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D E C I S I O N
of 9 July 2004

Case Number: T 0653/02 - 3.3.3

Application Number: 94919850.1

Publication Number: 0708218

IPC: C08G 64/30

Language of the proceedings: EN

Title of invention:
Process for producing polycarbonate

Patentee:
IDEMITSU PETROCHEMICAL CO., LTD.

Opponent:
Teijin Limited

Headword:
-

Relevant legal provisions:
EPC Art. 101(1)
EPC R. 55(c)

Keyword:
"Extent to which patent is opposed - transcended by amendment"

Decisions cited:
G 0009/91, T 0198/84, T 0026/85, T 0279/89

Headnote:
No competence of the Board to examine a claim derived by combination of granted claim 1 with a sub-claim not being within the extent to which the patent had been opposed (Reasons 2).

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Beschwerdekammern | Boards of Appeal | Chambres de recours

Case Number: T 0653/02 - 3.3.3

D E C I S I O N
of the Technical Board of Appeal 3.3.3
of 9 July 2004

Appellant: (Proprietor of the patent)	IDEMITSU PETROCHEMICAL CO., LTD. 6-1, Shiba 5-chome Minato-ku, Tokyo (JP)
Representative:	VOSSIUS & PARTNER Postfach 86 07 67 D-81634 München (DE)
Respondent: (Opponent)	Teijin Limited 6-7, Minamihonmachi 1-Chome, Chuo-ku, Osaka-shi, Osaka 541 (JP)
Representative:	Hallybone, Huw George Carpmaels & Ransford 43, Bloomsbury Square London WC1A 2RA (GB)
Decision under appeal:	**Decision of the Opposition Division of the European Patent Office dated 27 February 2002 and posted 9 April 2002 revoking European patent No. 0708218 pursuant to Article 102(1) EPC.**

Composition of the Board:

Chairman: R. Young
Members: P. Kitzmantel
E. Dufrasne

Summary of Facts and Submissions

I. Mention of the grant of European patent No. 0 708 128 in respect of European patent application No. 94 919 850.1 in the name of Idemitsu Petrochemical Co., Ltd., which had been filed on 5 July 1994 as PCT/JP94/01090 (International publication number: WO 95/02006) claiming a JP priority of 6 July 1993, was announced on 17 March 1999 on the basis of 8 claims, Claim 1 reading as follows:

"A process for preparing a polycarbonate from a dihydroxy compound (A) and a carbonic acid diester (B) in accordance with an ester exchange method, said process comprising the step of adjusting, to 2 ppm or less, the concentration of oxygen in an atmosphere in which an ester exchange reaction is carried out."

All further claims were dependent on Claim 1.

II. Notice of Opposition requesting revocation of the patent to the extent of the subject-matter of Claims 1 to 7 on the grounds of Article 100(a) and (b) EPC was filed by TEIJIN LIMITED on 17 December 1999.

The opposition was *inter alia* based on document D12: EP-B-0 575 810.

III. By its decision announced orally on 27 February 2002 and issued in writing on 9 April 2002, the Opposition Division revoked the patent.

This decision was based on a set of 7 claims of a main request and a set of 6 claims of a first auxiliary request.

Claim 1 of these requests was identical to the version as granted but for the change of the oxygen concentration limit from 2 ppm to, respectively, 1 ppm (main request), and 0.2 ppm (first auxiliary request).

IV. It was held in that decision that the both requests complied with the requirements of Article 123(2) and (3) EPC and Article 83 EPC (Article 100(b) EPC) but that the subject-matter of neither of the requests was novel over document D12 which was prior art according to Article 54(3) EPC for all designated Contracting States.

This conclusion was drawn because the process for producing a polycarbonate disclosed in D12 corresponded to that according to the examples of the patent in suit and defined in Claim 7 of both requests [as for the auxiliary request, the reference in the decision under appeal should rather be to Claim 6], and because, vis-à-vis D12s preferred range of "less than 5 ppm" of oxygen, the ranges of, respectively, "1 ppm or less" (Claim 1 of main request), and "0.2 ppm or less" (Claim 1 of first auxiliary request) did not meet the criteria to be fulfilled for the acknowledgement of novelty of a "selection invention" set out in T 198/84 (OJ EPO 1985, 209) and T 279/89 of 3 July 1991 (not published in the OJ EPO), namely that in order to be novel a selected sub-range should be narrow, sufficiently far removed from the known range illustrated by means of examples (Examples 8 and 9 of D12 disclosed an oxygen level of 3 ppm), and should not

provide an arbitrary specimen from the prior art (purposive selection).

