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Datasheet for the decision of 26 November 2018

Case Number: T 0592/15 - 3.3.05

Application Number: 07813483.0

Publication Number: 2046575

IPC: C01D7/00

Language of the proceedings: EN

Title of invention:
POLYMERIC CORE-SHELL NANOPARTICLES WITH INTERPHASE REGION

Applicant:
Bridgestone Corporation

Headword:
Polymeric core-shell nanoparticles/BRIDGESTONE

Relevant legal provisions:
EPC Art. 76(1)
EPC R. 36(1), 43(2)(c)
RPBA Art. 13(1), 13(3)

Keyword:
Oral proceedings - held in absence of appellant
Main and auxiliary requests include three independent method claims - appellant's burden to show compliance with Rule 43(2) EPC (yes)
Late-filed requests - introduce new objections (yes) - admitted (no)
Request to postpone the taking of the decision on the allowability of the appeal at least until a divisional application is filed (refused)

Decisions cited:
G 0004/98, J 0005/08, T 0056/01, T 0502/02, T 1388/10

Catchword:
A request to postpone the taking of the decision on the allowability of an appeal at least until a divisional application is filed would oblige a board to examine questions outside of the framework of the appeal concerned and is therefore to be refused (see Reasons 4 to 4.5).

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Case Number: T 0592/15 - 3.3.05

D E C I S I O N
of Technical Board of Appeal 3.3.05
of 26 November 2018

Appellant: (Applicant)	Bridgestone Corporation 10-1, Kyobashi 1-chome, Chuo-ku Tokyo 104 (JP)
Representative:	Oxley, Robin John George Marks & Clerk LLP 90 Long Acre London WC2E 9RA (GB)
Decision under appeal:	**Decision of the Examining Division of the European Patent Office posted on 8 September 2014 refusing European patent application No. 07813483.0 pursuant to Article 97(2) EPC.**

Composition of the Board:

Chairman	G. Glod
Members:	A. Haderlein
	O. Loizou

Summary of Facts and Submissions

I. The appellant (applicant) lodged an appeal against the decision of the examining division to refuse application No. 07 813 483.

II. The application was filed as an International application. The application as published comprised three independent method claims (claims 19, 39 and 40). In the European search opinion, the claims then on file were objected to under Rule 43(2) EPC for containing three independent method claims. After the issuance of the European search opinion, all claim sets submitted by the applicant during the examination phase contained only one independent method claim.

III. The examining division held that all requests underlying the impugned decision lacked novelty or inventive step. All requests underlying the decision under appeal comprised only one independent method claim.

IV. With the grounds of appeal, the appellant submitted a main request and an auxiliary request, both requests only containing one independent method claim.

V. The appellant was summoned to oral proceedings.

VI. In a communication pursuant to Article 15(1) RPBA, the board *inter alia* raised objections under Article 123(2) EPC and under Article 83 EPC with respect to the subject-matter of the independent method claim.

VII. With letter dated 26 October 2018, the appellant submitted a main request and first and second auxiliary requests. All requests comprised three independent

method claims.

VIII. By letter dated 22 November 2018, the appellant informed the board that it would not attend the oral proceedings. The letter also contains the following passage:

"You are advised that it is intended to file a divisional application based upon the present application and it is requested that the present application be maintained pending until the divisional application has been filed".

IX. Oral proceedings were held on 26 November in the absence of the appellant. At the end of the oral proceedings the chairman announced the decision.

X. The wording of the three independent method claims contained in the main request is as follows:

"7. A method of making a polymeric nanoparticle, comprising:
a first polymerization comprising polymerizing at least one shell monomer to form a shell;
attaching to the shell a core and an interphase region by a second polymerization comprising copolymerizing at least one core monomer different than the at least one shell monomer and at least one crosslinking agent in the presence of the shell; and,
crosslinking at least the core with the at least one crosslinking agent, thereby forming the polymeric nanoparticle;
wherein the interphase region separates and connects the core and the shell;
wherein:
the polymeric nanoparticle is produced with a

relatively thick interphase region between the core and tapered shell that possesses a gradient in glass transition temperature, through the simultaneous addition of alkenylbenzene units and divinylbenzene without the use of a randomizer."

"12. A method of making a polymeric nanoparticle comprising polymerizing conjugated diene monomers in the presence of at least one anionic initiator to form the shell;
attaching to the shell a core and an interphase region by copolymerizing alkenylbenzene monomer and a divinylbenzene mixture in the presence of the shell; and
crosslinking at least the core is with the divinylbenzene mixture to form the polymeric nanoparticle;
wherein the interphase region connects and separates the core and the shell and has a greater crosslinking density than the core, and wherein the divinylbenzene mixture comprises para-divinylbenzene and at least one benzene chosen from ortho-divinylbenzene, meta-divinylbenzene, ortho-ethylvinylbenzene, meta-ethylvinylbenzene, and para-ethylvinylbenzene."

