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**Datasheet for the decision
of 9 April 2019**

Case Number: T 0021/16 - 3.3.03

Application Number: 11005154.7

Publication Number: 2380929

IPC: C08K9/04, C09C1/02, C09C3/08

Language of the proceedings: EN

Title of invention:
Treated mineral filler product, and its uses

Patent Proprietor:
Omya Development AG

Opponent:
Imerys Minerals Limited

Relevant legal provisions:
RPBA Art. 13(1)
EPC Art. 69(1), 76(1), 123(2), 123(3), 84
EPC R. 80

Keyword:

Late-filed auxiliary requests - admitted (yes)

Claims - clarity - auxiliary request (no)

Amendment occasioned by ground for opposition - amendments allowable (no)

Decisions cited:

G 0001/93, G 0003/14, T 0002/80, T 0993/07, T 0657/11



Beschwerdekammern
Boards of Appeal
Chambres de recours

Boards of Appeal of the
European Patent Office
Richard-Reitzner-Allee 8
85540 Haar
GERMANY
Tel. +49 (0)89 2399-0
Fax +49 (0)89 2399-4465

Case Number: T 0021/16 - 3.3.03

D E C I S I O N
of Technical Board of Appeal 3.3.03
of 9 April 2019

Appellant: Omya Development AG
(Patent Proprietor) Baslerstrasse 42
4665 Oftringen (CH)

Representative: Plougmann Vingtoft a/s
Strandvejen 70
2900 Hellerup (DK)

Respondent: Imerys Minerals Limited
(Opponent 1) Par Moor Centre,
Par Moor Road
Par, Cornwall PL 24 2SQ (GB)

Representative: Haseltine Lake LLP
Bürkleinstrasse 10
80538 München (DE)

Decision under appeal: **Decision of the Opposition Division of the
European Patent Office posted on 19 October 2015
revoking European patent No. 2380929 pursuant to
Article 101(3) (b) EPC.**

Composition of the Board:

Chairman M. C. Gordon
Members: F. Rousseau
C. Brandt

Summary of Facts and Submissions

- I. The appeal lies against the decision of the opposition division posted on 19 October 2015 revoking European patent No. 2 380 929. The decision was based on a main request and auxiliary requests 1 to 5, all submitted with letter of 2 September 2015, as well as on auxiliary requests 6 and 7 submitted during the oral proceedings on 2 October 2015.
- II. Claim 1 of the patent as granted read as follows:
- "1. Mineral Filler Product especially calcium carbonate-comprising mineral fillers (such as precipitated calcium carbonate (PCC), namely one or more of the aragonitic, vateritic and calcitic mineralogical crystal forms, and/or natural ground calcium carbonate (NGCC), namely one or more of marble, limestone, or chalk, and/or dolomite) and/or plate-like minerals (featuring a length to width or length to height ratio of at least 2 as determined according to measurements made on scanning electron microscope (SEM) images), such as talc, characterised in that it has a total volatiles of less than 0.25% by mass, and in that it includes fatty acids in addition to fatty acid salts"
- III. The patent in suit was based on European patent application 11 005 154.7, which was a divisional application of the earlier European patent application 08 737 426.0 (parent application) which was published as EP 2 193 165. Claims 1, 2, 4, 30 and 42 of the parent application read as follows:

"1. A process for the preparation of a treated mineral filler product characterised in that the process comprises the following steps:

(a) treating at least one dry mineral filler with at least one Group II or Group III salt of a C8 to C24 aliphatic monocarboxylic acid to produce an intermediate mineral filler product; followed by
(b) treating the intermediate mineral filler product of step (a) with at least one C8 to C24 aliphatic monocarboxylic acid to produce a treated mineral filler product.

2. The process according to claim 1, characterised in that it is adapted to provide a treated mineral filler product featuring a total volatiles between 25 and 300 °C of less than 0.25 %, and preferably of less than 0.23 % by mass.

