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**Datasheet for the decision  
of 29 October 2015**

**Case Number:** T 0249/12 - 3.3.03  
**Application Number:** 06706210.9  
**Publication Number:** 1846506  
**IPC:** C08L77/00, C08K3/00, C08K5/00  
**Language of the proceedings:** EN

**Title of invention:**  
HEAT STABILIZED MOULDING COMPOSITION

**Patent Proprietor:**  
DSM IP Assets B.V.

**Opponent:**  
EMS-PATENT AG

**Headword:**

**Relevant legal provisions:**  
EPC Art. 123(2), 54, 84, 111(1)  
RPBA Art. 13(1)

**Keyword:**  
Late-filed request - justification for late filing (yes)  
Late-filed document - admitted (yes)  
Amendments - allowable (yes)  
Claims - clarity (not objected to)  
Novelty - main request (yes)  
Appeal decision -  
remittal to the department of first instance (yes)

**Decisions cited:**

T 0002/81, T 0522/96, T 1002/92

**Catchword:**



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Case Number: T 0249/12 - 3.3.03

**D E C I S I O N**  
**of Technical Board of Appeal 3.3.03**  
**of 29 October 2015**

**Appellant:**  
(Patent Proprietor)

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**Decision under appeal:**

**Decision of the Opposition Division of the  
European Patent Office posted on 23 December  
2011 revoking European patent No. 1846506  
pursuant to Article 101(3) (b) EPC.**

**Composition of the Board:**

**Chairman** M. C. Gordon  
**Members:** O. Dury  
C. Brandt

## Summary of Facts and Submissions

I. The appeal by the patent proprietor lies against the decision of the opposition division revoking European patent No. EP 1 846 506, based on application No. 06 706 210.9 corresponding to the international application No. WO 2006/074934.

II. The application as filed contained 14 claims, of which claims 1, 9 and 11-14 read as follows:

"1. Thermostabilized thermoplastic moulding composition comprising

- a) a thermoplastic polyamide composition, and
- b) a stabilizing system comprising a thermostabilizer selected from the group consisting of phenolic thermostabilizers, organic phosphites, aromatic amines, metal salts of elements from Group IB, IIB, III and IV of the Periodic Table and metal halides of alkali and alkali earth metals, and combinations thereof,

characterized in that

the thermoplastic polyamide composition (a) consists of a blend of at least two polyamides comprising

- a.1. at least 50 mass %, relative to the total mass of the thermoplastic polyamide composition, of a first polyamide (PA-1), being a semi-crystalline polyamide having a melting point  $T_m-1$ , or being an amorphous polyamide having a glass transition point  $T_g-1$ , wherein  $T_m-1$  and  $T_g-1$  together are denoted as  $T-1$  and  $T-1$  is at least  $200^\circ\text{C}$
- a.2. a second polyamide (PA-2), with a C/N ratio of at most 7, being a semi-crystalline polyamide having a melting point  $T_m-2$  or an amorphous polyamide having a glass

transition point Tg-2, wherein Tm-2 and Tg-2 together are denoted as T-2 and T-2 is at least 20°C lower than T-1, and

the moulding composition comprises

- c) a metal oxide, or salt thereof, of a transition metal element from Group VB, VIB, VIIB and VIIIB of the Periodic Table, or a mixture thereof."

"9. Moulding composition according to any of claims 1-8, wherein the second polyamide is present in an amount of 2.5-40 mass %."

"11. Use of a composition according to any of claims 1-8 for making moulded parts for high-temperature applications involving a use temperature of at least 150°C."

"12. Process for preparing a moulded part comprising feeding a composition according to any of claims 1-9, and optionally further ingredients, to a moulding machine."

"13. Moulded part consisting of a composition according to any of claims 1-8."

"14. Use of a moulded part according to claims 13 in an assembly process for making an automotive engine, a machine, or an electrical or electronic installation."

Claims 2-8 were directed to embodiments of the composition according to claim 1. Claim 10 is not relevant for the present decision.

