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**Datasheet for the decision
of 6 February 2018**

Case Number: T 2046/14 - 3.3.03

Application Number: 02006007.5

Publication Number: 1241229

IPC: C08L77/00, C08K3/34, B60K15/00,
F02F7/00

Language of the proceedings: EN

Title of invention:
Fuel resistant polyamide and its use

Patent Proprietor:
Ube Industries, Ltd.

Opponents:
NORMA Germany GmbH
Evonik Degussa GmbH
Rhodia Engineering Plastics SA
EMS-CHEMIE AG

Relevant legal provisions:
EPC Art. 123(2), 84
RPBA Art. 12(4), 13(1)

Keyword:

Amendments - extension beyond the content of the application as filed - main request, first, second and sixth to eighth auxiliary requests (yes)

Claims - clarity - first auxiliary request (no)

Late-filed requests - request withdrawn before the opposition division (third to fifth auxiliary requests) - request submitted during oral proceedings (ninth auxiliary request) - requests could have been filed in first instance proceedings (tenth to twelfth auxiliary requests) (not admitted)

Decisions cited:

G 0009/91, G 0002/10



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 2046/14 - 3.3.03

D E C I S I O N
of Technical Board of Appeal 3.3.03
of 6 February 2018

Appellant: Ube Industries, Ltd.
(Patent Proprietor) 1978-96, O-Aza Kogushi
Ube-shi,
Yamaguchi-ken 755-8633 (JP)

Representative: Grünecker Patent- und Rechtsanwälte
PartG mbB
Leopoldstraße 4
80802 München (DE)

Respondent 1: NORMA Germany GmbH
(Opponent 1) Edisonstrasse 4
63477 Maintal (DE)

Representative: Patentanwälte Olbricht Buchhold Keulertz
Partnerschaft mbB
Bettinastraße 53-55
60325 Frankfurt am Main (DE)

Respondent 2: Evonik Degussa GmbH
(Opponent 2) Rellinghauser Straße 1- 11
45128 Essen (DE)

Representative: f & e patent
Fleischer, Engels & Partner mbB, Patentanwälte
Braunsberger Feld 29
51429 Bergisch Gladbach (DE)

Respondent 3: Rhodia Engineering Plastics SA
(Opponent 3) Avenue Ramboz, B.P. 64
69192 Saint-Fons Cédex (FR)

Representative: Chatelan, Florence Anne
Rhodia Services
Direction Propriété Industrielle

Centre de Recherches de Lyon
BP 62
69192 Saint-Fons Cedex (FR)

Respondent 4:

(Opponent 4)

EMS-CHEMIE AG
Reichenauerstrasse
CH-7013 Domat/Ems (CH)

Representative:

Pfenning, Meinig & Partner mbB
Patent- und Rechtsanwälte
Theresienhöhe 11a
80339 München (DE)

Decision under appeal:

**Decision of the Opposition Division of the
European Patent Office posted on 29 July 2014
revoking European patent No. 1241229 pursuant to
Article 101(3) (b) EPC.**

Composition of the Board:

Chairman D. Semino

Members: O. Dury

C. Brandt

Summary of Facts and Submissions

I. The appeal by the patent proprietor lies against the decision of the opposition division posted on 29 July 2014 revoking European patent No. 1 241 229.

II. The claims of the application as filed which are relevant to the present decision read as follows:

"1. A fuel part excellent in fuel resistance at a weld portion thereof, which comprises a crystalline polyamide resin having a terminal amino group concentration > a terminal carboxyl group concentration."

"6. A material for a fuel part excellent in fuel resistance at a weld portion of the fuel part, which comprises a crystalline polyamide resin having a terminal amino group concentration > a terminal carboxyl group concentration."

"7. A fuel part excellent in fuel resistance at the weld portion thereof, which is obtained by welding a crystalline polyamide resin having a terminal amino group concentration > a terminal carboxyl group concentration and a polyolefin resin modified with an unsaturated carboxylic acid or derivative thereof."

"8. A process for producing a fuel part excellent in fuel resistance at a weld portion thereof, which comprises molding or forming a polyolefin resin modified with an unsaturated carboxylic acid or derivative thereof, injection molding a crystalline polyamide resin having a terminal amino group concentration > a terminal carboxyl group concentration

and then, welding the thus molded or formed products."

"9. A resin valve cover welded to the outer layer of a resin fuel tank, thereby sealing a valve-mounting slot formed in the fuel tank, wherein the resin valve cover has a cylindrical shape having one end closed except for a pipe hole for delivering a fuel; the inside portion of the cylinder to be brought into contact with a fuel when welded to the fuel tank is made of a first resin, while the outer portion of the cylinder not brought into contact with the fuel is made of a second resin; and a crystalline polyamide resin having a terminal amino group concentration > a terminal carboxyl group concentration is used as the first resin, while a polyolefin resin modified with an unsaturated carboxylic acid or derivative thereof is used as the second resin."

"10. A resin valve cover welded to the outer layer of a resin fuel tank, thereby sealing a valve-mounting slot formed in the fuel tank, wherein the resin valve cover has a cylindrical shape having one end closed except for a pipe hole for delivering a fuel; the inside portion of the cylinder to be brought into contact with a fuel when welded to the fuel tank is made of a first resin, while the outer portion of the cylinder not brought into contact with the fuel is made of a second resin; and a polyolefin resin modified with an unsaturated carboxylic acid or derivative thereof is used as the first resin, while a crystalline polyamide resin having a terminal amino group concentration > a terminal carboxyl group concentration is used as the second resin."

