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**Datasheet for the decision
of 25 April 2013**

Case Number: T 1786/11 - 3.3.03

Application Number: 03749032.3

Publication Number: 1554332

IPC: C08G 64/28

Language of the proceedings: EN

Title of invention:

Method of making polycarbonate

Patent Proprietor:

General Electric Company

Opponent:

Bayer MaterialScience AG

Headword:

-

Relevant legal provisions:

EPC Art. 54(2)(3)

Keyword:

"Revocation based on a post-published document"
"Remittal - yes"

Decisions cited:

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Catchword:

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Case Number: T 1786/11 - 3.3.03

D E C I S I O N
of the Technical Board of Appeal 3.3.03
of 25 April 2013

Appellant: General Electric Company
(Patent Proprietor) 1 River Road
Schenectady, NY 12345 (US)

Representative: Grever, Frederik , et al
SABIC Innovative Plastics B.V.
Plasticslaan 1
NL-4612 PX Bergen op Zoom (NL)

Respondent: Bayer MaterialScience AG
(Opponent) Law and Patents
Patents and Licensing
D-51368 Leverkusen (DE)

Representative: Dr. Haas, Michel
BIP Patents, et al
c/o Bayer Intellectual Property GmbH
Creative Campus Monheim
Alfred-Nobel-Strasse 10
D-40789 Monheim (DE)

Decision under appeal: **Decision of the Opposition Division of the
European Patent Office posted 6 June 2011 to
revoke the European patent No. 1554332 pursuant
to Article 101(3)(b) EPC.**

Composition of the Board:

Chairman: B. ter Laan
Members: D. Marquis
R. Cramer

Summary of Facts and Submissions

- I. The appeal by the patent proprietor lies against the decision by the opposition division dated 06 June 2011, to revoke European patent No. 1 554 332 (application No. 03 749 032.3).
- II. The opposition was based on the grounds of Article 100(a) EPC (lack of novelty as well as lack of inventive step). Reference was made *inter alia* to DE 10118307 A1 (D2).
- III. With letter dated 4 August 2008, the proprietor requested the maintenance of the patent in amended form on the basis of a new set of claims.
- IV. In the contested decision, the opposition division found that the requirements of Article 123(2) and (3) EPC were fulfilled and that the subject matter of the claims of the amended main request was clear, sufficiently disclosed and novel in view of D2. In view of D2, the opposition division however found that the objective technical problem solved was to provide of an alternative method of making an aromatic polycarbonate. Since the range of the net concentration of chloroformate groups as claimed was not found to provide a technical effect, the subject matter of the claims lacked an inventive step.
- V. On 2 August 2011, the patent proprietor lodged an appeal against that decision and paid the prescribed fee on the same day. The statement of grounds of appeal was filed on 29 September 2011. The patent proprietor requested to maintain the patent on the basis of the

main request as filed with letter of 4 August 2008 or on the basis of the auxiliary request filed with the statement of grounds of appeal.

- VI. With letter dated 13 April 2012, the respondent (opponent) filed a reply to the statement of grounds of appeal. The opponent requested to maintain the decision of the opposition division.
- VII. By communication of 25 February 2013, the Board informed the parties that the contested decision of the opposition division relied on a document that would not appear to be a prior art document within the meaning of Article 54(2) and (3) EPC and that it was therefore minded to remit the case to the opposition division for further prosecution. The parties were invited to comment.
- VIII. By letter of 6 March 2013, the patent proprietor withdrew his request for oral proceedings, provided that the Board would remit the case to the opposition division.
- IX. By letter of 21 March 2013, the opponent withdrew his request for oral proceedings, provided the Board would remit the case to the opposition division.

Reasons for the Decision

1. The appeal is admissible.
2. Inventive step

In the contested decision, the reasoning regarding inventive step is based on the disclosure of document D2 (DE 10118307 A1). D2 is a national patent application published on 17 October 2002, i.e. after the priority date of the patent in suit (16 October 2002). D2 is therefore *prima facie* not a prior art document within the meaning of article 54(2) and (3) EPC and hence is not relevant to inventive step (Article 56 EPC). The contested decision does however not indicate why the teaching of D2 was nevertheless considered during the analysis of inventive step. As D2 is the only document on which the conclusion of lack of inventive step is founded, the objection appears to be without basis. Since a lack of inventive step was the only ground leading to the revocation of the patent in suit, the decision under appeal has to be set aside. In this light, the Board considers it appropriate to remit the case to the opposition division 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 department of first instance for further prosecution.

The Registrar

The Chairman

E. Görgmaier

B. ter Laan