4. The process according to claim 3, characterised in that the calcium carbonate-comprising mineral fillers are precipitated calcium carbonate (PCC), namely one or more of the aragonitic, vateritic and calcitic mineralogical crystal forms, and/or natural ground calcium carbonate (NGCC), namely one or more of marble, limestone, or chalk, and/or dolomite.

30. The process according to any of claims 1 to 29, characterised in that the total aliphatic carboxylic acid(s) and aliphatic carboxylic acid salt(s) added during the process of the invention is of 0.2 to 8, preferably of 0.6 to 5, and most preferably of 3 to 4 mg of total aliphatic carboxylic acid(s) and aliphatic carboxylic acid salt(s)/m² mineral filler(s).

42. Product characterised in that it is obtained by a process according to any of claims 1 to 41."

IV. The reasons for the contested decision which are of relevance for the appeal proceedings can be summarized as follows:

The process disclosed in the parent application as filed implied the presence of a double coating on the filler, comprising a first layer of certain fatty acid salts and a second layer of certain fatty acids. Since claim 1 of the main request did not contain the product features directly derivable from the process of claim 1 of the earlier application its subject-matter extended beyond the content of the parent application as filed, contrary to the requirements of Article 76(1) EPC. In addition, in the absence of the restriction of the acids to C8 to C24 aliphatic monocarboxylic acids the definition that the filler included fatty acids in addition to fatty acids salts also gave rise to a violation of Article 76(1) EPC. An objection of lack of clarity pursuant to Article 84 EPC arose from the definition of specific acids and salts in brackets following the broader terminology fatty acids and fatty acids salts because it was ambiguous whether the definition of the specific fatty acids or their salts in brackets was limiting. As regards auxiliary request 6 the contradiction between the information in claim 1 that the mineral filler product could be especially calcium carbonate when according to steps a) and b) it had to be a calcium carbonate-comprising mineral filler lead also to a lack of clarity in contravention of Article 84 EPC. Claim 2 of that request also did not fulfill the requirements of Article 76(1) EPC. It was also held that claim 1 of auxiliary request 6 did not extend the scope of protection since the term "fatty

acids" encompassed not only unbranched aliphatic acids as disclosed in D10 (Excerpt of Wikipedia "Fatty acid"), but also branched or functionalized acids. Auxiliary request 7 submitted during the oral proceedings was not admitted into the proceedings, in particular, as prima facie it did not overcome the objections under Article 84 EPC against auxiliary request 6 and contained a claim 9 not complying with Rule 80 EPC.

- V. An appeal was lodged by the patent proprietor (appellant) against that decision. The statement setting out the grounds of appeal was submitted with letter of 23 February 2016 to which a main request and auxiliary requests 1 and 2 were attached.
- VI. Following the Board's communication sent in preparation of the oral proceedings the appellant submitted with letter of 8 February 2019 three sets of amended claims labelled first to third auxiliary requests replacing the auxiliary requests submitted with the statement setting out the grounds of appeal (letter of 23 February 2016).

Claims 1 to 4 of the first auxiliary request read as follows:

"1. Mineral Filler Product selected among calcium carbonate-comprising mineral fillers selected among precipitated calcium carbonate (PCC), namely one or more of the aragonitic, vateritic and calcitic mineralogical crystal forms, and/or natural ground calcium carbonate (NGCC), namely one or more of marble, limestone, or chalk, and/or dolomite, characterised in that it is prepared by a process comprising the following steps:

(a) treating at least one dry mineral filler with at least one Group II or Group III salt of a C8 to C24 aliphatic monocarboxylic acid to produce an intermediate mineral filler product; followed by (b) treating the intermediate mineral filler product of step (a) with at least one C8 to C24 aliphatic monocarboxylic acid to produce a treated mineral filler product, in that it has a total volatiles between 25 and 300°C of less than 0.25% by mass, and in that it includes C8 to C24 aliphatic monocarboxylic acids in addition to salts of C8 to C24 aliphatic monocarboxylic acids namely salts of Group II or Group III.

2. Mineral filler product according to claim 1, adapted to a subsequent application of the mineral filler in breathable or extrusion coating films, characterized in that it is treated calcium carbonate and/or dolomite, and more preferably a marble and/or dolomite.

