

Internal distribution code:

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

**Datasheet for the decision
of 8 July 2014**

Case Number: T 1668/13 - 3.3.03

Application Number: 04780147.7

Publication Number: 1663630

IPC: B29D22/00, B29D23/00, C08K3/08,
C08K3/10, C08K3/18, C08K3/22,
C08K3/30, C08K5/00

Language of the proceedings: EN

Title of invention:
METHOD TO MAKE SINGLE-LAYER PET BOTTLES WITH HIGH BARRIER AND
IMPROVED CLARITY

Patent Proprietor:
Invista Technologies S.à.r.l.

Opponent:
M. & G. Polymers U.S.A. LLC

Headword:

Relevant legal provisions:
RPBA Art. 13(1)

Keyword:
Late-filed requests - requests clearly allowable (no)
Late-filed request previously deleted -
procedural economy (no)

Decisions cited:
G 0009/91, T 1170/07

Catchword:



**Beschwerdekammern
Boards of Appeal
Chambres de recours**

European Patent Office
D-80298 MUNICH
GERMANY
Tel. +49 (0) 89 2399-0
Fax +49 (0) 89 2399-4465

Case Number: T 1668/13 - 3.3.03

**D E C I S I O N
of Technical Board of Appeal 3.3.03
of 8 July 2014**

Appellant II:
(Patent Proprietor)

Invista Technologies S.à.r.l.
Zweigniederlassung St. Gallen
Kreuzackerstrasse 9
9000 St. Gallen (CH)

Representative:

Schweitzer, Klaus
Plate Schweitzer Zounek
Patentanwälte
Rheingaustrasse 196
65203 Wiesbaden (DE)

Appellant I:
(Opponent)

M. & G. Polymers U.S.A. LLC
Akron Polyester Tech. Center
P.O. Box 590
6951 Ridge Road
Sharon Center OH 44274-0590 (US)

Representative:

HOFFMANN EITLE
Patent- und Rechtsanwälte
Arabellastrasse 4
81925 München (DE)

Decision under appeal:

**Interlocutory decision of the Opposition
Division of the European Patent Office posted on
12 July 2013 concerning maintenance of the
European Patent No. 1663630 in amended form.**

Composition of the Board:

Chairman B. ter Laan
Members: O. Dury
C. Brandt

Summary of Facts and Submissions

- I. The appeals of the patent proprietor and of the opponent lie against the decision of the opposition division posted on 12 July 2013 maintaining European patent No. 1 663 630 (application No. 04 780 147.7, based on international application WO 2005/023530, filed as PCT/US2004/025257) in amended form according to auxiliary request I filed with letter of 10 February 2012.
- II. The application as filed contained 30 claims, of which claims 1 to 4 and 9 read as follows:
- "1. A composition for containers comprising: polyester, partially aromatic polyamide, ionic compatibilizer, and a cobalt salt."
- "2. The composition of claim 1, wherein said partially aromatic polyamide is present in a range from about 1 to about 10 wt. % of said composition."
- "3. The composition of claim 1, wherein said ionic compatibilizer is present in a range from about 0.1 to about 2.0 mol-% of said composition"
- "4. The composition of claim 1, wherein said cobalt salt is present in a range from about 20 to about 500 ppm of said composition."
- "9. The composition of claim 1, wherein said ionic compatibilizer is preferably a copolyester containing a metal sulfonate salt."
- III. The granted patent was based on 18 claims, of which claims 1 to 4 and 9 corresponded respectively to claims

1 to 4 and 9 as originally filed, with the term "about" deleted in each of claims 2 to 4 and the term "preferably" deleted in claim 9. In addition, each of granted claims 2 to 4 and 9 was formulated as depending on the preceding claims.

IV. An opposition against the patent was filed in which it was requested that the patent be revoked on the sole ground of Art. 100(a) EPC together with Art. 56 EPC (inventive step).

