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**Datasheet for the decision
of 12 July 2022**

Case Number: T 0876/19 - 3.3.03

Application Number: 12751941.1

Publication Number: 2682428

IPC: C08L53/02, C08J5/18, C08L25/02,
C08F293/00

Language of the proceedings: EN

Title of invention:
RESIN COMPOSITION AND HEAT-SHRINKABLE FILM THEREOF

Patent Proprietor:
Denka Company Limited

Opponent:
INEOS Styrolution Group GmbH

Relevant legal provisions:
EPC Art. 84, 100(c), 111(1), 123(2)
RPBA 2020 Art. 11

Keyword:

Grounds for opposition - added subject-matter - main request
(yes)

Amendments - allowable (no and yes)

Claims - clarity (yes)

Appeal decision - remittal to the department of first instance
(yes)

Decisions cited:

G 0002/10, G 0003/14



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Case Number: T 0876/19 - 3.3.03

D E C I S I O N
of Technical Board of Appeal 3.3.03
of 12 July 2022

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Decision under appeal: **Decision of the Opposition Division of the
European Patent Office posted on 31 January 2019
revoking European patent No. 2682428 pursuant to
Article 101(3) (b) EPC.**

Composition of the Board:

Chairman D. Marquis
Members: O. Dury
 A. Bacchin

Summary of Facts and Submissions

I. The appeal of the patent proprietor is against the decision of the opposition division revoking European Patent No. 2 682 428.

II. Claims 1 and 5 of the **application as filed** read as follows:

"1. A resin composition comprising at least one type of block copolymer consisting of a vinyl aromatic hydrocarbon and a conjugated diene, the resin composition (i) having a Vicat softening temperature of 65 to 90 °C measured with a load of 10 N in accordance with ISO306, (ii) having a bending strength of 58 MPa to 80 MPa measured at a test speed of 2 mm/min in accordance with ISO178, (iii) a proportion of the resin composition occupied by the conjugated diene being 10 to 25 mass%, and (iv) a molecular weight distribution of the resin composition having molecular weight peaks from the block copolymers consisting of a vinyl aromatic hydrocarbon and a conjugated diene respectively in the range of molecular weight 70000 to 150000 and in the range of 150000 to 350000."

"5. The resin composition according to any one of claims 1 to 4, further comprising at least one type of polymer chosen from among the following (A) to (C) at a maximum of up to 30 mass%:

(A) a vinyl aromatic hydrocarbon polymer;

(B) a copolymer consisting of a vinyl aromatic hydrocarbon and an acrylic acid ester; and

C) a hydrogenated block copolymer consisting of a vinyl aromatic hydrocarbon and a conjugated diene."

III. The decision under appeal was based on the patent as granted as main request and on the first to fourth auxiliary requests filed during the oral proceedings before the opposition division. In that decision, the following conclusions were reached:

- Claim 1 of the main request extended beyond the scope of the application as filed (Article 100(c) EPC);
- Claim 1 of the first and second auxiliary requests did not meet the requirements of Article 123(3) EPC;
- Claim 1 of the third and fourth auxiliary requests did not meet the requirements of Article 84 EPC.

In view of the above, none of the patent proprietor's requests met the requirements of the EPC and the patent was revoked.

IV. The patent proprietor (appellant) appealed against the above decision and, together with their statement of grounds of appeal, filed a set of auxiliary requests 1, 1a, 2, 2a, 3, 3a, 4, 4a and 5 to 9.

V. The opponent (respondent) submitted a rejoinder to the statement of grounds of appeal.

VI. The parties were summoned to oral proceedings and a communication pursuant Article 15(1) RPBA 2020 indicating specific issues to be discussed at the oral

proceedings was sent to the parties.

VII. Oral proceedings were held on 12 July 2022 in the presence of both parties.

VIII. **The final requests of the parties were as follows:**

(a) The appellant requested that the decision under appeal be set aside and that the case be remitted to the opposition division for further prosecution of the patent as granted as main request, in order to deal with the grounds of opposition which had not been decided upon by the opposition division. In the alternative, the appellant requested that the decision under appeal be set aside and that the case be remitted to the opposition division for further prosecution of auxiliary requests 1, 1a, 2, 2a, 3, 3a, 4, 4a or 5 to 9, in this order, filed with the statement of grounds of appeal.

