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**Datasheet for the decision
of 13 April 2016**

Case Number: T 1587/13 - 3.3.01

Application Number: 04803537.2

Publication Number: 1692144

IPC: C07F17/00, C08F210/06

Language of the proceedings: EN

Title of invention:

ORGANOMETALLIC TRANSITION METAL COMPOUND, BISCYCLOPENTADIENYL
LIGAND SYSTEM, CATALYST SYSTEM AND PREPARATION OF POLYOLEFINS

Patent Proprietor:

Basell Polyolefine GmbH

Opponent:

Borealis AG

Headword:

Unsymetric metallocenes/BASELL

Relevant legal provisions:

EPC Art. 123(3), 123(2)

Keyword:

Appellant 2 adversely affected by decision under appeal (yes)
Main request: Amendments - broadening the scope of the claims
as granted (yes)
First and fourth auxiliary requests: Amendments - added
subject-matter (yes)

Decisions cited:

G 0001/88, T 0288/92, T 0859/94, T 0967/98, T 0801/02,
T 0902/02, T 0708/07, T 1297/11

Catchword:



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Case Number: T 1587/13 - 3.3.01

D E C I S I O N
of Technical Board of Appeal 3.3.01
of 13 April 2016

Appellant 1:
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Decision under appeal:

**Interlocutory decision of the Opposition
Division of the European Patent Office posted on
2 May 2013 concerning maintenance of the
European Patent No. 1692144 in amended form.**

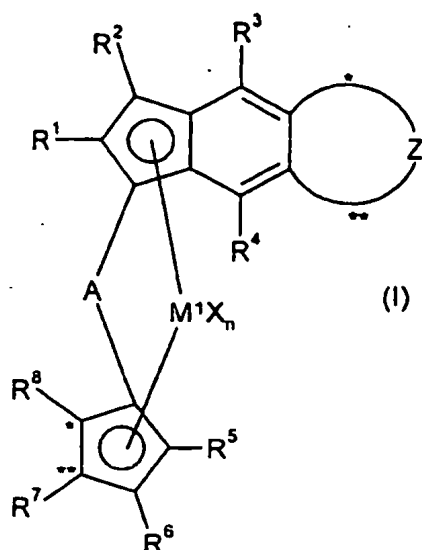
Composition of the Board:

Chairman	A. Lindner
Members:	G. Seufert
	O. Loizou

Summary of Facts and Submissions

- I. The patent proprietor (appellant 1) and the opponent (appellant 2) respectively lodged an appeal against the interlocutory decision of the opposition division on the amended form in which the European patent No. 1 692 144 could be maintained.
- II. The patent was granted on the basis of 11 claims, with claims 1 and 5 reading as follows:

"1. An organometallic transition metal compound of the formula (I)



where

M^1 is an element of group 3, 4, 5 or 6 of the Periodic Table of the Elements or the lanthanides,
 the radicals X are identical or different and are each an organic or inorganic radical, with two radicals X also being able to be joined to one another,
 n is a natural number from 1 to 4,
 Z is a divalent organic group which has from 1 to 40 carbon atoms and together with the two carbon atoms of

the indenyl system forms a saturated or unsaturated, substituted or unsubstituted ring system having a ring size of from 4 to 12 atoms, where Z within the ring system fused to the indenyl system may also contain one or more, identical or different heteroatoms selected from the group consisting of Si, Ge, N, P, O, S, Se and Te,

R¹ is hydrogen or an organic radical having from 1 to 40 carbon atoms,

R² is hydrogen,

R³ is hydrogen, halogen or an organic radical having from 1 to 40 carbon atoms,

R⁴ is hydrogen, halogen or an [sic] organic radical having from 1 to 40 carbon atoms,

