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D E C I S I O N
of 24 July 1996

Case Number: T 0887/93 - 3.3.3

Application Number: 87303250.2

Publication Number: 0242176

IPC: C08L 59/02

Language of the proceedings: EN

Title of invention:
Stabilized polyacetal compositions

Applicant:
E. I. DU PONT DE NEMOURS AND COMPANY

Opponent:

-

Headword:

-

Relevant legal provisions:
EPC Art. 109(1)

Keyword:
"Interlocutory revision not granted - remittal to Examining
Division"

Decisions cited:
T 0139/87

Catchword:

-



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Boards of Appeal

Chambres de recours

Case Number: T 0887/93 - 3.3.3

D E C I S I O N
of the Technical Board of Appeal 3.3.3
of 24 July 1996

Appellant: E. I. DU PONT DE NEMOURS AND COMPANY
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Decision under appeal: Decision of the Examining Division of the European Patent Office posted 6 July 1993 refusing European patent application No. 87 303 250.2 pursuant to Article 97(1) EPC.

Composition of the Board:

Chairman: C. Gérardin
Members: P. Kitzmantel
J. A. Stephens-Ofner

Summary of Facts and Submissions

- I. This appeal, which was filed on 3 September 1993, lies against the decision of the Examining Division dated 6 July 1993, refusing European patent application No. 87 303 250.2 in the name of E.I. Du Pont de Nemours and Company filed on 14 April 1987 and published under No. 242 176. The appeal fee was paid on 3 September 1993 and a Statement of Grounds of Appeal was filed on 9 November 1993.
- II. The decision under appeal referred to the Claims 1 of all the then valid requests, namely a Main and four Auxiliary Requests.

Claim 1 of the Main Request read as follows:

"A thermoplastic polyacetal composition consisting essentially of

- (a) 0.1-10 weight percent of at least one compound selected from hydroxy containing polymers and hydroxy containing oligomers of number average molecular weight of from 5000 to 100,000 and
- (b) 90-99.9 weight percent of at least one polyacetal polymer,

provided that the above-stated percentages are based on the total amount of components (a) and (b) only, provided further that the atoms in the backbone of the polymer or oligomer to which the hydroxy groups are

attached, directly or indirectly, are carbon atoms only and are separated from each other, on average, by not more than twenty chain atoms; and provided further that the hydroxy containing compound is substantially free of acidic materials."

Claim 1 of the 1st and 2nd Auxiliary Requests contained the same wording as Claim 1 of the Main Request, but complemented by further features.

Claim 1 of the 3rd Auxiliary Request differed from Claim 1 of the Main Request only by the substitution in the introductory portion of the claim of "comprising" for "consisting essentially".

Claim 1 of the 4th Auxiliary Request differed from Claim 1 of the Main Request only by insertion of the word "stabilized" between the word "A" and the passage "thermoplastic polyacetal composition consisting essentially of".

III. The decision under appeal held that the statement in Claim 1 of all requests, namely "that the atoms in the backbone of the polymer or oligomer to which the hydroxy groups are attached, directly or indirectly, **are carbon atoms only**" (emphasis added), contravened Article 123(2) EPC, as it went beyond of the content of the application as originally filed.

According to that decision the disclosure in the original application with respect to the hydroxy containing polymers and oligomers, as represented by the examples and by the statements on page 6, line 27 to page 7, line 5, did "not contain any suggestion that the atoms in the backbone of the polymer are carbon atoms only." That decision held also that the Applicant's argument, that the requirement of Article 123(2) EPC

would be met by virtue of the fact that "the new claims 1 would be anticipated by the original disclosure of the present application", was not conclusive, since the part of the subject-matter of said claims 1 whose definition exceeded the disclosure on page 6, line 27 to page 7, line 5 "would be regarded as new and could be used as the subject-matter of a further application."

IV. With his Statement of Grounds of Appeal the Applicant (Appellant) submitted in Annexes I, II and III three versions of an amended Claim 1, forming the basis of the following requests:

Main Request: Claim 1 of Annex I, plus Claims 2 to 18 filed with letter of 10 September 1992,

Auxiliary Request 1: Claim 1 of Annex II, plus Claims 2 to 18 as filed with letter of 10 September 1992,

Auxiliary Request 2: Claim 1 of Annex III, plus Claims 2 to 18 as filed with letter of 10 September 1992,

Auxiliary Request 3: Claim 1 of Annexes I, II or III, respectively, with the substitution of the word "comprising" for "consisting essentially of", plus Claims 2 to 18 as filed with letter of 10 September 1992,

Auxiliary Request 4: as previous requests but deleting Claims 2 and 3 from the respective sets of claims.

Arguments were provided in favour of the various versions of Claim 1 with respect to their admissibility under Article 123(2) EPC, which arguments were essentially directed to the Examining Division.

