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Datasheet for the decision of 24 October 2018

Case Number: T 1810/13 - 3.3.02

Application Number: 02747741.3

Publication Number: 1409600

IPC: C09D167/00

Language of the proceedings: EN

Title of invention:
BISPHENOL A DIGLYCIDYL ETHER-FREE COATING COMPOSITION FOR METAL SUBSTRATES

Patent Proprietor:
DSM IP Assets B.V.

Opponents:
Evonik Degussa GmbH
Akzo Nobel Coatings International B.V.
PPG Industries, Inc.

Headword:

Relevant legal provisions:
EPC Art. 54
RPBA Art. 13(1), 13(3)

Keyword:
Admissibility of appeal - (yes)
Late-filed facts - admitted (no)
Novelty - (no)
Late-filed request - adjournment of oral proceedings would have been required (no)

Decisions cited:
T 0594/01, T 0175/97

Catchword:

Europäisches Patentamt
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Beschwerdekammern

Boards of Appeal

Chambres de recours

Boards of Appeal of the
European Patent Office
Richard-Reitzner-Allee 8
85540 Haar
GERMANY
Tel. +49 (0)89 2399-0
Fax +49 (0)89 2399-4465

Case Number: T 1810/13 - 3.3.02

D E C I S I O N
of Technical Board of Appeal 3.3.02
of 24 October 2018

Appellant: (Opponent 1)	Evonik Degussa GmbH DG-IPM-PAT Rellinghauser Strasse 1-11 45128 Essen (DE)
Appellant: (Opponent 3)	PPG Industries, Inc. One PPG Place Pittsburgh, Pa.15272 (US)
Representative:	f & e patent Fleischer, Engels & Partner mbB Patentanwälte Braunsberger Feld 29 51429 Bergisch Gladbach (DE)
Respondent: (Patent Proprietor)	DSM IP Assets B.V. Het Overloon 1 6411 TE Heerlen (NL)
Representative:	DSM Intellectual Property P.O. Box 4 6100 AA Echt (NL)
Party as of right: (Opponent 2)	Akzo Nobel Coatings International B.V. Velperweg 76 6824 BM Arnhem (NL)
Representative:	Hobel, Klaus Akzo Nobel N.V. Legal & IP P.O. Box 9300 6800 SB Arnhem (NL)

Decision under appeal: **Interlocutory decision of the Opposition Division of the European Patent Office posted on 21 June 2013 concerning maintenance of the European Patent No. 1409600 in amended form**

Composition of the Board:

Chairman M. O. Müller
Members: P. O'Sullivan
M. Blasi

Summary of Facts and Submissions

I. This decision concerns the appeals filed by opponents 1 and 3 against the interlocutory decision of the opposition division according to which European patent 1 409 600 as amended and the invention to which it relates met the requirements of the EPC.

II. With the notices of opposition both opponents requested revocation of the patent in its entirety based on the grounds for opposition under Article 100(a)(lack of novelty and lack of inventive step) and Article 100(b) EPC, opponent 1 additionally requesting revocation on the ground of Article 100(c) EPC.

The documents submitted during opposition proceeding included:

D1 : US-A-5,739,215
F4 : Machine translation of JP 2001-172561
F4': Human translation of JP 2001-172561

III. The decision of the opposition division was based on a main request the claims of which had been filed with the letter of 26 September 2012.

Claim 1 of this request read as follows:

"1. *A substantially bisphenol A diglycidyl ether (BADGE)-free coating composition comprising:*
a. a non-linear polyester, having a molecular weight (Mw) higher than 20000, based on at least 80 weight % aromatic acid monomers (based on the total weight of acid monomers used for producing the polyester), an acid value between 3 and 0 mg KOH/gram resins and glass transition temperature (Tg) lower than 23 °C;

b. a phenolic based crosslinker; and
c. an organic solvent or water."

According to the contested decision:

The ground for opposition under Article 100(b) EPC was sufficiently substantiated. The subject-matter of claims 1-3 complied with Article 123(2) and (3) EPC and the invention defined in those claims was sufficiently disclosed.

Novelty over *inter alia* D1 was acknowledged. The subject-matter of claim 1 differed from comparative example B of D1 in terms of the acid value and the glass transition temperature (hereinafter: Tg) of the polyester. In this respect, the Tg mentioned in claim 1 was to be measured exclusively at a heating rate of 5°C/min.

