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**Datasheet for the decision  
of 28 July 2009**

**Case Number:** T 0858/07 - 3.3.03

**Application Number:** 03765443.1

**Publication Number:** 1539884

**IPC:** C08L 69/00

**Language of the proceedings:** EN

**Title of invention:**

Antistatic flame retardant resin composition and methods for  
manufacture thereof

**Applicant:**

Sabic Innovative Plastics IP B.V.

**Opponent:**

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**Headword:**

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**Relevant legal provisions:**

EPC Art. 123(2)

**Keyword:**

"Main request, auxiliary request - amendments - added subject-  
matter - yes"

**Decisions cited:**

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**Catchword:**

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Case Number: T 0858/07 - 3.3.03

**D E C I S I O N**  
of the Technical Board of Appeal 3.3.03  
of 28 July 2009

**Appellant:** Sabic Innovative Plastics IP B.V.  
Plasticslaan 1  
NL-4612 PX Bergen op Zoom (NL)

**Representative:** Modiano, Micaela Nadia  
Modiano Josif Pisanty & Staub Ltd  
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**Decision under appeal:** Decision of the Examining Division of the  
European Patent Office posted 28 November 2006  
refusing European application No. 03765443.1  
pursuant to Article 97(1) EPC.

**Composition of the Board:**

**Chairman:** R. Young  
**Members:** M. C. Gordon  
C. Vallet

## Summary of Facts and Submissions

- I. European patent application no. 03765443.1 was filed on 13 June 2003 as international application number PCT/US2003/018693, claiming priority of 22 July 2002 from an earlier application US 10/064,495 and published on 29 January 2004 as WO 2004/009703 A1.

The application had 19 claims whereby claim 1 read as follows:

"An antistatic composition comprising:  
a polycarbonate resin;  
an impact modifier comprising a polysiloxane;  
an antistatic agent; and  
a flame retardant in an amount greater than or equal to about 9 wt% of the total composition".

Claims 2-16 were dependent claims.

Claim 17 was an independent claim to an article comprising the composition of claim 1.

Claim 18 was an independent claim directed to an antistatic flame retardant composition having defined quantities of the components specified in claim 1.

Claim 19 was an independent claim directed to a method of manufacturing an antistatic composition.

- II. The application was refused by a decision of the Examining Division of the European Patent Office dated and communicated in writing on 28 November 2006, taken without oral proceedings.
- The decision was based on a set of 10 claims filed with a letter dated 2 August 2006.
- Claim 1 of this set of claims differed from claim 1 of the application as filed in that:

- the impact modifier was defined as follows:  
"an impact modifier comprising  
polymethylmethacrylate-polyacrylic-polysiloxane  
copolymer";
- the term "about" had been deleted from the  
specification of the content of flame retardant.  
Accordingly this feature now read:  
"a flame retardant in an amount greater than or  
equal to 9 wt% of the total composition."

Claims 2-6 corresponded to claims 2-6 of the  
application as filed, amended however by deletion of  
the term "about" where it occurred.

Claim 7 corresponded to claim 10 of the application as  
filed. Claims 8-10 corresponded to claims 17-19 of the  
application as filed, whereby in claims 9 and 10 the  
definition of the impact modifier had been amended as  
noted for claim 1 above and all occurrences of the term  
"about" had been deleted.

- (a) The decision under appeal held that the amended  
claims met the requirements of Art. 123(2) EPC. In  
particular it was held that the specification of  
the impact modifier as comprising  
polymethylmethacrylate-polyacrylic-polysiloxane in  
claims 1, 9 and 10 had its basis on originally  
filed page 9, lines 6 to 10 in combination with  
claim 5 as filed.
- (b) It was however held that the operative claims did  
not meet the requirements of Art. 84 EPC or  
Art. 56 EPC.
- (c) Accordingly the application was refused.

III. An appeal against this decision was filed by the  
applicant on 2 February 2007, the prescribed fee being  
paid on the same day.

Grant of a patent on the basis of the "present claims", i.e. the claims considered by the examining division, or on the basis of amended claims which might be submitted in the course of the proceedings was requested.

An auxiliary request was made for oral proceedings.

IV. The statement of grounds of appeal was filed on 5 April 2007.

The claims upon which the decision had been based were maintained as the main request.

