

Internal distribution code:

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

**Datasheet for the decision
of 8 April 2008**

Case Number: T 1152/05 - 3.3.03

Application Number: 94912848.2

Publication Number: 0690889

IPC: C08K 5/34

Language of the proceedings: EN

Title of invention:

Light stabilizer packages for partial paint applications

Patentee:

LyondellBasell Advanced Polyolefins USA Inc.

Opponent:

Ciba Specialty Chemicals Holding Inc.

Headword:

-

Relevant legal provisions:

EPC Art. 14(4), 108, 123(2)

Relevant legal provisions (EPC 1973):

-

Keyword:

"Appeal by Patent Proprietor - not deemed to have been filed"

"Reimbursement of the appeal fee - (yes)"

"Extension of subject-matter - (yes)"

Decisions cited:

G 0006/91, J 0008/80, J 0013/90, J 0027/92, T 0323/87,

T 0288/92, T 0690/93

Catchword:

-



Case Number: T 1152/05 - 3.3.03

DECISION
of the Technical Board of Appeal 3.3.03
of 8 April 2008

Appellant:
(Opponent)

Ciba Specialty Chemicals Holding Inc.
Klybeckstrasse 141
P.O. Box/Postfach
CH-4002 Basel (CH)

Representative:

Richter, Helmut
Ciba Specialty Chemicals Holding Inc.
Patentabteilung
Klybeckstrasse 141
CH-4057 Basel (CH)

Respondent:
(Patent Proprietor)

LyondellBasell Advanced Polyolefins USA Inc.
100 South Mitchell Road
Mansfield, Texas 76063 (US)

Representative:

Luderschmidt, Schüler & Partner
Partnership No. 141
John-F.-Kennedy-Straße 4
D-65191 Wiesbaden (DE)

Decision under appeal:

Interlocutory decision of the Opposition
Division of the European Patent Office dated
20 April 2005 and posted 12 July 2005
concerning maintenance of European patent
No. 0690889 in amended form.

Composition of the Board:

Chairman: R. Young
Members: C. Idez
H. Preglau

Summary of Facts and Submissions

I. The grant of the European patent No. 0 690 889 in the name of Solvay Engineered Polymers (later LyondellBasell Advanced Polyolefins USA Inc.) in respect of European patent application No. 94 912 848.2 filed on 23 March 1994 and claiming priority of the US patent application No. 36607 filed on 24 March 1993 was announced on 31 July 2002 (Bulletin 2002/31) on the basis of 18 claims.

Independent Claims 1, 10, and 17 read as follows:

"1. An improved light stabilized polymeric composition that does not interfere with acid curative coating systems comprising:

(a) thermoplastic polyolefin;

(b) monomeric hindered amine light stabilizer having a basicity or pKa of no greater than 7 present in an amount of 0.1% to 1% by weight;

(c) a polymeric hindered amine light stabilizer having a basicity or pKa of no greater than 7 present in an amount of 0.1% to 0.8% by weight; and

(d) an ultraviolet light absorbing agent present in an amount of 0.1% to 1% by weight,

wherein the monomeric hindered amine light stabilizer, the polymeric hindered amine light stabilizer and the ultraviolet light absorbing agent, in combination, provide light stability to the composition and hence resistance to degradation from UV light to the composition.

10. An article comprising a molded light stabilized polymeric composition according to claim 1 and having an exterior surface, and an acid curative coating

system upon at least a portion of the exterior surface of the molded composition.

17. A method of making a partially painted thermoplastic polyolefin article that does not interfere with an acid curative coating system, said method comprising the steps of:
incorporating into a thermoplastic polyolefin, a light stabilizer package comprising a monomeric hindered amine light stabilizer having a basicity or pKa of no greater than 7, a polymeric hindered amine light stabilizer having a basicity or pKa of no greater than 7, and an ultraviolet light absorbing agent, wherein each of the monomeric hindered amine light stabilizer, the ultraviolet light absorbing agent and the polymeric hindered amine light stabilizer are present in an amount of at least about 0.1% to provide light stability to the composition and hence resistance to degradation from UV light; and painting at least a portion of said stabilized thermoplastic polyolefin with an acid catalyst activated single component paint system to form a stable, partially painted thermoplastic polyolefin article."