V. The contested decision was based on a main request (maintenance of the patent as granted) and thirteen auxiliary requests. Claim 1 of auxiliary request I, filed with letter of 10 February 2012, which was maintained by the opposition division, read as follows (additions compared to claim 1 as filed are indicated by the Board in **bold**, deletions in ~~strikethrough~~):

"1. A composition for containers comprising: polyester, partially aromatic polyamide, ionic compatibilizer, and a cobalt salt,

- **wherein said partially aromatic polyamide is present in a range from 1 to 10 wt. % of said composition,**
- **wherein said ionic compatibilizer is present in a range from 0.1 to 2.0 mol-% of said composition,**
and
- **wherein said cobalt salt is present in a range from 20 to 500 ppm of said composition."**

VI. In its decision the opposition division made reference *inter alia* to the following documents:

D1: EP 0 301 719

D3: English translation of JP 2 663 578

D20: Data sheets "Exhibit 1" to "Exhibit 4" (9 pages)

The opposition division decided not to admit the fresh ground for opposition according to Art. 100(a) EPC regarding Art. 54 EPC (novelty) to the proceedings.

The main request, the patent as granted, was held not to be inventive in view of the combination of the closest prior art D1 with D3.

Auxiliary request I was considered to meet the requirements of Art. 123(2) EPC. Regarding inventive step, the claimed compositions were held to differ from those of the closest prior art D1 in that an ionic compatibilizer was mandatorily present in an amount of 0.1 to 2.0 mol.% of the composition. Containers produced from those compositions were found to exhibit improved haze compared to those prepared from compositions containing no ionic compatibilizer. Although D3 disclosed the use of ionic compatibilizers in compositions similar to those of D1 and for the same applications, it did not provide a hint to using an amount of 0.1 to 2.0 mol.% of ionic compatibilizer in order to reduce haze. Therefore, an inventive step was acknowledged.

VII. On 24 July 2013, appellant I (opponent) lodged an appeal against the above decision. The prescribed fee was paid on the same day. In the statement of grounds of appeal filed on 22 November 2013, the opponent requested that the decision of the opposition division be set aside and that the patent be revoked in its entirety. Reimbursement of the appeal fee was also requested. Also, several new documents were filed.

VIII. On 6 August 2013, appellant II (patent proprietor) lodged an appeal against the above decision. The prescribed fee was paid on 8 August 2013. In the statement of grounds of appeal filed on 22 November 2013, the proprietor requested that the decision of the opposition division be set aside and that the patent be maintained as granted (main request) or, alternatively, that the patent be maintained in amended form according to any of auxiliary requests A to S filed therewith. Also, several new documents were filed.

Claim 1 of auxiliary request F corresponded to claim 1 of auxiliary request I filed with letter of 10 February 2012 (maintained by the contested decision).

Claim 1 of auxiliary request K read as follows:

"1. A composition for containers comprising: polyester, partially aromatic polyamide, ionic compatibilizer, and a cobalt salt, **wherein said ionic compatibilizer is a copolyester containing a metal sulfonate salt.**"

IX. Following the request for accelerated examination submitted by the Oberlandesgericht Düsseldorf with letter of 21 October 2013, received on 24 October 2013, the parties were informed by a communication of the Board dated 2 December 2013 that the time limit of four months given to each party to reply to the statement of grounds of appeal of the adverse party would, in the present circumstances, not be extended and that they should reserve the date of 8 July 2014 for possible oral proceedings.

- X. By letters of 16 January 2014 and 11 April 2014 the proprietor submitted additional arguments.

- XI. By letter of 11 April 2014 the opponent submitted further arguments and raised objections pursuant among other things to Art. 100(a) EPC/Art. 54 EPC (novelty) in respect of two documents.

- XII. By letter of 22 April 2014 the parties were summoned to oral proceedings to be held on 8 July 2014.

- XIII. In a communication dated 28 May 2014 the Board set out its preliminary view of the case. Among other things, issues relating to the admissibility of the fresh ground of opposition pursuant to Art. 100(a) EPC/ Art. 54 EPC (novelty), the admissibility of the proprietor's auxiliary requests A to S and reimbursement of the appeal fee were addressed. Regarding inventive step, it was among other things pointed out that, considering that the wording of granted claim 1 was open as to the presence of components other than those specified therein ("comprising ...") and set no limits to the amounts of the components mandatorily present, it was questionable whether the technical problem addressed in the patent in suit was credibly solved over the whole scope of the claims, e.g. for a composition comprising a different polymer as the main component and/or comprising the components specified in granted claim 1 only in minute amounts.