"13. A method of making a polymeric nanoparticle comprising emulsion polymerization of at least one core monomer in the presence of at least one crosslinking agent to form a core;
surface-grafting onto the crosslinked core an interphase region and a shell by polymerization of at least two monomers in the presence of the core."

XI. The first and the second auxiliary requests also comprise the same method claims as the main request.

XII. The appellant's arguments, as far as relevant to the present decision, may be summarised as follows:

It was appropriate in the present case to include multiple independent method claims, in order to avoid objections of addition of subject-matter and in order to cover the whole scope of the invention as disclosed in the application as filed.

XIII. The appellant requested in writing that the decision under appeal be set aside and that a patent be granted on the basis of the set of claims of the main request or in the alternative of one of auxiliary requests 1 or 2, all requests filed with letter dated 26 October 2018.

Reasons for the Decision

1. The appeal is admissible.

2. *Admissibility of the main, first and second requests*

2.1 These requests were filed after the oral proceedings had been scheduled. Their admittance was therefore at the board's discretion (Article 13(1) and (3) RPBA).

2.2 When exercising their discretion to admit late-filed requests into the proceedings, in particular requests filed after arrangement of oral proceedings, the boards of appeal take into account in particular whether the proposed amendments do not introduce new objections (Case Law of the Boards of Appeal of the EPO, 8th ed., IV.E.4.1.3, second paragraph).

2.2.1 Applying these principles to the present case, the filing of more than one independent method claim is

prima facie objectionable under Rule 43(2) EPC which requires a European patent application to contain only one independent claim in the same category.

2.2.2 Rule 43(2), paragraphs (a), (b) and (c) EPC provide for exceptions to this provision, Rule 43(2)(c) EPC being the only exception that could be relevant in the present case. This provision allows for more than one independent claim in the case of "alternative solutions to a particular problem, where it is inappropriate to cover these alternatives by a single claim".

2.2.3 In the case of more than one independent claim per category, the applicant bears the burden to show that one of the exceptions under Rule 43(2) EPC apply (T 1388/10, Reasons 7.2 and 7.3 citing T 56/01, Reasons 5).

2.2.4 In the case at hand, the appellant has not submitted any argument in support of one of the aforementioned exceptions being applicable. Instead, it submits that it was appropriate to include multiple independent method claims, in order to avoid objections of addition of subject-matter and in order to cover the whole scope of the invention as disclosed in the application as filed. The appellant thus has not discharged its burden to show that one of the exceptions under Rule 43(2) EPC apply.

2.2.5 The board also notes that, while the originally filed claims contain three independent method claims, the appellant chose to restrict the number of independent method claims in reply to the European search opinion and all claims sets filed since then included one independent method claim only (see point II above). The board sees no convincing reason to file additional two

independent method claims only one month before the oral proceedings before the board. Rather, the board considers it inappropriate to react to an objection under Article 123(2) EPC at such a late stage by increasing the number of independent claims in the same category while not even indicating why the subject-matter of the independent claims effectively relates to alternative solutions to a particular problem.

2.3 For the above reasons, the appellant's main, first and second auxiliary claim requests are not admitted into the proceedings.

3. As there is no admissible claim request of the appellant, the appeal is to be dismissed.

4. *The request that the "application be maintained pending until [a] divisional application has been filed"*

4.1 A divisional application in the sense of Article 76(1) EPC can be filed as long as the earlier European patent application is pending (Rule 36(1) EPC). In the case where a decision is taken on the allowability of an appeal, a European patent application is pending at least up to the point in time when the decision is taken (J 5/08, Reasons 20, referring to Rule 25 EPC 1973 corresponding to Rule 36 EPC).

4.2 The board therefore understands the appellant's submissions (see VIII above) to request that the board postpones the taking of the decision on the allowability of the present appeal at least until the appellant has filed a divisional application.

4.3 According to the jurisprudence of the boards of appeal requests and actions obliging a board to examine

questions outside of the framework of the appeal concerned are not admissible and cannot be dealt with in substance within such appeal proceedings (T 502/02, Reasons 1).

4.4 In the case at hand the request to postpone the taking of the decision on the allowability of the appeal at least until a divisional application is filed would require the board to investigate whether the appellant has eventually indeed filed a divisional application and, as the case may be, to even postpone the oral proceedings. The question of whether a divisional application is filed is, however, a question outside of the framework of the present appeal proceedings in particular because the procedure concerning a divisional application and the procedure concerning the parent application are in principle independent (G 4/98, Reasons 5, last paragraph).

Also, the appellant would gain complete control over the duration of the present appeal proceedings including the possibility of having them pending *ad infinitum* if no divisional application was filed at all.

4.5 For the above reasons, the board refuses the appellant's request to postpone the taking of the decision on the allowability of the appeal.

Order

For these reasons it is decided that:

The appeal is dismissed.

The Registrar: The Chairman:

C. Vodz G. Glod

Decision electronically authenticated