Internal distribution code:

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

Datasheet for the decision of 22 June 2021

Case Number: T 0847/20 - 3.3.03

Application Number: 12720357.8

Publication Number: 2705073

IPC: C08G77/26, C08G77/388, C08L83/08, G02B1/04

Language of the proceedings: EN

Title of invention:
MACROINITIATOR CONTAINING HYDROPHOBIC SEGMENT

Patent Proprietor:
Toray Industries, Inc.

Opponent:
Novartis AG

Relevant legal provisions:
EPC Art. 123(2)
RPBA 2020 Art. 12(6) sentence 1, 12(6) sentence 2, 13(2)

Keyword:

Amendments - allowable (no)
Late filed requests - should have been submitted in first-instance proceedings (yes) - circumstances of appeal case justify admittance (no)
Late-filed objection - admitted (no)
Late-filed request - admitted in first-instance proceedings (no) - admitted (yes)

Decisions cited:

G 0002/10, T 2324/14, T 2026/15

Europäisches Patentamt
European Patent Office
Office européen des brevets

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 0847/20 - 3.3.03

D E C I S I O N
of Technical Board of Appeal 3.3.03
of 22 June 2021

Appellant: (Patent Proprietor)	Toray Industries, Inc. 1-1, Nihonbashi-Muromachi 2-chome Chuo-ku Tokyo, 103-8666 (JP)
Representative:	Mewburn Ellis LLP Aurora Building Counterslip Bristol BS1 6BX (GB)
Respondent: (Opponent)	Novartis AG Lichtstrasse 35 4065 Basel (CH)
Representative:	Breuer, Markus Brienner Straße 1 80333 München (DE)
Decision under appeal:	**Decision of the Opposition Division of the European Patent Office posted on 10 February 2020 revoking European patent No. 2705073 pursuant to Article 101(3)(b) EPC.**

Composition of the Board:

Chairman	D. Semino
Members:	M. Barrère
	C. Brandt

Summary of Facts and Submissions

I. The appeal by the patent proprietor lies against the decision of the opposition division posted on 10 February 2020 revoking European patent No. 2 705 073.

II. A notice of opposition had been filed against the patent, requesting the revocation of the patent in its entirety.

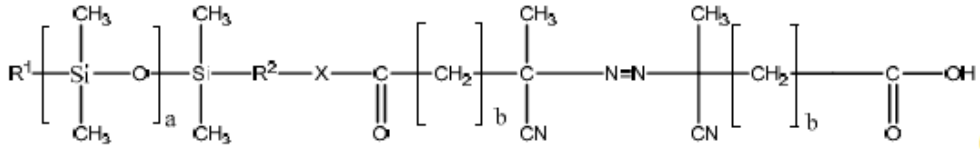
III. The contested decision was based on:

- a main request and auxiliary requests 1-34 as filed with letter of 1 March 2019,

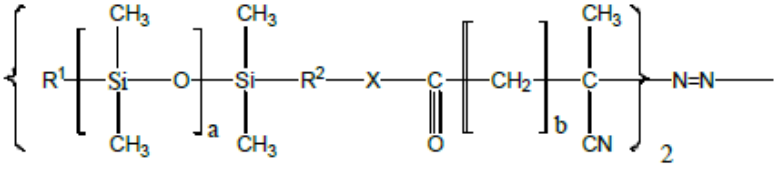
- auxiliary requests 1A and 1B filed during oral proceedings.

IV. Claims 1 and 2 of the patentee's main request read as follows:

"1. A macro initiator comprising one or two hydrophobic segments in a molecule, wherein a molecular weight of the hydrophobic segments is 400 to 1500, wherein the hydrophobic segment is a segment made from polysiloxane, and wherein the macro initiator is expressed by formula (a0) or (a1):



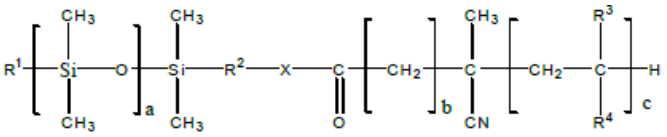
(a0)



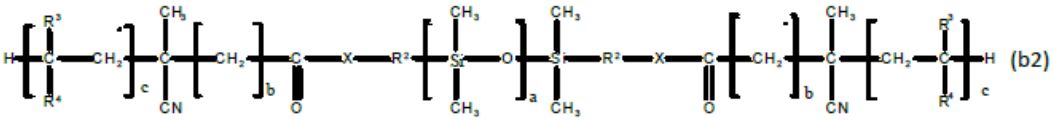
(a1)

(wherein in (a0) and (a1),
R^1 is one type of group selected from an alkyl group or an alkoxy group;
R^2 is one type of group selected from $(CH_2)_n$ and $(CH_2)_m-O(CH_2)_n$;
m is from 1 to 16; n is from 2 to 5; a is from 4 to 19; b is from 1 to 6, and X is one type of group selected from O, NH, and S)."