"15. A fuel part attached to a resin fuel tank, which has a multilayer structure comprising, as an inner

layer (A), high-density polyethylene modified with an unsaturated carboxylic acid or derivative thereof and, as an outer layer (B), a polyamide resin having a terminal amino concentration > a terminal carboxyl concentration and containing 3 to 27 wt.% of a plate-crystal inorganic filler."

"16. A fuel part attached to a resin fuel tank, which has a multilayer structure comprising, as an inner layer (A) and an outer layer (C), high-density polyethylene modified with an unsaturated carboxylic acid or derivative thereof; and as an intermediate layer (B), a polyamide resin having a terminal amino group concentration > a terminal carboxyl group concentration and containing 3 to 27 wt.% of a plate-crystal inorganic filler."

"21. A polyamide resin composition excellent in fuel resistance at a weld portion, which comprises (A) 100 parts by weight of a crystalline polyamide resin having a terminal amino group concentration > a terminal carboxyl group concentration, and (B) 0.05 to 10 parts by weight of layered silicates uniformly dispersed in the polyamide resin."

"22. The polyamide resin composition as claimed in claim 21, wherein the layered silicates have a side length of 0.002 to 1 μm and thickness of 6 to 20 \AA and are dispersed uniformly in the polyamide resin while maintaining a layer-layer distance of 20 \AA or greater on average."

"23. A fuel part excellent in fuel resistance at a weld portion thereof, which comprises a polyamide resin composition comprising (A) 100 parts by weight of a crystalline polyamide resin having a terminal amino

group concentration > a terminal carboxyl group concentration, and (B) 0.05 to 10 parts by weight of layered silicates uniformly dispersed in the polyamide resin."

"24. A fuel part excellent in fuel resistance at a weld portion thereof, which is obtained by welding a polyamide resin composition as claimed in claim 21 and a polyolefin resin modified with an unsaturated carboxylic acid or derivative thereof."

"25. A process for producing a fuel part excellent in fuel resistance at a weld portion thereof, which comprises molding or forming a polyolefin resin modified with an unsaturated carboxylic acid or derivative thereof, injection molding a polyamide resin composition as claimed in claim 21 and then welding the resulting molded or formed products."

III. Claim 1 of the granted patent, which is the sole granted claim relevant to the present decision, read as follows (additions as compared to claim 1 of the application as filed are indicated in **bold**, deletions in ~~strikethrough~~):

"1. A ~~fuel~~ part **attached to any one of a fuel tank, a fuel hose and a canister and** excellent in fuel resistance at a weld portion thereof, which comprises a crystalline polyamide resin having a terminal amino group concentration > a terminal carboxyl group concentration."

IV. Four notices of opposition against the patent were filed, in each of which the revocation of the patent in its entirety was requested.

- V. The contested decision was based on
- the patent as granted as main request,
 - the first and the second auxiliary requests filed with letter of 30 September 2011 and
 - the third to fifth auxiliary requests filed during the oral proceedings before the opposition division in replacement of the third to the fifth auxiliary requests filed with letter of 15 April 2014.

Claim 1 of the first auxiliary request read as follows (additions as compared to claim 1 of the application as filed are indicated in **bold**):

"1. A fuel part **attached to a fuel tank and** excellent in fuel resistance at a weld portion thereof, which comprises a crystalline polyamide resin having a terminal amino group concentration > a terminal carboxyl group concentration, **which is obtained by welding a crystalline polyamide resin having a terminal amino group concentration > a terminal carboxyl group concentration and a polyolefin resin modified with an unsaturated carboxylic acid or derivative thereof.**"

Claim 1 of the second auxiliary request was identical to claim 1 of the first auxiliary request.

Regarding the third auxiliary request,

- claims 1, 7, 8 and 16-18 corresponded to claims 1, 7, 8 and 23-25 of the application as filed, whereby the fuel part was further defined as being **"selected from the group consisting of valves attached to a fuel tank"**;
- claims 9-14 were identical to claims 9-14 as original filed;

- the wording of claim 15 corresponded to that of original claim 22 (taking into account that it depended on original claim 21).

Claim 1 of the fourth auxiliary request read as follows (additions as compared to claim 1 of the application as filed are indicated in **bold**):

"1. A fuel part **selected from the group consisting of valves attached to a fuel tank and** excellent in fuel resistance at the weld portion thereof, which comprises a crystalline polyamide resin having a terminal amino group concentration > a terminal carboxyl group concentration, **which is obtained by welding a crystalline polyamide resin having a terminal amino group concentration > a terminal carboxyl group concentration and a polyolefin resin modified with an unsaturated carboxylic acid or derivative thereof.**"

Claim 1 of the fifth auxiliary request was identical to claim 1 of the fourth auxiliary request.

VI. In the contested decision the opposition division *inter alia* held that:

- The main request did not fulfill the requirements of Article 123(2) EPC because the application as filed did not support any part attached to a fuel tank which is not a valve, any part attached to a fuel hose and any part attached to a canister. Also, it was held that there was no support in the application as filed for a part attached to a fuel hose or canister (see section 2.4.1 of the contested decision).

- Claim 1 of each of the first and the second auxiliary requests did not satisfy the requirements of Article 123(2) EPC and Article 84 EPC. Regarding Article 123(2) EPC it was in particular argued that there was no support in the application as filed for a fuel part attached to a fuel tank which was not a valve or which did not comprise a plate-crystal inorganic filler or wherein the modified polyolefin was not an intermediate adhesion layer (section 2.5.1 of the contested decision). Regarding Article 84 EPC, the feature "fuel part" was found to lack clarity, in particular because it was not a term known in the art (fourth paragraph of section 2.5.2 of the contested decision).