The subject-matter of claim 1 was inventive in view of example II of D1 as closest prior art.

IV. That decision was appealed by opponents 1 and 3 (hereinafter: appellant-opponents 1 and 3 respectively). The statement of grounds of appeal of appellant-opponent 3 included the following test report:

A1: "D4 Nachstellversuche"

V. The patent proprietor (hereinafter: respondent) with the reply to the grounds of appeal filed *inter alia* the following evidence:

A2: Declaration of L. J. Molhoek.

VI. A communication of the board was sent in preparation for oral proceedings. With regard to the anticipation of the features of claim 1 by the disclosure D1, the board identified the Tg and the acid value as those features upon which the parties appeared to disagree (point 7.1, final paragraph).

VII. On 24 October 2018, oral proceedings took place before the board. The appellant-opponents maintained their requests submitted in writing. Appellant-opponent 3 restricted its request to admit all documents submitted in first instance proceedings to documents D1, F4 and F4'.

During oral proceedings the respondent submitted a new set of claims 1-3 as auxiliary request 1. Claim 1 of that request differed from claim 1 of the main request in that the non-linear polyester was limited to those having a molecular weight (Mw) higher than 65000.

VIII. The appellant-opponents' arguments, insofar as relevant to the present decision, may be summarised as follows:

Admissibility of the appeals and consideration of the objections under Articles 123, 83, 54 and 56 EPC

Both appellant-opponents presented detailed submissions with the grounds of appeal as to why the main request found allowable in the opposition division's decision contravened Articles 123, 83, 54 and 56 EPC. Consequently, both appeals complied with the requirements of Article 108 and Rule 99 EPC and were admissible. Moreover, the objections under Articles 123, 83, 54 and 56 EPC raised in the statements of grounds were sufficiently substantiated.

Main request - Novelty

(a) In respect of D1, the respondent's first line of defence, the allegation that comparative examples A/B of document D1 were not enabling, was not to be admitted into the proceedings. The allegation had been raised for the first time in oral proceedings before the board, and the appellant-opponents had had no time to prepare counterarguments. Furthermore, the epoxy novolac resin concerned was part of the composition, so that the nature thereof would in any case not affect the properties of the polyester recited in comparative examples A/B of D1.

(b) The respondent's second line of defence, the allegation that comparative examples A/B of D1 did not clearly and unambiguously disclose a substantially BADGE-free coating composition as required by claim 1, was not to be admitted into the proceedings. The allegation had been raised by the respondent for the first time at oral proceedings, neither having been raised in (written) appeal nor opposition proceedings. Further investigation and/or evidence would be needed to counter the allegation, for which additional time would be required.

(c) D1 in comparative examples A/B directly and unambiguously disclosed a composition according to claim 1 comprising a non-linear polyester having a Tg lower than 23°C and an acid value between 3 and 0 mg KOH/gram resin. Decision T 594/01 was to be applied. Although D1 did not refer to a method of measurement for the Tg, claim 1 of the main request was not limited to compositions in which the value

recited was obtained using a specific method. Rather, the claim covered a resin having the recited Tg and acid value obtained using any method. The statement in the patent (paragraph [0023]) according to which "[g]enerally the heating rate used by DSC measurements is 5 °C/min" did not constitute a definition of how the Tg was to be measured according to the patent, but rather a description of how the skilled person would commonly measure it. The rounding-off convention was not relevant to the novelty of the subject-matter of claim 1 over D1 - it was not logical to argue that the value "less than 3" should be interpreted as "less than 2.5". The relevant questions were whether the physically measured values of "3 mg KOH/g" and "less than 3 mg/KOH/g" on the one hand, and "23 °C" and "less than 23 °C" on the other hand could be distinguished from each other.

Auxiliary request 1 - admittance

Auxiliary request 1 was not to be admitted into the proceedings. The objection that the subject-matter of claim 1 of the main request lacked novelty over D1 had been raised from the outset of both the opposition and appeal proceedings, and the communication of the board sent in preparation of oral proceedings had identified the relevant issues. The finding of lack of novelty could thus not have been seen as a surprising development, and the request was consequently late filed. A request comprising a claim having the amendment now introduced into claim 1 had not been among any of the requests pursued during opposition and appeal proceedings and the amendment took the

appellant-opponents by surprise, raising new issues for which they were unprepared.