Claims 2 to 9, 11 to 16, and 18 were dependent claims.

II. On 28 April 2003, a Notice of Opposition against the patent was filed by Ciba Speciality Chemicals Holding Inc.

The Opponent requested revocation of the patent in its entirety on the grounds of lack of novelty and lack of inventive step (Article 100(a) EPC), of insufficiency

of disclosure (Art.100(b) EPC), and of extension of subject-matter (Art.100(c) EPC).

III. In an interlocutory decision announced orally on 20 April 2005 and issued in writing on 12 July 2005, the Opposition Division held that the grounds of opposition did not prejudice the maintenance of the patent in amended form on the basis of Claims 1 to 17 submitted as fourth auxiliary request at the oral proceedings of 20 April 2005.

Independent Claims 1, 9 and 16 thereof read as follows:

"1. An improved light stabilized polymeric composition that does not interfere with acid curative coating systems comprising:

(a) thermoplastic polyolefin;

(b) monomeric hindered amine light stabilizer having a basicity or pKa of no greater than 7 present in an amount of 0.1% to 0.2% by weight;

(c) a polymeric hindered amine light stabilizer having a basicity or pKa of no greater than 7 present in an amount of 0.1% to 0.8% by weight; and

(d) an ultraviolet light absorbing agent present in an amount of 0.1% to 1% by weight,

wherein the monomeric hindered amine light stabilizer, the polymeric hindered amine light stabilizer and the ultraviolet light absorbing agent, in combination, provide light stability to the composition and hence resistance to degradation from UV light to the composition.

9. An article comprising a molded light stabilized polymeric composition according to claim 1 and having

an exterior surface, and an acid curative coating system upon at least a portion of the exterior surface of the molded composition.

16. A method of making a partially painted thermoplastic polyolefin article that does not interfere with an acid curative coating system, said method comprising the steps of:
incorporating into a thermoplastic polyolefin, a light stabilizer package comprising a monomeric hindered amine light stabilizer having a basicity or pKa of no greater than 7 in an amount of 0.1% to 0.2% by weight, a polymeric hindered amine light stabilizer having a basicity or pKa of no greater than 7, and an ultraviolet light absorbing agent, wherein each of the ultraviolet light absorbing agent and the polymeric hindered amine light stabilizer are present in an amount of at least about 0.1% to provide light stability to the composition and hence resistance to degradation from UV light; and painting at least a portion of said stabilized thermoplastic polyolefin with an acid catalyst activated single component paint system to form a stable, partially painted thermoplastic polyolefin article."

Dependent Claims 2 to 7, 8, 10 to 15, and 17 were based on granted Claims 2 to 7, 9, 11 to 16, and 18.

IV. Notice of Appeal was filed on 9 September 2005 by the Opponent with simultaneous payment of the prescribed fee.

V. Notice of Appeal was filed in the Dutch language by the Patent Proprietor (at that time Solvay Engineered Polymers) on 12 September 2005. A French translation of the Notice of Appeal was provided on the same day. In the Notice of appeal it was requested that the appeal fee be deducted from the deposit account No. 28020006.

On 15 November 2005, the Patent Proprietor filed its Statement of Grounds, in which maintenance of the patent in suit on the basis of the first auxiliary request submitted during the oral proceedings before the Opposition Division was requested.

VI. In its Statement of Grounds of Appeal filed on 18 November 2005, the Opponent submitted in particular that Claims 1 and 16 of the set of claims on the basis of which the Opposition Division had decided that the patent could be maintained did not meet the requirements of Article 123(2) EPC. In that respect, it argued essentially as follows:

(i) The amendments carried out in the course of the Examining procedure in the proviso at the end of Claim 1 were not allowable under Article 123(2) EPC.

(ii) The proviso in granted Claim 1 no longer made reference to the ability of the substrate to be coated by a acid catalyst activated single component paint system.

(iii) The incorporation of only a lower limit of 0.1% for the three light stabilizing components in Claim 16 (granted Claim 17) was not supported by the application

documents which referred to closed ranges (cf. page 10, lines 18 to 26).

(iv) The incorporation of the range 0.1 to 0.2% for the monomeric hindered amine in Claims 1 and 16 was not supported by the application as filed.