- Claim 1 of each of the third to the fifth auxiliary requests were held to satisfy among others the requirements of Article 123(2) EPC but not those of Article 56 EPC.

VII. The patent proprietor (appellant) appealed the above decision. With the statement setting out the grounds of appeal the appellant requested that the opposition division's decision 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 the first to the eleventh auxiliary requests filed with the statement of grounds of appeal. In that respect, the first and the second auxiliary requests corresponded to the first and the second auxiliary requests dealt with in the contested decision, the third to the fifth auxiliary requests corresponded to the third to the fifth auxiliary requests filed with letter of 15 April 2014 and the sixth to the eighth auxiliary requests corresponded to the third to the fifth auxiliary requests dealt with in the contested

decision.

Claim 1 of the third auxiliary request read as follows (additions as compared to claim 1 of the application as filed are indicated in **bold**):

"1. A fuel part **selected from the group consisting of valves, joints for fuel hose, canister connecting nozzles and separators, attached to a fuel tank and** excellent in fuel resistance at a weld portion thereof, which comprises a crystalline polyamide resin having a terminal amino group concentration > a terminal carboxyl group concentration."

Claim 1 of the fourth auxiliary request read as follows (additions as compared to claim 1 of the application as filed are indicated in **bold**):

"1. A fuel part **selected from the group consisting of valves, joints for fuel hose, canister connecting nozzles and separators, joined to a fuel tank and** excellent in fuel resistance at a weld portion thereof, which comprises a crystalline polyamide resin having a terminal amino group concentration > a terminal carboxyl group concentration, **which is obtained by welding a crystalline polyamide resin having a terminal amino group concentration > a terminal carboxyl group concentration and a polyolefin resin modified with an unsaturated carboxylic acid or derivative thereof.**"

Claim 1 of the fifth auxiliary request was identical to claim 1 of the fourth auxiliary request.

Claim 1 of the ninth auxiliary request read as follows (additions as compared to claim 1 of the application as filed are indicated in **bold**):

"1. A fuel part **selected from the group consisting of resin valve covers being welded to a polyethylene fuel tank of automobiles using gasoline and gasohol, and** excellent in fuel resistance at the weld portion thereof, which comprises a crystalline polyamide resin having a terminal amino group concentration > a terminal carboxyl group concentration."

Claim 1 of the tenth auxiliary request read as follows (additions as compared to claim 1 of the application as filed are indicated in **bold**):

"1. A fuel part **selected from the group consisting of resin valve covers being welded to a polyethylene fuel tank of automobiles using gasoline and gasohol, and** excellent in fuel resistance at the weld portion thereof, which comprises a crystalline polyamide resin having a terminal amino group concentration > a terminal carboxyl group concentration, **which is obtained by welding a crystalline polyamide resin having a terminal amino group concentration > a terminal carboxyl group concentration and a polyolefin resin modified with an unsaturated carboxylic acid or derivative thereof.**"

Claim 1 of the eleventh auxiliary request was identical to claim 1 of the tenth auxiliary request.

- VIII. In their reply to the statement of grounds of appeal each of opponents 1, 2 and 4 (respondents 1, 2 and 4) requested that the appeal be dismissed.
- IX. Issues to be discussed at the oral proceedings were specified by the Board in a communication dated 1 September 2017, in which it was in particular

indicated that respondent 3 (opponent 3) had not made any submission. Also, the following issues were *inter alia* identified:

- The appellant had not explained why the decision reached by the opposition division regarding the main request would be wrong and the Board saw no reasons to depart from the opposition division's findings (section 5.3);
- It appeared that the first and the second auxiliary requests neither satisfied the requirements of Article 123(2) EPC (section 7.3) nor of Article 84 EPC (section 8.3). Regarding Article 123(2) EPC the same line of argumentation as that used in the contested decision was followed. Regarding Article 84 EPC, it was indicated that no arguments or evidence was submitted by the appellant to refute the opposition division's view according to which the term "fuel part" had no accepted definition in the art and was, thus, unclear;
- Considering that it appeared that the appellant was not adversely affected by the decision of the opposition division as far as the third to the fifth auxiliary requests were concerned, the third to the fifth auxiliary requests might have to be not admitted into the proceedings pursuant to Article 12(4) RPBA (section 9);
- Considering that the wording "valves attached to a fuel tank" was found at a single passage of the application as filed and within a list of alternative embodiments, the question arose whether a valid support in the application as filed could

be found for the subject-matter of claims 7, 8 and 16-18 of the sixth auxiliary request (section 10);

- The question arose if the ninth to the eleventh auxiliary requests should be not admitted pursuant to Article 12(4) RPBA. In particular, it appeared that each of the ninth to the eleventh auxiliary request comprised claims directed to "resin valve covers" instead of the "valves" defined e.g. in the sixth to the eighth auxiliary requests. Those requests also appeared to be related to different embodiments of the resin valve covers otherwise defined e.g. in claims 9-14 of the sixth auxiliary request, i.e. they appear to be related to fundamentally different subject-matter (section 17.2).

- X. During the oral proceedings, which were held on 6 February 2018 in the absence of respondent 3 as announced by letter of 12 December 2017, the appellant submitted a new ninth auxiliary request. The then pending ninth to eleventh auxiliary requests were renumbered tenth to twelfth auxiliary requests.

The new ninth auxiliary request corresponded to the sixth auxiliary request whereby claims 7, 8 and 16-18 had been deleted, the remaining claims being renumbered accordingly.

