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**Datasheet for the decision
of 17 May 2022**

Case Number: T 1296/17 - 3.3.09

Application Number: 11174057.7

Publication Number: 2397510

IPC: C08J3/22

Language of the proceedings: EN

Title of invention:

High concentration pelletized additive concentrates for polymer

Patent Proprietor:

Ingenia Polymers Inc.

Opponents:

BASF SE
Clariant Produkte (Deutschland) GmbH

Headword:

Polymer additives/INGENIA

Relevant legal provisions:

EPC Art. 107, 116(1), 123(2)
RPBA 2020 Art. 15a(1)

Keyword:

Oral proceedings to be held by videoconference without the consent of the patent proprietor - (yes)
Admission of the proprietor's appeal - (no)
Main request and auxiliary requests 1 to 9 - added matter (yes)

Decisions cited:

G 0001/21, T 1848/09, T 0386/04

Catchword:



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Case Number: T 1296/17 - 3.3.09

D E C I S I O N
of Technical Board of Appeal 3.3.09
of 17 May 2022

Appellant: Ingenia Polymers Inc.
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Appellant: BASF SE
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Appellant: Clariant Produkte (Deutschland) GmbH
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Decision under appeal: Interlocutory decision of the Opposition
Division of the European Patent Office posted on
18 April 2017 concerning maintenance of the
European Patent No. 2397510 in amended form.

Composition of the Board:

Chairman A. Haderlein
Members: A. Veronese
 F. Blumer

Summary of Facts and Submissions

- I. Appeals were filed by the two opponents and by the patent proprietor against the decision of the opposition division finding that European patent No. 2 397 510 as amended met the requirements of the EPC. As all the parties are appellants, for the sake of simplicity the board will continue to refer to them as proprietor and opponents.
- II. With their notices of opposition the opponents had requested that the patent be revoked in its entirety, *inter alia* on the ground under Article 100(c) EPC.
- III. In its decision the opposition division found that, taking into account the amendments made by the patent proprietor in accordance with the main request filed during the oral proceedings before the opposition division, the patent met the requirements of the EPC. The opposition division held, *inter alia*, that the subject-matter of the main request did not contain added subject-matter.
- IV. With its grounds of appeal the proprietor filed a main request and nine auxiliary requests. The first auxiliary request corresponds to the request found allowable by the opposition division.
- V. Claim 1 of the main request reads:

*"1. A pelletized additive concentrate for a polymer comprising:
at least one primary polymer additive present in a total amount of between 20 wt.% and 90 wt.% of the pelletized additive concentrate, the primary polymer*

additive having a primary polymer-additive melting temperature between 100°C and 200°C; and at least one primary carrier polymer present in a total amount of between 10 wt.% and 80 wt.% of the pelletized additive concentrate, the primary carrier polymer having a primary carrier-polymer melting temperature below the primary polymer-additive melting temperature, wherein any additional polymer additive is present at a concentration of below 20 wt.% of the pelletized additive concentrate, wherein in the concentrate, the primary polymer additive and the primary carrier polymer have been processed at a temperature lower than each primary polymer additive melting temperature and higher than the primary carrier polymer melting temperature to produce the pelletized additive concentrate, wherein the primary polymer additive is a hindered phenol, a phosphite, a phosphonite, a hindered amine, a triazine, a benzophenone, a benzotriazole, a hydroxybenzoate, or a metal stearate; and wherein the at least one primary carrier polymer is a polyolefin."

VI. Claim 1 of auxiliary request 8 defines a method for preparing the additive concentrate, and reads:

*"1. A method of preparing a pelletized additive concentrate for a polymer, the pelletized additive comprising:
at least one primary polymer additive present in a total amount of between 20 wt.% and 90 wt.% of the pelletized additive concentrate, the primary polymer additive having a primary polymer-additive melting temperature between 100°C and 200°C; and
at least one primary carrier polymer present in a total amount of between 10 wt.% and 80 wt.% of the pelletized*

additive concentrate, the primary carrier polymer having a primary carrier-polymer melting temperature below the primary polymer-additive melting temperature, wherein any additional polymer additive is present at a concentration of less than 20 wt.% of the pelletized additive concentrate, the at least one carrier polymer is a polyolefin: wherein the pelletized additive concentrate is prepared at a temperature lower than each primary polymer additive melting temperature and higher than the primary carrier polymer melting temperature to produce the pelletized additive concentrate, wherein the primary polymer additive is a hindered phenol, a phosphite, a phosphonite, a hindered amine, a triazine, a benzophenone, a benzotriazole, a hydroxybenzoate, or a metal stearate."