3. Mineral filler product according to claim 1 or 2, characterized in that said mineral filler is dry ground or wet ground and dried prior to introduction into the process with or without grinding aids.

4. Mineral filler product according to claim 1 or 2, characterized in that conventional grinding aids, such as glycols for dry grinding and polyacrylates for wet grinding, are used when dry or wet grinding the said mineral filler."

Claim 1 of the third auxiliary request read as follows:

"1. Calcium carbonate-comprising mineral filler product selected among precipitated calcium carbonate (PCC), namely one or more of the aragonitic, vateritic and

calcitic mineralogical crystal forms, and/or natural ground calcium carbonate (NGCC), namely one or more of marble, limestone, or chalk, and/or dolomite, characterised in that it is prepared by a process comprising the following steps:

(a) treating at least one dry mineral filler with at least one Group II or Group III salt of a C8 to C24 aliphatic monocarboxylic acid to produce an intermediate mineral filler product; followed by
(b) treating the intermediate mineral filler product of step (a) with at least one C8 to C24 aliphatic monocarboxylic acid to produce a treated mineral filler product,
in that it has a total volatiles between 25 and 300°C of less than 0.25% by mass, and in that it includes C8 to C24 aliphatic monocarboxylic acids in addition to salts of C8 to C24 aliphatic monocarboxylic acids namely salts of Group II or Group III,

in that the range of total aliphatic monocarboxylic acid (s) an (sic) monocarboxylic acid salt(s) added during the process of the invention is 0.2 to 8 mg of total aliphatic monocarboxylic acid(s) and aliphatic monocarboxylic acid salt(s)/m² mineral filler(s).

Claims 2 to 4 of the Third Auxiliary Request had the same wording as those of the First Auxiliary Request.

VII. During the oral proceedings which took place on 9 April 2019 the main request submitted with the statement setting out the grounds of appeal and the first and second auxiliary requests both submitted with letter dated 8 February 2019 were withdrawn.

VIII. As far as relevant to the present decision, the submissions of the appellant can be summarised as follows:

Admissibility of the request labelled third auxiliary request submitted with letter dated 8 February 2019

(a) Claim 1 of the third auxiliary request differed from claim 1 of the first auxiliary request submitted with letter of 23 February 2016 by addition of a feature defining the amount of aliphatic monocarboxylic acid (s) and monocarboxylic acid salt(s) added during the process of the invention. The addition of this feature provided a clearer way to express the feature that both the carboxylic acid and its salt were present on the calcium carbonate filler. That request therefore represented a response to the argument of the respondent that the earlier application as filed did not disclose the presence of both the carboxylic acid and its salt on the mineral filler. Accordingly, this request should be admitted into the proceedings.

Article 123(3) EPC

(b) The term "fatty acids" of claim 1 of the patent as granted encompassed not only unbranched chains as disclosed in D10, but also branched or functionalized chains. Hence, the definition of C8 to C24 aliphatic monocarboxylic acids and group II and Group III salts thereof did not extend the scope of protection.

Article 76(1) EPC

(c) The last paragraph of page 11 of the earlier application as filed disclosed that sufficient surface treatment of the mineral filler should be provided to render the filler easily dispersible in polyolefins. An appropriate range of amounts for aliphatic monocarboxylic acid(s) and salt(s) thereof was now defined in claim 1. This range was disclosed in the first paragraph of page 12 of the earlier application as filed and encompassed the amount used in Example 10. Salts of C8 to C24 aliphatic monocarboxylic acids were stable and did not react with the calcium carbonate. As shown in the examples both the acid salts and the acids were applied in the molten state, the temperatures used for the first step - treatment with the salts - being higher than that used in the second step - treatment with the acids - due to the lower melting point of the acids compared to that of the salts. Accordingly, it was implicit that the salt of the aliphatic monocarboxylic acid did not react with the calcium carbonate and was present together with the aliphatic monocarboxylic acid salt on the product obtained by the process described in the earlier application as filed. In addition, the feature that the amount of volatiles was measured between 25 and 300°C was disclosed on page 13, lines 29-32 of the earlier application as filed.