V. Claim 1 contained in the Annexes I, II and III reads respectively as follows:

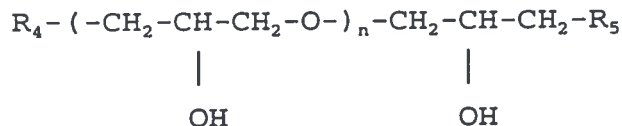
V.I Annex I (Main Request)

"1. A thermoplastic polyacetal composition consisting essentially of

(a) 0.1-10 weight percent of at least one compound selected from hydroxy containing polymers and hydroxy containing oligomers of number average molecular weight of from 5000 to 100,000 and

(b) 90-99.9 weight percent of at least one polyacetal polymer,

provided that the above-stated percentages are based on the total amount of components (a) and (b) only, provided further that the atoms in the backbone of the polymer or oligomer to which the hydroxy groups are attached, directly or indirectly, are separated from each other, on average, by not more than twenty chain atoms; and provided further that the hydroxy containing compound is substantially free of acidic materials, and provided further that the hydroxy-containing polymer or hydroxy-containing oligomer is not a polyglycerol fatty acid ester represented by the formula



where R₄ represents a hydroxyl radical or a C₈-C₂₀ fatty acid ester residual radical, R₅ represents C₈-C₂₀ fatty acid ester radical, and n is an integer of 1 or more.

V.2 Annex II (Auxiliary Request 1):

Claim 1 of this annex is identical to Claim 1 of the Main Request (Annex I), but for an added definition of the term "substantially free of acidic materials" by the maximum extent of the TEF₍₃₀₎ (thermally evolved formaldehyde).

V.3 Annex III (Auxiliary Request 2):

Claim 1 of this annex is identical to Claim 1 of Auxiliary Request 1 (Annex II), but for an added definition of the measurement of the TEF₍₃₀₎ (thermally evolved formaldehyde).

VI. The Appellant requested that the appealed decision be set aside and that a patent be granted on the basis of the Main or any of the Auxiliary Requests.

In view of his requests and arguments, the Appellant asked for interlocutory revision under Article 109 EPC.

As a further auxiliary request he also asked that oral proceedings be held.

Reasons for the Decision

1. The appeal is admissible.
2. According to Article 109(1) EPC the department whose decision is contested shall rectify its decision if it considers the appeal to be admissible and well founded.

The term "considers to be admissible and well founded" in this article cannot, in view of the well established general legal principles of equality before the law and of legal certainty (Article 125 EPC), be applied and interpreted in an arbitrary and subjective manner. On the contrary, it must impose an obligation to be objective and fair in the consideration of the facts and arguments at issue. Accordingly, if the amendments made by the Appellant clearly remove the cause for the original refusal, then there remains no room for any discretion of the responsible department to decide otherwise than to rectify its decision (see T 139/87, OJ EPO 1990, 68).

3. None of the versions of Claim 1 of any of the Appellant's requests contains the statement "that the atoms in the backbone of the polymer or oligomer to which the hydroxy groups are attached, directly or indirectly, **are carbon atoms only**" (emphasis added), which statement was considered in the appealed decision to offend against Article 123(2) EPC.
4. The objection under Article 123(2) EPC was the sole ground for refusing the application in suit (see appealed decision, Reasons 3).
5. The Appellant has therefore made amendments which fully meet the only objection on which the refusal of the application was based and notified by the Examining Division in the appealed decision.
6. Consequently the appeal is well founded and the Examining Division ought to have rectified its decision pursuant to Article 109(1) EPC.

7. In Point 4 of the Reasons of the appealed decision the Examining Division states that further deficiencies (lack of clarity, lack of novelty and lack of inventive step) had been mentioned during the examination procedure prior to the decision of refusal, but continues by saying that "a relevant evaluation of the latter criteria can only be made on the basis of claims formally acceptable in respect of the requirements of Article 123(2) EPC".

Nevertheless the Examining Division concludes that "These objections must also be overcome if the decision is to be rectified pursuant to Article 109 EPC."

8. Since the statement concerning the above-mentioned deficiencies was no part of the reason for the refusal, and, furthermore it sought explicitly to postpone any final opinion in these respects until the acknowledgement of admissibility under Article 123(2) EPC, the Board considers - except for the issue of clarity - that it is not appropriate to comment on these matters in order not to deprive the Appellant of his right for having his case considered by two instances.

With regard to the objections of lack of clarity raised by the Examining Division the Board wishes to stress that the terms "consisting essentially of" and "substantially free of acidic materials" present in the Claims 1 of all requests are not in themselves objectionable under Article 84 EPC, unless their scope may give rise to conflicts under Article 54 and/or 56 EPC. These terms are to be interpreted in the context of the invention as described in the application in the sense that their boundaries are where the essential characteristics of the claimed subject-matter can no longer be attained. As for the amount of acidic impurities in the hydroxy-containing compounds, it

appears that the statements on page 8, line 16 to page 9, line 9 provide sufficient guidance for the skilled person to establish where the above-mentioned boundaries lie with respect to the different materials that may be used (see T 472 of 10 October 1990, Reasons 3; Guidelines for Examination C-III 4.5a).

9. In view of the outcome of this appeal there is no need to accede to the Appellants subsidiary request to hold oral proceedings.

Order

For these reasons it is decided that:

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

The Registrar:


E. Gorgmaler

The Chairman:


C. Gérardin