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**Datasheet for the decision  
of 16 June 2021**

**Case Number:** T 2490/18 - 3.3.09

**Application Number:** 13160881.2

**Publication Number:** 2610290

**IPC:** C08J11/04, C08K9/04, C09C1/02,  
C08L23/10

**Language of the proceedings:** EN

**Title of invention:**  
Methods and compositions related to recycling polymer waste

**Patent Proprietor:**  
IMERTECH SAS

**Opponent:**  
Omya International AG

**Headword:**  
Polymer composition/IMERTECH

**Relevant legal provisions:**  
EPC Art. 76(1), 100(c)

**Keyword:**  
Divisional application - subject-matter extends beyond content  
of earlier application (yes)

**Decisions cited:**

**Catchword:**



**Beschwerdekammern**

**Boards of Appeal**

**Chambres de recours**

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Case Number: T 2490/18 - 3.3.09

**D E C I S I O N**  
**of Technical Board of Appeal 3.3.09**  
**of 16 June 2021**

**Appellant:** IMERTECH SAS  
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**Representative:** Maiwald Patent- und Rechtsanwalts-gesellschaft mbH  
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**Decision under appeal:** **Interlocutory decision of the Opposition  
Division of the European Patent Office posted on  
1 August 2018 concerning maintenance of the  
European Patent No. 2610290 in amended form.**

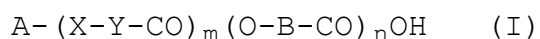
**Composition of the Board:**

**Chairman** A. Haderlein  
**Members:** M. Ansorge  
D. Rogers

## Summary of Facts and Submissions

- I. Appeals against the opposition division's interlocutory decision (holding auxiliary request 4 allowable) were filed by both parties to the proceedings. For simplicity, the board will continue to refer to them as proprietor and opponent.
- II. With its notice of opposition, the opponent had requested revocation of the patent, *inter alia*, on the ground for opposition under Article 100(c) EPC.
- III. Claim 1 of auxiliary request 4 held allowable by the opposition division reads as follows:

"A polymer composition comprising polymer and a functional filler, wherein the polymer comprises from 90 to 100 % by weight of a mixture of polyethylene and polypropylene, wherein the functional filler comprises (i) an inorganic particulate and (ii) a coating comprising a first compound including a terminating propanoic group or ethylenic group with one or two adjacent carbonyl groups, and wherein the polymer composition is a recycled polymer composition and the polymer is derived from waste polymer which is post-consumer waste polymer, and wherein the functional filler is present in an amount of at least 3% by weight of the waste polymer, and wherein the first compound has a formula (1):



wherein

A is a moiety containing a terminating ethylenic bond with one or two adjacent carbonyl groups;  
X is O and m is 1 to 4 or X is N and m is 1;  
Y is C<sub>1-18</sub>-alkylene or C<sub>2-18</sub>-alkenylene;  
B is C<sub>2-6</sub>-alkylene;  
n is 0 to 5;  
provided that when A contains two carbonyl groups adjacent to the ethylenic group, X is N."

- IV. The opposition division decided, *inter alia*, that the subject-matter of claim 1 of auxiliary request 4 met the requirements of the EPC, including the requirement of Article 76(1) EPC.
- V. With its statement of grounds of appeal, the proprietor filed a main request (claims as granted) and auxiliary requests 1 to 8.
- VI. Claim 1 of auxiliary request 5 on appeal is identical to claim 1 of auxiliary request 4 held allowable by the opposition division (see point III.). The exact wording of claim 1 of the main request and claim 1 of each of auxiliary requests 1 to 4 and 6 to 8 is not decisive for understanding the present decision and thus is not set out here.
- VII. In preparation for oral proceedings, the board issued a communication pursuant to Article 15(1) RPBA and indicated that none of the requests on file met the requirement of Article 76(1) EPC.
- VIII. The proprietor advised the board that no-one from its side would be attending the scheduled oral proceedings. Consequently, the oral proceedings were cancelled.

IX. The parties' relevant arguments are reflected in the reasoning below.

X. Requests

The proprietor requested that the decision be set aside and that the patent be maintained as granted (main request) or, alternatively, on the basis of one of auxiliary requests 1 to 8, all filed with the statement of grounds of appeal.

The opponent requested that the decision be set aside and that the patent be revoked in its entirety.

## **Reasons for the Decision**

### AUXILIARY REQUEST 5

1. Article 76(1) EPC

1.1 The opponent argued that the subject-matter of claim 1 of auxiliary request 5 extends beyond the content of the earlier application as filed and infringes the requirement of Article 76(1) EPC, whereas, in the proprietor's opinion, there is sufficient basis for the claimed subject-matter in the earlier application as filed. However, the proprietor did not file a response to the opponent's reply to the appeal and did not counter-argue against each objection under Article 76(1) EPC raised by the opponent.