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

Main request - Article 100(c) and 123(2) EPC

- (a) Considering that the terms "fuel part" and "part" were disclosed interchangeably in the application

as filed, the subject-matter of claim 1 was based on original claim 1. A further support was provided at page 2, lines 17-21 and page 3, lines 1-2 of the application as filed. In that respect, the description should be taken into account to interpret the claims. Also, according to Article 69 EPC the description and the drawings shall be used to interpret the claims and it could not be derived from the application as filed that a "part" in the sense of the present invention was not necessary a "fuel part". Although the exact wording of claim 1 was not explicitly disclosed as such in the application as filed, it was derivable from the application as filed as a whole. The skilled person would understand what the wording "a part attached to any one of a fuel tank, a fuel hose and a canister" only referred to the specific "fuel parts" disclosed in the description.

Therefore, the requirements of Article 123(2) EPC were met.

First and second auxiliary requests

- (b) The subject-matter of claim 1 of the first auxiliary request was either supported by the combination of original claims 1 and 7 or by the passage at page 15, line 23 to page 16, line 7 of the application as filed. Considering that it was derivable from the application as filed as a whole that claims 1 and 7 constituted preferred embodiments, the skilled person would have combined them. Also, the modified polyolefin layer mentioned at pages 15-16 of the application as filed did not have to be included in claim 1, since it did not represent a mandatory but only a preferred feature.

Therefore, claim 1 of the first auxiliary request, which was identical to claim 1 of the second auxiliary request, satisfied the requirements of Article 123(2) EPC.

- (c) Regarding Article 84 EPC, the term "fuel part" according to claim 1 of the first and second auxiliary requests had an accepted meaning in the present technical field. Should that view be contested, the skilled person would understand its meaning from the description of the patent specification as a whole and would be in a position to identify what was encompassed by the scope of operative claim 1.

Third to fifth auxiliary requests - Admittance

- (d) Considering the argumentation provided by the opposition division during the oral proceedings the then operative third to fifth auxiliary requests would not have overcome the objections retained against the higher ranked requests. To accommodate the opposition division, those requests were not discussed at the oral proceedings, but were not actively withdrawn and were, thus, part of the final decision.

The appellant had the right to file auxiliary requests together with its statement of grounds of appeal, in particular in reply to the findings of the opposition division in the contested decision, as was the case here.

For those reasons, the third to fifth auxiliary requests formed part of the appeal proceedings and were not inadmissible pursuant to

Article 12(4) RPBA.

Sixth auxiliary request - Article 123(2) EPC

(e) Claims 7, 8 and 16-18 of the sixth auxiliary request were based on the combination of each of the original claims 7, 8, and 23-25 with the passage at page 19, lines 1-3 of the application as filed. A single selection within the list of articles disclosed in that passage was necessary in order to arrive at the subject-matter being claimed. The fact that various independent claims were present in the application as filed did not affect that conclusion. For those reasons, claims 7, 8 and 16-18 fulfilled the requirements of Article 123(2) EPC.

**Seventh and eighth auxiliary request -
Article 123(2) EPC**

(f) Regarding claims 1, 7, 15 and 16 of the seventh auxiliary request and claims 1, 7 and 14 of the eighth auxiliary request, the same arguments as for claims 7, 8 and 16-18 of the sixth auxiliary request were valid.

Ninth auxiliary request - Admittance

(g) The ninth auxiliary request was filed in direct response to the Board's decision in respect of the sixth to the eighth auxiliary requests. Considering that the appellant could not foresee the decision of the Board in respect of the sixth auxiliary request, the ninth auxiliary request was submitted at the first possible opportunity. Since the operative claims were already present in the sixth

auxiliary request, the ninth auxiliary request could not take by surprise the respondents. In the Board's communication, it was only indicated that there might be an issue of Article 123(2) EPC in relation to claims 7, 8 and 16-18 of the sixth auxiliary request, which was neither a final decision nor an objection. Therefore, the ninth auxiliary request should be admitted.

Tenth to twelfth auxiliary requests - Admittance

(h) It was an appellant's right to present new requests at the beginning of the appeal. In the present case, the tenth to twelfth auxiliary requests were submitted in direct reaction to the contested decision and were filed together with the appellant's statement of grounds of appeal. Besides, the amendments made in those requests satisfied the requirements of Article 123(2) EPC since they were based on page 22, third paragraph of the application as filed. Therefore, the tenth to the twelfth auxiliary requests should be admitted into the proceedings.

XII. The respondents' arguments, insofar as relevant to the decision, may be summarised as follows:

Main request - Article 100(c) and 123(2) EPC

(a) As already concluded by the opposition division, there was no direct and unambiguous support in the application as filed for the subject-matter of claim 1.

First and second auxiliary requests

- (b) There was no direct and unambiguous support in the application as filed for the subject-matter of claim 1 of the first auxiliary request. The passage bridging pages 15 and 16 did not provide a valid support, because it was directed to an embodiment comprising an adhesion layer, which was not reflected in operative claim 1.

Claim 1 of the second auxiliary request was identical to claim 1 of the first auxiliary request.

For those reasons, the first and the second auxiliary requests did not satisfy the requirements of Article 123(2) EPC.

- (c) The term "fuel part" had no accepted definition in the art. Therefore, the skilled person was not in a position to determine unambiguously the scope of claim 1, contrary to the requirements of Article 84 EPC.

Third to fifth auxiliary requests - Admittance

- (d) The third to fifth auxiliary requests were identical to the third to fifth auxiliary requests filed with letter of 15 April 2014. However, those requests were not defended during the oral proceedings before the opposition division and were eventually replaced by the third to the fifth auxiliary requests dealt with in the contested decision. Therefore, the appellant was not adversely affected by the decision of the opposition division as far as those requests were concerned. Under those circumstances the third to the fifth auxiliary requests should not be admitted

into the proceedings pursuant to Article 12(4) RPBA.