IX. The respondent's arguments, insofar as relevant to the present decision, may be summarised as follows:

Admissibility of the appeals and consideration of the objections under Articles 123, 83, 54 and 56 EPC

The grounds of appeal of both appellant-opponents failed to state the legal and factual grounds as to why the decision of the opposition division should be set aside, rather repeating or referring to the respective positions taken in opposition proceedings. The appeals should consequently be set aside as inadmissible. The same rationale applied to the respective objections under Articles 123, 83, 54 and 56 EPC, which should equally be set aside as inadmissible.

Main request - Novelty

(a) In a first line of defence, neither comparative examples A/B of D1 nor the corresponding description disclosed the specific type of epoxy novolac resin employed. This example was thus not an enabling disclosure and consequently did not anticipate the subject-matter of claim 1. The issue of enablement in this context should be admitted into the appeal proceedings as it had been on file and discussed during opposition proceedings, and was not complex in that it did not require additional investigatory effort for the parties to comprehend.

(b) In a second line of defence, comparative examples A/B of D1 did not clearly and unambiguously

disclose a substantially BADGE-free coating composition, as required by claim 1. This new issue should be admitted into appeal proceedings since it was straightforward and required no further investigatory effort. Its admission would thus not lead to a delay in proceedings.

(c) In a third line of defence, despite disclosing for the polyester a Tg of 23 °C and an acid value of 3, comparative examples A/B of D1 did not directly and unambiguously disclose the features "Tg lower than 23°C" (which excluded the value 23 °C) and "an acid value between 3 and 0 mg KOH/gram resin" (which excluded the end values 0 and 3) recited in claim 1. Decision T 594/01 referred to the uncertainty of physical measurements due to experimental error, but crucially assumed that a method was specified. Since D1 did not disclose any method of measuring the Tg, it was not possible to speculate on any inherent experimental error, and the conclusions drawn in T 594/01 could thus not be applied to the present case. For example, methods for measuring the Tg were very different from each other. Even if one were to assume that the Tg according to D1 was measured by DSC, there was no way of knowing which heating rate, known to have a significant impact on the measurement, had been applied. In construing claims, the description was to be taken into account, and from the patent (paragraph [0023]) and the examples, the skilled person would have known that the Tg recited in claim 1 must be measured using DSC at a heating rate of 5 °C/min. Furthermore, by applying the principles of the rounding-off convention according to T 175/97 and the Guidelines for Examination, Part G-VI, 8.1, the skilled person would interpret

the values recited in claim 1, namely less than 23 °C (for the Tg) as meaning less than 22.5 °C, and between 0 and 3 (for the acid value) as meaning less than or equal to 0.5 up to 2.5, thereby distinguishing them from the corresponding values disclosed in D1.

Auxiliary request 1 - admittance

Auxiliary request 1 was to be admitted into the proceedings. The board's finding of lack of novelty in respect of claim 1 of the main request had come as a surprise. The communication of the board in preparation of oral proceedings did not hint at the possible finding of lack of novelty. The amendment in claim 1 of auxiliary request 1 represented a combination of granted claims 1 and 4 and thus should not be surprising to the parties. On the contrary, the amendment was not complex and was *prima facie* allowable under Articles 123 and 54 EPC.

X. Appellant-opponents 1 and 3 requested that the appealed decision be set aside and the patent be revoked in its entirety. Appellant-opponent 3 requested admittance into the proceedings of documents D1, F4 and F4'.

XI. The respondent requested that the appeals be rejected as inadmissible, or alternatively, that the appeals be dismissed, or further alternatively, that the appealed decision be set aside and the patent be maintained in amended form based on the set of claims of auxiliary request 1 filed at oral proceedings before the board.

Within the purview of the request to dismiss the appeals, the respondent requested that the objections under Articles 123, 83, 54 and 56 EPC be held

inadmissible and that document A1 not be admitted into the appeal proceedings.