- XIV. By letter dated 10 June 2014 the proprietor filed four auxiliary requests A to D, making the following statement (page 1):

"The Auxiliary Requests

In favor of procedural economics Appellant/Patentee has reduced the number of Auxiliary Requests. The following Auxiliary Requests were deleted: A, B, C, D, E, H, I, J, L, M, N, P, Q, R and S leaving Auxiliary Requests F, G, K and O in the proceedings. In order to have a consistent line of converging Requests Auxiliary Request F was replaced with Auxiliary Request T which is a combination of the features of Auxiliary Requests K and F. The resulting remaining Requests will be presented in the order K, T (=K+F), G, O. They have been reassigned with labels A through D."

Claim 1 of auxiliary request A read as follows:

"1. A composition for **polyester** containers comprising: polyester, partially aromatic polyamide, ionic compatibilizer, and a cobalt salt, **wherein said ionic compatibilizer is a copolyester containing a metal sulfonate salt.**".

Claim 1 of each of auxiliary requests B to D corresponded to claim 1 of auxiliary request A with additional features.

- XV. At the beginning of the oral proceedings held on 8 July 2014 in the presence of both parties, the proprietor withdrew its main request. The opponent withdrew its request for reimbursement of the appeal fee.

Following the decision of the Board during the oral proceedings not to admit auxiliary requests A to D, filed with letter of 10 June 2014, to the proceedings,

the proprietor filed a new main request and a new auxiliary request A.

Claim 1 of said main request corresponded to claim 1 of auxiliary request K filed with the statement of grounds of appeal.

Claim 1 of said auxiliary request A read as follows:

"1. A composition for containers ~~comprising~~ **consisting essentially of:** polyester, partially aromatic polyamide, ionic compatibilizer, and a cobalt salt,
- **wherein said partially aromatic polyamide is present in a range from 1 to 10 wt. % of said composition,**
- **wherein said ionic compatibilizer is present in a range from 0.1 to 2.0 mol-% of said composition,**
and
- **wherein said cobalt salt is present in a range from 20 to 500 ppm of said composition, and wherein said ionic compatibilizer is a copolyester containing a metal sulfonate salt."**

XVI. The opponent's arguments relevant for the present decision may be summarised as follows:

Auxiliary requests A to D filed with letter of 10 June 2014

- a) Following the introduction of "polyester" in claim 1, each of those requests constituted a new request that had not been submitted before, neither during the opposition proceedings nor in appeal. It appeared that said amendment was made in reply to the objection that no technical effect was plausible over the whole scope of the granted

claims. That objection had not only been made in the opponent's letter of 11 April 2014 but it had also been brought forward during the opposition proceedings. During the oral proceedings before the Board, the opponent referred to the letters of 13 January 2012 (page 1, paragraph 3) and 10 February 2012 (page 5, section 3.3.2). In these circumstances, there was no reason why those requests had not been filed earlier, for instance during the opposition proceedings or with the statement of grounds of appeal. Therefore, the requirements of Art. 12(4) RPBA were not met.

- b) The patent proprietor had already submitted thirteen auxiliary requests in the first-instance proceedings and nineteen auxiliary requests with its statement of grounds of appeal. Not only had the opponent had a tremendous amount of work in replying to the statement of grounds of appeal but he was now being confronted with a set of four new auxiliary requests shortly before the oral proceedings. The patent proprietor's behaviour amounted to an abuse of procedure, in particular taking into account the lack of convergency of the auxiliary requests previously on file.

- c) Auxiliary requests A to D *prima facie* raised new issues that went beyond the scope of the discussion of the contested decision and/or the statement of grounds of appeal and were not suitable to overcome the contested decision in respect of inventive step. Those requests were further not clearly allowable for the following reasons:

- i) If the expression "for polyester containers" was considered to be limiting, which was contested because it was merely related to the intended use, it was not supported by the application as filed, in particular not in combination with the additional technical features specified in each of auxiliary requests B to D. Hence, the requirements of Rule 80 EPC and Art. 123(2) EPC were not met;

- ii) The expression "for polyester containers" was not part of the granted claims and was therefore open to clarity objections. In that respect, it was not clear whether it meant that the claimed compositions mandatorily comprised more than 50 % polyester or, alternatively, that polyester should be the component present in the largest quantity. Since that expression was also not defined in the application as filed, it left the skilled person in doubt as to what was claimed (Art. 84 EPC);

- iii) It could not be derived from the wording of claim 1 of each of auxiliary requests A to D if the second "polyester" (... comprising: polyester, ...) referred to the same polyester as that of the expression "for polyester compositions". Therefore, it could not be concluded that polyester was a major component of the compositions being claimed, unclear as the term "major component" was;