An auxiliary request was submitted in which, compared to the main request, claim 1 had been amended by specifying mandatorily the presence of an anti drip agent. This auxiliary request consisted of a single page consisting of claims 1-6 and the first two lines of claim 7.

No explanation of this request was provided by the appellant.

The appellant presented arguments, addressing the matters of clarity and inventive step.

V. On 12 May 2009 the Board issued a summons to attend oral proceedings.

The Board presented its preliminary, provisional opinion in an accompanying communication.

*Inter alia* it was noted that the auxiliary request appeared to be incomplete.

An objection was raised pursuant to Art. 123(2) EPC in respect of the respective claim 1 of the main request and of the auxiliary request. This objection related to the specification of the feature added during the examination proceedings, i.e.

"an impact modifier comprising polymethylmethacrylate-polyacrylic-polysiloxane copolymer".

An objection pursuant to Art. 123(2) EPC was also raised in respect of the feature added to claim 1 of the auxiliary request, i.e. the anti drip agent.

Objections were also raised pursuant to Art. 56 and Art. 84 EPC in respect of both requests.

- VI. In a letter dated 14 July 2009 the appellant withdrew the request for oral proceedings and requested that a decision be taken on the basis of the file as it stood.
- VII. Oral proceedings were held as scheduled on 28 July 2009 in the absence of the appellant (R. 115(2) EPC).
- VIII. The appellant requests that a patent be granted on the basis of the main request filed with the letter dated 2 August 2006 (Claims 1 to 10) or in the alternative on the basis of the auxiliary request filed with the statement of grounds of appeal (claims 1 to 6 and 7 (partial)).

## **Reasons for the Decision**

- 1. The appeal is admissible.
- 2. *Main request - Article 123(2) EPC*
  - 2.1 Claim 1 of the main request specifies as the second feature:  
"an impact modifier comprising polymethylmethacrylate-polyacrylic-polysiloxane copolymer".

- 2.2 Although this impact modifier is specified in claim 5 of the application as filed (reference being made to the PCT pamphlet), it is further specified in said claim 5 that the impact modifier is present in an amount of "about 1 to about 20 wt% of the total composition". This feature is however absent from operative claim 1.  
Accordingly in contrast to claim 5 of the application, operative claim 1 does not impose any restriction on the amount of the stated impact modifier present.
- 2.3 There is a further reference to this impact modifier on page 9, first paragraph of the application. However here it is specified that the impact modifier is a particular type of polymer, namely a core-shell polymer whereby the nature of the core and shell (polymers making up each of these) is specified.  
This information is however also absent from operative claim 1.
- 2.4 For the reasons given in sections 2.2 and 2.3 above it is concluded that the subject-matter of claim 1 extends beyond the content of the application as filed contrary to the requirements of Article 123(2) EPC.
- 2.5 The main request therefore does not meet the requirements of Art. 123(2) EPC.
- 2.6 The main request is therefore refused.
3. *First auxiliary request - Article 123(2) EPC*

3.1 Claim 1 of the first auxiliary request employs the same definition of the impact modifier as claim 1 of the main request.

Accordingly for the reasons indicated in section 2 above, claim 1 of the first auxiliary request does not meet the requirements of Art. 123(2) EPC.

3.2 There is however a further defect pursuant to Art. 123(2) EPC arising in respect of the first auxiliary request.

3.3 Claim 1 of the auxiliary request additionally specifies the presence of "an anti drip agent".

3.4 The only reference to such a component in the application as filed is in the discussion of the examples on page 15, second paragraph where reference is made to a specific anti drip agent (TSAN) in a specific quantity (0.6 wt%).

3.5 The newly added feature of claim 1 is broader than this disclosure since it restricts neither the nature of the anti drip agent nor the quantity thereof.

3.6 Accordingly this feature also extends beyond the content of the application as filed, contrary to the requirements of Art. 123(2) EPC.

3.7 Therefore for the reasons explained in sections 3.1 and 3.2-3.6 above, the first auxiliary request does not meet the requirements of Art. 123(2) EPC.

3.8 The first auxiliary request is consequently refused.



4. Since neither of the requests on file meet the requirements of the EPC the appeal cannot be allowed.

**Order**

**For these reasons it is decided that:**

The appeal is dismissed.

The Registrar:

The Chairman:

E. Görgmaier

R. Young