Reasons for the Decision

1. Admissibility of the appeals and consideration of the objections under Articles 123, 83, 54 and 56 EPC

1.1 The respondent submitted that the appellant-opponent's respective grounds of appeal failed to state the legal and factual reasons as to why the decision of the opposition division should be set aside, and merely repeated or referenced what had been set out in opposition proceedings. Specific examples of unsubstantiated grounds within the appellant-opponents' statements of grounds were not provided.

1.2 The board notes that the contested decision provided reasons as to why, in the opinion of the opposition division, the main request (identical to the present main request) met the requirements of the EPC, notably of Articles 123, 54, 56 and 83 EPC.

1.3 Appellant-opponent 1 in the statement of grounds of appeal provided detailed arguments as to why the claims of the main request did not meet the requirements of each of Articles 123(2), 83, 54 and 56 EPC. Specific reasons as to why the contested decision was considered incorrect were provided. Appellant-opponent 3 equally provided detailed argumentation in the statement of grounds of appeal with respect to novelty and inventive step.

1.4 Thus in contrast to the general statement of the respondent, the respective statement of grounds of

appeal provide both the legal and factual reasons as to why the appellant-opponents considered the contested decision to be incorrect, and none of the objections identified by the respondent are supported solely by mere reference to the arguments submitted during the proceedings before the opposition division. With regard to Article 123(2) EPC, appellant-opponent 1 provided detailed argumentation including identification of certain aspects which were (allegedly) erroneously not taken into consideration in the contested decision (statement of grounds, page 2, lines 11-15). With regard to Article 54 EPC, appellant-opponent 3 provided detailed reasons as to why the conclusion reached according to the contested decision is allegedly incorrect (statement of grounds, page 3, second paragraph). As to the objection of lack of inventive step starting from D1 as the closest prior art, detailed explanation was provided in the respective statements of grounds of appeal by appellant-opponent 1 (page 8-9) and appellant-opponent 3 (section 5.1). Similarly, detailed reasoning concerning the objection of lack of sufficiency of disclosure was submitted by appellant-opponent 1 in the statement of grounds of appeal (pages 2-5). From the respective statements of grounds of appeal, one can immediately understand, without any need to resort to further investigations, why the decision is alleged to be incorrect and on which facts the appellant-opponents base their arguments. There is consequently no basis for concluding that the requirements of Rule 99(2) EPC - the sole disputed prerequisite of the admissibility of the appellant-opponents' appeals - are not met.

1.5 Additionally, the admissibility of an appeal under the EPC can only be assessed as a whole (see Case Law of the Boards of Appeal, 8th edition 2016, IV.E.2.6.2). In

order for the appellant-opponents' appeals to be held admissible, it is sufficient that at least one ground for opposition has been substantiated and relates to a point which could at least arguably have been decided in the appellant-opponents' favour by the opposition division, such that a favourable decision on this point would have produced a different outcome. As set out above, this condition is met.

1.6 Furthermore, in light of the above (see point 1.4), each of the objections under Articles 123, 83, 54 and 56 EPC was sufficiently substantiated by at least one appellant-opponent in the statement of grounds of appeal in accordance with Article 12(2) RPBA and the board saw no reason to disregard any specific objection under Article 12(4) RPBA. Hence, all of these objections were taken into consideration by the board.

2. Admittance - evidence

2.1 Appellant-opponent 3 requested admittance into the proceedings of documents D1, F4 and F4'.

2.2 However, it was not in dispute that those documents were already in the proceedings.

The board sees no reason to adopt a different view.

3. Main request - novelty (Article 54 EPC)

3.1 Appellant-opponents 1 and 3 submitted that claim 1 lacks novelty *inter alia* on the basis of comparative examples A/B of D1.

3.2 The board notes that comparative example B discloses a coating prepared with the polyester of comparative

example A, an epoxy novolac resin and an aromatic hydrocarbons/butylacetate/aromatic hydrocarbon/ butylglycol/n-butanol solvent. The polyester is composed of ethylene glycol, propylene glycol, trimethylolpropane, 3.6 moles of terephthalic acid, 4.5 moles of isophthalic acid and 1.9 moles of adipic acid, has a molecular weight (Mw) of 60000, a Tg of 23°C and an acid value of 3 mg KOH/gram resin.