Sixth auxiliary request - Article 123(2) EPC

(e) The subject-matter of claims 7, 8 and 16-18 could only be arrived at after combining specific independent claims with the passage at page 19, lines 2-4 of the application as filed. However, that combination was not directly and unambiguously disclosed and led to creating subject-matter which was not disclosed as such in the application as filed. For instance, there was no disclosure in the application as filed of valves obtained by welding a polyamide and a polyolefin according to claim 7 (see in particular the product-by-process feature) and/or of a process for producing a valve by moulding and welding according to operative claim 8.

Seventh and eighth auxiliary request - Article 123(2) EPC

(f) Regarding claims 1, 7, 15 and 16 of the seventh auxiliary request and claims 1, 7 and 14 of the eighth auxiliary request, the same arguments as for claims 7, 8 and 16-18 of the sixth auxiliary request were valid.

Ninth auxiliary request - Admittance

(g) All the objections retained against the higher ranking requests were on file from the beginning of the appeal proceedings and were already known from the opposition proceedings. They were also identified in the Board's communication which had

been sent well in advance of the oral proceedings. Under those circumstances, there was no justification why the ninth auxiliary request was only submitted at the latest possible opportunity, namely on the day of the oral proceedings and only after the Board had announced its decision regarding the higher ranking requests. For those reasons, the ninth auxiliary request should not be admitted into the proceedings.

Tenth to twelfth auxiliary requests - Admittance

(h) The tenth to the twelfth auxiliary requests were directed to completely different subject-matter than that dealt with in the higher ranking requests. The claims were now directed to "valve covers" defined in a completely different manner than the valve covers defined in the claims of the higher ranking requests. Admitting those requests into the proceedings forced the respondents to deal with new subject-matter which had never been claimed before. In that respect, there had been no surprising development of the case and all objections dealt with in the contested decision were known by the appellant. For those reasons, the tenth to the twelfth auxiliary requests should not be admitted into the proceedings.

XIII. The appellant requested that the decision under appeal 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 the first to eighth auxiliary requests filed with the statement of grounds of appeal, or on the basis of the ninth auxiliary request filed during the oral proceedings on 6 February 2018, or on the basis of the

tenth to twelfth auxiliary requests, filed as ninth to eleventh auxiliary requests with the statement of grounds of appeal.

The respondents 1, 2 and 4 requested that the appeal be dismissed.

Reasons for the Decision

Main request (patent as granted)

1. Article 100(c) EPC and Article 123(2) EPC
 - 1.1 The subject-matter of granted claim 1 differs from that of original claim 1 in that the wording "fuel part" was replaced by "a part attached to any one of a fuel tank, a fuel hose and a canister and".
 - 1.2 The Board sees no reasons to depart from the opposition division's findings according to which the application as filed does not support any part attached to a fuel tank which is not a valve, any part attached to a fuel hose and any part attached to a canister and that there is no support in the application as filed for a part attached to a fuel hose or canister (see section 2.4.1 of the contested decision). In particular, the following passages of the application as filed, which were referred to by the appellant, are not related to the subject-matter of claim 1 at the present level of generality:
 - Page 1, first paragraph and page 4, third paragraphs: those passages are related to "fuel

parts" in general, but do not specifically disclose parts "attached to any one of a fuel tank, a fuel hose and a canister";

- Page 2, second and third full paragraphs: those passages are only related to fuel tanks and valves and deal with the prior art. The latter of those passages is further specifically related to fuel tanks made of high density polyethylene, which is not reflected in granted claim 1;
- Page 3, lines 1-2: that sentence is in particular related to specific multilayer structures, which is not reflected in granted claim 1. Also, that passage is not directed to the invention but to prior investigations;
- Page 4, fourth paragraph: that section is either specifically related to parts which are "weldable easily to the polyethylene fuel tank" or to a "valve cover attached to a polyethylene fuel tank" and which should have "excellent interlayer adhesion", which is not reflected in granted claim 1;
- Page 19, lines 2-4: that sentence deals specifically with valves attached to a fuel tank, joints for fuel hose and canister connecting nozzles and separators, i.e. to more specific embodiments than the generic term "part attached to any one of a fuel tank, a fuel hose and a canister" according to granted claim 1;
- Page 26, second and third full paragraph: those passages are specifically related to parts attached to fuel tanks of automobiles and are only

directed to fuel parts produced using a polyamide resin composition comprising a plate-crystal inorganic filler, which is not reflected in granted claim 1;

- Original claims 15-16 are directed to parts attached to a fuel tank further having a multilayer structure and comprising 3-27 wt.% of a plate-crystal inorganic filler, which is also not reflected in granted claim 1.

In view of the above, the appellant's arguments according to which the above cited passages of the application as filed provide a valid support for the amendment made in granted claim 1 are rejected.

1.3 The appellant argued that although there might be no literal support in the application as filed for the subject-matter defined in claim 1, the skilled person would derive it from the application as filed as a whole. In particular, interpreting the claims in the light of the description, the skilled person would understand that the wording "a part attached to any one of a fuel tank, a fuel hose and a canister" only referred to the specific "fuel parts" disclosed in the description. Reference was further made to Article 69 EPC.

1.3.1 In that respect, for the assessment of Article 123(2) EPC, the question to be answered is whether or not the subject-matter of an amended claim extends beyond the content of the application as filed, i.e. whether after the amendment the skilled person is presented with new technical information (see G 2/10, OJ EPO 2012, 376, point 4.5.1 of the Reasons and Case Law of the Boards of Appeal of the

EPO, 8th edition, 2016, II.E.1 and 1.2.1). This means, in the present case, that it has to be assessed whether or not there is a direct and unambiguous support in the application as filed for the expression "a part attached to any one of a fuel tank, a fuel hose and a canister", which was amended and represent new technical information as compared to the wording "a fuel part" present in original claim 1.

