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**Datasheet for the decision
of 21 October 2024**

Case Number: T 1322 / 22 - 3.3.03

Application Number: 15728917.4

Publication Number: 3152247

IPC: C08G65/40, C08L71/00,
B32B27/28, B32B15/08,
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B29C69/00, B32B37/06, B29L7/00,
C08K3/34, C08K7/14, B32B15/18,
B29C43/00

Language of the proceedings: EN

Title of invention:

POLYMERIC MATERIALS

Patent Proprietor:

Victrex Manufacturing Limited

Opponent:

Solvay Specialty Polymers USA, LLC

Relevant legal provisions:

RPBA 2020 Art. 13(1)

EPC Art. 123(2), 84

Keyword:

New auxiliary request submitted after rejoinder - feature inserted *prima facie* suitable to resolve issues raised by other party without giving rise to new objection - admitted (yes)

Argument against new auxiliary request not concerning modification inserted therein - admitted (no)

Amendments - added subject-matter (no)

Clarity (yes)

Decisions cited:

G 0003/14, T 0398/01, T 0247/20



Beschwerdekammern

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Case Number: T 1322/22 - 3.3.03

D E C I S I O N
of Technical Board of Appeal 3.3.03
of 21 October 2024

Appellant: Solvay Specialty Polymers USA, LLC
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Decision under appeal: **Interlocutory decision of the Opposition**
Division of the European Patent Office posted on
14 March 2022 concerning maintenance of the
European Patent No. 3152247 in amended form.

Composition of the Board:

Chairman: O. Dury
Members: F. Rousseau
W. Ungler

Summary of Facts and Submissions

I. The appeal concerns the interlocutory decision of the opposition division according to which European patent No. 3 152 247 as amended according to the claims of auxiliary request 3 submitted during the oral proceedings on 8 February 2022 and a description adapted thereto met the requirements of the EPC.

II. The following items of evidence were submitted among others during the opposition proceedings:

D2: US 4,717,761

D8: JP 2000-272049A and English machine translation thereof D8a

D13: D. Blundell and B. Osborn, *Polymer*, 1983, Vol 24, pages 953-958

D15: WO 2012/001131 A1

III. According to the reasons for the contested decision relative to auxiliary request 3 which are pertinent for the appeal proceedings:

(a) Documents D13 and D15 were admitted into the proceedings.

(b) Claim 4 was considered to be clear.

(c) No objections were raised in respect of the requirements of Article 123(2) EPC or novelty.

(d) The claimed subject-matter was inventive over the teaching of D8 considered to describe the closest prior art, while the opponent's argumentation

starting from D2 for assessing inventive step was based on hindsight and therefore not persuasive.

- IV. An appeal against that decision was lodged by the opponent (appellant) and a statement setting out the grounds of appeal was submitted.
- V. With the reply to the statement of grounds of appeal (letter of 21 November 2022) the patent proprietor (respondent) requested as main request that the appeal be dismissed, or alternatively that the decision under appeal be set aside and that the patent be maintained in amended form on the basis of auxiliary requests 1 to 3 submitted with said reply.
- VI. With letter of 28 June 2024, the respondent filed additional auxiliary requests 2, 2bis, 3, 3bis, 4 and 4bis, former auxiliary request 2 and 3 being renumbered as auxiliary requests 5 and 5bis.
- VII. In preparation of the oral proceedings, a communication pursuant to Article 15(1) RPBA conveying the Board's provisional opinion was issued.
- VIII. Oral proceedings before the Board were held on 21 October 2024 by videoconference with the participation of both parties, in the course of which the respondent withdrew their request to dismiss the appeal.
- IX. The final requests of the parties were as follows:

The appellant requested that the decision under appeal be set aside and that the patent be revoked.