R⁵ is hydrogen or an organic radical having from 1 to 40 carbon atoms,

R⁶ is hydrogen,

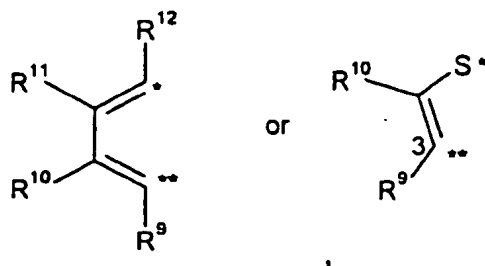
R⁷ R³ [sic] are identical or different and are each hydrogen or an organic radical having from 1 to 40 carbon atoms or R⁷ and R⁸ together with the atoms connecting them form a monocyclic or polycyclic, substituted or unsubstituted ring system which has from 1 to 40 carbon atoms and may also contain heteroatoms selected from the group consisting of the elements Si, Ge, N, P, O, S, Se and Te,

A is a bridge consisting of a divalent atom or a divalent group,

and

if R³ is hydrogen, then R⁵ is an organic radical which has from 3 to 20 carbon atoms and is branched in the a position."

"5. An organometallic transition metal compound of the formula (I) as claimed in any of claims 1 to 4 in which R⁷, R⁸ together form



where

R⁹, R¹⁰, R¹¹ and R¹² are identical or different and are each hydrogen, halogen or an organic radical having from 1 to 40 carbon atoms or two adjacent radicals R⁹, R¹⁰ and/or R¹¹ together with the atoms connecting them form a monocyclic or polycyclic, substituted or unsubstituted ring system which has from 1 to 40 carbon atoms and may also contain heteroatoms selected from the group consisting of the elements Si, Ge, N, P, O, S, Se and Te, and

A is a substituted silylene group or a substituted or unsubstituted ethylene group,

and

the other variables and indices are as defined for the formula (I)."

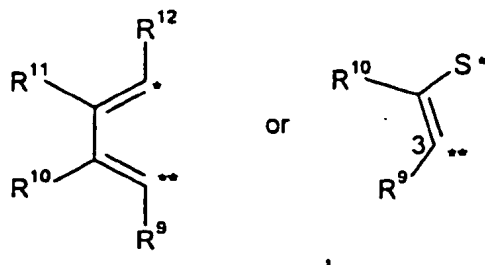
- III. Notice of opposition was filed by appellant 2 requesting revocation of the patent in suit, in its entirety, on the grounds of lack of novelty, lack of inventive step and insufficiency of disclosure (Article 100(a) and (b) EPC).
- IV. The decision under appeal is based on an amended main request and amended second to fourth auxiliary requests. No first auxiliary request had been filed (see page 2, paragraph 9, of the decision under appeal).

The main request was held to contravene Article 123(3) EPC. According to the opposition division, the definition of the substituents R⁷ and R⁸ in formula (I) of amended claim 1 was broader than the definition in the claims as granted. The second and third auxiliary requests were found to contravene Article 123(2) EPC because the definitions of the various substituents in formula (I) had been arbitrarily selected and combined. The fourth auxiliary request was held to comply with the requirements of the EPC. With regard to Article 123(2) EPC, the division took the view that the definitions of the substituents in formula (I) were based on the most preferred definitions mentioned in the application as filed.

V. With the statement of grounds of appeal appellant 1 filed a main request and first to fourth auxiliary requests. The second and third auxiliary requests were subsequently withdrawn (see point IX below).

Claim 1 of the main request differs from claim 1 as granted in that the substituents R⁷ and R⁸ in formula (I) are defined as follows:

"R⁷ ad [sic] R⁸ together form:



Wherein R⁹, R¹⁰, R¹¹ and R¹² are identical or different and are each hydrogen, halogen, or an organic radical having

from 1 to 40 carbon atoms, or two adjacent radicals R⁹, R¹⁰ together with the atoms connecting them form a monocyclic or polycyclic, substituted or unsubstituted ring system which has from 1 to 40 carbon atoms and may also contain heteroatoms selected from the group consisting of the elements Si, Ge, N, P, O, S, Se and Te;"