3.3 The polyester does not contain any bisphenol A diglycidyl ether and thus is BADGE-free as required by claim 1. Since the polyester is composed *inter alia* of the trifunctional trimethylolpropane, it is non-linear as required by claim 1. Since the Mw is 60000, it is within the range (higher than 20000) defined by claim 1. The content of aromatic acid monomers present lies within the range of at least 80 wt% defined in claim 1. The epoxy novolac resin is a phenol formaldehyde resin and thus corresponds to the phenolic crosslinker of claim 1. The aromatic hydrocarbons/ butylacetate/aromatic hydrocarbon/butylglycol/n-butanol solvent corresponds to the organic solvent of claim 1.

The above corresponds to what had been observed in the board's preliminary opinion set out in the communication under Article 15(1) RPBA. Up until the oral proceedings, this has not been disputed by any of the parties.

3.4 In defending the novelty of the subject-matter of claim 1 *vis à vis* comparative examples A/B of D1, the respondent submitted three separate lines of defence, (see Facts and Submissions, IX), each of which shall be addressed in the following.

3.5 It was conceded by the respondent that the submission of both the first and second lines of defence during oral proceedings before the board represented the first time they had been raised during appeal proceedings.

3.6 The first line of defence concerns the allegation that comparative examples A/B of D1 were not enabling due to the type of epoxy novolac resin employed not being specified. The second line of defence concerns the allegation that D1 does not disclose a BADGE-free composition. Since neither the nature of the epoxy novolac resin in D1 nor the qualification of the composition in D1 as "BADGE-free" had been raised in (written) appeal proceedings before oral proceedings, both lines of defence represent new allegations of fact.

3.7 Consequently, both lines of defence represent an amendment of the case of the respondent after the summons to oral proceedings was issued and their admittance may thus be considered at the board's discretion under Article 13(3) RPBA, according to which amendments (to a party's case) made after oral proceedings have been arranged shall not be admitted if they raise issues which the board or the other parties cannot reasonably be expected to deal with without adjournment of the oral proceedings.

3.8 The justification for submitting the first line of defence at this stage of the proceedings, was that it had been "on file" and discussed during opposition proceedings and was not complex in that it did not require additional investigatory effort for the parties to comprehend. However, as stated by the appellant-opponents during the oral proceedings, in order to counter said allegation they would have required

adequate time to prepare potential counterarguments, possibly supplemented, where appropriate, by suitable evidence to show that comparative example A/B could be carried out and thus was enabling.

3.9 The respondent's late submission would thus have necessitated adjournment of the oral proceedings in order to safeguard the appellant-opponents' rights to fair proceedings. Moreover, in relation to the respondent's point of view that this issue was "on file" in view of it having been discussed during the proceedings before the opposition division, what is to be considered as on file before the board is governed by Articles 12 and 13 RPBA, which presuppose that the issue has to be presented to the board.

3.10 Consequently the board in application of Article 13(3) RPBA decided not to admit the new allegation of fact based on the first line of defence into the proceedings.

3.11 Similar considerations apply to the respondent's second line of defence, for which the justification for submitting it at this stage of the proceedings was that it was straightforward and required no further investigatory effort, such that it's admission would not lead to a delay in proceedings. The board does not share this opinion. As set out by the appellant-opponents, faced with a completely new and unexpected allegation of fact during oral proceedings, adequate time would be required to prepare potential counterarguments and/or file further evidence. It is to be noted in this respect that comparative examples A/B do not explicitly disclose the presence of BADGE and that the board, in its communication under Article 15(1) RPBA, observed that the composition of

that example appeared to be BADGE-free. Confronted with the new (and unsubstantiated) allegation of the respondent that the composition contained BADGE, the appellant-opponents would have required time to rework comparative example A/B and to prove that the resulting composition is BADGE-free, thereby necessitating adjournment of the oral proceedings.

3.12 Consequently the board in application of Article 13(3) RPBA decided not to admit the new allegation of fact based on the second line of defence into the proceedings.

3.13 The third line of defence was that the polyester of comparative examples A/B of D1 disclosing a Tg of **23 °C** and an acid value of **3,** did not directly and unambiguously anticipate the features "Tg **lower than 23°C**" and "an acid value **between 3 and 0** mg KOH/gram resin" recited in claim 1. These issues were argued by both of the appellant-opponents in the respective grounds of appeal, and by the respondent in the reply thereto, and their being taken into consideration was not disputed. They represent the remaining disputed matter between the parties with respect to the disclosure of D1 to be considered by the board.