III. The granted patent was based on the set of claims as originally filed.

IV. An opposition against the patent was filed, in which the revocation of the patent was requested on the grounds of Art. 100 (a) EPC (lack of novelty and lack of an inventive step) and Art. 100 (b) EPC.

V. The decision under appeal was based, *inter alia*, on the following document:

D1: EP-A-1 498 445

According to that decision, neither the main request nor any of auxiliary requests 1-5 was allowable because the amendments made therein in respect of feature c) of granted claim 1 did not fulfill the requirements of Art. 84 EPC, Art. 123(2) EPC and/or Art. 123(3) EPC. In addition, auxiliary request 6 was not novel in view of example III of D1.

VI. The patent proprietor (appellant) appealed the above decision. With the statement setting out the grounds for the appeal, the appellant requested, *inter alia*, that the opposition division's decision be set aside and the patent be maintained in amended form according to either the main request or any of auxiliary requests 1-7 filed therewith. Remittal to the first instance to deal with the issue of inventive step was requested.

VII. With its rejoinder dated 18 December 2012 the opponent (respondent) requested that the appeal be dismissed and that, should any of the appellant's requests be held to fulfill the requirements of Art. 123(2), 83, 84 and 54 EPC, the case be remitted to the first instance to deal with the issue of inventive step. Also, further documents were filed, in particular

D38: DE 691 03 907 T2

D39: Experimental report (2 pages)

- VIII. With a letter of 11 August 2014 the appellant withdrew the main request and auxiliary requests 2-7 filed with the statement of grounds of appeal. Auxiliary request 1 filed with the statement of grounds of appeal was maintained as the new main request. Additionally, a set of new auxiliary requests 1-4 was submitted. Each of the main request and auxiliary requests 1-4 contained an amended version of feature c) of granted claim 1.
- IX. With a communication accompanying the summons to oral proceedings, the Board set out its preliminary view of the case. Concerns were in particular identified in respect of Art. 84 and 123(2) EPC regarding the amendment made in feature c) of claim 1 of each of the pending requests. It was further indicated *inter alia* that the appellant had not taken position in respect of the respondent's novelty objection based on example 1 of D38 and that the issues of the admission to the proceedings and of the relevance of D38 would have to be addressed during the oral proceedings.
- X. With a letter of 20 August 2015, the patent proprietor filed a new main request and new auxiliary requests 1-4 in replacement of the then pending main request and auxiliary requests 1-4.

Claim 1 of the main request was identical to claim 1 as originally filed with the exception of feature a.2 which read as follows (additions as compared to feature a.2 of claim 1 of the application as filed are indicated in **bold**):

"a.2 **10-50 mass%, relative to the total mass of the**

**thermoplastic polyamide composition, of** a second polyamide (PA-2), with a C/N ratio of at most 7, being a semi-crystalline polyamide having a melting point T<sub>m-2</sub> or an amorphous polyamide having a glass transition point T<sub>g-2</sub>, wherein T<sub>m-2</sub> and T<sub>g-2</sub> together are denoted as T-2 and T-2 is at least 20°C lower than T-1"

Claim 9 of the main request read as follows (additions as compared to claim 9 of the application as filed are indicated in **bold**, deletions in ~~strikethrough~~):

"9. Moulding composition according to any of claims 1-8, wherein the second polyamide is present in an amount of ~~2-5~~ **10-40** mass %."

The wording of each of claims 2-8 and 10-13 was identical to that of original claims 2-8 and 11-14, respectively.

- XI. With a telefax of 20 August 2015, the respondent submitted further arguments.
- XII. During the oral proceedings, which were held on 29 October 2015 in the presence of both parties,
- the appellant did not maintain a request made in the statement of grounds of appeal that the appeal fee be reimbursed and the case be remitted to the first instance due to a substantial procedural violation;
  - questioned by the Board, the appellant declared that he did not object to the admissibility of D38 and D39 to the proceedings;
  - the respondent requested that the main request and auxiliary request 1 filed with letter of



20 August 2015 not be admitted to the proceedings.

XIII. The appellant's arguments in respect of the main request filed with letter of 20 August 2015, insofar as relevant to the present decision, may be summarised as follows:

#### Admissibility

- a) The main request was filed in order to address the novelty objection raised for the first time in the opponent's rejoinder to the statement of grounds of appeal. It only became clear with receipt of the Board's communication that D38, which was late-filed, would probably be admitted to the proceedings. There would have been no need for the appellant to react before that issue had been clarified. Also, the main request had been submitted two months in advance of the oral proceedings, which was within the time period set in the Board's communication and allowed the respondent to take it into account.