"2. A block copolymer comprising one hydrophobic segment and one hydrophilic segment, wherein a molecular weight of the hydrophobic segment is 400 to 1500, wherein the hydrophobic segment is a segment made from polysiloxane, wherein the block copolymer is expressed by formula (b1) or (b2).
Formula:



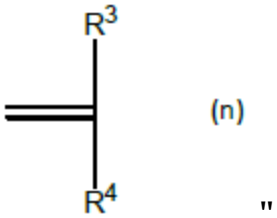
(b1)



(b2)

(wherein in (b1) and (b2),
R^1 is one type of group selected from an alkyl group or an alkoxy group;

R^2 is one type of group selected from $(CH_2)_n$ and $(CH_2)_m$ $-O(CH_2)_n$;
m and n are independent, ranging from 1 to 16; a is from 4 to 19; b is from 1 to 6, c is from 1 to 10,000, X is one type of group selected from O, NH, and S; and R^3 and R^4 represent groups made of monomers with hydrophilicity wherein a monomer is expressed by general formula (n)).



"

The remaining claims of that request are not relevant to the present decision.

V. The following document was *inter alia* cited in the decision under appeal:

Declaration of Mr. Nakamura (inventor) dated 27 February 2019 (filed with letter of 1 March 2019)

VI. In that decision the opposition division held in summary that:

- The main request did not comply with Article 123(2) EPC;

- Auxiliary requests 1A and 1B were not admitted into the proceedings;

- Auxiliary requests 1 and 2-34 did not comply with Article 123(2) EPC.

Therefore, the patent was revoked.

VII. The patent proprietor (appellant) appealed the above decision. With the statement setting out the grounds of appeal the appellant requested that the contested decision be set aside and that the case be remitted to the opposition division for further prosecution in respect of the opponent's attacks under Article 100(a) and 100(b) EPC on the basis of the main request (MR) or auxiliary requests 1-42 (AR1-AR42) all filed with the statement of grounds of appeal.

The following table was inserted by the patent proprietor in the statement of grounds to provide concordance with the requests on file before the department of first instance (no request was indicated in the second column for new requests in appeal):

New ID: Appeal	**Old ID: Opposition**
MR	MR
AR1	-
AR2	AR7
AR3	AR1A
AR4	AR1B
AR5	-
AR6	AR5
AR7	-
AR8	AR20
AR9	-
AR10	-
AR11	-
AR12	AR1
AR13	AR2
AR14	AR3

AR15	AR4
AR16	AR6
AR17	AR8
AR18	AR9
AR19	AR10
AR20	AR11
AR21	AR12
AR22	AR13
AR23	AR14
AR24	AR15
AR25	AR16
AR26	AR17
AR27	AR18
AR28	AR19
AR29	AR21
AR30	AR22
AR31	AR23
AR32	AR24
AR33	AR25
AR34	AR26
AR35	AR27
AR36	AR28
AR37	AR29
AR38	AR30
AR39	AR31
AR40	AR32
AR41	AR33
AR42	AR34

In auxiliary request 1 claims 1 and 2 were amended with respect to the main request by adding the expression "wherein the hydrophobic segment is formed from reaction of a reactive polysiloxane".

In auxiliary request 2 claims 1 and 2 were amended with respect to the main request by adding the expression "wherein the macro initiator is formed by reacting a reactive linear polysiloxane having a functional group on at least one terminus with an azo-type initiator having a carboxy group".

In auxiliary request 3 claims 1 and 2 were amended with respect to the main request in that the hydrophobic segment was defined as being "a segment made from a reactive linear polysiloxane having a functional group selected from a hydroxyl group, and amino group, and a thiol group on at least one terminus, the macro initiator being formed by reacting the reactive linear polysiloxane with an azo-type initiator having a carboxy group".

In auxiliary request 4 claim 1 was deleted and claim 2 was amended with respect to the main request in that the hydrophobic segment was defined as "a polysiloxane segment", the polysiloxane segment was defined as being "a segment made from a reactive linear polysiloxane having a functional group selected from a hydroxyl group, and amino group, and a thiol group on at least one terminus, the reactive linear polysiloxane being reacted with an azo-type initiator having a carboxy group to form a hydrophobic segment containing macroinitiator" and the expression "the hydrophobic segment containing macroinitiator being reacted with at least one hydrophilic monomer to form the block copolymer" was added.