- iv) The patent proprietor had provided no indication why the subject-matter so claimed

was suitable to remove the objection of lack of inventive step of the granted claims concluded in the contested decision (Art. 56 EPC). For each of those auxiliary requests, the proprietor had in particular not identified the distinguishing feature over the closest prior art D1, nor explained why an inventive step could be acknowledged over a combination of D1 and D3.

d) All the arguments provided in writing by the patent proprietor were in respect of the patent as granted. Therefore no argument had been provided as to the merit of the present auxiliary requests.

e) For those reasons, auxiliary requests A to D filed with letter of 10 June 2014 should not be admitted to the proceedings.

Requests filed during the oral proceedings

f) The filing of the huge amount of requests on appeal already amounted to an abuse of procedure (see section b) above) and that was all the more the case with the filing of the present requests during the oral proceedings before the Board.

g) The operative main and auxiliary request should not be admitted to the proceedings because

i) they were filed late;

ii) the opponent was not prepared to deal with those requests and would be taken by surprise should they be admitted to the proceedings;

- iii) the operative main request corresponded to auxiliary request K submitted with the proprietor's statement of grounds of appeal, which had been withdrawn by letter of 10 June 2014. The scope of the operative main request was, however, larger than that of the main request previously pending (auxiliary request A filed with letter of 10 June 2014). The operative main request was therefore not convergent with those previously on file, which was not allowable. The filing of the operative main request constituted a procedural abuse, and its admission would run counter to procedural economy.
- h) The introduction of "consisting essentially of" in auxiliary request A caused new objections that had never been dealt with before and that went beyond the scope of the discussion of the contested decision and/or the statement of grounds of appeal. Auxiliary request A was in particular not clearly allowable for the following reasons:
- i) Said amendment was not supported by the application as filed (Art. 123(2) EPC);
 - ii) Said amendment set no clear limit as to which compounds could be contained in the compositions claimed and, if present, in which amounts. Should the proprietor's arguments regarding the meaning of that expression be followed, "consisting essentially of" would be equivalent to "comprising", which further led to an

objection pursuant to Rule 80 EPC. Besides, should claim 1 be allowed, the skilled person would be left with the necessity to elaborate a research programme in order to find out which components could be present in which amounts in the claimed composition;

iii) Some of the additives listed in paragraph [0045] of the patent in suit such as fillers, dyes or heat stabilisers had an effect on the properties of the composition, e.g. yellowness, haze or oxygen barrier properties. It was not clear whether such additives could be present and, if yes, in which amount, in the compositions according to claim 1 of auxiliary request A;

iv) In reply to a question from the Board, the opponent indicated that sodium acetate was seen as being excluded from the scope of claim 1 since it was known that it might affect the properties of the claimed compositions, in particular of the polyester. Issues related to sodium acetate had been discussed at length in writing, in particular based on D20.

i) It was still not clear why those requests would be inventive over the combination of D1 and D3 (Art. 56 EPC).

j) For those reasons, the main and auxiliary request A should not be admitted to the proceedings.

XVII. The proprietor's arguments relevant for the present decision may be summarised as follows:

*Auxiliary requests A to D filed with letter of
10 June 2014*

- a) Auxiliary requests A to D corresponded to auxiliary request K, the combination of requests F and K, request G and request O, respectively, all filed together with the statement of grounds of appeal, further amended by indicating that they were directed to "polyester" containers. Therefore, those requests were mostly based on requests that were previously on file.

- b) The introduction of "polyester" was made in response to the argument that the claimed technical effect would not be present over the whole scope of the claims, which had been raised for the first time in the opponent's statement of grounds of appeal and further identified in the Board's communication. It also removed the objection that the auxiliary requests filed with the statement of grounds of appeal were not convergent. In that respect, the set of nineteen requests filed with the statement of grounds of appeal in fact amounted to three main groups of requests and was not as large as depicted by the opponent. By filing those sets of claims, the patent proprietor had only replied as soon as possible to the objections made by the opponent and the Board and had also concentrated on its strongest line of defence. The subject-matter so claimed could not have taken the opponent by surprise, nor was it more complex than that previously on file, nor did it complicate the proceedings. In these circumstances, there was no abuse of procedure.

- c) The addition of "polyester" in claim 1 of each of auxiliary requests A to D was supported at least by the second full paragraph on page 9 of the application as filed (Art. 123(2) EPC).