3.14 According to decision T 594/01 (catchword):

"*An experimental value in quantitative analytical chemistry cannot be dissociated from the margin of uncertainty attached to the measurement. When a specific experimental value is disclosed in an example of the prior art, seeking to distinguish the claimed subject-matter therefrom only in terms of an upper limit required to be "lower than" the experimental value must fail as the claimed subject-matter is still*

not distinguishable from the prior art within the margin of experimental error."

In the reasons (point 4.1.5) it is confirmed that the same applies not only to experimental values in quantitative analytical chemistry, but to "the result of any physical measurement". The present board follows the principles set out in this decision.

3.15 Both the Tg and the acid value according to the patent in suit are physical values obtained by physical measurement and indisputably are associated with a certain amount of experimental error. In the view of the board, the teaching of T 594/01 as laid out above is fully applicable to the present case, such that the glass transition temperature of 23 °C and the acid value of 3 mg KOH/g resin disclosed in D1 directly and unambiguously anticipate the features "Tg lower than 23°C" and "an acid value between 3 and 0 mg KOH/gram resin" respectively recited in claim 1.

3.16 The respondent argued that decision T 594/01 was not applicable, since D1 did not disclose the method by which the Tg and acid value referred to in comparative examples A/B had been measured. The values of 23°C and 3 mg KOH/g resin reported in D1 could thus equally have been fabricated by the inventors of D1. Since in that case a method by which the values had been measured would not exist, there could be no experimental error linked thereto.

The board acknowledges that D1 fails to disclose the relevant methods of measurement employed. However, the skilled reader normally interprets a value given in the example of a patent as being that obtained using an appropriate measurement method. Arguing, as the

respondent does, that such a value has simply been fabricated rather than being the result of a measurement is merely an allegation, which due to its unsubstantiated nature, must fail.

3.17 The respondent furthermore submitted that the skilled person in construing claim 1 would understand from the description of the patent (paragraphs [0023], [0051], [0055] and [0059]) that the Tg was to be measured by DSC at a heating rate of 5 °C/min, and that since D1 did not disclose this method, the Tg of 23°C according to comparative examples A/B could not be seen to directly and unambiguously disclose a value falling within the claimed range. However, according to Article 84 and Rule 43(1) EPC the claims define the matter for which protection is sought, and claim 1 of the main request does not comprise the limitation that the Tg should be measured using a specific method.

Furthermore, although the description cannot normally be used to read a limitation into claim 1, even if it were to be taken into account, it would still not lead to the conclusion that the scope of the claim was to be limited to polyesters having a Tg within the claimed range, measured exclusively using DSC at a rate of 5 °C/min. Specifically, it is stated in the description that the Tg of a polyester is "most commonly" determined by DSC; that the values for the Tg obtained by DSC are dependent on the heating rate chosen during the experiment; and that "[g]enerally, the heating rate used by DSC measurements is 5 °C/min" (paragraph [0023]). Although the latter corresponds to the method and heating rate employed in the examples, it is not stated nor hinted at anywhere in the patent that the Tg of the claimed method is to be measured solely using said heating rate. Nor for that matter is it absolutely

necessary, according to the patent, to use DSC as the measurement method at all. Rather, DSC is merely identified in the description as the most commonly used method. Consequently, claim 1 must be interpreted as including within its scope polyesters having a Tg in the range recited, measured using any method which would be considered technically reasonable to the skilled person.

Thus the argument that due to the lack of a specified method in D1 as to how to measure the Tg, the 23 °C provided therefor would be outside of the range defined in claim 1, must fail.

3.18 It is also not possible, in the view of the board, to apply the principles of the rounding-off convention (decision T 175/97 and the Guidelines for Examination, Part G-VI, 8.1) as proposed by the respondent and thereby distinguish the relevant values recited in claim 1 from the corresponding values disclosed in D1. According to the rounding-off convention, for example, a number having one decimal place such as 2.5 is rounded up to 3. In the present case, however, the numbers in question (23 for the Tg and 3 for the acid value) in both D1 and the patent are identical and have no decimal place. Thus the rounding-off convention cannot be applied, and even if one were to attempt to do so, the respective values provided in the claim and D1 would be no more distinguished from each other after application of the rounding-off convention than beforehand.