(b) The respondent requested that the appeal be dismissed.

IX. Claim 1 of the **main request** (patent as granted) read as follows (additions as compared to claim 1 of the application as filed in **bold**, deletions in ~~striketthrough~~):

"1. A resin composition comprising at least one type of block copolymer consisting of a vinyl aromatic hydrocarbon and **butadiene as** a conjugated diene, the resin composition (i) having a Vicat softening temperature of 65 to 90 °C measured with a load of 10 N in accordance with ISO306, (ii) having a bending strength of 58 MPa to 80 MPa measured at a test speed of 2 mm/min in accordance with ISO178, (iii) a

proportion of the resin composition occupied by the ~~conjugated diene~~ **butadiene** being 10 to 25 mass%, and (iv) a molecular weight distribution of the resin composition having molecular weight peaks from the block copolymers consisting of a vinyl aromatic hydrocarbon and a ~~conjugated diene~~ **butadiene** respectively in the range of molecular weight ~~70000~~ **80000** to 150000 and in the range of ~~150000~~ **170000** to ~~300000~~ **350000**."

- X. Claim 1 of **auxiliary request 1** read as follows (additions as compared to claim 1 of the application as filed in **bold**, deletions in ~~strikethrough~~):

"1. A resin composition ~~comprising~~ **consisting of**

(a) at least one type of block copolymer consisting of a vinyl aromatic hydrocarbon and **butadiene as** a conjugated diene,

(b) **optionally, at least one type of polymer chosen from among the following (A) and (B) at a maximum of up to 30 mass%:**

(A) a vinyl aromatic hydrocarbon polymer;

(B) a copolymer consisting of a vinyl aromatic hydrocarbon and an acrylic acid ester; and

(c) **optionally an inorganic filler; an anti-oxidant selected from 2-tert-butyl-6-(3-tert-butyl-2-hydroxy-5-methylbenzyl)-4-methylphenylacrylate, 2-[1-(2-hydroxy-3,5-di-tert-pentylphenyl)ethyl]-4,6-di-tert-pentylphenylacrylate, n-octadecyl-3-(4-hydroxy-3,5-di-tert-butylphenyl)propionate, 2,2'-methylenebis(4,6-di-tert-butylphenyl)octylphosphite and tris(2,4-di-tert-**

butylphenyl)phosphite; a weathering agent selected from 2-(2-hydroxy-3-tert-butyl-5-methylphenyl)-5-chlorobenzotriazole and tetra-cis(2,2,6,6-tetramethyl-4-piperidyl)-1,2,3,4-butane tetracarboxylate; and a lubricant selected from paraffin waxes, microcrystalline waxes and petrolatum;

the resin composition (i) having a Vicat softening temperature of 65 to 90 °C measured with a load of 10 N in accordance with ISO306, (ii) having a bending strength of 58 MPa to 80 MPa measured at a test speed of 2 mm/min in accordance with ISO178, (iii) a proportion of the resin composition occupied by the ~~conjugated diene~~ **butadiene** being 10 to 25 mass%, and (iv) a molecular weight distribution of the resin composition having molecular weight peaks from the block copolymers consisting of a vinyl aromatic hydrocarbon and a ~~conjugated diene~~ **butadiene** respectively in the range of molecular weight ~~70000~~ **80000** to 150000 and in the range of ~~150000~~ **170000** to ~~300000~~ **350000**."

- XI. **Auxiliary request 1a** contained the same set of claims as auxiliary request 1 together with a set of amended pages 5, 6 and 15 of the patent specification.
- XII. Claim 1 of **auxiliary request 2** was directed to the use of a resin composition according to claim 1 of auxiliary request 1 "for obtaining a heat-shrinkable film having a haze of 8% or less".
- XIII. **Auxiliary request 2a** contained the same set of claims as auxiliary request 2 together with the same set of amended pages 5, 6 and 15 of the patent specification as auxiliary request 1a.