- d) Regarding Art. 84 EPC, the patent proprietor explained during the oral proceedings that the expression "for polyester containers" would be clear to a skilled person willing to understand and that it meant that the claimed compositions should be suitable for making containers containing polyester "as a major component". That conclusion was unambiguously derivable from the description of the patent in suit as a whole, in particular the introduction. Asked by the Board to clarify the meaning of "major component", the patent proprietor considered that it meant more than 50%. Claim 1, read in the light of the whole patent specification, was evidently limited to compositions based on polyester that were suitable for making PET bottles, i.e. comprised a polyester matrix.

- e) Regarding the merit of the auxiliary requests, in particular in respect of inventive step (Art. 56 EPC), it was evident that the arguments provided for the main request equally applied to each of the auxiliary requests. Those only limited the scope of the subject-matter being claimed without affecting the gist of the invention, which resided in the combination of the four components specified in granted claim 1.

- f) For those reasons auxiliary requests A to D filed with letter of 10 June 2014 should be admitted to

the proceedings.

Requests filed during the oral proceedings

- g) The main request corresponded to auxiliary request K filed with the statement of grounds of appeal. Accordingly it could not take the opponent by surprise. Answering a question from the Board, the proprietor confirmed that auxiliary request K filed with the statement of grounds of appeal had been deleted by letter of 10 June 2014. However, said deletion was intended to streamline the proceedings and it did not constitute a waiver of the subject-matter defined therein.

The main request had been submitted in direct reply to the objection of lack of clarity raised against the requests previously on file. Besides, it should be read in the light of the description, considering that the polyester was the main component. Therefore, it was suitable for removing the objection that the technical problem addressed in the patent in suit was not credibly solved over the whole scope of the claim.

- h) Auxiliary request A corresponded to the combination of auxiliary requests F and K filed with the statement of grounds of appeal, further amended by replacing the term "comprising" with the expression "consisting essentially of", which was allowable according to decision T 1170/07.

Regarding Art. 123(2) EPC, it was clear from the application as filed that the four components specified in original claim 1 were the essential components of the invention. Therefore, the

skilled person, willing to understand the invention, would understand from the original application as a whole that the claimed compositions should consist essentially of those four components.

"Consisting essentially of" meant that the claimed compositions comprised those components responsible for the technical effect that was achieved. Accordingly, all the additives specified in paragraph [0045] of the patent in suit could be present in such amounts that the compositions were suitable for containers and had the properties aimed at in the patent in suit. That expression was commonly used in patent claims and was usually considered to be clear in the sense of Art. 84 EPC.

In reply to a question from the Board, the proprietor argued that sodium acetate could also be present in the claimed compositions. Its presence in all the examples of the patent in suit in which an ionic compatibilizer consisting of a polyester containing a metal sulfonate salt was used had been discussed at length, e.g. during the written appeal proceedings. It was a known heat stabiliser corresponding to an optional additive as listed in paragraph [0045] of the patent in suit.

- i) For those reasons, the main and auxiliary request A should be admitted to the proceedings.

XVIII. Appellant I (opponent) requested that the decision under appeal be set aside and that European patent No. 1663630 be revoked.

Appellant II (patent proprietor) requested that the decision under appeal be set aside and that the patent be maintained in amended form on the basis of the main request, or alternatively on the basis of auxiliary request A, both requests filed during the oral proceedings on 8 July 2014.

XIX. The Board announced its decision at the end of the oral proceedings.

Reasons for the Decision

1. The appeals are admissible.

Auxiliary requests A to D filed with letter of 10 June 2014

2. Following withdrawal of the main request pending until then, namely the patent as granted, at the beginning of the oral proceedings, the operative requests at that stage were auxiliary requests A to D filed with letter of 10 June 2014. Since those requests, which have not been formally withdrawn by the patent proprietor, were all filed after oral proceedings had been arranged and after the communication of the Board setting out its preliminary view of the case had been received, their admissibility had to be assessed, in particular pursuant to Art. 13(1) RPBA.

3. Art. 13(1) RPBA specifies a non-exhaustive list of factors that may be considered by the Board in exercising its discretion for admitting requests filed

after the statement of grounds of appeal. A further decisive criterion for admissibility to the proceedings of late-filed requests is that they have to be clearly allowable (Case Law of the Boards of Appeal of the European Patent Office, 7th ed., 2013, IV.E 4.4.1 and 4.4.2).