1.3.2 Even reading the application as filed as a whole, as argued by the appellant, it was explained in section 2.2 why, in the present case, no direct and unambiguous support for the wording "a part attached to any one of a fuel tank, a fuel hose and a canister" was found.

1.3.3 Besides, the patent in suit does not provide any limitation in respect of the definition of "a part attached to any one of a fuel tank, a fuel hose and a canister". Under those circumstances, the normal rule of claim construction is that the terms used in a claim should be given their broadest technically sensible meaning in the context of the claim in which they appear. This means, in the present case, that granted claim 1 is directed to **any** part attached to a fuel tank, a fuel hose or a canister, without any limitation.

In any case, there is no reason to consider that the wording of claim 1 "a part attached to any one of a fuel tank, a fuel hose and a canister" is in anyway ambiguous or unclear, so that there is no ground to turn to the description to interpret the wording of granted claim 1 in that respect. Nor is there any reason to make use of Article 69 EPC to interpret the claims, as argued by the appellant. In that respect,

it is further noted that Article 69 EPC deals with the determination of the extent of protection of a claim, which rather appears to be possibly relevant for the purposes of Article 123(3) EPC and in infringement proceedings, but not for Article 123(2) EPC.

Therefore, the appellant's arguments according to which the subject-matter of granted claim 1 was derivable from the application as filed as a whole or that the parts specified in operative claim 1 were limited to those mentioned in the description, are rejected.

- 1.4 For those reasons the main request does not satisfy the requirements of Article 100(c) EPC in combination with Article 123(2) EPC.

First and second auxiliary requests

- 2. Article 123(2) EPC
 - 2.1 The appellant argued that the subject-matter of claim 1 of the first auxiliary request was either supported by the combination of original claims 1 and 7 or by the passage at page 15, line 23 to page 16, line 7 of the application as filed.
 - 2.2 However, neither claim 1 nor claim 7 of the application as filed are directed to a fuel part which is "attached to a fuel tank". Besides, original claim 7 makes no reference to original claim 1. Therefore, the combination of original claims 1 and 7 does not provide a direct and unambiguous support for the subject-matter of operative claim 1.

2.3 The passage at page 15, line 23 to page 16, line 7 not only does not contain the wording "attached to a fuel tank" (only "bonded to a fuel tank" or "joined to a fuel tank"), but is further limited to embodiments wherein the fuel part is made of the polyamide (page 15, line 23) and wherein a modified polyolefin resin is used as an intermediate adhesion layer between the fuel part and the fuel tank (page 16, line 1 and 2-7). Considering that those features are not reflected in operative claim 1, the passage at page 15, line 23 to page 16, line 7 of the application as filed does not provide a direct and unambiguous support for the subject-matter of operative claim 1.

In that respect, the appellant argued that the modified polyolefin layer mentioned in the respective passages of the application as filed cited did not have to be included in claim 1, since it did not represent a mandatory but only a preferred feature.

However, in the passage at page 15, line 23 to page 16, line 1 of the application as filed it is unambiguously stated that the fuel part is bonded to a fuel tank with a modified polyolefin resin as an intermediate adhesion layer. In the next sentence, in which that embodiment is more specifically described, it is further indicated that the polyamide is welded with a modified polyolefin and then, the resulting part is joined to a fuel tank. Therefore, it makes no doubt that those passages only disclose an embodiment in which the modified polyolefin resin is present as an intermediate adhesion layer, contrary to the appellant's argumentation.

2.4 For those reasons, claim 1 of the first auxiliary request does not satisfy the requirements of Article 123(2) EPC. Since claim 1 of the second

auxiliary request is identical to claim 1 of the first auxiliary request, the same conclusion is reached for that claim.

3. Article 84 EPC

Although the Board arrived at the conclusion that it could be adhered to the opposition division's finding according to which the term "fuel part" according to claim 1 lacked clarity, there is no need for the Board to elaborate any further on that issue in view of the conclusion reached in section 3 in respect of Article 123(2) EPC.

Third to fifth auxiliary requests

4. Admittance

4.1 The respondents requested that the third to fifth auxiliary requests be not admitted into the proceedings.

4.2 Considering that the third to the fifth auxiliary requests were submitted together with the appellants' statement of grounds of appeal, they were filed pursuant to Article 12(2) RPBA and underlie the stipulations of Article 12(4) RPBA according to which the Board has the power to hold inadmissible requests which could have been presented in the first instance proceedings.

4.3 In that respect, the third to the fifth auxiliary requests are identical to the third to fifth auxiliary requests filed with letter of 15 April 2014. However, those requests were - apparently voluntarily - not defended any further during the oral proceedings before

the opposition division and were eventually replaced by auxiliary requests 3-5 dealt with in the contested decision (see page 4 of the minutes of the oral proceedings before the opposition division: paragraphs 2-3 and last paragraph together with Annexes I and II).

In view of the above, there was no decision on those requests due to the deliberate choice of the appellant to replace the requests.

The appellant has not shown nor argued that there had been any surprising development of the case during the opposition proceedings which could have justified the re-submission of those requests in appeal.