XIV. Claim 1 of **auxiliary request 3** read as follows
(additions as compared to claim 1 of the application as
filed in **bold**, deletions in ~~strikethrough~~):

"1. A resin composition ~~comprising~~ **consisting of**
at least one type of block copolymer consisting of a
vinyl aromatic hydrocarbon and **butadiene as** a
conjugated diene, the resin composition (i) having a
Vicat softening temperature of 65 to 90 °C measured
with a load of 10 N in accordance with ISO306, (ii)
having a bending strength of 58 MPa to 80 MPa measured
at a test speed of 2 mm/min in accordance with ISO178,
(iii) a proportion of the resin composition occupied by
the ~~conjugated diene~~ **butadiene** being 10 to 25 mass%,
and (iv) a molecular weight distribution of the resin
composition having molecular weight peaks from the
block copolymers consisting of a vinyl aromatic
hydrocarbon and a ~~conjugated diene~~ **butadiene**
respectively in the range of molecular weight ~~70000~~
80000 to 150000 and in the range of ~~150000~~ **170000** to
~~300000~~ **350000**."

XV. Auxiliary requests 3a, 4, 4a and 5 to 9 are not
relevant for the present decision.

XVI. The appellant's arguments, in so far as they are
pertinent, may be derived from the reasons for the
decision below. They are essentially as follows:

(a) The amendments made in claim 1 of each of the main
request and auxiliary requests 1, 1a, 2, 2a and 3
did not extend beyond the content of the
application as filed.

(b) The term "consisting of", which had been introduced
in claim 1 of each of auxiliary requests 1, 1a, 2,

2a and 3, had an unambiguous meaning and did not render the scope of the claims unclear (Article 84 EPC).

XVII. The respondent's arguments, in so far as they are pertinent, may be derived from the reasons for the decision below. They are essentially as follows:

- (a) The amendment made in feature (iii) of claim 1 of the main request led to an unallowable extension beyond the content of the application as filed;
- (b) The same was valid for the combination of amendments made in claim 1 of each of auxiliary requests 1, 1a, 2 and 2a;
- (c) Considering the arguments put forward by the appellant during the first instance proceedings regarding the meaning of the term "consisting of" used to define the block copolymer(s), the limitation implied by the term "consisting of" used to define the resin composition according to claim 1 of each of auxiliary requests 1, 1a, 2, 2a and 3 was unclear (Article 84 EPC).

Reasons for the Decision

Main request (patent as granted) - Article 100(c) EPC

- 1. Added subject-matter
 - 1.1 In order to assess whether claim 1 as granted extends beyond the content of the application as filed, which was in dispute between the parties, it has to be

established if a direct and unambiguous basis for the subject-matter of said claim 1 may be found in the application as filed. In that respect, the question to be answered is whether or not the disclosure extends beyond the content of the application as filed, i.e. whether after the amendments made 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, 9th edition, 2019, II.E.1.1 and II.E.1.3.1).

- 1.2 The opposition division held that the amendment made in feature (iii) of claim 1 as granted extended beyond the scope of the application as filed, whereby the same objection was pursued in appeal by the respondent.
- 1.3 In order to determine if the amendments made in said feature (iii) actually present the skilled person with new technical information, the meaning of feature (iii) in claim 1 as granted has first to be determined. Then, it has to be examined whether said feature is directly and unambiguously derivable from the application as filed.
- 1.4 Meaning of feature (iii) in claim 1 as granted
 - 1.4.1 The parties do not agree on the meaning of feature (iii). The issue in dispute is if the amount of 10 to 25 mass% mentioned in feature (iii) of claim 1 as granted refers to the amount of butadiene comprised only in the "at least one type of block copolymer consisting of a vinyl aromatic hydrocarbon and butadiene as a conjugate diene" (as read by the appellant) or in the whole resin composition (as read by the respondent and the opposition division).

1.4.2 In that respect, the Board finds that, as argued by the appellant, albeit in respect of the wording of claim 1 of the application as filed related to the conjugated diene (statement of grounds of appeal: section 4.2), the fact that in said feature (iii) the term "butadiene" is preceded by the definite article "the" can only mean that reference is made to the previously mentioned "butadiene", whereby the sole possibility is that reference is made therewith to "butadiene as a conjugated diene" as comonomer in the block copolymer(s) defined at the beginning of the claim. This reading further makes sense from a technical point of view, since the amount of butadiene so being defined is related to the sole polymeric component(s) defined in any details in that claim. In the Board's view, should said feature have been meant to be related to the whole composition, "butadiene" as a generic term and without the definite article "the" would have been the appropriate wording, as put forward by the appellant (statement of grounds of appeal: page 9, second paragraph). Therefore, the respondent's objection (which was shared by the opposition division) that the amount of butadiene of 10-25 mass% of the resin composition referred to any butadiene present in the resin composition being claimed is not persuasive.