The respondent requested that the decision under appeal be set aside and that the patent be maintained in amended form on the basis of auxiliary request 2 filed with letter of 28 June 2024 (main request), or alternatively, on the basis of one of the following auxiliary requests, in this order, auxiliary requests 3, 4 filed with letter of 28 June 2024, auxiliary request 2 filed with letter of 21 November 2022 renumbered as auxiliary request 5 with letter of 28 June 2024, auxiliary request 1 filed with letter of 21 November 2022, auxiliary requests 2bis, 3bis, and 4bis filed with letter of 28 June 2024, auxiliary request 3 filed with letter of 21 November 2022 renumbered as auxiliary 5bis with letter of 28 June 2024.

X. The claims which are relevant to the present decision are claims 1 and 4 of auxiliary request 2 filed with letter of 28 June 2024. They read as follows (features inserted in the claims of auxiliary request 3 maintained by the opposition division are indicated in underline) :

"1. A component comprising a first part and a second part, wherein a surface of said second part is in contact with and bonded to said first part and wherein the surface of said second part in contact with and bonded to the first part is pretreated with a treatment selected from flame treatment, mechanical abrasion, and chemical treatment, wherein:

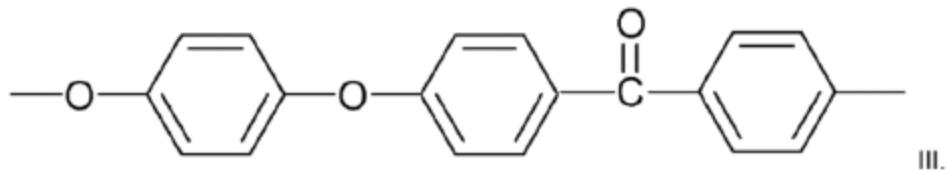
(i) said first part comprises a polymer having a repeat unit of formula
-O-Ph-O-Ph-CO-Ph- I

and a repeat unit of formula

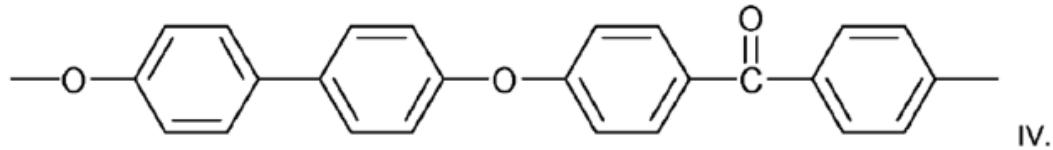
-O-Ph-Ph-O-Ph-CO-Ph- II

wherein Ph represents a phenylene moiety; and
(ii) said second part comprises a metal,
wherein the polymer is part of a composition which
includes the polymer and a filler, and wherein the
composition is in contact with the metal of the second
part;

wherein said repeat unit of formula I has the structure:



said repeat unit of formula II has the structure:



the sum of the mol% of units of formula III and IV in
said polymer is at least 95 mol%; and

the ratio defined as the mol% of the units of formula
III divided by the mol% of units of formula IV is in
the range 1.8 to 5.6.

4. A component according to any preceding claim,
wherein, in said polymer, the following relationship
applies:

$$\log_{10}(X\%) > 1.50 - 0.26 \text{ MV};$$

wherein X% refers to the % crystallinity measured by differential scanning calorimetry as described in Example 22 and MV refers to the melt viscosity measured using capillary rheometry operating at 340°C at a shear rate of 1000s⁻¹ using a circular cross-section tungsten carbide die, having a capillary diameter of 0.5mm and a capillary length of 3.175mm."

XI. The parties' submissions, in so far as they are pertinent to the present decision, may be derived from the reasons for the decision below. The contentious points concerned the questions whether auxiliary request 2 filed with letter of 28 June 2024 should be admitted into the proceedings, the objection that the subject-matter of its claim 1 extended beyond the content of the application as filed and its claim 4 lacked clarity.