(v) Although a value of 0.2% was indicated in Tables III and XII for the monomeric hindered amine, this was done in specific compositions comprising specific amounts of the other components.

(vi) The incorporation of the range 0.1 to 0.2 % for component (b) in Claim 1 would have necessitate the following steps:

(α) Arbitrary selection of one of the 3 components (b) to (d) and restriction of the concentration range of (b), independently of the remaining components;.

(β) Arbitrary selection of an example of a concrete stabilizer combination;

(γ) Isolated consideration of only the component (b) in the arbitrary selected example;

(δ) Arbitrary selection of the range 0.1 to 1% on page 10 of the original description;

(ε) Selection of the upper limit of that range as the end-point which could be replaced (i.e. the lower limit might also have been replaced); and

(ζ) Arbitrary replacement of the limit value 1% by the value 0.2% inferred from the arbitrarily selected example.

(vii) It was hence evident that a new range had been created, which had not been considered by the inventors.

(ix) Reference was also made to the decision T 288/92 of 18 November 1993 (not published in OJ EPO).

VII. In a communication issued on 28 March 2006, the Board expressed its preliminary view that the appeal of the Patent Proprietor should apparently be deemed not to have been filed.

VIII. With its letter dated 30 May 2006, the Patent Proprietor submitted two new auxiliary requests. It also presented *inter alia* arguments concerning Article 123(2) EPC, which may be summarized as follows:

(i) The composition according to Claim 1 was entirely characterized by the presence of components (a)-(d). The deleted expression "to provide a stable substrate... component system" represented no technical limitation and could be deleted without adding new subject-matter.

(ii) The reference to the coating system could be deleted because the coating system was already mentioned in the first lines of Claim 1.

(iii) The ranges of monomeric HALS (hindered amine light stabilizer), polymeric HALS and UV light absorbing agents of respectively 0.1-1%, 0.1-0.8% and

0.1-1% were fully supported by the description on page 3, paragraph [0008] of the patent in suit.

(iv) The range for the monomeric HALS of 0.1 to 0.2 % (claim 1, first auxiliary request) was also supported by the description (cf. package 5 of Table III with no limitation to a specific monomeric HALS, and in combination with no specific polymeric HALS and UV-stabilizers; Table XII (B-low) for Tinuvin® 440 which was a monomeric HALS.

(v) The contents of polymeric HALS and UV stabilizers were different in both Tables.

(vi) Thus, there was no reason to suppose that the value of 0.2 % given in Table III could only be used in connection with the contents of polymeric HALS and UV absorbers mentioned in that Table.

(vii) Original claim 17 contained no numerical range for the concentrations, and consequently the original disclosure was not limited to an upper numerical limit.

(viii) The ranges for each component were given on page 10, lines 18-26 of the patent as filed, in each case with 0.1 % as the lower limit.

(ix) It was then allowable in Claim 16 to replace the "unlimited amount" of each component by an open-ended range with the originally mentioned value as the lower limit.

IX. In its letter dated 18 July 2006, the Opponent maintained its view that Claims 1 and 16 of the set of

claims on which the Opposition Division had decided to maintain the patent in suit infringed Article 123(2) EPC.

Concerning the new auxiliary requests, it was submitted that they contravened Article 123(2) EPC.

- X. In its letter dated 3 August 2006, the Patent Proprietor submitted that its appeal should be deemed to have been filed. It requested under Rule 88 EPC that the term "Traduction" be deleted from the Notice of Appeal filed in French on 12 September 2005, and that the remaining amount of 20% of the appeal fee be deducted from its account No. 28020006.

While admitting that it had erroneously tried to benefit from the 20% tax reduction which might be granted according to Article 14(4) EPC, it essentially argued that the EPO should have drawn the attention of the Patent Proprietor to this evident mistake, and should have invited the Patent Proprietor to remedy this deficiency before the expiry of delay for filing the notice of appeal. It relied in particular on the decisions J 27/92 (OJ EPO 1995, 288) and J 13/90 (OJ EPO 1994, 456).

- XI. Oral proceedings were held on 8 April 2008 before the Board.

At the oral proceedings, the discussion firstly focussed on the question as to whether or not the appeal of the Patent Proprietor should be deemed to have been filed.