1.2 For the following reasons, the subject-matter of claim 1 of auxiliary request 5 does not meet the requirement of Article 76(1) EPC, second sentence.

- 1.2.1 In the earlier application as filed, claim 14 or the embodiment described in the paragraph bridging pages 21 and 22 (which is similar in scope) comes closest to the subject-matter of claim 1 of auxiliary request 5.
- 1.2.2 Claim 1 of auxiliary request 5 differs from claim 14 of the earlier application as filed *inter alia* in that the conditional feature "with the proviso that when the at least one polymer is not recycled from polymer waste in accordance with any one of claims 1 to 7, the coating additionally comprises a second compound selected from the group consisting of one or more fatty acids and one or more salts of a fatty acid, and combinations thereof" ("decisive feature") is not included in claim 1 of auxiliary request 5. In this context, it is noted that claims 1 to 7 of the earlier application as filed relate to specific processes for recycling polymer waste material, including a cleaning step.

It similarly differs from the embodiment described in the paragraph bridging pages 21 and 22, the crucial part of which reads as follows:

"In embodiments in which the at least one polymer is not recycled from polymer waste in accordance with the first, second or third aspects of the invention, the coating additionally comprises a second compound selected from the group consisting of one or more fatty acids and one or more salts of a fatty acid, for example, stearic acid and/or calcium stearate, as described above."

The first, second and third aspects of the invention mentioned in this embodiment correspond to the specific recycling processes according to claims 1 to 7 of the earlier application as filed, referred to in claim 14.

- 1.2.3 For the following reasons, not including the decisive feature of claim 14, or the embodiment disclosed in the paragraph bridging pages 21 and 22, of the earlier application as filed in claim 1 of auxiliary request 5 leads to an extension beyond the content of the earlier application as filed.
- 1.2.4 The decisive feature of claim 14, or analogously the embodiment described in the paragraph bridging pages 21 and 22, does not deal with just any kind of recycled waste polymer, as does in claim 1 of auxiliary request 5, but specifically with one which is recycled from polymer waste in accordance with the processes of any one of claims 1 to 7 or in accordance with the first, second or third aspect of the invention.
- 1.2.5 The opponent argued that the paragraph bridging pages 21 and 22 of the earlier application as filed relates to an embodiment in which the coating mandatorily requires a second compound in cases where the polymer is not recycled from polymer waste in accordance with the first, second or third aspect of the invention. Since this requirement is not present in claim 1 of auxiliary request 5, the opponent argued that there is an infringement of Article 76(1) EPC.
- 1.2.6 The board shares this view. Although the decisive feature is a conditional feature, it requires the presence of a second compound in cases where the polymer is not recycled in a specific manner, i.e. from polymer waste in accordance with the first, second or third aspect of the invention (corresponding to the recycling processes according to claims 1 to 7).



1.2.7 Claim 1 of auxiliary request 5 encompasses polymers not recycled in accordance with the first, second or third aspect of the invention (or any one of claims 1 to 7). According to the disclosure of the earlier application as filed, the presence of a second compound is mandatory for polymers not recycled in this way (see claim 14 and the paragraph bridging pages 21 and 22 of the earlier application as filed). However, no such limitation is present in claim 1 of auxiliary request 5.

1.2.8 In view of the above, the board concludes that not including the decisive feature in claim 1 of auxiliary request 5 leads to subject-matter which extends beyond the content of the earlier application as filed. In other words, not including the decisive feature renders the second compound a purely optional feature, which is not in line with the disclosure of the earlier application as filed.

Thus, the subject-matter of claim 1 of auxiliary request 5 infringes the requirement of Article 76(1) EPC.

#### MAIN REQUEST AND AUXILIARY REQUESTS 1 TO 4 AND 6 TO 8

#### 2. Article 76(1) EPC

Claim 1 of each of the main request and auxiliary requests 1 to 4 and 6 to 8 neither specifies a polymer recycled from polymer waste in accordance with any one of claims 1 to 7 of the earlier application as filed, or in accordance with the first, second or third aspect of the invention, nor contains the decisive feature. For the same reasons as outlined above for claim 1 of auxiliary request 5, this leads to subject-matter

extending beyond the content of the earlier application as filed.

Thus, the ground for opposition under Article 100(c) EPC prejudices the maintenance of the patent as granted (main request), and the subject-matter of claim 1 of auxiliary requests 1 to 4 and 6 to 8 infringes the requirement of Article 76(1) EPC.

3. Accordingly, there is no allowable claim request on file.

## 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:



C. Moser

A. Haderlein

Decision electronically authenticated