In auxiliary request 5 claims 1 and 2 were amended with respect to the main request in that the hydrophobic segment was defined as being "a segment made from a

reactive linear polysiloxane expressed by the formula (p0), (p1) or (p2)", the formula being defined in the claims, and the expression "the macro initiator being formed by reacting the reactive linear polysiloxane with an azo-type initiator having a carboxy group" was added at the end of the claim.

Auxiliary request 6 included amendments indicated by the appellant to be related to an added matter issue with respect to formula (b2), which amendments are not relevant to the present decision.

Auxiliary requests 7-11 included the amendments in auxiliary requests 1-5 respectively together with further amendments which the appellant indicated to be related to an added matter issue with respect to formula (b2), which further amendments are not relevant to the present decision.

Auxiliary request 12-42 included amendments indicated by the appellant to be related to grounds under Article 100(a) and (b) EPC, which amendments are not relevant to the present decision.

VIII. In the rejoinder, the opponent (respondent) requested that the appeal be dismissed. The respondent further requested that the newly filed auxiliary requests 1, 5, 7 and 9-11 as well as re-filed auxiliary requests 3 and 4, which correspond to requests not admitted by the opposition division, not be admitted into the proceedings.

IX. By letter of 28 January 2021, the parties were summoned to oral proceedings to be held on 22 June 2021.

X. By letter of 29 April 2021 the appellant made further submissions and filed new auxiliary requests 5 and 11 to replace the corresponding requests on file.

XI. The board specified issues to be discussed at the oral proceedings in a communication dated 4 May 2021.

XII. With letter of 16 June 2021 the appellant made a further written submission.

XIII. With the explicit agreement of both parties, oral proceedings were held before the Board on 22 June 2021 by video conference.

During oral proceedings, the respondent further requested that auxiliary request 2 be not admitted into the proceedings.

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

(a) Main request

(i) Article 123(2) EPC - Basis for the molecular weight range in claim 1

The molecular weight range of the hydrophobic segment ("400 to 1500") found basis on page 5, penultimate paragraph of the description as filed. Although said passage referred to the reactive linear polysiloxane (RLP), it was clear from the application as a whole that the molecular weight of the hydrophobic segment was identical to the molecular weight of the RLP.

In particular the application as filed provided a synthetic definition of the hydrophobic segment

according to which the hydrophobic segment was formed "by reacting a reactive linear polysiloxane ... with an azo-type initiator" (see application as filed, page 5, first paragraph). Thus the skilled person would glean from the specification that (i) there is a direct link between the hydrophobic segment and the polysiloxane, and furthermore that (ii) the nature of the direct link is that RLP is the source of the polysiloxane. It would follow from this that the expression "wherein the hydrophobic segment is a segment made from polysiloxane" (as recited in claims 1-2 of the main request) would be understood by the skilled person to mean that the hydrophobic segment is synonymous with the RLP. This was furthermore confirmed by the examples of the application as filed wherein the molecular weight of the RLP (see example 1) and the molecular weight of the polysiloxane segment (see table 3) were identical. This understanding of the application as filed was corroborated by the declaration of Mr. Nakamura as inventor and skilled person in the present technical field.

Furthermore, the assessment of added matter should be a forward looking holistic assessment, wherein the skilled person, in the light of their common general knowledge and with a mind willing to understand, would start with the application as filed and would examine, looking at the explicit and implicit content of the application as a whole, whether any new technical information has been added in the granted patent. This was not what the opposition division did, rather they undertook a backward looking literal assessment.

Applying the technical and legal framework set out in the preceding paragraphs to the feature in question, the opposition division would have found that the

molecular weight feature did not add matter because it flowed naturally from the skilled person's understanding of the chemistry and of the disclosure of the application as filed. In particular, recognising the synthetic definition, the skilled person understood that the molecular weight of the hydrophobic segment was synonymous with the molecular weight of the RLP. Specifically, the explicit recitation of the RLP having a molecular weight of 400 to 1500 implicitly conveyed to the skilled person the information that the hydrophobic segment had a molecular weight of 400 to 1500. In view of this the skilled person was not presented with new technical information as a result of the amendment.

Furthermore, also the preliminary opinion of the Board did not apply the above holistic assessment, rather they undertook a narrow reading of isolated parts of the application. In reply to the question whether the RLP was entirely hydrophobic, the appellant considered that the RLP could include some hydrophilic parts, as long as it was hydrophobic overall. With regard to the leaving group of the RLP, the appellant argued that there would not be any support in the application as filed for a leaving group other than hydrogen. Besides, the skilled person’s unimaginative understanding would not extend to higher molecular weight leaving groups. Furthermore, the change of 1 Da between the molecular weight of the RLP and the molecular weight (due to the loss of one hydrogen) would be *de minimis* in the context of polymer chemistry, where the molecular weights at issue are several orders of magnitude higher. This would be confirmed by the examples of the application as filed wherein the molecular weight of the RLP and the molecular weight of the polysiloxane segment are indicated as identical (see example 1 and

table 3). In connection to the question whether the azo-initiator could contribute to the molecular weight of the hydrophobic segment, the appellant took the view that the skilled person would understand from the application as a whole that the hydrophobic segment corresponded to the section derived from the RLP and did not include any part of the azo-type initiator.