In claim 1 of the first auxiliary request, the definitions of the substituents M¹, n, R¹, R³, R⁴, R⁵, R⁹, R¹⁰, R¹¹, R¹² and A (i. e. all substituents except X, Z, R² and R⁶) in formula (I) have been restricted as compared to the main request. They read as follows:

"M¹ is Ti, Zr or Hf,

n is 2,

R¹ is hydrogen or an organic radical which has from 1 to 20 carbon atoms and is unbranched in the α position,

R³ is a substituted or unsubstituted C₆-C₄₀-aryl radical,

R⁴ is hydrogen, fluorine, C₁-C₁₀ alkyl, a substituted or unsubstituted C₆-C₄₀-aryl radical or a C₂-C₄₀-heteroaromatic radical containing at least one heteroatom selected from the group consisting of O, N, S and P,

R⁵ is an organic radical which has from 3 to 20 carbon atoms and is branched in the α position,

R⁹, R¹⁰, R¹¹ and R¹² are identical or different and are each hydrogen, halogen or an organic radical having from 1 to 40 carbon atoms,

A is a substituted silylene group or a substituted or unsubstituted ethylene group."

In claim 1 of the fourth auxiliary request, the substituents X, A, R¹, R³, R⁴, Z, R⁵, R⁹, R¹⁰, R¹¹ and

R¹² have been further amended compared to the first auxiliary request and are defined as follows:

"X is selected from the [sic] group consisting of halogen, hydrogen, C₁-C₄-alkyl group;

A is selected from the group consisting of:

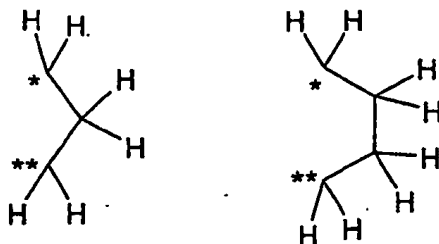
dimethylsilanediyl, methylphenylsilanediyl, diphenylsilanediyl, dimethylgermanediyl, ethylidene, 1-methylethylidene, 1,1-dimethylethylidene, 1,2-dimethylethylidene, 1,1,2,2-tetramethylethylidene, dimethylmethylidene, phenylmethylmethylidene and diphenylmethylidene, in particular dimethylsilanediyl, diphenylsilanediyl and ethylidene;

R¹ is selected from the group consisting of methyl, ethyl, n-propyl, n-butyl, n-pentyl, n-hexyl, benzyl and 2-phenylethyl, in particular methyl, ethyl, n-propyl and n-hexyl;

R³ is selected from the group consisting of phenyl, 2-tolyl, 3-tolyl, 4-tolyl, 2,3-dimethylphenyl, 2,4-dimethylphenyl, 2,5-dimethylphenyl, 2,6-dimethylphenyl, 3,4-dimethylphenyl, 3,5-dimethylphenyl, 3,5-di(tert-butyl)phenyl, 2,4,6-trimethylphenyl, 2,3,4-trimethylphenyl, 1-naphthyl, 2-naphthyl, phenanthrenyl, p-isopropylphenyl, p-tert-butylphenyl, p-s-butylphenyl, p-cyclohexylphenyl and p-trimethylsilylphenyl;

R⁴ is selected from the [sic] group consisting of hydrogen, methyl, ethyl, isopropyl, n-butyl, n-hexyl, cyclohexyl, phenyl, 2-tolyl, 3-tolyl, 4-tolyl, 2,3-dimethylphenyl, 2,4-dimethylphenyl, 2,5-dimethylphenyl, 2,6-dimethylphenyl, 3,4-dimethylphenyl, 3,5-dimethylphenyl, 3,5-di(tert-butyl)phenyl, 2,4,6-trimethylphenyl, 2,3,4-trimethylphenyl, 1-naphthyl, 2-naphthyl, phenanthrenyl, p-isopropylphenyl, p-tert-butylphenyl, p-s-butylphenyl, p-cyclohexylphenyl or p-trimethylsilylphenyl;