Besides, during the appeal proceedings, the appellant has not explained why the third to the fifth auxiliary requests would overcome the objections pursuant to Article 123(2) EPC retained by the opposition division against the higher ranking requests, in particular regarding the fact that the passage at page 19, lines 2-4 of the application as filed was specifically related to "valves attached to a fuel tank" but not to any fuel part, in particular not to "joints for fuel hose, canister connecting nozzles and separators, attached to a fuel tank" which are mentioned in operative claim 1 of any of the third to the fifth auxiliary requests (see contested decision: passage related to page 19, lines 2-4 at the bottom of page 12) so that they cannot be seen as a proper reaction to the decision.

Under those circumstances the Board concludes that the appellant, who already filed the requests in opposition proceedings, should have maintained them at that stage

if a decision on them was desired and finds it appropriate to make use of its power under Article 12(4) RPBA to hold the third to the fifth auxiliary requests as inadmissible.

Sixth auxiliary request

- 5. Article 123(2) EPC
- 5.1 The respondents argued that claims 7, 8 and 16-18 of the sixth auxiliary request did not satisfy the requirements of Article 123(2) EPC.
- 5.2 It is correct that each of operative claims 7, 8 and 16-18 may be arrived at by combining original claims 7, 8 and 23-25, respectively, with the disclosure of "valves attached to a fuel tank" at page 19, lines 2-4 of the application as filed after performing a single selection within a list of alternative embodiments.
- 5.3 However, the question remains to be answered whether the specific combination of features now being defined in each of those claims 7, 8 and 16-18 emerges from the application as filed, whereby the description is not to be viewed as a reservoir from which features pertaining to separate embodiments can be freely combined in order to artificially create a certain embodiment (Case Law, *supra*, II.E.1.4.1).
- 5.4 In that respect, the subject-matter of claim 7 is *inter alia* defined by a process related feature, whereby it makes no doubt that the product-by-process feature of that claim effectively characterises the product so defined, at least because it is bound to result in a welded area between the polyamide and the polyolefin of

a valve obtained by such a welding process. Therefore the combination of that process related feature with the specific product now defined in operative claim 7, namely the valve, constitutes a new technical information as compared to the original set of claims and it has to be assessed if that combination of features is directly and unambiguously derivable from the application as filed.

- 5.5 In that respect, the original set of claims comprised various embodiments, disclosed independently one of each other and directed to fundamentally different subject-matter such as "fuel parts" defined in several different manners, a "material for a fuel part", a process for producing a "fuel part", "resin valve covers", multilayer "fuel parts" and polyamide resin compositions (see original claims 1, 6 to 10, 15, 16, 21-25). Under such circumstances, it cannot be concluded that any passage of the application as filed, in particular the passage at page 19, lines 2-4, mandatorily applies to each of those embodiments.

In addition, the appellant could not identify any other passage of the application as filed which was directed to the making of a valve by a process comprising welding a polyamide and a polyolefin as now defined in operative claim 7. It is in particular noted that the passage at page 15, line 23 to page 16, line 7 additionally relied upon by the appellant is not directed to a valve in particular and is directed to parts having limitations which are not reflected in operative claim 7 (see in particular the requirement that the modified polyolefin is an intermediate adhesion layer between the part and the fuel tank). Therefore, said passage does not constitute a valid support for the subject-matter of operative claim 7 at

the present level of generality. The same is valid regarding Figures 2, 3, 7 of the application as filed which are all directed to articles comprising an intermediate modified polyolefin layer between the polyamide layer and the fuel tank, which is not reflected in operative claim 7. Therefore, none of those passages provide a direct and unambiguous support for the subject-matter of claim 7 at the present level of generality.

Under those circumstances, the subject-matter of claim 7 can only be arrived at after combining passages of the application as filed which were originally disclosed separately. In the absence of any pointer to that particular combination, it must be concluded that the combined selection of features now present in claim 7 does not emerge directly and unambiguously from the application as filed.

5.6 Similarly, in the absence of any pointer in the application as filed for the combination of each of original claims 8 and 23-25 with the disclosure of "valves attached to a fuel tank" at page 19, lines 2-4 of the application as filed, the same conclusion as for claim 7 is reached for each of claims 8 and 16-18.

5.7 Under those circumstances claims 7, 8 and 16-18 of the sixth auxiliary request do not satisfy the requirements of Article 123(2) EPC.

Seventh and eighth auxiliary requests

6. Article 123(2) EPC

Considering that

- claims 1, 7, 15 and 16 of the seventh auxiliary request comprise the same amendments as claims 7, 8, 16 and 18 of the sixth auxiliary request and
- claims 1, 7 and 14 of the eighth auxiliary request comprise the same amendments as claims 7, 8 and 16 of the sixth auxiliary request,

and further noting that the appellant has not provided any other argument than those put forward for the sixth auxiliary request, the same conclusion in respect of Article 123(2) EPC is reached for claims 1, 7, 15 and 16 of the seventh auxiliary request and for claims 1, 7 and 14 of the eighth auxiliary request as for claims 7, 8, 16 and 18 of the sixth auxiliary request.

Ninth auxiliary request

7. Admittance

7.1 The respondents requested that the ninth auxiliary request be not admitted into the proceedings.

7.2 Since the ninth auxiliary request was filed during the oral proceedings before the Board, its admittance into the proceedings underlies *inter alia* the stipulations of Article 13(1) RPBA.

7.3 According to the case law, it is a matter for each party to submit all facts, evidence, arguments and requests relevant for the enforcement or defence of his rights as early and completely as possible, in particular in *inter partes* proceedings in order to act fairly towards the other party and, more generally, to ensure due and swift conduct of the proceedings (Case

Law, *supra*, IV.E.4.1.2 and 4.1.4).