1.4.3 The above conclusion is reached on the basis of the analysis of the wording of claim 1 as granted alone, whereby it is considered that said wording does not leave room for interpretation. Since, according to established case law, if the claims have an unambiguous wording and a clear technical meaning the description cannot be used to interpret the claims (Case Law, *supra*, II.A.6.3.1), in the present case reference to the description to interpret the meaning of that claim cannot be made. For that reason, any considerations put

forward by the respondent or the opposition division which were based on the content of the patent specification cannot succeed.

1.4.4 In view of the above, feature (iii) of claim 1 as granted defines that the amount of butadiene of the "at least one type of block copolymer consisting of a vinyl aromatic hydrocarbon and butadiene as a conjugate diene" must be from 10 to 25 mass% based on the resin composition.

1.5 Support for feature (iii) of claim 1 as granted in the application as filed

1.5.1 The appellant argued that a valid support for feature (iii) of claim 1 as granted (read according to section 1.4.4 above) was claim 1 of the application as filed in combination with the indication in paragraph 13 of the application as filed that butadiene was one of the two preferred conjugated dienes to be used.

1.5.2 Regarding the meaning of feature (iii) in claim 1 of the application as filed, the Board considers that the same conclusion as reached in respect of the reading of feature (iii) of claim 1 as granted is also valid, i.e. feature (iii) defines that the amount of conjugated diene of the "at least one type of block copolymer consisting of a vinyl aromatic hydrocarbon and a conjugate diene" must be from 10 to 25 mass% based on the resin composition.

1.5.3 In addition, during the oral proceedings before the Board both parties agreed that the resin composition defined both in claim 1 of the application as filed and in claim 1 as granted could encompass several block

copolymers consisting of vinyl aromatic hydrocarbon and various conjugated dienes (e.g. a block copolymer consisting of a vinyl aromatic hydrocarbon and butadiene together with a block copolymer consisting of a vinyl aromatic hydrocarbon and isoprene). This follows for claim 1 of the application as filed both from the open wording of the claim ("a resin composition comprising", which allows the presence of further components, in addition to the ones specified in the claim) and from the fact that said composition comprises "at least one type of block copolymer consisting of a vinyl aromatic hydrocarbon and a conjugated diene" (which allows the presence of several types of block copolymers, including block copolymers consisting of different vinyl aromatic hydrocarbons and/or different conjugated dienes). That conclusion is further also valid for claim 1 as granted in view of the open wording thereof ("a resin composition comprising"). For such compositions, it was also undisputed, as clarified during the oral proceedings before the Board, that whereas feature (iii) defined in claim 1 of the application as filed imposed that the *total amount of conjugated dienes comprised in said block copolymers* was limited to 10 to 25 mass%, the wording of claim 1 as granted only defined that the *amount of butadiene comprised in said block copolymers was limited to 10 to 25 mass%*, but did not impose any limitation on the amount of the other conjugated dienes possibly also present in these block copolymers (e.g. isoprene in the example cited above).

- 1.5.4 In view of the above, even considering the passages of the application as filed which were relied upon by the appellant as providing a valid basis for the amendment made in feature (iii) of claim 1 as granted (section 1.5.1 above), said amendment presents the

skilled person with new technical information which is not directly and unambiguously derivable from the application as filed.

- 1.5.5 In view of the above, the ground for opposition under Article 100(c) EPC prejudices the maintenance of the patent as granted and the main request is not allowable.

Auxiliary requests 1 and 1a - Article 123(2) EPC and Article 84 EPC

2. Article 123(2) EPC

- 2.1 Claim 1 of auxiliary request 1 differs from claim 1 of the main request in that:

- The resin composition being claimed is defined using a closed wording "A resin composition consisting of ...";
- The resin composition may comprise components (b) and (c) as defined therein as sole optional components in addition to the block copolymer(s) defined as component (a).