Article 123(2) EPC

(d) For the same reasons as indicated in relation to Article 76(1) EPC the subject-matter of claim 1 did not extend beyond the content of the divisional application as filed.

Article 84 EPC

- (e) The contradictory definitions in claim 1 of the third auxiliary request concerning both the use of either one aliphatic monocarboxylic acid as well as more than one aliphatic monocarboxylic acids to be used in the treatment of the mineral filled could be resolved when claim 1 was read by a mind willing to understand, reference being made to page 12, lines 21-24 of the earlier application as filed which specified that a 1:1 mixture of stearic acid:palmitic acid was used. Moreover, the plural form reflected the presence of a mixture of acids in natural sources of acids.

Rule 80 EPC

- (f) The subject-matter of dependent claims 3 to 5 of the granted patent had been indicated in the notice of opposition to lack novelty. The amendments to those claims, now renumbered claims 2 to 4 in the third auxiliary request, was therefore occasioned by a ground of opposition. Accordingly, claims 2 to 4 met the requirements of Rule 80 EPC.

IX. As far as relevant to the present decision, the submissions of the respondent can be summarised as follows:

Admissibility of the request labelled third auxiliary request submitted with letter dated 8 February 2019

- (a) The third auxiliary request was late filed and the patent proprietor had not provided an explanation or justification for the lateness of its submission. No new objections had been introduced.

Moreover, in order for that late filed request to be admitted into the proceedings, it was a requirement that prima facie it overcame any deficiencies. However, no indication had been provided as to why the paragraph added at the end of claim 1 would overcome the objection that claim 1 extended beyond the content of the earlier application as filed. Moreover, the rewording of claim 1 in its first paragraph contravened the requirements of Rule 80 EPC. Consequently, the third auxiliary request should not be admitted into the proceedings.

Article 123(3) EPC

- (b) Due to the replacement of the term "fatty acids" in the claims as granted with "C8 to C24 aliphatic monocarboxylic acids" the protection conferred by the patent had been extended. The term "aliphatic acid" had a broader meaning than the term "fatty acid" as was shown in D10. Moreover having regard to paragraph [0015] of the patent in suit stating that "*an aliphatic carboxylic acid, which in some cases may also commonly be referred to as a fatty acid*" it followed that the term "aliphatic acids" did not equate to "fatty acids" alone, but rather to a broader range of compounds.

Article 76(1) EPC

- (c) There was no disclosure in the earlier application as filed that the product obtained by the process of treating the mineral filler led to a product including C8 to C24 aliphatic monocarboxylic acids in addition to salts of C8 to C24 aliphatic monocarboxylic acids. The earlier application did

not contain any analysis of the product obtained by the treatment. Since the surface of the calcium carbonate filler was basic it would interact during the treatment with the aliphatic monocarboxylic acid part of the salt used. Accordingly, there was no guarantee and therefore no disclosure in the earlier application as filed that the aliphatic monocarboxylic acid salt used in the first step of the process was present on the treated filler in combination with the aliphatic monocarboxylic acid used in the second step of the treatment. Moreover the passage on page 7 of the earlier application as filed describing the total volatiles content did not disclose the range of temperature, over which the measurement was carried out, as defined in operative claim 1.

Article 123(2) EPC

- (d) For the same reasons as indicated in relation to Article 76(1) EPC the subject-matter of claim 1 extended beyond the content of the divisional application as filed.

Article 84 EPC

- (e) The expression "adapted to a subsequent application in breathable or extrusion coating films" in claim 2 required interpretation. Since it was not clear how it should be interpreted, its introduction into claim 2 after grant of the opposed patent resulted in that claim to lack clarity.

Rule 80 EPC

(f) Dependent claims 2 to 4 contained amendments which were not warranted by grounds of opposition. Those claims therefore contravened the requirements of Rule 80 EPC.

X. The appellant requested that the decision under appeal be set aside and that the case be remitted to the first instance for further prosecution on the basis of the third auxiliary request filed with the letter of 8 February 2019.