Reasons for the Decision

Auxiliary request 2 (filed with letter of 28 June 2024)

Admittance

1. Claim 1 of auxiliary request 2 differs from claim 1 of auxiliary request 3 submitted during the oral proceedings on 8 February 2022 on the basis of which the patent was to be maintained in amended form, in that it comprises the additional feature "*wherein the polymer is part of a composition which includes the polymer and a filler, and wherein the composition is in contact with the metal of the second part*".

The submission of auxiliary request 2 with the respondent's letter of 28 June 2024 is to be regarded as an amendment to the party's case within the meaning of Articles 13(1) and 12(4) RPBA. Its admittance to the proceedings, which is contested by the appellant (letter of 30 July 2024, item 3), is subject to the discretionary power of the Board in accordance with Article 13(1) RPBA. Pursuant to Article 13(1) RPBA, the Board shall exercise its discretion in view of, *inter alia*, the current state of the proceedings, the suitability of the amendment to resolve the issues which were admissibly raised by another party in the appeal proceedings or which were raised by the Board, whether the amendment is detrimental to procedural economy, and, in the case of an amendment to a patent application or patent, whether the party has demonstrated that any such amendment, *prima facie*, overcomes the issues raised by another party in the appeal proceedings or by the Board and does not give rise to new objections.

The new feature inserted consists in two elements, namely "*wherein the polymer is part of a composition which includes the polymer and a filler,*" and "*wherein the composition is in contact with the metal of the second part*".

As pointed out by the respondent, the first element of this feature is obviously in response to the objection that the claimed component lacks novelty over D2 (respondent's letter of 28 June 2024, page 5, section 2, third paragraph). As indicated in the respondent's letter of 28 June 2024 (paragraph bridging pages 6 and 7), the second element is in reply to the appellant's new argument in item 33 of the statement of grounds of appeal that the experimental evidence contained in the

specification does not support a technical effect, and implicitly therefore the existence of an inventive step, as far as embodiments of claim 1 of the former main request on appeal (auxiliary request 3 submitted on 8 February 2022) illustrated in item 14 of the statement of grounds of appeal by figures 1 and 2 are concerned, i.e. embodiments for which there is no direct contact between the metal of the second part and the first part comprising the polymer. Such second element of this new feature inserted in auxiliary request 2 was already part of former auxiliary requests 2 and 3, submitted with the rejoinder (letter of 21 November 2022), which auxiliary requests have been now renumbered auxiliary requests 5 and 5bis, respectively.

Although present auxiliary request 2 could have been submitted with the rejoinder, the amendments it comprises were not only *prima facie* suitable to resolve the two above mentioned issues, but did not also give rise by themselves to new objections. On that basis, the Board exercised its discretion under Article 13(1) RPBA by admitting auxiliary request 2 into the proceedings.

Article 123(2) EPC

2. The basis in the application as filed for the feature introduced into claim 1 can be found on page 4, lines 25-26, as noted by the respondent with letter of 28 June 2024. This is not disputed by the appellant.
- 2.1 The appellant, however, submitted in item 11 of their letter of 30 July 2024 that claim 1 would be in violation of Article 123(2) EPC, since the notion of pretreatment present on page 7, lines 4-5 and claim 20

of the application as filed would be intimately linked with the alteration of the surface, which feature would be missing in claim 1 of auxiliary request 2.

2.2 This objection under Article 123(2) EPC is new. Its admittance is thus subject to the discretionary power of the Board in accordance with Article 13(1) RPBA. In this regard, an amendment to a party's appeal case is a submission which is not directed to the requests, facts, objections, arguments and evidence relied on by the party in its statement of grounds of appeal or its reply (T 0247/20, Reasons, point 1.3, page 10, second and third paragraphs). Moreover, according to Article 13(1) RPBA, the provisions of Article 12, paragraphs 4 to 6 shall apply *mutatis mutandis*.

This objection of the appellant is independent from the modifications inserted in auxiliary request 2 of 28 June 2024. It concerns the pretreatment of the second part selected from flame treatment, mechanical abrasion, and chemical treatment, i.e. a feature already present in claim 1 as maintained by the opposition division.