- 2.2 Although it was not in dispute that a basis could be found in the application as filed for the individual components (b) and (c) now further specified in operative claim 1, as put forward by the appellant (statement of grounds of appeal: section 2.2), the respondent argued that the specific combination of features of claim 1 of auxiliary requests 1 was not directly and unambiguously derivable from the application as filed.

2.3 In that respect, it was common ground that the subject-matter defined in operative claim 1 may be arrived at starting from claim 5 of the application as filed (as relied upon by the appellant), which has to be further modified as follows:

- (i) The resin composition should be limited to comprise only components (a) to (c) as defined therein (in view of the amendment "a resin composition consisting of") but no other additional components (which was possible in original claim 5 in view of the open wording "a resin composition comprising ...");
- (ii) The block copolymer(s) (component (a) of operative claim 1) should be limited to the one(s) consisting of vinyl aromatic hydrocarbon and butadiene (i.e. block copolymers consisting of vinyl aromatic hydrocarbon and other conjugated dienes different from butadiene cannot be present any more);
- (iii) The optional additional polymer(s) (component (b) of operative claim 1) defined in original claim 5 should be limited to those chosen from among (A) and (B) (instead of those chosen from (A) to (C));
- (iv) The optional additives (component (c) of operative claim 1) should be limited to inorganic fillers, several specific anti-oxidants, two specific weathering agents and three specific lubricants as defined

therein;

(v) Features (iii) and (iv) should be directed to butadiene;

(vi) The ranges of molecular weight defined at the end of the claim should be limited to specific narrower ranges.

2.4 For the assessment of Article 123(2) EPC in the case of multiple amendments being made, as is the case here, the question has to be posed whether the specific combination of features now being defined in operative claim 1 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.1.6.1).

2.5 In the present case, the respondent's objection was primarily directed to an alleged lack of a valid basis in the application as filed for the combination of amendments (ii), (iii) and (iv) as identified in section 2.3 above.

2.6 Regarding amendment (ii), it is correct that, as argued by the appellant, it is indicated in paragraph 13 of the application as filed that butadiene is one of two preferred embodiments for the conjugated diene making up the block copolymer defined in original claim 5 and that butadiene is also the sole conjugated diene used in the examples of the application as filed. However, it has to be further taken into account that according to paragraph 12 of the application as filed, styrene is also disclosed as the preferred vinyl aromatic hydrocarbon making up the block copolymer(s) defined in

original claim 5, whereby styrene is also the sole vinyl aromatic hydrocarbon used in the examples of the application as filed. Therefore, amendment (ii) amounts to limiting the conjugated diene to the preferred embodiment indicated in the application as filed while maintaining the vinyl aromatic hydrocarbon to the highest level of generality.

- 2.7 Regarding amendment (iii), the Board agrees with the appellant that it amounts to a limitation of the block copolymers to only some of the various alternatives originally disclosed in claim 5 (statement of grounds of appeal: section 2.2, second paragraph).
- 2.8 Regarding amendment (iv), the appellant indicated that a valid support may be found in paragraphs 21 and 23 to 25 of the application as filed.
- 2.8.1 In that respect, it is indicated in paragraph 20 of the application as filed that the compositions being claimed may contain a filler, whereby it is further stated in paragraph 21 that said filler may either be organic or inorganic. A preference is even indicated towards organic fillers if good transparency is wished (paragraph 21, second sentence). Therefore, amendment (iv) amounts to limiting the optional filler to one of two embodiments originally disclosed, whereby no preference for the class of fillers selected is derivable from the application as filed.
- 2.8.2 It is further derivable from paragraph 22 of the application as filed that various other additives may also be present in the compositions being claimed, whereby the examples listed are "plasticizers, anti-oxidants, weathering agents, lubricants, anti-static agents, anti-clouding agents and pigments". Therefore,

the general classes of additives (anti-oxidant, weathering agent, lubricant) specified in above amendment (iv) amounts to selecting only three of these classes of additives, while avoiding the other four classes.