XI. The respondent requested that the appeal be dismissed.

Reasons for the Decision

Admissibility of the request labelled third auxiliary request submitted with letter dated 8 February 2019

1. The request labelled third auxiliary request (now the main request) was filed after the appellant's statement setting out the grounds of appeal and therefore constitutes an amendment to the appellant's case, the admissibility of which has to be judged on the basis of Article 13(1) RPBA. Following these provisions, the admission of an amendment to a party's case is at the board's discretion. Moreover, Article 13(3) RPBA states that amendments sought to be made after oral proceedings have been arranged shall not be admitted if they raise issues the board or the other parties cannot reasonably be expected to deal with without adjournment of the oral proceedings.

1.1 In the case at hand, the opposition division had held in the contested decision (page 4 of the Reasons, second full paragraph) that the product disclosed in the earlier application as filed had a double coating on the filler, comprising a first layer of fatty acid salts and a second layer of fatty acids. This was not contested by the respondent until the oral proceedings before the Board when it was argued that the earlier application as filed did not disclose that the carbonate calcium filler resulting from the treatment contained a salt of the fatty acid. In other words it was disputed that the earlier application as filed disclosed that the salt of the fatty acid had not reacted at the surface of the calcium carbonate. On that basis it was argued by the respondent that the presence in claim 1 of the feature "in that it includes C8 to C24 aliphatic monocarboxylic acids in addition to salts of C8 to C24 aliphatic monocarboxylic acids namely salts of Group II or Group III" was in violation of Article 76(1) EPC. The respondent did not provide any justification for the lateness of these submissions.

1.2 The appellant did not contest the admissibility of these new submissions, but argued that the presence in claim 1 of the third auxiliary request of the additional feature specifying the total amount of aliphatic monocarboxylic acid and its salt used for preparing the calcium-carbonate filler represented a better way to define what the earlier application as filed disclosed. In that sense the third auxiliary request was submitted by the appellant to represent an appropriate answer to the submissions made by the respondent for the first time during the oral proceedings in relation to the question whether claim 1 met the requirements of Article 76(1) EPC. In addition,

this amendment inserted in the third auxiliary request could be easily dealt with during the oral proceedings, in particular as it had been known long enough in advance to the oral proceedings and claim 1 of the third auxiliary request contained only minor amendments compared to the first auxiliary request whose admissibility had not been contested by the respondent. Hence, independently of whether said additional feature inserted in the third auxiliary request represents an appropriate way to reply to the respondent's new submissions, should the Board find the objection of the respondent on that basis to be convincing, it would not be equitable under the present circumstances to have accepted unjustified new submissions by the respondent at an extremely late stage of the procedure, whose admissibility was not questioned by the appellant, and at the same time to deprive the appellant of the possibility of submitting the third auxiliary request, representing in its opinion a genuine and suitable response to the new submissions.

Under these circumstances the Board does not consider it appropriate or equitable to apply the criterion of whether the claims of the third auxiliary request were *prima facie* allowable in the sense that they overcome all objections previously raised in deciding on the admissibility of the third auxiliary request.

- 1.3 Hence, the Board, in exercise of its discretion under Article 13(1) RPBA, admits the third auxiliary request into the proceedings.

Article 123(3) EPC

2. Article 123(3) EPC precludes amending the claims during opposition proceedings in such a way as to extend the

protection conferred by the patent as granted. The respondent objected that the wording "aliphatic monocarboxylic acids" now present in claim 1 had a broader meaning than "fatty acid" used in claim 1 as granted meaning that the protection conferred by the patent as granted had been extended.