VII. Claim 1 of the main request and auxiliary requests 1, 2, 3 and 8 contain the feature "wherein any additional polymer additive is present at a concentration of below 20 wt.% of the pelletized additive concentrate".

VIII. Claim 1 of auxiliary requests 4, 5, 6, 7 and 9 differs from claim 1 of the aforementioned requests in particular in that the additive concentrate "consists of" rather than "comprises" the ingredients listed in the claims.

IX. The arguments of the patent proprietor which are relevant to the present decision can be summarised as follows:

- the oral proceedings had to be conducted in person before the board, and not by videoconference
- the appeal was admissible

- paragraphs [0015], [0016], [0027], [0046], [0048] and [0050] of the description as originally filed provided a basis for the feature "wherein any additional polymer additive is present at a concentration of below 20 wt.% of the pelletized additive concentrate"; paragraph [0027] provided a basis for replacing the wording "comprising" used in the application as filed with the wording "consisting of".

X. The arguments of the opponents which are relevant to the present decision can be summarised as follows:

- the oral proceedings before the board should be conducted by videoconference (argument put forward by opponent 2)
- the proprietor's appeal was not admissible because its main request during the opposition proceedings was considered allowable by the opposition division
- the application for the patent as originally filed did not provide any basis for the feature "wherein any additional polymer additive is present at a concentration of below 20 wt.% of the pelletized additive concentrate" or for the replacement of the wording "comprising" with "consisting of".

Requests

XI. The patent proprietor requested that the decision under appeal be set aside and that the patent be maintained on the basis of the main request or, alternatively, on the basis of any one of the first to ninth auxiliary

requests, all requests filed with the statement setting out the grounds of appeal.

- XII. The opponents requested that the decision under appeal be set aside and that the patent be revoked in its entirety. They also requested that the patent proprietor's appeal be rejected as inadmissible.

Reasons for the Decision

1. *Oral proceedings conducted by videoconference*
 - 1.1 With a communication dated 22 March 2022 the board informed the parties that the oral proceedings scheduled to take place on 17 May 2022 were to be held by videoconference.
 - 1.2 The proprietor objected to the oral proceedings being conducted by videoconference.
 - 1.3 The proprietor referred to the ruling of the Enlarged Board of Appeal in decision G 1/21, that, during a general emergency impairing the parties' possibilities to attend in-person oral proceedings at the EPO premises, the conduct of oral proceedings before the boards of appeal in the form of a videoconference was compatible with the EPC, even if not all of the parties to the proceedings had given their consent to the conduct of oral proceedings in the form of a videoconference.
 - 1.4 The proprietor further considered that, at the time when the board communicated its intention to hold the oral proceedings by videoconference, there were no circumstances impairing the ability of the parties to

attend oral proceedings in person, and that there were no quarantine, testing or registration requirements for parties wishing to enter Germany. In the absence of other case-specific circumstances affecting the parties' ability to attend the oral proceedings, these had to be held in person before the board.

