
- 2.2 Thus the lower limit of 0.5% w/w for the polyfunctional monomer is disclosed only in association with a restriction with respect to the chemical nature of the polyfunctional monomer. This restriction is however absent from claim 2 of the main request.
- 2.3 In this connection it is immaterial if one or more of the examples discloses concentrations of polyfunctional monomers in the claimed range since each example relates to a specific combination of features which cannot be independently isolated and generalised.
- 2.4 Since claim 2 of the main request contains subject matter which extends beyond the content of the application as filed, it does not meet the requirements of Art. 123(2) EPC.
- 2.5 The main request is refused.

Auxiliary requests 1 to 5

3. Admissibility

- 3.1 Prior to the oral proceedings before the opposition division, by letter of 16 December 2008, the opponent (present respondent) submitted objections in respect of amendments made to claim 1 during the opposition

proceedings. The opponent invoked as the legal basis for these objections Art. 100(c) EPC. However as the objections related to amendments made during the opposition proceedings these should have been raised under Art. 123(2) EPC.

- 3.2 The contentious amendment concerned insertion of the feature "conversion of monomer to polymer is >90%" into the claim. According to the written submissions of opponent before the opposition division this feature had been originally disclosed mandatorily in combination with the feature "in one step".

In support of this written argument the opponent had cited *verbatim* from page 2, lines 57 and 58, of the patent (not of the application as filed which is the correct basis for an objection of added subject matter), and highlighted the features "performed in one step" and "conversion of monomer to polymer (>90%)". Although the opponent also quoted the passage containing the feature "absence of solvent", the opponent neither emphasised said passage nor referred to it in the written arguments. Only on the occasion of the oral proceedings before the opposition division a further objection was raised in respect of the omission of the feature "absence of solvent" from the claim.

- 3.3 The question to be answered is whether the auxiliary requests submitted together with the statement of grounds of appeal could and should have been submitted during first instance proceedings, and if so whether the patent proprietor had made a "considered and deliberate choice" not to file amendments during first instance proceedings (cf T 144/09 reasons 1.14), under

circumstances where it was evident which amendments could have been submitted to overcome the objections (T 144/09 reasons 1.5).

- 3.4 In view of the evidence that the aspect of the "absence of solvent" had only been raised at the oral proceedings before the opposition division (see section 3.2, above), it is plausible that the patent proprietor had been taken by surprise by the objection.

The submissions of the patent proprietor regarding the influence of introducing the term "absence of solvent" into the claim in view of the feature "non-solution method" also credibly demonstrate that an amendment to overcome the objection raised was not immediately apparent. On the basis of the foregoing it is concluded that the situation in the present case is closely aligned with that considered in T 848/09 and different from that considered in T 144/09.

- 3.5 The respondent/opponent has failed to demonstrate:
- that the objections raised at the oral proceedings before the opposition division should have been expected by the patent proprietor
 - that the amendments reflected in the auxiliary requests as submitted with the statement of grounds of appeal were immediately evident
 - that the amendments would not have given rise to further problems and hence
 - that the amendments could or should have been submitted on the occasion of the oral proceedings before the opposition division.

3.6 The strategy of the patent proprietor upon filing the statement of grounds of appeal was to submit as the main request the set of claims as refused by the opposition division, which demonstrates that in the first place the aim of filing the appeal was to overturn the decision of the opposition division. The auxiliary requests introduce features which attempt to address specifically the objection of the opposition division with respect to the feature "absence of solvent".

3.7 This structure of the requests is in accordance with the purpose of the appeal procedure as derivable from in Art. 12(4) RPBA.

3.8 Also, the Board can identify no grounds to conclude that the patent proprietor had been in a position at the oral proceedings to formulate the auxiliary requests as submitted upon entry to the appeal phase but merely elected not to do so.

3.9 Accordingly the filing of the auxiliary requests submitted with the statement of grounds of appeal is admissible and the auxiliary requests 1-5 submitted with the statement of grounds of appeal are admitted to the procedure.

4. Article 123(2) EPC

As the first, second, third, fourth and fifth auxiliary requests all contain the same claim 2 as the main request, the conclusions reached above also apply to these requests.

The first, second, third, fourth and fifth auxiliary requests therefore do not meet the requirements of Art. 123(2) EPC and are refused.

Sixth to Eighth auxiliary requests

5. The appellant argued that since claim 1 of all these requests was identical to claim 1 of the fifth auxiliary request which had been submitted with the statement of grounds of appeal, and admitted to the proceedings, these requests should also be considered as being admitted to the proceedings.