- 2.1 The question to be answered is whether the wording "C8 to C24 aliphatic monocarboxylic acids" employed in operative claim 1 has a broader meaning than "fatty acids" used in granted claim 1. D10 cited by the respondent to demonstrate the meaning of the term "fatty acid" at the relevant priority date of the patent in suit is an article of Wikipedia whose reliability cannot be assessed. Accordingly, D10 cannot be considered to demonstrate which meaning of the term "fatty acid" was generally recognized in the art at the priority/application date of the patent in suit. Even if, to the benefit of the respondent, D10 were taken into consideration it did not show that the term "fatty acid" would necessarily exclude some of the known "C8 to C24 aliphatic monocarboxylic acids".
- 2.2 Furthermore and more importantly the protection conferred by the patent as granted is, according to the established jurisprudence of the Boards of Appeal (see in particular G 1/93, OJ EPO 1994, 541, point 11 of the reasons), assessed taking into account the provisions of Article 69(1) EPC and the protocol on its interpretation, although said provisions are primarily intended to be applied by the Courts responsible for deciding on infringement cases (Case Law of the Boards of Appeal of the EPO, 8th edition, 2016, II.A.6.3.2).
- 2.3 Article 69(1) EPC stipulates that the extent of the protection conferred by a European patent or a European

patent application shall be determined by the claims. Nevertheless, the description and drawings shall be used to interpret the claims. According to Article 1 of the Protocol on the Interpretation of Article 69, the Article should not be interpreted as meaning that the extent of the protection conferred by a European patent is to be understood as that defined by the strict, literal meaning of the wording used in the claims, the description and drawings being employed only for the purpose of resolving an ambiguity found in the claims. Nor should it be taken to mean that the claims serve only as a guideline and that the actual protection conferred may extend to what, from a consideration of the description and drawings by a person skilled in the art, the patent proprietor has contemplated. On the contrary, it is to be interpreted as defining a position between these extremes which combines a fair protection for the patent proprietor with a reasonable degree of legal certainty for third parties.

- 2.4 Whereas having regard to paragraph [0015] of the patent in suit stating "*an aliphatic carboxylic acid, which in some cases may also commonly be referred to as a fatty acid*" it appears that any aliphatic carboxylic acid will not necessarily be considered by the skilled person as a fatty acid, it is nevertheless abundantly and unambiguously indicated in the patent in suit, in particular in paragraphs [0026], [0029], [0030], [0031] and [0056] that the use of aliphatic monocarboxylic acids having 8 to 24 carbon atoms and their Group II or Group III salts for treating the mineral filler is intended. Accordingly, even if the exact definition of the term "fatty acid" intended by the patent proprietor in claim 1 of the patent as granted might not emerge from the patent as granted as a whole, there is no doubt for the reader having regard to the above

mentioned paragraphs that it would at least encompass C8 to C24 aliphatic monocarboxylic acids and their Group II or Group III salts so that their use was covered by the subject-matter - protection conferred by - claim 1 as granted.

- 2.5 Thus, in these circumstances, the Board concludes that that the protection conferred by the patent as granted has not been extended by the claims now put forward.

Article 76(1) EPC

3. As shown in above section III claim 1 of the earlier application as filed describes that a treated mineral filler is obtained by treating a dry mineral filler with at least one Group II or Group III salt of a C8 to C24 aliphatic monocarboxylic acid to produce an intermediate mineral filler product, followed by a treatment of the obtained intermediate mineral filler with at least one C8 to C24 aliphatic monocarboxylic acid, i.e. process steps (a) and (b) as defined in claim 1 of the third auxiliary request.

- 3.1 The group of calcium carbonate-comprising mineral filler and the total volatiles defined in operative claim 1 are disclosed in claims 4 and 2 of the earlier application as filed, respectively. The range of temperatures between 25 and 300°C used for determining the total volatiles is also disclosed in claim 2 of the earlier application as filed.