(b) Auxiliary requests 1, 5, 7 and 11

(i) Admittance into the proceedings

These requests were responsive to and sought to address the reasoning of the opposition division given in their written decision. It would therefore not have been possible to file the requests earlier. This was all the more relevant given the "change in the subject matter of proceedings" caused by the divergence of the opposition division from their preliminary opinion at oral proceedings. Furthermore, the amendments in the said requests served to explicitly recite the relationship between the hydrophobic segment and the RLP. Accordingly, auxiliary requests 1, 5, 7 and 11 should be admitted into the proceedings.

(c) Auxiliary request 2

(i) Admittance into the proceedings

Auxiliary request 2 corresponded to auxiliary request 7 filed in response to the notice of opposition and dealt with in the contested decision. In addition to original auxiliary request 7, granted claims 2 and 7 were amended as per claim 1. The amendments in said request served to explicitly recite the relationship between

the hydrophobic segment and the RLP. On that basis, the request should be admitted into the proceedings.

(ii) Article 123(2) EPC - Basis for the molecular weight range in claim 1

The new feature of claim 1 provided a link between the RLP and the hydrophobic segment. Consequently, it was clear for the skilled person that the parts contributing to the molecular weight of the hydrophobic segment are those which are derived from the RLP. As a result the hydrophobic segment and the RLP were clearly synonymous and the requirements of Article 123(2) EPC were met.

(d) Auxiliary requests 3-4

(i) Admittance into the proceedings

The opposition division did not assess the relevance of auxiliary requests 3-4 (corresponding to auxiliary requests 1A and 1B of the opposition proceedings) on a *prima facie* basis but undertook a full examination. On that basis the requests were *de facto* admitted into the proceedings. Furthermore the departure of the opposition division from their preliminary opinion (which was in favour of the main request with respect to added matter) meant that auxiliary requests 3-4 ought to have been admitted on the grounds that the subject of the proceedings has changed.

(ii) Article 123(2) EPC - Basis for the molecular weight range in claim 1

Auxiliary requests 3-4 reflected more closely the language of the description. Claim 1 of said requests

specified the identity of the RLP. Furthermore, the claim specified that the RLP reacts with an azo-type initiator having a carboxy group. This would emphasise that the azo-type initiator does not contribute to the molecular weight of the hydrophobic segment. As a result, the molecular weights of the hydrophobic segment and of the RLP were identical and the requirements of Article 123(2) EPC were met.

(e) Auxiliary requests 6, 8-10 and 12-42

(i) Article 123(2) EPC - Basis for the molecular weight range in claim 1

Auxiliary requests 6 and 8-10 were filed to address a separate added matter issue to the above requests, concerning formula (b2) in claim 2. Likewise auxiliary requests 12-42 were filed as part of the appellant's defence to the attacks under Article 100(a) and 100(b) EPC. Nonetheless, the arguments brought forward with respect to the main request and auxiliary requests 2-4 equally applied to auxiliary requests 6, 8-10 and 12-42.

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

(a) Main request

(i) Article 123(2) EPC - Basis for the molecular weight range in claim 1

No clear and unambiguous basis was present in the application as filed for a molecular weight range of the hydrophobic segment of "400 and 1500". Said range

appeared only once in the original application, namely in the context of the molecular weight of a RLP (see page 5). Contrary to the appellant's view, the "hydrophobic segment" and the RLP were not synonymous in the application as filed. Page 5 of the original description only related to the reactants needed to obtain the hydrophobic-containing macroinitiator (and more specifically to the RLP) while claim 1 of the main request (as well as page 8 of the application as filed) pertained to the structure of the macroinitiator. There was no direct correspondence between the structure of the macroinitiator and the RLP. Even the examples did not provide a basis for the contested amendment since the molecular weight of the hydrophobic segment was not mentioned (but only the molecular weight of a silicone portion). Furthermore, claim 1 of the main request did not reflect that a RLP is used and was not limited to a specific chemistry. Finally, the molecular weights of the RLP and of the hydrophobic segment could not be seen as identical at least in view of the leaving group of the RLP (reducing the molecular weight of the hydrophobic segment by at least 1 Da compared to the molecular weight of the RLP).