5.1 In making this submission the appellant confuses the issues of admissibility of the requests and their allowability.

It is true that the first to fifth auxiliary requests were admitted to the proceedings. The reasons for admitting these requests are set out in point 2 above. However the first to fifth auxiliary requests were filed at the earliest possible stage of the appeal proceedings, i.e. with the statement of grounds of appeal whereas the sixth, seventh and eighth auxiliary requests were filed at an advanced stage of the oral proceedings before the Board.

5.2 The question of admission of late filed requests to the appeal procedure is a matter for the discretion of the Board, and depends on the question in particular of whether the newly submitted requests are clearly allowable.

- 5.2.1 As discussed extensively above, and reported in the facts and submissions, the justification advanced by the appellant for not submitting amended claims before the opposition division was related to the impact upon the clarity and scope of claims of the occurrence in the same claim of the terms "non-solution method" and "absence of solvent".
- 5.2.2 Although the potential for problems to arise from this juxtaposition of features was referred to during the discussion at the oral proceedings before the Board, the appellant failed to provide any detailed explanation of what these potential problems might be or how these could be resolved. In particular no explanation was provided as to what this juxtaposition of features meant in terms of the subject matter covered by the claim.
- 5.2.3 On the contrary, the arguments advanced by the appellant with respect to the relationship of these two features accentuate and emphasise the potential for unclarity arising from their dual presence in the claim. In this connection it is sufficient to refer to the submission of the appellant that the "absence of solvent" is intended to denote a material which does not dissolve the polymer but might serve as a solvent for the monomer(s). This submission demonstrates that the meaning of the terms "non-solution method" and "absence of solvent" varies depending on which component of the reaction system is being considered. The claim however contains no feature which reflects this or allows the ambiguity in the term acknowledged by the appellant/patent proprietor to be resolved.

- 5.3 Under these circumstances the Board is unable to conclude that claims having the two features "non-solution method" and "absence of solvent" meet the requirements of clarity following from Art. 84 EPC. The consequence is that the claims according to the sixth, seventh and eighth auxiliary requests, submitted only at a late stage of the oral proceedings before the Board, are not clearly allowable, and therefore are not to be admitted to the procedure.
6. Request for submission of questions to the Enlarged Board of Appeal.
- 6.1 The respondent/opponent has taken the position that in admitting the auxiliary requests filed with the statement of grounds of appeal the Board is diverging from the case law as set out in R 11/11 which derived from decision T 144/09.
- 6.2 Case T 144/09 concerned a situation in which the patent proprietor had, on its own initiative, inserted one of a pair of linked features into the claim, i.e. without the arguments of the opponent having given rise to the need for such an amendment. This amendment was considered by the Board responsible for T 144/09 to be an unallowable generalisation. The remedy was immediately apparent - either to remove the added feature or to incorporate the linked feature (T 144/09 reasons 1.5 and R 11/11 reasons 7).
- 6.3 In the present case however, the disputed amendment had been made in response to an objection of the opponent filed at a late stage of the opposition proceedings. Neither the exact reason for the objection nor an

- appropriate amendment to address this had been immediately apparent to the patent proprietor.
- 6.4 Consequently decision T 144/09 and the related petition for review R 11/11 relate to a different set of circumstances to those underlying the present case.
- 6.5 That the present Board on the basis of the facts of the present case arrives at a different conclusion to that reached by the Enlarged Board of Appeal in case R 11/11 on the basis of different facts, does not constitute an inconsistent or divergent application of the law since, to repeat, the underlying facts are different.
- 6.6 Consequently the Board does not consider that a decision of the Enlarged Board of Appeal is required to ensure uniform application of the law, nor that a point of law of fundamental importance has arisen, which was not argued by the respondent.
- 6.7 In support of its arguments concerning the alleged divergent application of case law and in its request for questions to be put to the Enlarged Board of Appeal the respondent referred during the oral proceedings *inter alia* also to "decision T 939/09". The present Board is somewhat mystified by this reference since on the date of the oral proceedings in the present case (12 October 2012), case T 939/09 was still pending before Board 3.3.05. Similarly the respondent did not provide any elucidation in what way the findings of petition R 13/11, to which it also referred during the oral proceedings, were relevant to the present case.

6.8 The request for referral of three questions to the Enlarged Board of Appeal is therefore refused.

Order

For these reasons it is decided that:

1. The appeal is dismissed.
2. The request of the respondent to refer the three questions submitted during the oral proceedings of 12 October 2012 to the Enlarged Board of Appeal is refused.

The Registrar

The Chairman

E. Görgmaier

B. ter Laan