In the Opposition Division's view, this conclusion was furthermore in agreement with T 26/85 (OJ EPO 1990, 22) because - in view of the teaching derivable from D12 that a lower oxygen content favoured a better (smaller) yellowness index YI - the skilled person would "seriously contemplate" the claimed reduction of the oxygen content.

V. On 19 June 2002 the Patentee lodged an appeal against the decision of the Opposition Division and paid the appeal fee on the same day. The Statement of Grounds of Appeal was filed on 19 August 2002.

With its submission dated 26 September 2003 the Appellant withdrew all previous requests and filed *inter alia* a set of six claims of a new main request whose Claim 1 reads as follows:

"A process for preparing a polycarbonate from a dihydroxy compound (A) and a carbonic acid diester (B) in accordance with an ester exchange method, said process comprising the step of adjusting, to 1 ppm or less, the concentration of oxygen in an atmosphere in which an ester exchange reaction is carried out, wherein the pressure in a reaction system is set in the range of atmospheric pressure to an increased pressure at an early stage of the ester exchange reaction and is set to a reduced pressure in a second half of the ester exchange reaction."

VI. In its submissions the Appellant argued that the claimed subject-matter as amended was novel over D12, that this document which was prior art pursuant to Article 54(3) EPC was not relevant for the assessment of inventive step and also argued that "inventive step of the feature of original claim 8, which is now included in new claim 1, was also not questioned by the Opponent during the opposition procedure" (submission dated 26 September 2003, last paragraph).

VII. In its communication of 28 April 2004 the Board addressed the parties as follows:

"Provisional comments of the Board:

1. According to its submission dated 26 September 2003 the Appellant requests maintenance of the patent on the basis of a set of six claims of a main request whose Claim 1 combines the features of granted Claims 1, 2 and 8.

2. In essence, this Claim 1 relates to a process for preparing a polycarbonate from a dihydroxy compound and a carbonic acid diester by an ester exchange method wherein
   (a) the oxygen concentration of the atmosphere in which the reaction is carried out is adjusted to 1 ppm or less, and
   (b) at an early stage of the reaction the pressure in the reaction system is set from atmospheric pressure to increased pressure and thereafter, in a second half of the reaction, is set to a reduced pressure.

3. Afore-mentioned feature (b) is derived from granted Claim 8 which, according to section V of the Notice of Opposition (on EPO Form 2300) received on 17 December 1999, was not among the opposed claims.

4. According to section 7.1 of "Annex 1 to EPO Form 2300.1" the Appellant requested "that the Opposed Patent be revoked, at least to the extent of claims 1-7" (emphasis added).

5. The "Facts and Arguments" contained in sections 1 to 6 of said Annex 1 exclusively relate to Claims 1 to 7 and do not comment on the meaning of the words "at least".

It is however stated in sections 6.6.8 and 6.6.9 of Annex 1:

"6.6.8 ... All that the Proprietor describes in the Examples of the specification are details of a very specialised and unusual method for PC production in which an initial high pressure is reduced over the course of the production process. ...

6.6.9 It appears as if this same process is that claimed in Claim 8 of the Patent in suit. If that is the case, and if no prior art exists to prejudice the allowability of this process claim, then the Proprietor may in fact be entitled to such a claim. ..."

6. Since the opposition statement is explicitly directed against Claims 1 to 7 and since with regard to Claim 8 the opposition was not substantiated - let alone by reference to any "prior art" - it must be concluded that the Opponent deliberately excluded the subject-matter of Claim 8 from the opposition.

7. This is confirmed by the later submission dated 3 August 2001 (page 5, middle to page 6, first paragraph) wherein the Opponent suggests that Claims 1 to 6 (granted Claims 1 to 7) be restricted to include the features set out on page 8, lines 46 to 50 of the patent, i.e. the pressure conditions defined in granted Claim 8, because "the Proprietor's monopoly should correspond to the technical contribution made to the art".

   From that it is evident that the Opponent's request in this submission for revocation of the patent "*in toto*" (cf. page 7) does not extend to subject-matter amended according to its suggestion, i.e. comprising the features of granted Claim 8.