Z is



;

R⁵ is selected from the group consisting of isopropyl, 1-methylpropyl, 1-methylbutyl, 1-ethylbutyl, 1-methylpentyl and cyclohexyl;

The radical R⁹ is selected from the group consisting of phenyl, 2-tolyl, 3-tolyl, 4-tolyl, 2,3-dimethylphenyl, 2,4-dimethylphenyl, 2,5-dimethylphenyl, 2,6-dimethylphenyl, 3,4-dimethylphenyl, 3,5-dimethylphenyl, 3,5-di(tert-butyl)phenyl, 2,4,6-trimethylphenyl, 2,3,4-trimethylphenyl, 1-naphthyl, 2-naphthyl, phenanthrenyl, p-isopropylphenyl, p-tert-butylphenyl, p-s-butylphenyl, p-cyclohexylphenyl and p-trimethylsilylphenyl;

R¹⁰, R¹¹ and R¹² are each hydrogen;"

The fourth auxiliary request is identical to the fourth auxiliary request underlying the decision under appeal.

- VI. In its statement of grounds of appeal, appellant 2 raised objections of added matter, lack of inventive step and insufficiency of disclosure against the fourth auxiliary request underlying the decision under appeal.
- VII. In its reply to the statement of grounds of appeal by appellant 2, appellant 1 objected to the admissibility of appellant 2's appeal.
- VIII. In its reply to the statement of grounds of appeal of appellant 1, appellant 2 raised various objections

under Articles 123(3), 123(2), 54, 56 and/or 83 against the main request and first to third auxiliary requests.

IX. At the oral proceedings, appellant 1 withdrew the second and third auxiliary requests (see point V above).

X. The arguments of appellant 1, insofar as they are relevant for the decision, can be summarised as follows:

- Admissibility of appellant 2's appeal

As is apparent from the minutes (see point 3) and the decision under appeal (see pages 23 and 25, points 12.2 and 13.10), appellant 2 had no objections against the fourth auxiliary request during the oral proceedings before the opposition division. It was therefore not adversely affected by the decision under appeal and its appeal should be considered as inadmissible.

- Amendments (Article 123(3) EPC)

For compliance with Article 123(3) EPC, all claims had to be considered. The definition of the substituents R⁷ and R⁸ was already present in claim 5 as granted, which could be considered as an independent claim and covered the group of claim 1 of the main request when read in combination with claim 1 as granted. The limitation with respect to the substituent A could be disregarded because this substituent was not closely associated with the other substituents of claim 5. The amendment concerning the substitution of the ring system restricted the scope of claim 5 as granted and therefore could not contravene Article 123(3) EPC.

- Amendments (Article 123(2) EPC)

Claim 1 of the first auxiliary request found its basis in the combined reading of claims 1, 2, 3, 4 and 5 as originally filed. It was recognized that the definition of R⁷ and R⁸ in claim 5 was inconsistent with the definition given in claim 3. However, since claim 5 referred to any of the preceding claims 1 to 4, the definition of R⁷ and R⁸ in claim 5 superseded any previously mentioned definition. For the same reason, it could also be combined with all the definitions present in the preceding claims.

The definition of each of the substituents of claim 1 of the fourth auxiliary request had a basis in the application as filed. The definition of R¹⁰ to R¹² as hydrogen was disclosed in the examples. Since all substituents were independent, they could be readily combined. Furthermore, all selections had been made to limit the scope of the claims of the patent in suit.