(b) Auxiliary requests 1, 5, 7 and 11

(i) Admittance into the proceedings

No explanation or proper justification was given as to why these requests were filed only at the appeal stage. Furthermore, they were not *prima facie* allowable. In fact, they gave rise to additional objections under Articles 84 and 123(2) EPC. Accordingly, auxiliary requests 1, 5, 7 and 11 should not be admitted into the proceedings.

(c) Auxiliary request 2

(i) Admittance into the proceedings

Auxiliary request 2 was not identical to auxiliary request 7 of the opposition proceedings and was therefore to be considered as a new request filed for the first time with the statement of grounds of appeal. The amendments of claim 2 of auxiliary request 2 raised new issues. Auxiliary request 2 should therefore not be admitted into the proceedings.

(ii) Article 123(2) EPC - Basis for the molecular weight range in claim 1

The added matter objections with regard to the main request were not addressed in auxiliary request 2. The new feature of claim 1 did not remove the deficiency of the main request. In particular the molecular weights of the hydrophobic segment and of the RLP remained different so that the requirements of Article 123(2) EPC were still not met.

(d) Auxiliary requests 3-4

(i) Admittance into the proceedings

The amendments made in auxiliary requests 3-4 were not suitable to overcome the added matter objections. Furthermore the appellant's reference to a change of the subject of the proceedings during the oral proceedings in opposition was not correct. The added matter objections had already been raised earlier during opposition proceedings. Consequently the decision of the opposition division not to admit these

requests into the proceedings was correct and should be maintained.

(ii) Article 123(2) EPC - Basis for the molecular weight range in claim 1

The added matter objections with regard to the main request were not addressed in auxiliary requests 3-4. The new features of claim 1 did not remove the deficiency of the main request. In particular the molecular weights of the hydrophobic segment and of the RLP remained different so that the same conclusion applied.

(e) Auxiliary requests 6, 8-10 and 12-42

(i) Article 123(2) EPC - Basis for the molecular weight range in claim 1

The arguments brought forward with respect to the main request and auxiliary requests 2-4 equally applied to auxiliary requests 6, 8-10 and 12-42.

XVI. The appellant requested that the decision under appeal be set aside and that the case be remitted to the opposition division for further prosecution on the basis of the main request or any of auxiliary requests 1-42, whereby the main request and auxiliary requests 1-4, 6-10 and 12-42 were filed with the statement of grounds of appeal and auxiliary requests 5 and 11 were filed with the letter of 29 April 2021.

XVII. The respondent requested that the appeal be dismissed. The respondent further requested that the newly filed auxiliary requests 1, 2, 5, 7 and 9-11 as well as re-filed auxiliary requests 3 and 4, which correspond to

requests not admitted by the opposition division, not be admitted into the proceedings. Should the Board come to the conclusion that a request fulfils the requirements of Articles 84 and 123(2) EPC, the respondent requested that the case be remitted to the department of first instance for further prosecution.

Reasons for the Decision

1. Main request

1.1 Basis for the molecular weight range in claim 1 (Article 123(2) EPC)

Claim 1 of the main request includes the limitation that the molecular weight of the hydrophobic segment is in the range of "400 to 1500"•

In the contested decision the opposition division took the view that the range of 400-1500 is only disclosed in relation to the RLP but not with respect to the hydrophobic segment.

According to the appellant, the explicit recitation of the RLP having a molecular weight of 400 to 1500 implicitly conveyed to the skilled person the information that the hydrophobic segment has a molecular weight of 400 to 1500. In particular the person skilled in the art would understand from the application as a whole that the hydrophobic segment is synonymous with RLP and therefore the range of molecular weight disclosed for the RLP is equally valid for the hydrophobic segment.

Claim 1 as filed specifies that the molecular weight of the hydrophobic segment is 300 to 1800. The only disclosure of a molecular weight range of 400 to 1500 in the application as filed is on page 5, penultimate paragraph, which reads:

> *"The molecular weight of the reactive linear polysiloxane is between about 300 to about 1800, and in some embodiments between about 400 to about 1500, about 500 to about 1500, and between about 800 to about 1200."*

Thus the range of 400 to 1500 is explicitly connected to the RLP and not to the hydrophobic segment.

Therefore the main question to be answered by the Board is whether the alleged fact that the RLP and hydrophobic segment are synonymous (so that their molecular weight are the same) is, explicitly or implicitly, directly and unambiguously derivable by the skilled person using common general knowledge relative to the date of filing from the application as filed ("Gold standard", G 2/10, OJ 2012, 376).