- 3.2 The treatment process disclosed in claim 1 of the earlier application is exemplified in Examples 5 to 11 in which marble from Carrara, i.e. a calcium-carbonate comprising mineral filler is treated in the first step with a salt of the aliphatic monocarboxylic acid at a

temperature of 180°C, i.e. at a temperature which is high enough for the salt to be in the molten state which was not disputed by the respondent. After a cooling period the second step is carried out at a temperature of 130°C at which the aliphatic monocarboxylic acid is also in the molten state. The salt used in Examples 5 to 9 is calcium stearate, while magnesium laurate is used in Examples 10 and 11. The mineral filler being dry, as described in the examples, and the salt being added in the molten state, there is no reason to assume that these salts will dissociate. Comparative example 1 concerning the same treatment of a marble from Carrara with stearic acid alone demonstrates that 25% of the acid is not transformed when applied on the surface of the mineral filler. On that basis there is no reason to assume that applying a salt of said acid on the same mineral filler, which salt is already in a more stable form, will lead to the salt being transformed, let alone in totality. Example 5 shows that applying the acid in the second step as defined in operative claim 1, i.e. after having applied the salt of said acid in the first step, leads as could be expected to a transformation rate of the acid added which is lower (25% instead of 75%) than when it is applied directly on the surface of the mineral filler.

- 3.3 Accordingly, the respondent's objection that the earlier application as filed does not disclose that the mineral filler treated by the process defined in operative claim 1 includes (i) salts of Group II or Group III of C8 to C24 aliphatic monocarboxylic acids, as well as (ii) C8 to C24 aliphatic monocarboxylic acids fails to convince.

Article 123(2) EPC

4. The same objections raised by the respondent in relation to Article 76(1) EPC were also raised in view of Article 123(2) EPC. In this respect, the relevant passages of the divisional application as filed are claim 1 (type of mineral filler and total volatiles), page 6, line 14 to page 7, line 3) (treatment steps), page 13, lines 22-25 (range of temperatures for determining the total volatiles) and the same examples mentioned in above section 3.2. Accordingly, for the same reasons as indicated in relation to Article 76(1) EPC, the respondent's objection that the subject-matter of operative claim 1 extends beyond the content of the divisional application as filed does not convince.

Article 84 EPC

5. Claim 1 defines that the treated mineral filler is obtained by treatment with at least one Group II or Group III salt of a C8 to C24 aliphatic monocarboxylic acid to produce an intermediate mineral filler product followed by treating the intermediate mineral filler product obtained with at least one C8 to C24 aliphatic monocarboxylic acid. The definition that the mineral filler is treated in steps a) and b) with at least one acid and with at least one salt thereof, respectively, is consistent with the "s" placed in brackets after the terms "monocarboxylic acid" and "monocarboxylic acid salt" in the last section of the claim defining the total amount of aliphatic monocarboxylic acid(s) and aliphatic monocarboxylic acid salt(s) added for the treatment of the mineral filler. However, the passage immediately preceding that section does not define the use of at least one Group II or Group III salt of a C8 to C24 aliphatic monocarboxylic acid and at least one

C8 to C24 aliphatic monocarboxylic acid, but that the mineral filler so prepared includes C8 to C24 aliphatic monocarboxylic acids in addition salts of C8 to C24 aliphatic monocarboxylic acids, i.e. a contradiction exists in present claim 1 as to whether a plurality of C8 to C24 aliphatic monocarboxylic acids and their salts is used for the treatment steps a) and b) and is present on the treated filler.

5.1 It is undisputed that this ambiguity in operative claim 1 arises out of an amendment made in opposition or opposition appeal proceedings, so that following the ruling of decision G 3/14 of the Enlarged Board of Appeal (OJ 2015, A102) it can be addressed. The appellant, however, argued that the above contradiction would be resolved by a mind willing to understand, reference being made to page 12, lines 21-24 of the earlier application as filed. However, as early as decision T 2/80 of 5 June 1981 (OJ EPO 1981, 431) (Point 2 of the Reasons, last sentence), it has been established case law (see Case Law, supra, II.A.6.3.5) that the requirement of clarity following of Article 84 EPC requires that it is possible to understand the claims without reference to the description. This is in particular applicable in a situation such as that in the present case when the lack of clarity has its origin in the introduction into a granted claim of a feature which gives rise to a contradiction with the other features that were already present in that claim. Hence, in view of the paramount nature of the requirement of legal certainty, reliance on the indicated part of the description of the granted patent, i.e. paragraph [0052] corresponding to page 12, lines 21-24 of the earlier application as filed cannot serve as a substitute for or alternative to a different

amendment of the ambiguous claim which would remove the introduced lack of clarity.