XI. The arguments of appellant 2, insofar as they are relevant for the decision, can be summarised as follows:

- Admissibility of appellant 2's appeal

The statement in point 2 of the minutes of the oral proceedings before the opposition division was not an indication that appellant 2 had withdrawn its opposition, or an admission that the fourth auxiliary request was allowable. Appellant 2's position on added matter was clear from the discussion of the preceding requests, in particular the third auxiliary request. It was therefore not necessary to repeat the arguments. At no point in time had appellant 2 dropped its objections

under Article 123(2) EPC. This was confirmed by the minutes (see point 1) and the decision under appeal. Appellant 2 was therefore adversely affected by the decision of the opposition division and entitled to appeal.

- Amendments (Article 123(3) EPC)

Claim 5 as granted was a dependent claim to which the limitation according to claim 1 as granted applied, namely that the ring system formed by the substituents R⁷ and R⁸ did not contain more than 40 carbon atoms. Since claim 1 of the main request did not contain this limitation, its scope was broader than claim 5 as granted. Furthermore, claim 5 as granted required a particular substituent A which was also not present in claim 1 of the main request.

- Amendments (Article 123(2) EPC)

Claim 1 of the first auxiliary request was not merely a combination of claims 1, 2, 3, 4 and 5 of the application as originally filed, but contained further amendments in that the limitation with respect to the substituents R⁷ and R⁸, which is present in claim 3 as originally filed, had been removed. There was no basis for such an amendment in the application as originally filed. If, contrary to the wording, the back reference in claim 5 as originally filed was invalid and the claim had to be considered as an independent claim, then there was no basis for a combination with any of the claims referred to.

Claim 1 of the fourth auxiliary request was the result of numerous selections of embodiments from multiple lists to create a disclosure, which was not present in

the application as originally filed. The selection of R¹⁰, R¹¹ and R¹² as hydrogen alone was the result of a selection from three lists. The examples, which were relied on to justify this amendment, were specific embodiments and could not be used as a basis for amendments in generically defined claims. Furthermore, the opposition division's statement that R¹¹ to R¹² were hydrogen in all examples was not correct.

- XII. The patent proprietor requested that the decision under appeal be set aside and the patent be maintained on the basis of the main request, or alternatively on the basis of one of the first and the fourth auxiliary requests, all requests filed with the statement of grounds of appeal. In addition, it requested that the appeal of appellant 2 be held inadmissible.
- XIII. The opponent requested that the decision under appeal be set aside and the patent be revoked in its entirety.
- XIV. At the oral proceedings, the decision of the board was announced.

Reasons for the Decision

- 1. Admissibility of the appeals
 - 1.1 The appeal by appellant 1 is admissible. This was not contested.
 - 1.2 The admissibility of the appeal by appellant 2 was challenged by appellant 1 (see point X above). In support of its argument, appellant 1 relied on the minutes of the oral proceedings held before the opposition division. In point 3 of the minutes it was

stated that the opponent declared "that he wishes not to put forward any arguments against this request in respect of Arts. 123(2), 83, 56, 54(1) and (2)".

- 1.3 A party is adversely affected within the meaning of Article 107 EPC if the decision fails to meet that party's request. In the notice of opposition, appellant 2 requested revocation of the patent in its entirety. It is clear from the minutes (see point 1) that appellant 2 maintained this request. Accordingly, by deciding that the patent could be maintained in amended form, namely on the basis of the fourth auxiliary request, the division did not fully meet appellant 2's request for revocation of the patent in suit. Appellant 2 was therefore adversely affected by the decision.
- 1.4 In the board's judgment, the fact that appellant 2 did not present arguments on the fourth auxiliary request cannot be construed as a clear indication of the withdrawal of its request for revocation of the patent. According to established jurisprudence of the boards of appeal, such a withdrawal cannot simply be presumed, but requires an explicit statement (cf. G 1/88, point 2 of the Reasons, T 708/07, point 1 of the Reasons, T 967/98, point 1.1 of the Reasons).
- 1.5 Moreover, appellant 2 argued that by the time the fourth auxiliary request was considered, the compliance of the preceding requests with the requirements of Article 123(2) and (3) EPC had already been extensively discussed. Appellant 2 had objected to the amendments made in these requests, in particular to the numerous selections made in the third auxiliary request. Since the fourth auxiliary request contained further selections, the arguments with regard to the previous

requests continued to apply and there was no need to repeat them. This, however, did not mean that appellant 2 had no objections under Article 123(2) EPC.