The Board is not convinced that the person skilled in the art would conclude that the RLP and the hydrophobic segment are clearly and unambiguously synonymous for the following reasons:

(a) First, as pointed out by the respondent, the RLP is only disclosed in the application as filed in the context of the preparation of the hydrophobic-containing macroinitiator (see pages 5-7 of the application as filed), however there is no clear and unambiguous link between the RLP and the structure of the macroinitiator, let alone the hydrophobic segment. While it can be understood from the application as a whole that the

hydrophobic-containing macroinitiator is derived or made from the RLP, it cannot be concluded that the RLP is synonymous or identical to the hydrophobic segment. Contrary to the appellant's view, the examples do not remedy this lack of support, because they only mention the molecular weight of the RLP and of the "silicone portion" (see Table 3) and not the molecular weight of a "hydrophobic segment". Even the embodiment on page 4, lines 2-3 according to which "the hydrophobic segment of the block copolymer is a polysiloxane segment" does not necessary imply that the hydrophobic segment (or in that embodiment the polysiloxane segment) is identical to the RLP.

(b) Secondly, as mentioned in the preliminary opinion of the Board, the chemistry involved in the reaction between the RLP and the azo-initiator as well as the structure of the RLP itself (see page 5 of the application as filed), leads to the conclusion that the molecular weight of the RLP and the molecular weight of the "hydrophobic segment" cannot be identical. In particular, it was not contested by the parties that the RLP looses at least one hydrogen atom by reacting with the azo-type initiator.

Furthermore, there is no indication in the application as filed that the reactive linear polysiloxane must be entirely hydrophobic. In fact, a possible structure of the RLP encompasses groups which are hydrophilic, for instance the group R^{11} which may be substituted (see application as filed, page 5, third and fourth paragraph). According to the appellant, while hydrophilic parts may be present, the RLP is nevertheless hydrophobic

overall (see letter of 16 June 2021, point 12). The Board cannot follow this reasoning. It is clearly mentioned in the application as filed that the macroinitiator contains one or two hydrophobic segments (see original claim 1), which means for the skilled person that further segments and in particular hydrophilic segments or parts may be present.

Finally, the reactive segment of the azo-type initiator being possibly hydrophobic, the person skilled in the art would also have to consider its molecular weight in order to determine the molecular weight of the hydrophobic segment. The appellant held that this argument finds no support in the application as filed and that the part derived from the azo-initiator is not hydrophobic (see letter of 16 June 2021, point 13). The Board cannot concur with the appellant on this point. Admittedly, the application as filed does not mention whether the azo-initiator is hydrophobic or not. However, the same applies to the RLP as pointed out previously. In that case the person skilled in the art whishing to determine the molecular weight of the hydrophobic segment has no other choice but to add the molecular weight of the hydrophobic part of the RLP to the molecular weight of the hydrophobic part of the azo-initiator.

In conclusion the molecular weight of the hydrophobic segment cannot be considered to be clearly and unambiguously disclosed as being identical to the molecular weight of the RLP.

(c) Thirdly, although the board carefully considered the declaration made by the inventor (Mr.

Nakamura), it cannot come to a different conclusion for the above reasons. The board can only rely on this declaration insofar as it can help to shape the understanding of the "person skilled the art" at the filing date. However, the inventor is not the same as the "person skilled the art" who is a conceptual skilled practitioner in the relevant field of technology and who is in possession of average knowledge and ability and is aware of what was common general knowledge in the art at the relevant date (see Case Law of the Boards of Appeal, 9th edition 2019, I.D.8.1.1) and the assessment of the amendments in view of Article 123(2) EPC must be based primarily on the application as filed.

For these reasons, the board comes to the conclusion that the application as filed does not clearly and unambiguously disclose that the "RLP" and the "hydrophobic segment" are identical or synonymous. In particular this conclusion is reached by application of the so-called "Gold standard" as indicated above and not by making use of a different approach not in conformity with the case law. Consequently no support for a molecular weight range of the hydrophobic segment of 400-1500 can be found in the original application contrary to the requirements of Article 123(2) EPC.

2. Auxiliary requests 1, 5, 7 and 11

2.1 Admittance

The admittance into the appeal proceedings of new auxiliary requests filed for the first time during appeal proceedings is subject to the stipulations of Article 12(6), second sentence, RPBA 2020.

Specifically, the Board shall not admit requests which should have been submitted in the proceedings leading to the decision, unless the circumstances of the appeal case justify their admittance.

In the present case, the appellant filed auxiliary requests 1 and 5 during appeal proceedings (and similarly auxiliary requests 7 and 11 including *inter alia* the same amendments as in auxiliary requests 1 and 5 respectively) in order to address the reasoning of the opposition division given in their written decision and in particular the finding according to which the application as filed would not disclose a hydrophobic segment having a molecular weight in the range of 400-1500.