(i) In that respect, the Patent Proprietor while essentially relying on the arguments presented during

the written phase of the appeal, made additional submissions which may be summarized as follows:

(i.1) The document presented as translation in French of the Notice of Appeal had been submitted within the time limit mentioned in Article 108 EPC.

(i.2) Thus, it should be considered that a Notice of Appeal in one of the official language of the EPO (i.e. French) had been filed in time.

(i.3) In the Notice of Appeal filed on 12 September 2005, it had requested to deduct the appeal fee from the account but no amount was mentioned.

(i.4) The EPO was wrong in deciding to deduct only 80% of the appeal fee.

(i.5) In any case the 20% of the appeal fee which were lacking should be regarded as a small amount. Reference was made to the decision J 27/92 in that respect.

(i.6) Reference was made to Article 9(1) of the Rules Relating to Fees and in that context to the discretion of the EPO to overlook small amounts having regard to all the circumstances of the case, i.e. in the case under consideration here the consequences for the Patent Proprietor to have its appeal not deemed to have been filed.

(ii) The arguments presented by the Opponent in that respect may be summarized as follows:

(ii.1) The Notice of Appeal had been filed in Dutch. Since the Patent Proprietor did not have its principal place of business within the territory of a Contracting State, its appeal should not be deemed to have been filed.

(ii.2) The decision J 27/92 was not concerned with the payment of the appeal fee.

(ii.3) Furthermore, in contrast to the case under consideration in J 27/92, no wrong information had been given by the EPO.

(ii.4) It was not obvious from the Notice of Appeal that the Patent Proprietor was not entitled to file it in Dutch, since the address mentioned at the bottom of the Notice of Appeal was that of Solvay in Brussels.

(iii) The Board, after deliberation having informed the Parties that the appeal of the Patent Proprietor was not deemed to have been filed, the discussion moved to the question of the allowability of Claims 1 to 16 of the set of claims on which the Opposition Division had decided to maintain the patent in suit.

In that respect, both Parties essentially relied on their written submissions. Following preliminary observations of the Board concerning in particular the allowability of the range 0.1 to 0.2% of component (b) in Claim 1 of that set of claims, the Patent Proprietor filed a set of Claims 1 to 15 labelled "1. auxiliary request" and a set of Claims 1 to 14 labelled "2. auxiliary request" in order to replace the requests then on file, i.e. the set of Claims 1 to 17 on which the Opposition Division had decided to maintain the

patent in suit, the set of Claims 1 to 16 submitted as auxiliary request I with letter dated 30 May 2006, and the set of Claims 1 to 17 of the auxiliary request II submitted with letter dated 30 May 2006.

Claim 1 of the "1. auxiliary request" submitted at the oral proceedings before the Board read as follows:

"1. An improved light stabilized polymeric composition that does not interfere with acid curative coating systems comprising:

(a) thermoplastic polyolefin;

(b) monomeric hindered amine light stabilizer having a basicity or pKa of no greater than 7 present in an amount of 0.1% to 0.2% by weight;

(c) a polymeric hindered amine light stabilizer having a basicity or pKa of no greater than 7 present in an amount of 0.1% to 0.8% by weight; and

(d) an ultraviolet light absorbing agent present in an amount of 0.1% to 1% by weight,

wherein the monomeric hindered amine light stabilizer, the polymeric hindered amine light stabilizer and the ultraviolet light absorbing agent, in combination, provide light stability to the composition and hence resistance to degradation from UV light to the composition and wherein (b) is present in amount which is equal to or greater than the amounts of either of the (c) or (d)."

Claims 2 to 15 corresponded to Claims 2 to 15 of the request on which the Opposition Division had decided to maintain the patent in suit.