In that respect, D38 was more relevant than D1 in respect of novelty because it was the only document explicitly disclosing a polyamide blend comprising a metal oxide. In D1, only elementary iron was disclosed.

- b) The amendment made concerned a feature which was already the subject-matter of granted claim 9 (i.e. original claim 9). A similar amendment had already been present in auxiliary request 3, previously pending. Therefore, the amendment made could not take the respondent by surprise.

- c) The subject-matter claimed was directed to a blend of polyamides comprising at least polyamides (PA-1) and (PA-2), and which was characterised, as had been the case in the application as filed, in terms of the amount of polyamide (PA-1). Any assessment of the prior art required that the amounts of each polyamide present in the composition, including (PA-1) and (PA-2), be determined. Therefore, the amendment made did not raise new issues. Nor did it complicate the case.
- d) The range now being defined in respect of the amount of polyamide (PA-2) was based on a combination of ranges disclosed in the application as filed, which was clearly allowable according to the established case law based on decision T 2/81. Therefore, the main request was clearly allowable.
- e) For those reasons, the main request should be admitted to the proceedings pursuant to Art. 13(1) RPBA.

Art. 123(2) EPC

- f) The subject-matter of claim 1 was derivable from claim 1 in combination with the passage on page 9, lines 7-10 of the application as originally filed. The case law based on T 2/81 was invoked, reference being made to the publication "Case Law of the Boards of Appeal of the EPO", 7th. Ed., 2013, section II.E.1.7.1.

Art. 54 EPC

- g) Neither example III of D1 nor example 1 of D38 disclosed a composition comprising a blend of two

polyamides (PA-1) and (PA-2) as defined in claim 1 and wherein polyamide (PA-2) was present in an amount of 10-50 mass %.

XIV. The respondent's arguments in respect of the main request filed with letter of 20 August 2015, insofar as relevant to the present decision, may be summarised as follows:

#### Admissibility

- a) There was no reason justifying such a late filing of the main request. D38 was already on file when the appellant submitted the previous set of requests with letter of 11 August 2014. There was no reason why D38 had not been taken into account at that stage. In that respect, D38 was not more relevant than D1 and the operative main request could have been submitted earlier in order to address the novelty objection in respect of D1.
- b) Whereas the main request focused on the amount of polyamide (PA-2) the previous set of requests focused on the amount and nature of the metal oxide according to feature c). Therefore, the main request amounted to an extension of the case requiring that new issues had to be dealt with, which was not allowable.
- c) T 2/81 dealt with the creation of a new range from the combination of only two ranges. In the present case, the newly defined range was obtained by combining limits selected from four disclosed possible ranges. Therefore, in the present case there were more possibilities to define ranges than in the case considered in T 2/81. In that

respect, the case law had further developed since T 2/81 and, in the meantime, the "gold standard" for assessing the allowability of an amendment was that it had to be clearly and unambiguously disclosed in the application as filed. That requirement was not met in the present case.

- d) Therefore, the main request should not be admitted to the proceedings.

Art. 123(2) EPC

- e) For the reasons indicated in above section c), the passage of the application as filed relied upon by the appellant did not provide a valid basis for the amendment made.

Art. 54 EPC

- f) During the oral proceedings, the respondent agreed that neither example III of D1 nor example 1 of D38 anticipated the subject-matter of the operative main request.

XV. The appellant (patent proprietor) requested that the decision under appeal be set aside and that the patent be maintained in amended form on the basis of either the main request or any of auxiliary requests 1 to 4, all requests as filed with letter dated 20 August 2015.

The respondent (opponent) requested that the appeal be dismissed.