- 1.5 The board does not agree with the proprietor.
- 1.6 As it appears from the history of the present case, the board has endeavoured to arrange oral proceedings for several years, but without success. Oral proceedings scheduled a first time for 27 October 2020, a second time for 22 April 2021 and a third time for 1 July 2021 were postponed at the request of the patent proprietor. The postponements were granted because when the requests were made health risks existed and travel restrictions applied due to the COVID-19 pandemic, and furthermore because there was still legal uncertainty as to whether oral proceedings could be carried out by videoconference where not all parties agreed.
- 1.7 During this period opponent 2 twice requested that, in view of the uncertainties associated with the ongoing pandemic, the oral proceedings be conducted by videoconference to avoid further cancellations.
- 1.8 It is true that, as noted by the proprietor, neither travel restrictions nor quarantine requirements were in force in Germany in March 2022, when the board communicated its intention to hold the oral proceedings by videoconference. However, in that period the Omicron variant of COVID-19 was spreading at a high rate in Germany. The pandemic situation was still highly uncertain and no forecasts could be made as to its evolution. Experience in the preceding two years had

shown that restrictions could be reintroduced by health authorities at short notice to react to new waves of infection. Therefore in March 2022 there were good reasons for the board to convert the oral proceedings scheduled for 17 May 2022 into the videoconference format provided for by new Article 15a(1) RPBA 2020.

- 1.9 There were also good reasons not to grant the proprietor's request dated 14 April 2022 that the oral proceedings be reverted to the in-person format. In the first place, the aforementioned uncertainties associated with the pandemic still existed. Furthermore, the change of format would have obliged the board to postpone the oral proceedings for the fourth time, because not enough time was left for the parties to arrange for travel and accommodation.
- 1.10 The board also considers that there are no reasons of a technical nature, or associated with the specific nature of the present appeal case, which speak against conducting the oral proceedings in the format of a videoconference.
- 1.11 For these reasons the board has decided that, in the specific circumstances of the present case, it is appropriate to conduct the oral proceedings by videoconference.

2. *Admissibility of the appeal*

- 2.1 In the decision under appeal the opposition division decided that the patent could be maintained on the basis of the main request filed by the proprietor during the oral proceedings held before the opposition division.

- 2.2 Under Article 107 EPC, any party to proceedings before the EPO who is adversely affected by a decision may appeal. A party is adversely affected within the meaning of Article 107 EPC if the decision fails to meet that party's requests. Since in the present case the opposition division acceded to the proprietor's main request, the proprietor is not adversely affected by the decision (see Case Law of the Boards of Appeal of the European Patent Office, Ninth Edition, 2019, Section V.A.2.4.2(a) and decision T 1848/09, reasons 1.1 and 1.2).
- 2.3 Referring to decision T 386/04, the patent proprietor argued that an appellant/proprietor whose patent has been revoked had the right to seek maintenance of its patent as granted even though its main request before the opposition division had been maintenance in an amended form. Thus, in its opinion, a broadening of the claims beyond that main request should be permissible in the present case as well.
- 2.4 The board does not agree. The situation in T 386/04 was different: since the patent had been revoked, the proprietor was adversely affected by the decision and its appeal was admissible. In the present case the patent has not been revoked and the opposition division has acceded to the proprietor's main request, and thus the proprietor is not adversely affected.
- 2.5 Therefore the proprietor's appeal is not admissible.
- 2.6 The inadmissibility of the proprietor's appeal implies that any request filed in the appeal proceedings which is broader than the main request found to be allowable by the opposition division could not be acceded to. During the written appeal proceedings and the oral

proceedings the board found that all the requests contained added subject-matter. For this reason the issue of added subject-matter has been dealt with in the following, without considering whether certain requests might be broader than the main request found allowable in the decision under appeal.

Main request and auxiliary requests 1, 2, 3 and 8

3. *Added subject-matter*

3.1 When discussing added subject-matter the parties referred to the "A" publication of the patent application as filed. The parties did not dispute that the text of that publication is identical to that of the application originally filed. Thus the board agrees to rely on the A publication for the discussion.

3.2 Claim 1 of the main request has been amended, *inter alia* introducing the feature wherein "any additional polymer additive is present at a concentration of below 20 wt.% of the pelletized additive concentrate" (emphasis added).

3.3 According to the opponents this feature goes beyond the content of the application as filed.

3.4 As the basis for the amendment, the proprietor referred, in particular, to paragraph [0027] on page 4, lines 31-32 of the patent application, which reads: "Optionally there may be one or more additional common polymer additives present at a low concentration (<20%) chosen from any of the polymer additives and or fillers known to one skilled in the art" (emphasis added).