Claim 1 of the "2. auxiliary request" read as follows:

"1. An improved light stabilized polymeric composition that does not interfere with acid curative coating systems comprising:

(a) thermoplastic polyolefin;

(b) monomeric hindered amine light stabilizer having a basicity or pKa of no greater than 7 present in an amount of 0.1% to 0.2% by weight;

(c) a polymeric hindered amine light stabilizer having a basicity or pKa of no greater than 7 present in an amount of 0.1% to 0.8% by weight; and

(d) an ultraviolet light absorbing agent present in an amount of 0.1% to 1% by weight,

wherein the monomeric hindered amine light stabilizer, the polymeric hindered amine light stabilizer and the ultraviolet light absorbing agent, in combination, provide light stability to the composition and hence resistance to degradation from UV light to the composition wherein the monomeric hindered amine light stabilizer [sic] is 2, 2, 6, 6-tetramethyl-4-(2-dodecylsuccinamidyl)-piperidinyll acetamide or 1, 3, 8-triazaspiro(4.5)decane-2, 4-dione and the polymeric hindered amine light stabilizer is a N-(2-hydroxyethyl)-2, 2, 6, 6-tetramethylpiperidin-4-ol-succinic acid copolymer and wherein (b) is present in amount which is equal to or greater than the amounts of either of the (c) or (d)."

Claims 2 to 7, and 8 to 14, corresponded to Claims 2 to 7, and 9 to 15 of the request on which the Opposition Division had decided to maintain the patent in suit.

The Patent Proprietor submitted that Claim 1 of the request labelled 1. auxiliary request differed from Claim 1 of the set of claims on which the Opposition Division had decided to maintain the patent in suit in that the feature that "(b) is present in amount which is equal to or greater than the amounts of either of the (c) or (d)." has been incorporated therein. This feature was in its view supported by lines 23 to 25 on page 9 of the application as originally filed. Concerning Claim 1 of the request labelled 2. auxiliary request, it submitted that it further incorporated features of Claim 8 of the set of claims on which the Opposition Division had decided to maintain the patent in suit.

XII. The Appellant (Opponent) requested that the decision under appeal be set aside and the patent be revoked.

The Patent Proprietor requested that its appeal be deemed to have been filed, that the decision under appeal be set aside and the patent be maintained on the basis of the set of claims 1 to 17 submitted as first auxiliary request at the oral proceedings before the Opposition Division.

Should the Board decide that the appeal of the Patent Proprietor is not deemed to have been filed, the Patent Proprietor requested that the decision under appeal be set aside, and the patent be maintained on the basis of the first or second auxiliary request, both filed during the oral proceedings before the Board. Furthermore, reimbursement of the appeal fee was requested.

Reasons for the Decision

1. The appeal filed by the Opponent is admissible.
2. *Procedural matters*
 - 2.1 As indicated above in Section V, Notice of Appeal was filed in the Dutch language on 12 September 2005 by the Patent Proprietor, then Solvay Engineered Polymers. A translation in French of the Notice of Appeal was filed on the same day.
 - 2.2 Since, however, Solvay Engineered Polymers is a company having its principal place of business at the following address:

"1201 Avenue H. East
Grand Prairie, TX, 75050 US",

i.e. not within a Contracting State having a language other than English, French or German as an official language, it cannot benefit from the provisions of Article 14(4) EPC.
 - 2.3 Since the Notice of Appeal filed on 12 September 2005 by the Patent Proprietor was not in one of the official language of the EPO, this document is, in accordance with Article 14(4) EPC, deemed not to have been filed.
 - 2.4 Nor could it, in the Board's view, be considered that a Notice of Appeal had been filed in French before the end of the appeal period set out in Article 108 EPC in view of the document filed on 12 September 2005 and

presented as a translation of the Notice of Appeal filed in Dutch on the same day.

- 2.5 This is because, in view of the considerations made in the decision G 6/91 (OJ EPO 1992, 491; Reasons point 10), where the translation is filed at the same time as the original, the EPO could not take it as the "official" notice of appeal and ignore the original as superfluous. As further stated in G 6/91 "a translation cannot become the original; whatever the date on which it is filed it remains a translation, with all ensuing legal consequences, including the possibility of correction to bring it into conformity with the original."
- 2.6 Consequently, in accordance with Article 108 EPC, the Board comes to the conclusion that the appeal of the Patent Proprietor is deemed not to have been filed.
- 2.7 This conclusion cannot be altered by the argument of the Patent Proprietor that the EPO should have warned him before the end of the appeal period that it was not entitled to file its Notice of Appeal in the Dutch language and that it would hence have had sufficient time to file a Notice of Appeal in one of the official languages of the EPO.
- 2.8 While in the decision J 13/90 relied on by the Patent Proprietor in its letter dated 3 August 2006, it was held that the principle of good faith requires the EPO to warn the party in question of any impending loss of rights if the deficiency is readily identifiable and said party can still correct it within the time limit, the Board observes that in decision T 690/93 of

11 October 1994 (not published in OJ EPO) it was held that there was no justification for the suggestion that the principle of good faith imposes an obligation to warn a party of deficiencies within the area of the party's own responsibility (Reasons point 3.3).