Both parties requested that the case be remitted to the first instance to deal with the issue of inventive step in case any of the main request or auxiliary requests 1

to 4 was found to comply with Art. 84, 123 and 54 EPC.

XVI. The Board announced its decision at the end of the oral proceedings.

### **Reasons for the Decision**

1. The appeal is admissible.

#### **Main request**

2. Admissibility issues

2.1 The operative main request was filed in reply to the Board's communication accompanying the summons to oral proceedings. Therefore, it represents an amendment to a party's case pursuant to Art. 13(1) RPBA and its admission to the proceedings is subject to the Board's discretion (Art. 13(1) and 13(3) RPBA).

2.1.1 According to the appellant the main request was submitted specifically to address the novelty objection based on documents D38 and D39 but was only submitted once the appellant had been informed by the Board of the possible relevance of those late-filed documents.

a) Considering that D38 and D39 were first filed together with the respondent's rejoinder to the statement of grounds of appeal the admission to the proceedings of those documents, which were not filed during the nine-months period pursuant to Rule 55(c) EPC, is not mandatory and is subject to the Board's discretion considering the stipulations of

Art. 12(2) and 12(4) RPBA as well as the criteria developed in the established case law based on decision T 1002/92 (Case Law of the Boards of Appeal of the EPO, 7th Ed., 2013, IV.C.1.2.3). In particular,

- Art. 12(4) RPBA allows the Board to hold inadmissible facts and evidence which could have been presented in the first instance proceedings and
- pursuant to T 1002/92, evidence filed in appeal proceedings which goes beyond that presented with the notice of opposition should only be admitted if such new evidence is *prima facie* highly relevant to the extent that it can reasonably be expected to change the eventual result and prejudice maintenance of the contested patent.

In view of those considerations and in the absence of any justification provided by the respondent why D38 and D39 could not have been filed during the first instance proceedings, the patent proprietor could not know whether D38 and D39 would be admitted to the proceedings prior to receipt of the Board's preliminary opinion informing him that D38 and D39 might indeed be considered highly relevant. Therefore, although the operative main request could have been filed earlier by the appellant, e.g. in direct reply to the respondent's rejoinder, there was, in view of the uncertain procedural status of D38 and D39, no mandatory reason to do so. The appellant's decision to wait for the optional - Board's communication pursuant to Art. 15(1) RPBA and for the Board's opinion in respect of D38 and D39 may thus be explained, in the present circumstances of the case, by the previous late-filing of D38 and D39. However, in doing so, the appellant also had to accept that the admission to the proceedings of any request filed at a later stage could

undergo more stringent stipulations since in general the later such new material is filed, the greater the degree of procedural complication it is likely to cause (see e.g. Art. 13(3) RPBA; T 1002/92: reasons 3.4).

b) Regarding the timeliness of the filing, it is further conspicuous that the operative main request was submitted within the deadline set in the Board's communication and about two months before the oral proceedings took place. Therefore, in the present case, both the Board and the respondent had enough time to take it into account. Furthermore, there is no evidence that the appellant's behaviour amounts to a deliberate abuse of the procedure.

2.1.2 Regarding the substance of the amendment made, it effectively restricts the amount of polyamide (PA-2) of feature a.2 which has to be present in the thermoplastic polyamide composition (a) defined in operative claim 1. That amendment is neither particularly complicated in itself, nor was it shown to raise new issues which increased the complexity of the present case.

Although the operative main request constitutes a shift of focus as compared to the requests previously pending, namely onto the amount of polyamide (PA-2) defined in feature a.2 rather than on the nature and amount of metal oxide as defined in feature c) according to operative claim 1 (see section IX above), the issue related to the amount of polyamide (PA-2) is not new since that feature was already implicitly present in granted claim 1 (corresponding to original claim 1) due to the requirement that polyamide (PA-1) had to be present in an amount of at least 50 mass % relative to the total mass of the thermoplastic

polyamide composition, said composition consisting of a blend of at least two polyamides comprising polyamides (PA-1) and (PA-2). Furthermore, said feature was already the subject-matter of granted claim 9 and had already been used, although in combination with a different range, to limit auxiliary requests previously pending (e.g. auxiliary requests 3-4 filed with the statement of grounds of appeal, auxiliary requests 5-6 filed with the statement of grounds of appeal and auxiliary requests 3-4 file with letter of 11 August 2014).