1.6 The board has no reason to doubt appellant 2's account of the course of events. Point 2 of the minutes confirms that appellant 2 raised objections under Article 123(2) EPC against the main request and the second and third auxiliary requests. As is apparent from the decision, the opposition division concurred with appellant 2's position with respect to the second and third auxiliary requests (see decision under appeal, pages 11 to 13, point 7, and pages 16 to 17, point 9). Furthermore, the board notes that, contrary to the statements on pages 23 and 25 of the decision under appeal (see points 12.2 and 13.10) indicating that appellant 2 had no objections when the issues of novelty or inventive step were addressed, no such statement can be found with respect to Article 123(2) EPC. Hence, the board can only conclude that the division was well aware of the fact that appellant 2 had indeed objections under Article 123(2) EPC against the fourth auxiliary request. Therefore, appellant 2 was adversely affected by the decision of the opposition division and entitled to appeal.

1.7 The decision T 1297/11, relied on by appellant 1 in support of its arguments, is not relevant. In this decision, the appellant opponent had declared in the oral proceedings before the opposition division that it dropped its objection on novelty. The opposition division understood this declaration as withdrawal of the objection and did not decide on novelty. The board agreed with the division and held that with its declaration, the opponent expressly renounced its

challenge to the patent on the ground of lack of novelty.

In the present case, neither the minutes nor the decision under appeal support the presumption that appellant 2 had withdrawn its objections under Article 123(2) EPC against the fourth auxiliary request.

- 1.8 For the aforementioned reasons, the board concludes that the appeal of appellant 2 is admissible.

Main request

2. Amendments (Article 123(3) EPC)

2.1 Claim 1 of the main request has been amended compared to claim 1 as granted in that the substituents R⁷ and R⁸ in formula (I) in combination with the carbon atoms to which they are attached form a particular ring system (see point V above). The definition of this ring system - except for a minor restriction concerning its substitution - is disclosed in claim 5 as granted. This was uncontested.

2.2 However, the parties were divided as to the status and consequently the scope of claim 5 as granted. According to appellant 2, claim 5 as granted was a dependent claim. Therefore, the ring system formed by R⁷ and R⁸, including the substituents R⁹, R¹⁰, R¹¹ and R¹², could not contain more than 40 carbon atoms in accordance with the definition of R⁷ and R⁸ in independent claim 1 as granted (see point II above). Appellant 1 considered claim 5 as granted to be an independent claim, to which the limitation with regard to the number of carbon atoms, as defined in claim 1 as granted, did not apply.

The amendment concerning the substitution of the ring system restricted the scope of claim 5 as granted and therefore could not contravene Article 123(3) EPC.

2.3 In the board's judgement, the amendment in claim 1 of the main request broadens the scope of the claims as granted, irrespective of the status of claim 5 as granted for the following reasons:

2.3.1 The board concurs with appellant 2 in that according to claim 1 as granted the ring system which can be formed by substituents R^7 and R^8 does not contain more than 40 carbon atoms. Claim 1 of the present main request encompasses ring systems formed by R^7 and R^8 which can contain far more than 40 carbon atoms, since each of the substituents R^9 , R^{10} , R^{11} and R^{12} can have up to 40 carbon atoms. The scope of claim 1 of the main request is therefore clearly broader than the scope of claim 1 as granted.