- 3.5 This passage provides for the optional presence of additional additives. However, it does not disclose an embodiment excluding the presence of 20 wt.% or more of additional polymer additives which differ from those identified as primary polymer additives in claim 1.
- 3.6 No further teaching for excluding the presence of these additional additives can be found in the application as filed. It is worth noting that the application defines the composition of the invention using the word "comprising". This allows for the presence of additional additives, in addition to the at least one primary polymer additive and at least one primary carrier polymer (page 3, lines 26-32, and claim 1).
- 3.7 The proprietor has also referred to paragraphs [0015], [0016], [0046], [0048] and [0049] of the application as a basis for claim 1. In its opinion these paragraphs confirm that the primary polymer additive/s must be present in a high concentration, namely at least 20 wt.%, and furthermore that it could be inferred from these paragraphs that, if any additional additive is present, it may not be present in an amount of 20 wt.% or more.
- 3.8 The board does not agree because, in so far as they mention additional additives at all, these passages do not mention their amounts.
- 3.9 As noted by opponent 1, there are further reasons why the feature "any additional polymer additive is present at a concentration of below 20 wt.% of the pelletized additive concentrate" adds subject-matter.
- 3.10 This feature implies that any additional additive in the composition must be present at the given concentration. This means that, if the composition

comprises more than one additional additive, each of them individually must be present below that amount.

3.11 This teaching differs from that of paragraph [0027] of the application as filed, which states that "Optionally there may be one or more additional common polymer additives present at a low concentration (<20%)". The board concurs with opponent 1 that the skilled person would assume from this sentence that, if two or more additional additives are present, their total amount must be below 20 wt.%. Therefore the amendment in claim 1 results in a change in technical teaching and creates originally-undisclosed subject-matter.

3.12 For these reasons it is concluded that claim 1 of the main request, as well as of auxiliary requests 1 to 3 and 8, which are characterised by the same added feature, contain subject-matter extending beyond the content of the application as filed, contrary to the requirements of Article 123(2) EPC.

Auxiliary requests 4, 5, 6, 7 and 9

3.13 Claim 1 of auxiliary requests 4, 5, 6, 7 and 9 specifies that the pelletized additive "consists" of certain ingredients. This wording differs from that used in the claims and in the other parts of the application as filed, which refer consistently to pelletized additives "comprising" those ingredients, see e.g. claim 1 and paragraph [0015] as filed.

3.14 The expression "consist of" is normally used to exhaustively define the composition of a substance. Consequently, claim 1 defines a pelletized additive which contains no other constituents but those which are explicitly mentioned in the claim.

3.15 The application as filed does not contain a general teaching for a composition which is made up only of the specific ingredients listed in claim 1 and nothing else, i.e. excluding the presence of any other agent.

3.16 In particular, no basis can be found in the application as filed for a composition where:

- only one primary polymer additive is present
- the only one primary polymer additive and the at least one carrier polymer are selected from among the specific compounds, and in the amounts given in claim 1
- at least one additional polymer additive is present in an amount of below 20 wt.%
- a processing temperature below the melting temperature of the primary additive has been selected among other possible temperatures mentioned on page 4, line 30 of the A publication, namely a temperature "near or below the melting or softening point of at least one of the highly loaded primary additive"
- the presence of any other ingredients is excluded.

3.17 It is noted that according to the application as filed other ingredients beyond those listed in the claims could be present. The composition is defined using the wording "comprising" and the presence of other agents (e.g. fillers) is provided for: see page 4, line 32 and page 13, line 26 of the A publication.

3.18 For these reasons it is concluded that claim 1 of auxiliary requests 4, 5, 6, 7 and 9 contains added subject-matter, contrary to the requirements of Article 123(2) EPC.

Order

For these reasons it is decided that:

1. The patent proprietor's appeal is rejected as inadmissible.
2. The decision under appeal is set aside.
3. The patent is revoked.

The Registrar:

The Chairman:



A. Nielsen-Hannerup

A. Haderlein

Decision electronically authenticated