7.4 As may be seen from the minutes of the oral proceedings before the Board, the ninth auxiliary request was submitted by the appellant after the Board had announced its conclusion that the main request and the first to the eighth auxiliary requests were either not allowable or not admitted into the proceedings and as a further attempt to overcome the objections pursuant to Article 123(2) EPC (and Article 84 EPC) retained against the higher ranking requests.

7.5 Independently of its success in overcoming the objections, the Board considers that a piecemeal filing of auxiliary request(s) in a case where the relevant objections were known from the beginning of the appeal proceedings neither satisfies the requirements of Article 12(2) RPBA, according to which the appellant should submit a complete case in its statement of grounds of appeal, nor satisfies the requirements of due process (efficient conduct of the proceedings) and the need for economy of the proceedings (Article 13(1) RPBA). This is particularly true in the present case for the ninth auxiliary request which was only submitted after a negative conclusion against each higher pending requests had been announced and despite the fact that all objections retained were known by the appellant from the beginning of the appeal proceedings (the objection pursuant to Article 123(2) EPC against claims 7, 8 and 16-18 of the sixth auxiliary request was submitted in respondent 2's rejoinder to the appellant's statement of grounds of appeal dated 10 April 2015, section VII.1). Also, all those objections were identified in the Board's communication which was sent to the parties well in advance of the oral proceedings (see above: section IX, last but one

paragraph), so that they had sufficient time to prepare their case accordingly, in particular to file in due time any auxiliary requests susceptible to overcome the issues identified therein.

- 7.6 For those reasons, the Board finds it appropriate to exercise its discretion under Article 13(1) RPBA by not admitting into the proceedings the ninth auxiliary request submitted during the oral proceedings before the Board.

Tenth to twelfth auxiliary requests

8. Admittance

8.1 The respondents requested that the tenth to the twelfth auxiliary requests be held inadmissible because they should have been filed in first instance proceedings.

8.2 Considering that the tenth to the twelfth auxiliary requests were submitted together with the appellants' statement of grounds of appeal, they were filed pursuant to Article 12(2) RPBA and underlie the stipulations of Article 12(4) RPBA according to which the Board has the power to hold inadmissible requests which could have been presented in the first instance proceedings.

8.3 The appellant has not justified why those requests were only filed at the present stage of the proceedings. Besides, it was not shown that there had been any surprising development of the case which could justify the filing of those requests only with the statement of grounds of appeal. Therefore, there is no apparent reason which could justify why the appellant has not submitted those requests already in the first instance

proceedings.

8.4 The appellant argued that he should be allowed to file new requests together with its statement of grounds of appeal in direct reaction to the contested decision.

8.4.1 However, in its statement of grounds of appeal the appellant provided no substantiation why the tenth to the twelfth auxiliary requests may overcome the objection of lack of inventive step retained against the third to the fifth auxiliary requests dealt with as last requests in the contested decision.

Regarding the objections pursuant to Article 123(2) EPC retained by the opposition division against the then pending main request, first and second auxiliary requests, the appellant only indicated that the tenth to twelfth auxiliary requests were allowable because the amendments made was based on the passage at page 22, third paragraph of the application as filed. Therefore, the appellant's line of argumentation was similar to that used in respect of the main request, first and second auxiliary requests dealt with and not allowed in the contested decision, apart from the fact that it relied on the combination of original claims with a different passage of the application as filed. However, considering that that passage of the application as filed is directed to the embodiment of Figure 7, i.e. to a specific embodiment comprising features which are not reflected in e.g. claim 1 of each of the ninth to the eleventh auxiliary requests, it is not apparent and it was not explained by the appellant why those new requests could possibly overcome the opposition division's findings in respect of Article 123(2) EPC.

8.4.2 Also, it is noted that in the present case, the contested decision did not deal with claims directed to "resin valve covers" as now defined in operative claims 1, 9 and 10 of any of the tenth to the twelfth auxiliary requests (whereby claims 9 and 10 correspond to original claims 9 and 10, respectively).

Besides, the subject-matter of operative claim 1 of the tenth to the twelfth auxiliary requests is directed to "resin valve covers" instead of the "valves" defined e.g. in claim 1 of the sixth to the eighth auxiliary requests. Claim 1 of the tenth to the twelfth auxiliary requests is further related to different embodiments of the resin valve covers otherwise defined in the higher ranking requests e.g. in claims 9 and 10 of the sixth auxiliary request (corresponding to claims 9 and 10 of the application as filed), i.e. they are related to fundamentally different subject-matter. On that basis these requests appear to diverge from the previous requests.

Under those circumstances, although it is not contested that the subject-matter of the tenth to the twelfth auxiliary requests is within the scope of the opposition (see e.g. granted claim 1), admitting any of those requests into the proceedings would have required dealing for the first time with completely new issues during the appeal proceedings or, possibly, to remit the case to the first instance for further prosecution. This would run counter to the need for economy of the proceedings and would not be in line with the purpose of the *inter partes* appeal proceedings which is mainly to give the losing party a possibility to challenge the decision of the opposition division on its merits (G 9/91, section 18 of the reasons).

In view of this the Board considers that these requests together with the submissions relevant to them in the statement of grounds of appeal cannot be seen as a proper reaction to the decision, so that these requests could and should have been filed in opposition proceedings, if a decision on them was desired.

- 8.4.3 Under these circumstances, the Board finds it appropriate to make use of its power under Article 12(4) RPBA to hold inadmissible the tenth to the twelfth auxiliary requests.
9. None of the appellants' requests which are in the proceedings (main request, first, second and sixth to eighth auxiliary requests) being allowable, the appeal is to be dismissed.

Order

For these reasons it is decided that:

The appeal is dismissed.

The Registrar:

The Chairman:



B. ter Heijden

D. Semino

Decision electronically authenticated