However, the Board notes that the objection on which the decision is based was present in the notice of opposition (see paragraph 4.2). Although the opinion of the opposition division changed in the course of the proceedings, the appellant had several opportunities to address this objection by filing new requests (at the latest during oral proceedings when several further requests were filed to address this objection). Furthermore the Board cannot recognize any valid reason that would justify the filing of further requests to address this very same issue at the appeal stage. The general explanation that the appellant sought to address the reasoning of the opposition division is not considered to be specific enough to justify the admittance of the requests at appeal stage (otherwise any new request should be admitted on this ground). The board therefore concludes that auxiliary requests 1, 5, 7 and 11 should have been filed in the proceedings leading to the decision and does not find any circumstances which justify their admittance.

Consequently the Board finds it appropriate to exercise its discretion by not admitting auxiliary requests 1, 5, 7 and 11 into the proceedings (Article 12(6), second sentence, RPBA 2020).

3. Auxiliary request 2

3.1 Admittance

Auxiliary request 2 was submitted with the statement of grounds of appeal. The admittance of this request into the proceedings was not challenged by the respondent in their reply to the statement of grounds of appeal and it was not an issue that was raised by the Board in their preliminary opinion on the case either. It is only during oral proceedings that the respondent requested the non-admittance of auxiliary request 2.

In particular the respondent submitted that auxiliary request 2 was a new request having no counterpart in the opposition proceedings and that the amendments raised new issues.

The Board notes that the appellant had made clear from the beginning of the appeal proceedings that auxiliary request 2 was formally a new request (see statement of grounds of appeal, page 22, second paragraph) by specifying that it corresponded to auxiliary request 7 in opposition in which additionally the same amendments introduced in claim 1 had been inserted in claims 2 and 7. This situation did not change in the course of the appeal proceedings.

Consequently, the objection against its admittance should have been raised with the rejoinder of

respondent and not at the latest possible point in time of the appeal proceedings.

In the absence of valid reasons to raise this objection during oral proceedings, the Board finds it appropriate to exercise its discretion under Article 13(2) RPBA 2020 by not admitting the present objection into the proceedings.

Auxiliary request 2 is therefore part of the appeal proceedings.

3.2 Basis for the molecular weight range in claim 1 (Article 123(2) EPC)

Claim 1 of auxiliary request 2 corresponds to claim 1 of the main request with the following additional feature:

> "wherein the macro initiator is formed by reacting a reactive linear polysiloxane having a functional group on at least one terminus with an azo-type initiator having a carboxy group"

According to the appellant, the new feature of claim 1 provides a link between the RLP and the hydrophobic segment. Consequently, it would be clear for the skilled person that the parts contributing to the molecular weight of the hydrophobic segment are those which are derived from the RLP. As a result the hydrophobic segment and the RLP are synonymous.

The Board cannot follow this interpretation of claim 1. The new feature of claim 1 merely specifies that the macro initiator is derived from the RLP, however no direct link between the hydrophobic segment and the RLP

can be identified leading to an identity of their molecular weight. Consequently the amendments of claim 1 are not suitable to overcome the deficiency of the main request and the same reasons hold (see point 1.1 of the decision).

Therefore auxiliary request 2 does not comply with Article 123(2) EPC.

4. Auxiliary requests 3-4

4.1 Admittance

Auxiliary requests 3-4 correspond to auxiliary requests 1A-1B filed during the oral proceedings before the opposition division. Said requests were not admitted into the opposition proceedings in view of their late filing and the fact that they did not comply with Article 123(2) EPC.

The admittance into the appeal proceedings of auxiliary requests not admitted by the opposition division is governed by Article 12(6), first sentence, RPBA 2020. Specifically the Board shall not admit requests which were not admitted in the proceedings leading to the decision under appeal, unless the decision not to admit them suffered from an error in the use of discretion or unless the circumstances of the appeal case justify their admittance.

In this respect the Board notes that the opposition division has conducted a complete examination of the allowability of auxiliary requests 1A and 1B under Article 123(2) EPC before concluding that said requests shall not be admitted (see decision, reasons 2.4-2.5 and 3.3-3.4). The opposition division has therefore not

carried out a *prima facie* assessment but has fully considered the requests. By doing so, the opposition division has implicitly admitted the requests. Consequently, the Board takes the view that the opposition division wrongly exercised its discretion because, having implicitly admitted the requests, there was no discretion left not to admit them (reference is made to similar cases: T 2026/15 of 17 April 2018, reasons 2.4-2.5 and T 2324/14 of 4 October 2017, reasons 2.4-2.6).