- 2.9 In any case, it follows from the decision J 13/90 that the obligation to warn a party of an impending loss of rights firstly presupposes that the deficiency is readily identifiable.
- 2.10 While in the case under consideration in decision J 13/90, the deficiency in the request for re-establishment which - were it not corrected - would render the request inadmissible was expressly mentioned in the request itself and was therefore readily identifiable for the European Patent Office, the alleged deficiency cannot, in the Board's view, in the present case be considered as readily identifiable.
- 2.10.1 This is because the Notice of Appeal dated 12 September 2005 was filed under the letterhead of **Solvay** (i.e. a well known Belgian company) and signed by Ms. Anne Vande Gucht and indicated that the correspondence should be addressed to Ms Vande Gucht at **Solvay**, Rue de Ransbeek, 310 B-1120 Bruxelles (Belgique), so that there was *prima facie* no reason for the formality officer of the EPO to consider that the Patent Proprietor "**Solvay** Engineered Polymers" would not be entitled to file its Notice of Appeal in Dutch (emphasis by the Board).
- 2.10.2 Nor would it have been immediately apparent from the statement in the Notice of Appeal that Solvay

Engineered Polymers had one of its offices in Grand Prairie, Texas 75050 (USA), that the Patent Proprietor was indeed not entitled to file its Notice of Appeal in Dutch. This is not only because this statement makes no reference to the **principal** place of business of the Patent Proprietor, but because it might even have suggested that the Patent Proprietor, despite having an office in the USA, would still be entitled to file its Notice of Appeal in Dutch.

2.10.3 Consequently, even on the basis of the *ratio decidendi* of decision J 13/90, the EPO was not obliged to warn the Patent Proprietor of the fact that it could not benefit of the provisions of Article 14(4) EPC.

2.11 Nor can the further argument of the Patent Proprietor that the document presented as a French translation of the Notice of Appeal be considered as the Notice of Appeal by way of correction under Rule 88 EPC, i.e. by deleting the term "traduction" from that document be accepted for the following reasons:

2.11.1 For the purposes of Rule 88 EPC, a mistake may be said to exist in a document filed with the European Patent Office if the document does not express the true intention of the person on whose behalf it was filed (cf. J 8/80 OJ EPO, 1980, 293).

2.11.2 In the present case, it is however evident that this document filed on 12 September 2005 cannot be dissociated from the Notice of Appeal filed in Dutch on the same day. In other words, the word "traduction" in the French document is perfectly in accordance with the concomitant filing of the original Notice of Appeal in

- Dutch, and can hence only be considered as expressing the true intention at that time of the person on behalf of which it has been filed.
- 2.11.3 Taking further into account that this correction, if accepted, could prejudice the Opponent (Appellant) due to the change of the status of the Patent Proprietor of Respondent to Appellant, it thus follows that the correction under Rule 88 EPC requested by the Patent Proprietor cannot be allowed.
- 2.12 Since, for the reasons indicated above, the appeal of the Patent Proprietor is not deemed to have been filed, there is no need for the Board to examine as to whether the remaining 20% of the appeal fee should be considered as a small amount lacking.
- 2.13 Since the appeal of the Patent Proprietor is not deemed to have been filed, it follows that the appeal fee has been paid without reason and must in consequence be reimbursed (cf. also T 323/87 (OJ EPO 1989; 343; Reasons point 4)).