3.1 In claim 1 of each of auxiliary requests A to D filed with letter of 10 June 2014, the expression "a composition for containers" was amended to "a composition for **polyester** containers" (emphasis added by the Board). Since the term "polyester" is not present in the same context in any of the granted claims, that amendment is to be fully examined as to its compatibility with the requirements of the EPC, including Art. 84 EPC (G 9/91, OJ EPO 1993, 408: reasons 19).

3.2 In that respect, the patent in suit provides no information regarding the meaning of the expression "for polyester containers". The passages of paragraphs [0021], [0046] and [0047] relied upon by the patent proprietor merely repeat the wording of claim 1 but fail to explain its precise meaning.

During the oral proceedings before the Board several interpretations of that expression were contemplated by the appellants, namely that polyester should be a major component, i.e. present in the largest quantity compared to the other components present in the claimed composition, that polyester should be present in an amount of more than 50 %, or that polyester should be the polymeric matrix of the claimed compositions. It was not shown during the oral proceedings that any of those interpretations did not make technical sense and/or would be excluded from consideration by the skilled

person. In that respect, apart from the examples, the patent specification contains no indication regarding the amount of polyester in the claimed compositions. Moreover, in the absence of any basis for the calculation of the "50%", it is unclear whether that amount would have to be calculated on the basis of the whole composition or only the four components mentioned in granted claim 1. Therefore, even if, to the proprietor's benefit, the expression "for polyester containers" were understood as meaning "more than 50%", the claim is still not clear because the exact meaning of 50% is not given.

3.3 In the wording of claim 1 of each of auxiliary requests A to D filed with letter of 10 June 2014, there is also no relationship between the polyester used in the expression "for polyester containers" and the polyester listed as one of the four mandatory components of the compositions being claimed. Therefore, although claim 1 of each of auxiliary requests A to D is directed to a composition comprising four components (polyester, partially aromatic polyamide, ionic compatibilizer and cobalt salt) and has to be suitable "for polyester containers", it is questionable if the wording of claim 1 requires that said composition comprising the four components is the composition that should be suitable for making a container or if it encompasses such compositions used e.g. as a layer of or as an additive/masterbatch in e.g. a PET bottle.

In that respect, the claims should be given their normal meaning, in the absence of any ambiguity in that sense, and should not be interpreted in the light of the description. Therefore, the proprietor's argument that it was evident from the patent in suit as a whole that the claimed subject-matter was limited to

compositions having a polyester matrix cannot be followed.

3.4 For those reasons, it is highly questionable if the skilled person would be in a position to decide unambiguously if he is working within or outside claim 1 of each of auxiliary requests A to D. Consequently, in the present case, the amendment of "for containers" to "for polyester containers" renders the subject-matter for which protection is sought unclear, contrary to the requirements of Art. 84 EPC.

3.5 Considering that the admission of any of auxiliary requests A to D would run counter to the need for procedural economy, the Board, exercising its discretionary power, decided not to admit any of auxiliary requests A to D filed with letter of 10 June 2014 to the proceedings (Art. 13(1) RPBA).

Requests filed during the oral proceedings

Main request

4. Considering that the main request was filed during the oral proceedings before the Board, its admissibility has to be assessed pursuant to Art. 13(1) RPBA.

4.1 It was agreed by the parties that said main request corresponds to auxiliary request K filed with the statement of grounds of appeal. From the wording used in the paragraph "The Auxiliary Requests" on page 1 of the proprietor's letter dated 10 June 2014 (see above section XIV), there can be no doubt that all the auxiliary requests filed with the statement of grounds of appeal, including auxiliary request K, were replaced by a set of four auxiliary requests A to D. The patent

proprietor argued that the claims had only been deleted, which did not constitute a waiver of the subject-matter defined therein. However, that argument cannot be followed because a replacement means that those requests are submitted instead of the previous requests, not in addition thereto.