2.1.3 No submissions were made as to why the respondent would not have been in a position to deal with the operative main request without adjourning the oral proceedings. Therefore, there was no reason not to admit the main request pursuant to Art. 13(3) RPBA.

2.1.4 In view of the above, the Board considers that the operative main request together with the arguments advanced in the appellant's letter of 20 August 2015 in respect of Art. 123(2) EPC and Art. 54 EPC constitute a *bona fide* reply to the issues identified in the Board's communication and to the objections raised by the appellant as of that stage of the appeal proceedings. Therefore, the Board, exercising its discretion, decided to admit the main request filed with letter of 20 August 2015 to the proceedings (Art. 13(1) RPBA).

2.2 D38 and D39 were both submitted by the respondent together with its rejoinder to the statement of grounds of appeal i.e. according to the stipulations of Art. 12(2) RPBA. Further considering the absence of any objection of the appellant in that respect, there is no reason not to admit those documents to the proceedings.



Under those circumstances, D38 and D39 were both admitted to the proceedings.

3. Art. 123(2) EPC

3.1 Claim 1 corresponds to claim 1 of the application as filed, in which the expression "a.2 a second polyamide (PA-2) ..." was amended to "a.2 10-50 mass %, relative to the total mass of the thermoplastic polyamide composition, of a second polyamide (PA-2) ...".

3.1.1 In that respect, the passage on page 9, lines 7-10 of the application as filed, which was relied upon by the appellant, reads as follows:

"In a further preferred embodiment of the invention the second polyamide is present in an amount of 1-50 mass %, preferably 2.5-40 mass %, more preferably 5-30 mass %, and still more preferably 10-20 mass %, relative to the total mass of the thermoplastic polyamide composition."

3.1.2 It was not disputed that said passage refers to polyamide (PA-2) according to feature a.2 of operative claim 1. As derivable from the passage of the application as filed cited above, the range of 10-50 mass % now being specified in operative claim 1 amounts to defining a range by using the upper limit of the less preferred broader range (50 mass %) and the lower limit of the most preferred narrower range (10 mass%). It is concurred with the findings of T 2/81 that the end-points of the new range now defined being both specifically mentioned in the application as filed, the range defined using the lower limit(s) and the upper limit(s) of those ranges would have been "unequivocally and immediately apparent to the skilled

person" (T 2/81; section 3 of the reasons) i.e. the range now being specified in claim 1 is directly and unambiguously disclosed in the application as filed.

- 3.1.3 It was neither shown nor argued by the respondent that the range of 10-50 mass % now being defined for polyamide (PA-2) in operative claim 1 is in any way special as compared to the range defined in claim 1 as originally filed, which was implicitly limited by the fact that the thermoplastic polyamide composition (a)
- consists of a blend of at least two polyamides comprising (PA-1) and (PA-2);
  - comprises at least 50 mass %, relative to the total mass of the thermoplastic polyamide composition, of (PA-1).

Therefore, there is no evidence on file that the subject-matter now being defined is related to a different invention as compared to the application as filed. The amendment made therefore merely amounts to defining a sub-range by deleting a part of the initial broader range i.e. it is a limitation of the range originally disclosed.

Under those circumstances, although the amendment made amounts to combining the upper limit and the lower limit disclosed in two different ranges originally disclosed in a list of four possible ranges (see section 3.1.1 above), there is no justification for deviating from the general conclusion drawn in T 2/81, which dealt according to the respondent with the combination of only two ranges. That conclusion is in line with accepted case law of the Boards of Appeal see e.g. T 522/96 (section 2.1 of the reasons).

3.2 The respondent considered that the criteria for the assessment of Art. 123(2) EPC had developed since T 2/81 and that the "gold standard" criteria now to be considered was whether or not the amendment made was "directly and unambiguously derivable" from the application as filed, which was allegedly not the case here.

