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**Datasheet for the decision
of 14 December 2011**

Case Number: T 1734/08 - 3.3.03

Application Number: 01910865.3

Publication Number: 1290079

IPC: C08K 5/3475, C08K 5/3492,
C08K 5/315, C08L 69/00

Language of the proceedings: EN

Title of invention:
Carbonate polymer compositions comprising low volatile UV
absorbers

Patentee:
Dow Global Technologies LLC

Opponents:
Bayer MaterialScience AG
BASF Schweiz AG

Headword:
-

Relevant legal provisions:
EPC Art. 114(2)

Relevant legal provisions (EPC 1973):
-

Keyword:
"Newly filed document - highly relevant - (yes)"
"Newly filed document - admitted to procedure - (yes)"

Decisions cited:
T 1002/92

Catchword:

-



Case Number: T 1734/08 - 3.3.03

D E C I S I O N
of the Technical Board of Appeal 3.3.03
of 14 December 2011

Appellant II:
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Respondent:
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Decision under appeal: Decision of the Opposition Division of the
European Patent Office announced 16 July 2008
and posted 7 August 2008 rejecting the
opposition filed against European patent
No. 1290079 pursuant to Article 101(2) EPC.

Composition of the Board:

Chairman: B. ter Laan
Members: M. C. Gordon
C. Vallet

Summary of Facts and Submissions

I. The appeal lies from a decision of the Opposition Division announced 16 July 2008 and posted 07 August 2008 rejecting the oppositions against European Patent EP-B1-1 290 079.

II. The European patent was granted on the basis of nine claims, claims 1, 6, 7 and 8 being independent claims and reading as follows:

1. A carbonate polymer composition comprising:

(a) a carbonate polymer
and

(b) one or more UV absorbing compounds selected from two or more of the following groups:

- (i) a hydroxybenzotriazole derivative,
- (ii) a hydroxyphenyltriazine derivative or
- (iii) a cyanoacrylic acid ester compound

wherein all UV absorbing compounds (i), (ii) and (iii) have a molecular weight of at least 400 g/mol.

6. A carbonate polymer composition comprising:

(a) a carbonate polymer
and

(b) at least two UV absorbing compounds selected from:

- (i) 2,2'-methylene-bis-(6-{2H-benzotriazol-2-yl}-4-{1,1,3,3-tetramethylbutyl}-phenol),
- (ii) 2-(4,6-diphenyl-1,3,5-triazin-2-yl)-5-hexyloxyphenol,
or
- (iii) 1,3-bis-[(2'-cyano-3',3'-diphenylacryloyl)oxy]-2,2-bis-[(2-cyano-3',3'-diphenylacryloyl)oxy] methyl propane.

7. A process for preparing a carbonate polymer composition which comprises the step of combining:

(a) a carbonate polymer
and

(b) one or more UV absorbing compounds selected from two or more of the following groups:

- (i) a hydroxybenzotriazole derivative,
- (ii) a hydroxyphenyltriazine derivative, or
- (iii) a cyanoacrylic acid ester compound

wherein all UV absorbing compounds (i), (ii) and (iii) have a molecular weight of at least 400 g/mol.

8. A process for producing an extruded or molded article of a carbonate polymer composition comprising the steps of:

(A) preparing a carbonate polymer composition which comprises the step of combining:

(a) a carbonate polymer

and

(b) one or more UV absorbing compounds selected from two or more of the following groups:

(i) a hydroxybenzotriazole derivative,

(ii) a hydroxyphenyltriazine derivative, or

(iii) a cyanoacrylic acid ester compound

wherein all UV absorbing compounds (i), (ii) and (iii) have a molecular weight of at least 400 g/mol,
and

(B) extruding or molding the carbonate polymer composition into an extruded or molded article.

III. Oppositions against the patent were filed by Opponent 01 on 24 September 2004 and Opponent 02 on 29 September 2004. Both opponents requested revocation of the patent in its entirety on the grounds pursuant to Art. 100(a) EPC (lack of novelty, lack of inventive step).

The following documents, *inter alia* were cited in support of the oppositions:

D1: EP-A-899 302

D2: WO-A-94/05645

D3: EP-A-1 130 058

D4: US-A-5 106 891

D8: US-A-4 288 067

IV. The decision under appeal was based on the patent as granted. According to the decision under appeal:

(a) Novelty was acknowledged since none of the documents D1, D2 or D3 disclosed at least two different UV absorbing compounds, having a molecular weight of at least 400 g/mol.

Similarly the subject matter of the claims of the patent in suit could only be arrived at from the disclosure of D8 via multiple selections.

- (b) Regarding inventive step, the opposition division held that the evidence of the patent showed that a combination of two UV absorbers as specified in the patent in suit resulted in polycarbonate compositions with a reduced physical loss of the UV absorbers during sheet extrusion as compared to a polycarbonate composition containing only a single one of those two UV absorbers.

The closest prior art was held to be D4. D4 showed that loss of UV absorber from lacquers under weathering conditions was reduced if a combination of two UV absorbers both having a molecular weight of 400 was employed instead of a single such UV absorber. However the weathering conditions reported in D4 were not comparable to the conditions in an extruder, meaning that the results of D4 could not be transferred to the patent in suit. Furthermore, polycarbonate was not mentioned as a component of the lacquers of D4.