2.3.2 Claim 5 as granted is directed to compounds having the particular ring system of claim 1 of the main request (i.e. a ring system which may contain far more than 40 carbon atoms), however, only in combination with a specific substituent A. The latter is defined as a substituted silylene group or a substituted or unsubstituted ethylene group (see point II above). Therefore, even if claim 5 as granted were to be considered as an independent claim to which the limitation with respect to the number of carbon atoms does not apply, it does not encompass compounds where A is any divalent atom or divalent group as defined in claim 1 of the main request.

2.4 It follows from the above that claim 1 of the main request encompasses compounds, which are neither

covered by claim 1 as granted nor by claim 5 as granted. Hence, the board concludes that the amendments in claim 1 of the main request extends the scope of protection conferred by the claims as granted and therefore contravenes Article 123(3) EPC.

First auxiliary request

3. Amendments (Article 123(2) EPC)

3.1 Claim 1 of the first auxiliary request has been amended by introducing specifically selected definitions for each of the substituents in formula (I) (see point V above).

3.2 According to appellant 1, the subject-matter of claim 1 of the first auxiliary request has its basis in the combined reading of claims 1, 2, 3, 4 and 5 as originally filed.

3.3 The board does not agree, particularly in view of the inconsistent definition of the substituents R^7 and R^8 in claims 3 and 5 as originally filed.

Claim 3 discloses the presently claimed definitions of the substituents R^2 , R^3 , R^4 and R^6 in combination with a particular definition of R^7 and R^8 , namely a "divalent organic group T **having from 1 to 40 carbon atoms** where T together with the two carbon atoms of the cyclopentadienyl ring forms a saturated or unsaturated, substituted or unsubstituted ring system which has a ring size of from 5 to 7 atoms... ". This definition is clearly inconsistent with the corresponding definition of the substituents R^7 and R^8 in claim 5, where the number of carbon atoms can be considerably higher in view of the definition of R^9 to R^{12} , each of which may

have up to 40 carbon atoms. In these circumstances, the board is of the opinion that the skilled reader would primarily rule out reading claims 3 and 5 in combination, irrespective of the general reference in claim 5 to any of claims 1 to 4, or, as argued by appellant 2, in due consideration of said reference, he would consider the limitation with respect to the ring system formed by R^7 and R^8 to apply to a combination of claims 3 and 5. A group of compounds, as claimed in claim 1 of the first auxiliary request, with R^7 and R^8 as defined in claim 5 and R^2 , R^3 , R^4 and R^6 as defined in claim 3 is therefore not directly and unambiguously derivable from the claims as originally disclosed.

Appellant 1's argument that the definition of R^7 and R^8 in claim 3 as originally filed can simply be ignored and replaced by a definition, which is essentially inconsistent with the previous definition, cannot be accepted, unless there is a clear basis for such an understanding in the description of the application as originally filed. However, no such group of compounds is disclosed anywhere in the description as originally filed.

- 3.4 Hence, the board concludes that the subject-matter of claim 1 of auxiliary request 1 is not clearly and unambiguously derivable from the application as filed. Claim 1 therefore extends beyond the content of the application as originally filed, contrary to Article 123(2) EPC.

Fourth auxiliary request (identical to the request that the opposition division considered to meet the requirement of the EPC)

4. Amendments (Article 123(2) EPC)

4.1 Claim 1 of the fourth auxiliary request has been amended by selecting, amongst others, a specific meaning (i.e. hydrogen) from a list of meanings for each of the substituents R^{10} , R^{11} and R^{12} . As correctly observed by the opposition division, there is no explicit disclosure in the application as filed indicating that each of the substituent R^{10} , R^{11} or R^{12} , is hydrogen. According to claim 5 as originally filed, the substituents R^9 to R^{12} are **identical or different and are each hydrogen, halogen or an organic radical having from 1 to 40 carbon atoms**. The same disclosure is to be found on page 9, lines 28 to 30 of the description as originally filed. In the board's judgement, the selection that each of the substituents R^{10} , R^{11} and R^{12} is hydrogen amounts to an inadmissible singling out of a specific sub-group, which is not disclosed as such by the application as originally filed (see T 801/02; point 2.2.1 of the Reasons; T 859/94, point 2.4.3 of the Reasons).