In addition, among the lists of more specific examples of additives that may suitably be used indicated in paragraphs 23 to 26 of the application as filed, the following additional choices have to be made:

- use any of the anti-oxidants indicated in paragraph 23;
- limit the weathering agent to only two specific embodiments given in the last two lines of page 5 of the application as filed (whereby neither considering the most general disclosures directed to benzotriazole UV absorbers and hindered amines, nor the other two specific embodiments indicated at page 6, line 1);
- limit the lubricants to the last three embodiments indicated in paragraph 25 (while not considering the other components indicated in the four first lines of that paragraph);
- disregard any of the specific anti-static agents indicated in paragraph 26 of the application as filed.

2.9 In view of the above, in order to arrive at the combination of amendments (ii), (iii) and (iv) of operative claim 1, one has not only to make a specific selection within the application as filed to define the block copolymers (feature (a)) and to limit the

additional polymer(s) optionally present to only some embodiments originally disclosed (feature (b)) but also to further select both a single type of fillers and very specific types of additives(feature (c)) within all the possibilities originally disclosed.

2.10 However, it was not shown by the appellant that such a combination of features is directly and unambiguously derivable from the application as filed. In that respect, although examples 13-14 and 15-16 of the application as filed (see Table 8) disclose compositions consisting of specific block copolymers consisting of styrene and butadiene with either polystyrene or a styrene-n-butyl acrylate copolymer (Table 7: components (a) and (b)), these compositions only illustrate specific embodiments, which are in particular i) limited to block copolymers consisting of styrene and butadiene (component (a) of operative claim 1), ii) limited to a single specific type of component (A) or (B) (component (b) of operative claim 1) and which iii) contain neither fillers, nor additives (component (c) of operative claim 1). Therefore, these examples cannot provide a valid basis for the subject-matter of operative claim 1 at the present level of generality.

2.11 During the oral proceedings before the Board, the appellant argued that the amendments made amounted to a shrinking of lists originally disclosed without singling out a combination of features, which was allowable.

2.11.1 However, although original claim 5 provides a basis for the combination of features corresponding to a more generic disclosure of the combination of components (a) and (b) of operative claim 1, it is not directed to

component (c) as defined in operative claim 1. In fact, to arrive at component (c), originally claim 5 has to be further combined not only with paragraphs 20 and 21 of the application as filed (fillers), whereby a further selection has to be made, but also with paragraphs 22-26 of the application as filed (specific additives), whereby further selections also have to be made. Therefore, in the Board's view, the combination of features according to above amendments (ii) to (iv) does not amount to a list of features originally disclosed in combination, as argued by the appellant.

2.11.2 In addition, at least the selection of butadiene (within the more generic original disclosure of conjugated diene) and inorganic fillers (within both alternatives of organic and inorganic fillers) leads to a particular combination of features being now defined in operative claim 1 which, in the Board's view, was not originally disclosed as such in the application as filed.

2.11.3 For these reasons, the appellant's argument cannot be followed.

2.12 In the absence of any pointers to the combination of features according to amendments (ii), (iii) and (iv) defined above, it cannot be concluded that the subject-matter of operative claim 1 is directly and unambiguously disclosed in the application as filed.

2.13 For these reasons, claim 1 of auxiliary request 1 does not meet the requirements of Article 123(2) EPC. For that reason, auxiliary request 1 is not allowable.

2.14 Since claim 1 of auxiliary request 1a is identical to claim 1 of auxiliary request 1, it can only share the

same fate.

3. Article 84 EPC

3.1 The respondent argued that claim 1 of auxiliary request 1 did not meet the requirement of Article 84 EPC in view of the introduction of the term "consisting of" (rejoinder to the statement of grounds of appeal: page 9, second paragraph).

3.1.1 In that respect, the respondent's objection can only be directed to the presence of that term in the expression contained in operative claim 1 "a resin composition consisting of". Indeed, it was not disputed that said term was not present in the granted claims so that it may be examined whether it introduces non-compliance with Article 84 EPC (G 3/14, OJ EPO 2015, 102). However, said objection cannot be directed to the presence of the same term in the expression "a block copolymer consisting of a vinyl aromatic hydrocarbon", which is already present in claim 1 as granted.