8. The Enlarged Board of Appeal held in G 9/91 (OJ EPO 1993, 408) that subject-matters not covered in accordance with Rule 55(c) EPC by the Notice of Opposition filed during the nine months opposition period "are therefore, strictly speaking, not subject to any "opposition" in the sense of Articles 101 and 102 EPC, nor are there any "proceedings" in the sense of Articles 114 and 115 EPC in existence concerning such non-opposed

subject-matters. Consequently, the EPO has no competence to deal with them at all." (Reasons 10, fifth and sixth sentence)

9. As an exception to this principle, the Enlarged Board held in the subsequent section of its decision (Reasons 11, second and third sentence) that "even if the opposition is explicitly directed only to the subject-matter of an independent claim ..., subject-matters covered by claims which depend on such an independent claim may also be examined as to patentability, if the independent claim falls in opposition or appeal proceedings, provided their validity is *prima facie* in doubt on the basis of already available information ... . Such dependent subject-matters have to be considered as being implicitly covered by the statement under Rule 55(c) EPC ... ."

10. Considering

- that the opposition was directed not only against granted independent Claim 1, but also against granted Claims 2 to 7 dependent thereon,
- that, in view of the explicit statements referred to above, the Opponent deliberately refrained from making use of its right under the EPC to oppose the subject-matter of dependent Claim 8, and
- that G 9/91 (Reasons 10, second and third sentence) emphasises the importance of the requirements of Rule 55(c) EPC and of the time limit prescribed by Article 99(1) EPC

in the context of the basic concept of the post-grant opposition under the EPC

it appears that the present situation is not within the scope of the exception granted by G 9/91 (Reasons 11; cf. paragraph 9 above) which relates to the situation where an opposition "is explicitly directed only to the subject-matter of an independent claim" (emphasis added) and is not at all concerned with claims dependent thereupon.

11. In the Board's judgment, the EPO has therefore no competence to examine Claim 1 of the present main request because it comprises the features of granted Claim 8 which is not within the extent to which the patent has been opposed.

12. The decision under appeal may therefore be set aside and - in the absence of valid objections under Article 84 EPC and Article 123(2)/(3) EPC - the patent be maintained on the basis of Claims 1 to 6 of the main request (after any necessary consequential amendment of the description).

13. Until now the Respondent Opponent has not commented on the appeal. A further 2 months time limit is granted to file observations on the appeal and on the Board's communication."

VIII. With its letter dated 2 June 2004 the Respondent Opponent declared: "In view of the substantial amendment which the proprietor has made to the claims, the opponent will not be filing observations on the proceedings."

IX. With its letter dated 28 June 2004 the Appellant agreed to the opinion expressed in the Board's communication and filed amended pages of the specification.

X. The Appellant requests that the decision under appeal be set aside and the patent be maintained on the basis of the following documents:

- Claims 1 to 6 submitted with the letter dated 26 September 2003,

- pages 3 to 7, 10 and 11 of the granted description,

- pages 2, 8 and 9 of the granted description as amended according to the submission dated 28 June 2004.

Subsidiarily, the Appellant requested that the patent be maintained on the basis of the set of claims of an auxiliary request filed with the submission dated 26 September 2003, or, alternatively, that the case be remitted to the first instance for examination of inventive step.

Reasons for the Decision

1. The appeal is admissible.

Main request

2. Claim 1 combines the features of original Claims 1, 2 and 8.

Claims 2 to 6 which are dependent on Claim 1 correspond to original Claims 3 to 7, with the oxygen concentration range in Claim 6 being adjusted to the upper limit of 1 ppm as according to amended Claim 1.

The amendments made on pages 2, 8 and 9 of the description as granted correspond to the amendments made to the claims.

The main request thus complies with the requirements of Article 123(2) and (3) EPC and no objections arise under Article 84 EPC.

In view of the reasoning set out in the Board's communication of 28 April 2004 (cf section VII above) the Board, in compliance with the conclusions of the decision of the Enlarged Board G 9/91, has no competence to examine Claim 1 of the main request because the subject-matter of this claim corresponds to the subject-matter of granted Claim 8, in the form of its embodiment dependent on granted Claim 1, which is not within the extent to which the patent had been opposed.

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 with the order to maintain the patent as amended in the following version:

   – Claims 1 to 6 submitted with the letter dated 26 September 2003,

   – pages 3 to 7, 10 and 11 of the granted description,

   – pages 2, 8 and 9 of the granted description as amended according to the submission dated 28 June 2004.

The Registrar: The Chairman:

E. Görgmaier R. Young