A similar objection was already submitted in relation to claim 1 as granted with the notice of opposition (paragraph bridging pages 9 and 10), but not pursued in respect of claim 1 as maintained by the opposition division, either during the oral proceedings (point 5.2 of the minutes), or with the statement of grounds of appeal.

Pursuant to Article 12(6) RPBA, the Board shall not admit requests, facts, objections or evidence which should have been submitted, or which were no longer maintained, in the proceedings leading to the decision

under appeal, unless the circumstances of the appeal case justify their admittance. This, in the Board's opinion apply to any amendment of a party's appeal case within the meaning of Article 12(4) RPBA, and therefore to that objection of the appellant which was no longer maintained before the opposition division and not even submitted on appeal until the appellant's letter of 30 July 2024. This is especially the case when such objection, which is based on new facts, is detrimental to procedural economy.

Under these circumstances, the Board exercised its discretion under Article 13(1) RPBA by not admitting these submissions into the proceedings.

2.3 On that basis, in the absence of any further objection by the appellant as to why claim 1 of auxiliary request 2 would be in violation of Article 123(2) EPC, the Board takes the view that auxiliary request 2 is in keeping with the requirements of Article 123(2) EPC.

Clarity of claim 4

3. The appellant submits that the reference to example 22 in claim 4 in order to define the % crystallinity measured by DSC leads to a lack of clarity of said claim, since the DSC method is defined in example 22 by reference to two trademarks for defining the specific apparatus and sensor used for the measurement (Mettler Toledo DSC1 and FRS5 sensor, respectively). In that regard, it was common ground that the reference to example 22 was not part of the claims as granted and could, therefore, following the ruling of G 3/14 be examined at the present stage of the proceedings. Referring to section F-IV 4.8 of the Guidelines for Examination in the EPO and decision T 398/01, the

appellant submits that trademarks are only allowable if they have a generally recognised precise meaning and are unavoidable. These conditions would not be met in the present case (statement of grounds of appeal, items 3 and 4).

This is in the Board's view not convincing.

As pointed out by the respondent, the % crystallinity was at the date of filing a well known parameter, as was its measurement by DSC, reference being made to D13 and D15 (rejoinder, page 3, 4th paragraph).

Even if the trademarks indicated in example 22 would not allow for an exact definition of the apparatus and sensor used in this example, this would not render the subject-matter of claim 4 unclear. In this respect, claim 4 is not about a process using a specific type of apparatus and sensor to determine a % crystallinity of the polymer defined in claim 1, but about a product defined by the relationship between the % crystallinity and melt viscosity of said polymer, namely $\log_{10}(X\%) > 1.50 - 0.26 \text{ MV}$. Accordingly, the expression "*wherein X% refers to the % crystallinity measured by differential scanning calorimetry as described in Example 22*" must be understood as "*wherein X% refers to the % crystallinity measurable by differential scanning calorimetry as described in Example 22*".

Therefore, a lack of clarity of the claimed product due to a deficient definition of the DSC apparatus and its sensor would arise only if the choice of the apparatus and sensor would have any significant impact on the relationship defined in claim 4. This has not been shown to be the case.

Furthermore, it can be agreed with the respondent that the skilled person would understand that any DSC apparatus could be used to make the measurement described in the description so long as the DSC apparatus was compatible with the sample size and scanning rate requirements set out in the description (rejoinder, page 3, 5th paragraph).

On that basis, the Board concludes that claim 4 of auxiliary request 2 meets the requirements of Article 84 EPC.

4. In the absence of any additional objection against the claims of auxiliary request 2, the claims of that auxiliary request are considered to be allowable.

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 with the order to maintain the patent in amended form on the basis of the claims of auxiliary request 2 filed with letter of 28 June 2024 and any necessary adaptation of the description thereto.

The Registrar:

D. Hampe

The Chairman:

O. Dury



Decision electronically authenticated