Requests based on the sets of claims labelled "1.auxiliary request" and "2. auxiliary request"

3. Claim 1 of the set of claims labelled "1. auxiliary request" differs from Claim 1 of the application as originally filed (cf. WO-A-94/22946), in that
- (i) the amount of monomeric hindered amine stabilizer
 - (b) had been limited to 0.1% to 0.2% by weight;

(ii) the amount of polymeric hindered amine stabilizer (c) had been limited to 0.1% to 0.8% by weight;

(iii) the amount of ultraviolet absorbing agent (c) had been limited to 0.1% to 1 by weight;

(iv) it has been indicated that that (b) is present in an amount which is equal or greater than the amounts of either of the (c) or (d); and

(v) that the proviso "wherein each of the monomeric hindered amine light stabilizer, the ultraviolet light absorbing agent and the polymeric hindered amine are present in an amount effective to provide a stable substrate for an acid catalyst activated single component paint system" at the end of original Claim 1 has been deleted, and replaced by the indication that "the monomeric hindered amine light stabilizer, the polymeric hindered amine light stabilizer and the ultraviolet light absorbing agent, in combination, provide light stability to the composition and hence resistance to degradation from UV light to the composition."

3.1 While amendments (ii) and (iii) find their support on page 10, lines 18 to 26 of the original application, it is however evident that there is no explicit support in the original application for a range of 0.1% to 0.2% by weight of component (b) (i.e. amendment (i)).

3.2 However, the Patent Proprietor has taken the view that it would be allowable to amend the generally disclosed range of 0,1 to 1% for component (b) mentioned at page 10, lines 19 to 20 of the original application on

the basis of the particular value i.e. 0.2 % of component (b) disclosed Tables III (package 5) and XII (composition B-low).

- 3.3 As indicated in the decision T 288/92 referred to by the Appellant in its Statement of Grounds of Appeal, the allowability of amendments under Article 123(2) EPC is to be decided solely on the basis of examining whether the amendments are directly and unambiguously derivable (extractable) from the application as filed.
- 3.4 In the present case, the question of the allowability of the amendment (i) boils down as to whether there is some support in the application as originally filed for restricting the original disclosed range of 0.1 to 1% of component (b) by the incorporation of a **new upper limit**, i.e. 0.2%.
- 3.5 In this connection the Board however notes not only that the preferred range for component (b) mentioned in the original application is from 0.1 to 0.5% (cf. page 10, lines 19 to 21, but furthermore that the value 0.2% for component (b) is indeed the **lowest value** disclosed for that component in the examples of the original application (cf. Table III and Table XII).
- 3.6 Consequently, the Board can only come to the conclusion that there is no original disclosure, whether in the claims or in the description, from which it could be objectively derived that the sub-range 0.1 to **0.2%** of component (b) was an embodiment of the claimed invention.

- 3.7 In view of the above, and independently of the fact that amendment (i) is also not compatible with amendments (ii) and (iii) in view of amendment (iv) since the amounts of (c) and (d) might be greater (e.g. 0.8% and 1% respectively) than the maximum amount of component (b) (i.e. 0.2%), it thus follows that amendment (ii) contravenes Article 123(2) EPC.
- 3.8 Consequently, the request of the Patent Proprietor based on the set of claims labelled "1.auxiliary request" must be refused.
- 3.9 Claim 1 of the set of claims labelled "2.auxiliary request" differs from Claim 1 of the set of Claims labelled "1.auxiliary request" only in that the following feature (vi) according to which "the monomeric hindered amine light stabilizer is 2, 2, 6, 6-tetramethyl-4-(2-dodecyl-succinamidyl)-piperidyl acetamide or 1, 3, 8-triazaspiro(4.5)decane-2, 4-dione and the polymeric hindered amine light stabilizer is a N-(2-hydroxyethyl)-2, 2, 6, 6-tetramethylpiperidin-4-ol-succinic acid copolymer" has been incorporated therein.
- 3.10 Since however Claim 1 of that request still contains the unallowable amendment (i) referred to in paragraph 3.1 above, it is evident that Claim 1 of that request contravenes Article 123(2) EPC.
- 3.11 Consequently, the request of the Patent Proprietor based on the set of claims labelled "2.auxiliary request" must be refused.

4. Since none of the requests presented by the Patent Proprietor can be granted, the patent must be revoked.

Order

For these reasons it is decided that:

1. The decision under appeal is set aside.
2. The patent is revoked.
3. Reimbursement of the appeal fee paid by the Patent Proprietor is ordered.

The Registrar:

The Chairman:

E. Görgmaier

R. Young