Thus auxiliary requests 3-4 are admitted into the proceedings, since they were *de facto* fully considered (and therefore implicitly admitted) by the opposition division.

4.2 Basis for the molecular weight range in claim 1 of auxiliary request 3 (Article 123(2) EPC)

Claim 1 of auxiliary request 3 corresponds to claim 1 of the main request with the following amendment:

> "wherein the hydrophobic segment is a segment made from a reactive linear polysiloxane having a functional group selected from a hydroxyl group, amino group or a thiol group on at least one terminus, the macro initiator being formed by reacting the reactive linear polysiloxane with an azo-type initiator having a carboxy group" (the new features being underlined)

According to the appellant, the claim more closely specifies the identity of the RLP. Furthermore, the claim specifies that the RLP reacts with an azo-type initiator having a carboxy group. This would emphasise that the azo-type initiator does not contribute to the molecular weight of the hydrophobic segment. As a

result, the molecular weight of the hydrophobic segment and the RLP would be synonymous.

The Board cannot follow this interpretation of claim 1 of auxiliary request 3. The use of the wording "made from" is not suitable to indicate that the RLP and the hydrophobic segment are identical or synonymous. In fact, the new features of claim 1 merely specify that the macro initiator is derived from the RLP, however no clear and unambiguous link between the hydrophobic segment and the RLP can be identified, let alone that the two are the same. Consequently the amendments of claim 1 are not suitable to overcome the deficiency of the main request and the same reasons hold (see point 1.1 of the decision).

Therefore auxiliary request 3 does not comply with Article 123(2) EPC.

4.3 Basis for the molecular weight range in claim 1 of auxiliary request 4 (Article 123(2) EPC)

Claim 1 of auxiliary request 4 corresponds to claim 2 of the main request with the following amendments:

"the hydrophobic segment is a polysiloxane segment, wherein the polysiloxane segment is a segment made from a reactive linear polysiloxane having a functional group selected from a hydroxyl group, an amino group, and a thiol group on at least one terminus, the reactive linear polysiloxane being reacted with an azo-type initiator having a carboxy group to form a hydrophobic segment containing macroinitiator, the hydrophobic segment containing macroinitiator being reacted with at least one hydrophilic monomer to form the block copolymer"
(the new additions being underlined)

According to the appellant, auxiliary request 4 amends the claims to more closely reflect the language of the description. Compared to auxiliary request 3, the hydrophobic segment is no longer "simply made from an RLP", but is defined as a polysiloxane segment. The polysiloxane segment acts as a bridge between the hydrophobic segment and synthesis from RLP. This eliminates any potential (perceived) ambiguity, as the claim itself now leads the reader through the synthetic definition of the hydrophobic segment set out in the description. The skilled person would therefore understand that the part contributing to the hydrophobic segment's molecular weight is the part derived from the RLP.

The Board cannot follow this line of arguments for the following reasons. Present claim 1 still uses the wording "made from" to characterise the relation between the hydrophobic polysiloxane segment and the RLP. As pointed out previously, this wording is not suitable to indicate that the RLP and the hydrophobic segment are identical or synonymous (see point 4.2 of the decision). Furthermore the additional feature of claim 1 of auxiliary request 4 according to which the "hydrophobic segment is a polysiloxane segment" does not necessary imply that the hydrophobic segment is the RLP. Consequently the amendments of claim 1 are not suitable to overcome the deficiency of the main request and the same reasons hold (see point 1.1 of the decision).

Therefore auxiliary request 4 does not comply with Article 123(2) EPC.

5. Auxiliary requests 6, 8-10 and 12-42

5.1 Basis for the molecular weight range in claim 1 (Article 123(2) EPC)

Auxiliary requests 6 and 8-10 were filed to address a separate added matter issue with respect to the higher ranked requests, concerning formula (b2) in claim 2. Likewise auxiliary requests 12-42 were filed as part of the appellant's defence to the attacks under Article 100(a) and 100(b) EPC.

At the oral proceedings before the Board, no further arguments were put forward by the parties in respect of the basis for the molecular weight range in claim 1. In particular, it was not argued that the amendments made in claim 1 of these auxiliary requests constituted additional attempts to overcome the deficiencies of the previous requests. On the contrary, the appellant acknowledged that these requests could only share the same fate as the higher ranked requests dealt with in appeal. On this basis it is concluded that auxiliary requests 6, 8-10 and 12-42 do not comply with Article 123(2) EPC.

6. Since all the requests of the appellant are not allowable or not admitted into the proceedings, the appeal is to be dismissed and there is no need to deal with any other issues.

Order

For these reasons it is decided that:

The appeal is dismissed.

The Registrar: The Chairman:

B. ter Heijden D. Semino

Decision electronically authenticated