4.2 In the decision under appeal, the opposition division considered that the amendment with respect to the substituents R^{10} to R^{12} had a basis in the examples of the application as filed, which all shared this particular feature.

4.3 The board notes that in example 7 the substituent R^{10} is methyl, not hydrogen. Moreover, in examples 1 to 6, in which R^{10} , R^{11} , R^{12} are hydrogen, the substituent A is dimethylsilanediyl, the substituent M^1X_n is $ZrCl_2$, the substituent R^1 is methyl, the substituent R^5 is isopropyl and the substituents R^3 and R^9 are specifically substituted phenyl groups. From these examples, the skilled person derives nothing more than

the bare disclosure of the structural elements in their particular combinations. Taking the meaning "R¹⁰ to R¹² equal to hydrogen" out of the only context in which it is disclosed in the application as filed (namely the individual compounds in examples 1 to 6 with their specific substitution pattern) and combining it with the general definitions of the substituent A, M¹X_n, R¹, R³, R⁵ and R⁹ according to claim 1 of the fourth auxiliary request, creates a new group of compounds. The skilled person is thus provided with technical information that is not directly and unambiguously disclosed in the application as filed.

- 4.4 According to appellant 1, the selected definitions of each of the substituents in claim 1 of the fourth auxiliary request had a basis in the application as filed. All substituents were independent from each other and could therefore be readily combined. Moreover, all selections were made to limit the scope of the claims as granted and therefore could not contravene Article 123(2) EPC.
- 4.5 The board does not agree. As set out in points 4.1 and 4.3 above, there is no disclosure of a group of compounds of the general formula (I) with R¹⁰, R¹¹ and R¹² being hydrogen. Appellant 1's argument that the selected definitions for all substituents had a basis in the application as filed, is therefore not accepted. Furthermore, the board also notes that according to established jurisprudence of the boards of appeal, the content of an application cannot be considered as a reservoir from which features pertaining to different embodiments can be arbitrarily combined in order to artificially create a particular embodiment. In the present case, claim 1 of the fourth auxiliary request is the result of a combination of definitions of

substituents in formula (I), which have been picked from numerous options disclosed for each individual substituent. In the board's judgment, for such a claim it is not sufficient to provide a basis for each individual feature alone, but rather to provide a clear and unambiguous disclosure for the combination of the selected definitions. In this context, the board notes that the application as filed describes certain groups of compounds on page 13, line 11 to page 15, line 20, none of which, however, discloses a group of compounds having the particular combination of substituents as defined in claim 1 of the fourth auxiliary request.

Decision T 902/02, to which appellant 1 referred, is not considered to be relevant in the present case. The amendment in the case underlying said decision was the result of a selection from a **single** list of explicitly disclosed equivalent alternatives. In the present case, there are numerous selections from various lists including the triple selection that each of R^{10} , R^{11} and R^{12} is hydrogen.

- 4.6 The board also does not accept appellant 1's argument that merely because the amendment restricted the scope of the claims it was admissible under Article 123(2) EPC. Article 123(2) EPC prohibits amendments which generate "subject-matter that extends beyond the content of the application as originally filed". Thus, the introduction of any technical information - in the present case the creation of a new sub-group - that a skilled person would not have objectively and unambiguously derived from the application as filed, even if it results in a restriction, is prohibited (see decision T 288/92, point 3.1 of the Reasons).

4.7 For the reasons mentioned above, the board concludes that claim 1 of the fourth auxiliary request has been amended in such a way that its subject-matter extends beyond the content of the application as originally filed, contrary to Article 123(2) EPC.

Order

For these reasons it is decided that:

1. The decision under appeal is set aside.
2. The patent is revoked.

The Registrar:

The Chairman:



M. Schalow

A. Lindner

Decision electronically authenticated