3.1.2 The term "consisting of" has an accepted and unambiguous meaning which excludes anything else than what is explicitly specified (Case Law, *supra*, II.A.6.2, first paragraph, in which it is indicated that the term "consisting of" has an unequivocal character). Therefore, there is no room for interpretation for the subject-matter being therewith defined, i.e. the resin composition being claimed can at most contain components (a) to (c) as defined therein, any other components being excluded.

3.1.3 In that respect, the decision of the opposition division that claim 1 of the then operative third and fourth auxiliary requests lacked clarity in view of the

introduction of the term "consisting of" to define the resin composition was reached considering that the content of the description of the patent in suit (example 2; use of an initiator in addition to the monomers to prepare the block copolymer(s)) cast doubt on the definition of the wording "consisting of" (decision under appeal: bottom of page 12).

However, the fact that example 2 of the patent in suit may not be a block copolymer as defined in operative claim 1 or that an initiator may be present in the copolymers prepared in the patent in suit (rejoinder to the statement of grounds of appeal: bottom of page 9) provides no cause to interpret the operative claims in a different manner than what their otherwise unambiguous wording defines (Case Law, *supra*, II.A.6.3.1, last two paragraphs). Therefore, the argument is rejected.

3.1.4 For these reasons, the objection is rejected.

3.2 The respondent further considered that in the absence of any indication regarding the definition of the different types of block copolymers in operative claim 1, the wording "consisting of at least one type of block copolymers consisting of ... as a conjugated diene" also led to a lack of clarity (rejoinder to the statement of grounds of appeal: page 9, first paragraph).

However, considering the appellant's arguments (statement of grounds of appeal: end of section 5.2), the wording "consisting of at least one type of block copolymers" may be understood as meaning that the resin composition may comprise different block copolymers, wherein the blocks are prepared from the same monomers

but differ e.g. in terms of their composition or sequence distribution of the blocks. It was not contested that this made sense from a technical point of view. Therefore, the respondent's objection is not convincing.

- 3.2.1 In view of the above, the respondent's objections pursuant to Article 84 EPC raised against claim 1 of auxiliary request 1 are rejected.

Auxiliary requests 2 and 2a - Article 123(2) EPC and Article 84 EPC

4. Claim 1 of each auxiliary requests 2 and 2a is directed to a specific use of a resin composition according to claim 1 of auxiliary request 1 and contains therefore the same combination of technical features. Therefore, the same conclusions regarding Article 123(2) EPC and Article 84 EPC are bound to be reached for claim 1 of both auxiliary requests 2 and 2a as for claim 1 of auxiliary request 1. Therefore, auxiliary requests 2 and 2a are not allowable because they do not meet the requirements of Article 123(2) EPC for the same reasons as claim 1 of auxiliary request 1.

Auxiliary request 3 - Article 123(2) EPC and Article 84 EPC

5. At the oral proceedings before the Board (see minutes: bottom of page 3), the respondent indicated that, regarding auxiliary request 3, they had no objections pursuant to Article 123(2) EPC and that the sole objection pursuant to Article 84 EPC was the one directed to the introduction of the term "consisting of" in claim 1, which had been already raised against claim 1 of auxiliary request 1 but was rejected by the

Board (section 3.1). Under these circumstances and in view of the appellant's requests, it remains to be decided if the case is to be remitted to the opposition division for further prosecution.

6. Remittal

6.1 The appellant requested that the case be remitted to the opposition division for further prosecution in order to deal with the grounds for opposition which had not been decided upon in the decision under appeal, which was agreed to by the respondent during the oral proceedings before the Board (see minutes of the oral proceedings: page 3, last line).

6.2 In that respect, the grounds for opposition regarding sufficiency of disclosure, novelty and inventive step, which were put forward by the opponent, were not addressed in the decision under appeal. Considering that these circumstances amount to special reasons in the sense of Article 11 RPBA 2020 and in view of the primary object of the appeal proceedings to review the decision under appeal in a judicial manner (as indicated in Article 12(2) RPBA 2020), the Board finds it appropriate to remit the case to the department of first instance for further prosecution (Article 111(1) EPC).

Order

For these reasons it is decided that:

1. The decision under appeal is set aside.
2. The case is remitted to the opposition division for further prosecution.

The Registrar:

The Chairman:



B. ter Heijden

D. Marquis

Decision electronically authenticated