The opposition division also considered that the skilled person would not consult D4 in order to solve the problem of physical loss of UV absorbers from polymers during injection moulding or sheet extrusion.

- (c) Consequently the oppositions were rejected.

V. Appeals against this decision were lodged by the opponents on 9 September 2008 (Opponent 02) and 24 September 2008 (Opponent 01).

VI. In their respective statements setting out the grounds of appeal both appellants made reference for the first time to

D14: JP 10-279 788, translations into English being provided.

Both appellants requested the revocation of the patent and as an auxiliary measure oral proceedings.

VII. In its rejoinder to the statements of grounds of appeal, dated 26 June 2009, the respondent/patent proprietor submitted an experimental report, designated D15. The respondent requested maintenance of the patent as granted, but also submitted four amended sets of claims as auxiliary requests 1-4 indicating that the amendments had been made in order to take account of the teachings of D14.

Oral proceedings were requested as an auxiliary measure.

It was requested, in view of the submission of D14, that the case be remitted to the first instance for further prosecution.

VIII. In two communications dated 7 April 2011 and 14 July 2011 the Board informed the parties that, in view of the submission of D14, its preliminary view of the case was that the appropriate course of action would be to remit the case to the first instance.

IX. By letter dated 6 June 2011 appellant/opponent 02 stated that the question of whether the case was to be remitted was a matter for the discretion of the Board, but that it did not have any objections in principle to remittal ("keinen prinzipiellen Einwand").

In a letter dated 2 September 2011 appellant/opponent 01 stated that it did not maintain its request for oral proceedings and that it agreed to remittal of the case to the first instance.

X. In a letter of 16 June 2011 the respondent confirmed its request for remittal to the first instance. Further, amended sets of claims forming a new main request and three auxiliary requests were submitted.

XI. The appellants/opponents request that the decision under appeal be set aside and that the patent in suit be revoked. Both appellants/opponents have confirmed that they agree to remittal to the first instance (appellant 01) or that remittal is not objected to (appellant 02). If the patent is not revoked in the written procedure, appellant 02 also requests oral proceedings before the Board, or, in case of a remittal, before the first instance.

The respondent/patent proprietor requests maintenance of the patent in amended form on the basis of the main request, or auxiliarily on the basis of one of the first to third auxiliary requests as filed with the letter of 16 June 2011.

Also remittal of the case to the first instance for further prosecution is requested. Oral proceedings are requested should the Board not feel minded to grant a

patent or to remit the case to the first instance for further prosecution.

Reasons for the Decision

1. The appeals are admissible.
2. Both appellants have cited the same - new - document with their statements of grounds of appeal.

This document was not cited in due time, i.e. within the period specified by Art. 99(1) EPC, and the citation thereof consequently goes beyond the indication of facts and evidence set out in the statement pursuant to R. 76(2) EPC.

According to Art. 114(2) EPC the admission of such documents is a discretionary matter for the European Patent Office.

- 2.1 The scope of exercise of this discretion has been the subject of a number of decisions of the Boards of Appeal, for example T 1002/92 (OJ EPO 1995, 605). According to that decision, in appeal proceedings, new facts and evidence which go beyond the indication provided in the notice of opposition should only very exceptionally be admitted in the appropriate exercise of the board's discretion if "such new material is *prima facie* highly relevant in the sense that it is highly likely to prejudice maintenance of the European patent" (Reasons 3.4).
- 2.2 D14 relates to a polycarbonate resin composition for surface material to be laminated to a polycarbonate

resin substrate. The polycarbonate mandatorily contains two UV absorbers, a hydroxybenzotriazole having a molecular weight of 448 and a hydroxy phenyl triazine compound of molecular weight 425 (Claim 1). Lamination may be carried out by kneading and extrusion whereby the two extrusion streams are merged in an adaptor either before or in the extrusion die to form a laminate (D14, paragraph [0019]).

This document therefore appears, *prima facie*, to relate to a composition within the terms of the claims of the patent as granted and also to one aspect of the technical field to which the patent is directed, i.e. extrusion (see patent in suit claim 8).

- 2.3 Accordingly this document provides the teachings which were absent from the prior art taken into account by the opposition division in the decision under appeal. Under these circumstances the Board has to conclude that this document is "highly relevant" and that the teachings thereof are "highly likely" to prejudice maintenance of the patent in suit. Following the principles established in decision T 1002/92 *supra* the Board considers that the appropriate course of action is to admit D14 into the procedure.
- 2.4 None of the parties objected to this. Both appellants explicitly request the admission into the proceedings of D14. The respondent has not raised any objections to the citation of this document, but on the contrary has filed new claims taking account of D14 and has requested remittal to the first instance.
- 2.5 D14 is therefore admitted to the procedure.

3. The respondent has requested remittal of the case to the first instance for further prosecution should the Board not maintain the patent as granted (Sections VII and X above). The appellants did not object to such a remittal (Section IX above).

The introduction of D14 has changed the case against the patent to such an extent that the Board considers it appropriate to give the respondent the opportunity to have the case considered by two instances. Therefore, the case is remitted to the first instance for further prosecution.

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

The Chairman

E. Görgmaier

B. ter Laan