5.2 Moreover, the argument of the appellant that the plural form of the word acid in claim 1 reflects the presence of a mixture of acids when a natural source of aliphatic acid is employed does not remove the above ambiguity since the origin of the acids is not defined in claim 1 and therefore any source of acids, of natural or man-made origin, conventionally used in the art may be employed. Moreover, even if, to the benefit of the appellant, such limitation would be read into claim 1 the above contradiction would still be present, since the same interpretation would be valid for all occurrence of the term acid, i.e. claim 1 would define for steps a) and b) the use of at least one salt of an acid from natural sources and at least one acid from natural sources when the following paragraph would define the presence on the filler of at least two salts of two acids originating from natural sources and two acids also from natural sources.

5.3 Since a different amendment to claim 1 was not proposed in order to overcome the lack of clarity arising from the amendment to claim 1 as granted the Board concludes that operative claim 1 lacks clarity contrary to the requirements of Article 84 EPC. Having regard to this finding it is not necessary to assess whether the feature defining that a plurality of C8 to C24 aliphatic monocarboxylic acids and their salts is present on the treated filler extends beyond the content of the earlier application as filed, as was questioned by the respondent.

5.4 Claim 3 of the granted patent, now claim 2 after deletion of dependent claim 2 of the granted patent,

was modified by defining that the mineral filler was "adapted to" a subsequent application in breathable or extrusion coating films, characterized in that it is treated calcium carbonate and/or dolomite, and more preferably a marble and/or dolomite. Following G 3/14 it is permissible to assess the question of whether an ambiguity arises from that amendment made in opposition appeal proceedings. The appellant did not indicate which features of the mineral filler would be implied by the wording "adapted to", let alone submitted evidence in this respect. Nor is this apparent to the Board. Under those circumstances the insertion of the wording "adapted to" leads to a lack of clarity of the subject-matter of claim 2.

Rule 80 EPC

6. In addition to amendments made to claim 1 as granted the third auxiliary request contains further amendments in its dependent claims 2 to 4 representing amended forms of granted dependent claims 3 to 5. Those amendments are not merely corrections pursuant to Rule 139 EPC, which provision and the specific requirements defined therein apply independently from Rule 80 EPC (see decision T 0657/11 of 8 November 2013, point 3.4 of the Reasons), but represent amendments to the substance of what is claimed in those dependent claims.

6.1 It is also not disputed that the amendments concerned have not been triggered by a necessary and consequential adaptation of those dependent claims to the amendments operated in claim 1 as granted. The appellant nevertheless argued that these amendments had been occasioned by a ground of opposition since the novelty of the subject-matter of claims 3 to 5 had been challenged in the notice of opposition of the

respondent. It is however established case law (see Case Law, supra, IV.D.4.1.1, in particular T 0993/07 of 20 May 2010, point 1.2 of the Reasons) that Rule 80 EPC means that in opposition proceedings the proprietor's right to amend the patent, e.g. the claims as granted, is limited to making amendments in order to overcome an objection based on a ground for opposition as specified in Article 100 EPC, thereby possibly avoiding revocation of the patent. Grounds of opposition which could justify an amendment to those dependent claims such as ground of opposition under Article 100 b) or Article 100 c) EPC were not invoked and are not apparent to the Board. In the present case there is therefore no justification to submit an amendment relating to the substance of claims 2 to 4 when claim 1 has been already restricted to overcome an objection of lack of novelty and those further amendments are not a consequential adaptation of the dependent claims to the amendments operated in claim 1 as granted. Accordingly, the amendments contained in dependent claims 2 to 4 are not in accordance with the requirements of Rule 80 EPC.

7. Accordingly the sole claim request of the appellant i.e. the third auxiliary request as submitted by letter of 8 February 2019 is not allowable and the appeal must be dismissed.

Order

For these reasons it is decided that:

1. The appeal is dismissed.

The Registrar:

The Chairman:



B. ter Heijden

M. C. Gordon

Decision electronically authenticated