- 4.2 In these circumstances, admitting the main request at such a late stage would run counter to procedural economy. This is particularly true in the present case since the proceedings had been accelerated in order to take into consideration a request submitted by the Oberlandesgericht Düsseldorf (see section IX).
- 4.3 Furthermore, returning to the former wording of the claims (according to auxiliary request K filed with the statement of grounds of appeal) by deleting the word "polyester" in the expression "for polyester containers" would expand the scope of the subject-matter being claimed, which had been limited with the proprietor's letter of 10 June 2014. Moreover, it would also change the proprietor's case in a direction that could not have been expected because all formerly pending auxiliary requests A to D had been amended in that manner. Auxiliary request K could evidently have been maintained as it was, had this been the proprietor's intention. Before the oral proceedings there had also been no indication at all that the proprietor had any intention of defending auxiliary request K as filed with the statement of grounds of appeal.
- 4.4 For these reasons, the main request is not admitted to the proceedings (Art. 13(1) RPBA).

Auxiliary request A

5. It was not disputed by the parties that auxiliary request A filed during the oral proceedings corresponded to a new request that had never been submitted in writing before the oral proceedings. Therefore, its admissibility has to be assessed pursuant to Art. 13(1) RPBA.
- 5.1 Claim 1 is based on the combination of original claims 1 to 4 and 9, further amended by replacing "comprising" with "consisting essentially of". Since that expression was not present in the granted claims, that amendment is to be fully examined as to its compatibility with the requirements of the EPC (G 9/91: reasons 19), i.e. including Art. 84 and 123(2) EPC.
- 5.2 It is accepted that the term "consisting essentially of" implies that the claimed compositions also comprise components other than those specified as mandatory in the wording of the claims, as long as it is not an "active agent" (T 1170/07, reasons 3.1). In the present case it means that, apart from the four mandatory components specifically mentioned in claim 1, only certain types and amounts of other components may be present in the claimed compositions, namely those types and amounts that do not materially affect the essential properties of the claimed compositions. Those include, in the present case and having regard to the technical problem to be solved as formulated in the patent in suit, properties such as reduced yellowness, haze and gas barrier properties (see e.g. paragraphs [0001] and [0021] and the examples of the patent in suit).
- 5.3 It was not disputed by the parties, in particular the proprietor, that the expression "consisting essentially

of" was not explicitly disclosed in the application as filed. Regarding Art. 123(2) EPC, it has therefore to be assessed whether or not there is a direct and unambiguous implicit disclosure in the application as filed for that amendment.

In that respect, a list of usual additives different from the four mandatory components specified in claim 1 of auxiliary request A is mentioned in the paragraph bridging pages 8 and 9 of the application as filed. Said list in particular encompasses additives such as dyes, pigments, fillers or heat stabilisers. However, no limitation is set in respect of the amounts of those additives. Therefore, said passage of the application as filed does not directly and unambiguously disclose that those components may only be present in so far as they do not affect the essential characteristics of the claimed compositions. Therefore, it is questionable if the requirements of Art. 123(2) EPC are met.

- 5.4 The list of optional additives disclosed in the application as filed comprises components such as dyes, pigments, antioxidants, light stabilisers and fillers which are likely to affect the essential properties of the claimed compositions, in particular yellowness, haze and gas barrier properties. In the absence of any limitation regarding the amounts in which those components may be used, both in the wording of claim 1 and in the whole patent specification, it is unclear how the amounts of these additives would be limited. In these circumstances, the question is whether the skilled person would be in a position to decide when he is working within or outside the scope of the claims (Art. 84 EPC).

- 5.5 During the course of both the opposition and the appeal proceedings, the use of sodium acetate in the claimed compositions turned out to be a crucial issue. In these circumstances, should auxiliary request A be admitted to the proceedings, questions would have arisen whether or not compositions comprising sodium acetate are encompassed by the subject-matter of claim 1 and, should that be the case, in how far the amount of sodium acetate would be limited (Art. 84 EPC).
- 5.6 In these circumstances, should auxiliary request A be admitted to the proceedings, the amendment "consisting essentially of" would have implied that complex new issues would have had to be dealt with during the oral proceedings for the first time, and neither the opponent nor the Board would have been prepared for them.
- 5.7 For these reasons, auxiliary request A filed during the oral proceedings is not clearly allowable and is therefore not admitted to the proceedings (Art. 13(1) RPBA).
6. Since none of the patent proprietor's requests is admissible, its appeal has to be dismissed and the patent has accordingly to be revoked.

Order

For these reasons it is decided that:

1. The decision under appeal is set aside.
2. The appeal of appellant II (patent proprietor) is dismissed.
3. European patent No. 1 663 630 is revoked.

The Registrar:

The Chairman:



B. ter Heijden

B. ter Laan

Decision electronically authenticated