However, it is derivable from section 3 of T 2/81 that the conclusion according to which the amendment made was allowable was arrived at by considering that:

- (a) the new range was "unequivocally and immediately apparent to the person skilled in the art"; and
- (b) the restriction made would not merit novelty as "selection" so that it does not represent any new subject-matter within the meaning of Art. 123(2) EPC.

In the Board's view, above criterion (a) is equivalent to the "gold standard" mentioned by the respondent i.e. it has to be assessed whether the subject-matter now being defined is directly and unambiguously derivable from the application as filed. That that requirement is satisfied in the present case is shown in above section 3.1.2.

Also, above criterion (b) is here satisfied (see section 3.1.3).

For those reasons, the respondent's arguments did not convince.

3.3 Under those circumstances, the subject-matter now being defined in operative claim 1 does not extend beyond the content of the application as filed and satisfies the

- requirements of Art. 123(2) EPC.
- 3.4 No further objection was raised by the respondent in respect of the main request. The Board is also satisfied that claims 2-13 meet the requirements of Art. 123(2) EPC.
4. As confirmed during the oral proceedings before the Board, no objection pursuant to Art. 84 EPC was raised by the respondent.
5. Art. 54 EPC
- 5.1 During the oral proceedings before the Board, the appellant's argument according to which neither the blend of two polyamides disclosed in example III of D1 or that of example 1 of D38 comprised a polyamide (PA-2) as defined in feature a.2 of operative claim 1 in an amount of 10-50 mass% was not contested by the respondent.
- 5.2 The Board sees no reason to deviate from that view because:
- (a) The Board concurs with the opposition division's finding, which was not disputed by the parties, according to which Example III of D1 deals with the preparation of a polyamide blend comprising a first polyamide "PA-4,6" corresponding to component (PA-1) of operative claim 1 and a second polyamide "PA-6-No.2" corresponding to component (PA-2) of operative claim 1 (section 6.1 of the contested decision; second paragraph). It is further derivable from the amounts of the components making up the composition of example III of D1 reported in Table 3 of D1 that

the amount of polyamide "PA-6-No.2" is clearly below 10 mass % relative to the total mass of the thermoplastic polyamide composition i.e. outside the range now defined in feature a.2 of claim 1 in respect of the second polyamide (PA-2);

(b) The respondent's novelty objection in respect of D38 was based on the argument that the composition of example 1 of D38 was as follows:

PA66	93,5 Gew.-%
PA6 (Nylon 6)	5,81 Gew.-%
Cul	0,0198 Gew.-%
FeO	0,0135 Gew.-%
Elvamid	0,23 Gew.-%
Kanalruß	0,01 Gew.-%
Titandioxid	0,17 Gew.-%
Antimonchrom-Titanat	0,135 Gew.-%
<u>KBr</u>	<u>0,104 Gew.-%</u>
Gesamt-Formmasse	99,99 Gew.-%

in which, as shown by the DSC data of D39, PA 66 and PA6 correspond to components (PA-1) and (PA-2) as defined in features a.1 and a.2, respectively, of operative claim 1. However, according to that argumentation, component (PA-2) is present in a lower amount (5.81 mass %) than that defined in operative claim 1 (10-50 mass %).

5.3 For those reasons, the main request fulfils the requirements of Art. 54 EPC.

6. Remittal

The issue of inventive step was not addressed in the contested decision. In that respect, it is conspicuous that the respondent's argumentation submitted in

section 1.3.1 of its rejoinder to the statement of grounds of appeal dated 18 December 2012 is based on documents and pieces of evidence (designated D40 and D41) which were relied upon for the first time on appeal. Further considering that both parties requested remittal to the first instance to deal with inventive step, it is appropriate to remit the case to the department of first instance for further prosecution for dealing with that issue (Art. 111(1) EPC).

## 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 with respect to the requirements of Art. 56 EPC on the basis of the main request filed with letter dated 20 August 2015.

The Registrar:

The Chairman:



B. ter Heijden

M. C. Gordon

Decision electronically authenticated