3.19 It follows that the subject-matter of claim 1 of the main request lacks novelty.

The main request is consequently not allowable.

4. Auxiliary request 1 - admittance

4.1 Claim 1 of auxiliary request 1 differs from that of the main request in that claim 1 thereof was limited to recite a non-linear polyester having a molecular weight (Mw) higher than 65000.

4.2 The respondent filed this request during oral proceedings after the announcement of the board's opinion on novelty of the subject-matter of claim 1 of the main request. Since this request was filed after the filing of the respondent's reply to the grounds of appeal, it constitutes an amendment to the respondent's case under Article 13(1) RPBA, according to which the board has discretion over whether to admit it into the proceedings, *inter alia* in view of the complexity of the new subject-matter submitted, the current state of the proceedings and the need for procedural economy. Since the new request was filed in oral proceedings, Article 13(3) RPBA also applies, according to which amendments filed after oral proceedings have been arranged shall not be admitted if they raise issues which the board or the other parties cannot reasonably be expected to deal with without adjournment of the oral proceedings.

4.3 The issue of novelty *vis à vis* the disclosure of D1 was raised for the first time at least in the notice of opposition of opponent 1 (now appellant-opponent 1), filed in November 2011, and was dealt with by the opposition division in the contested decision. In the statements setting out the grounds of appeal, both appellant-opponents argued that the conclusion of the opposition division establishing novelty of the subject-matter of claim 1 over the disclosure of D1 was

incorrect. In the communication sent in preparation for oral proceedings (point 7.1, final paragraph), the board drew attention to the matters of dispute underlying the submissions to date with respect to novelty over the disclosure of D1, and indicated that decision T 594/01 (in particular catchword and point 4.1.5) appeared to be of relevance. Consequently, already when receiving the appellant-opponents' statements of grounds of appeal and at the very latest on reception of the board's communication, the respondent must have been aware that a risk existed that the disclosure of D1 would be seen to anticipate the disputed features of claim 1. Therefore, the board cannot see, based on any objective measure, how the conclusion of lack of novelty *vis à vis* the disclosure of D1 could have come as a surprise to the respondent. Thus, there was no justification apparent to the board for the submission of this request by the respondent at this very late stage of the appeal proceedings.

4.4 Independently from the above, the amendment would have given rise to new issues for which neither the board, nor the appellant-opponents had had adequate time to prepare. As a non-exhaustive example, the adjustment of the Mw from "higher than 20000" to "higher than 65000" has the effect that new issues are raised in respect of the relevance of A2, a declaration filed by the respondent in the context of sufficiency of disclosure, alleged to demonstrate *inter alia*, through "example A-DSM", that the skilled person was able to prepare the polyester recited in claim 1. Since the polyester prepared according to this example has an Mw of 22100, the example fails to demonstrate the intended preparation of a polyester according to new claim 1 of auxiliary request 1, and consequently will raise new issues in respect to the assessment of sufficiency of

disclosure. Furthermore, by filing auxiliary request 1 at this late stage the appellant-opponents were prevented from adequately addressing in particular, the ground of inventive step. Until the filing of this request during oral proceedings, there was no indication from the side of the respondent that the intention was to amend at all, not least by adjustment of the Mw in claim 1. Consequently, this request raises new issues which, if admitted, would require adjournment of the oral proceedings in order to provide the appellant-opponents adequate opportunity to prepare and thereby safeguard the right to fair proceedings.

4.5 The above is aggravated by the fact that none of the claim requests pursued by the respondent during the opposition proceedings or filed in appeal contained any claim directed to a polyester having a molecular weight of higher than 65000. The inclusion of this feature into claim 1 of auxiliary request 1 thus comes as a complete surprise to the appellant-opponents.

4.6 For these reasons the board exercised its discretion under Article 13(1) and (3) RPBA not to admit auxiliary request 1 into the proceedings.

Order

For these reasons it is decided that:

1. The decision under appeal is set aside.

2. The patent is revoked.

The Registrar: The Chairman:

N. Maslin M. O. Müller

Decision electronically authenticated