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**Datasheet for the decision
of 11 January 2021**

Case Number: T 0895/18 - 3.3.03

Application Number: 05712751.6

Publication Number: 1713863

IPC: C08L83/04

Language of the proceedings: EN

Title of invention:

POLYCARBONATE COMPOSITIONS WITH THIN-WALL FLAME RETARDANCE

Patent Proprietor:

SABIC Global Technologies B.V.

Opponent:

Covestro Deutschland AG

Relevant legal provisions:

EPC Art. 100, 123(2)

RPBA 2020 Art. 13(2)

Keyword:

Amendments - allowable- - no

Request filed after issue of summons to oral proceedings -
admitted - (no) - no "exceptional circumstances"

Basis for examination of allowability of amendments -
application as filed not granted patent

Examination of allowability of amendments made prior to grant
in combination with further amendments - not equivalent to
introduction of a new ground of opposition - duty to examine

Decisions cited:

G 0009/91



Beschwerdekammern

Boards of Appeal

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Case Number: T 0895/18 - 3.3.03

D E C I S I O N
of Technical Board of Appeal 3.3.03
of 11 January 2021

Appellant: SABIC Global Technologies B.V.
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Decision under appeal: **Decision of the Opposition Division of the
European Patent Office posted on 19 January 2018
revoking European patent No. 1713863 pursuant to
Article 101(3) (b) EPC.**

Composition of the Board:

Chairman D. Semino
Members: M. C. Gordon
C. Brandt

Summary of Facts and Submissions

- I. The appeal of the patent proprietor lies against the decision of the opposition division posted on 19 January 2018 revoking European patent number 1 713 863.
- II. The patent was granted with a set of 12 claims, whereby claim 1 read as follows:
- "A composition comprising:
- (a) a polycarbonate/siloxane component, said polycarbonate/siloxane component being a polycarbonate siloxane copolymer, or a mixture of a polycarbonate siloxane copolymer and polycarbonate resin;
 - (b) a mineral filler selected from the group consisting of clay, talc and wollastonite and combinations thereof; and
 - (c) a flame retardant component comprising a phosphate based flame retardant; wherein the composition comprises at least 50% by weight of polycarbonate taking into account the polycarbonate portion of the polycarbonate siloxane copolymer and any polycarbonate resin and from 1 to 20% of the mineral filler; and wherein the amounts of polycarbonate siloxane copolymer, mineral filler and flame retardant are effective to provide a composition with a UL94 V0 rating at a thickness of 0.8 mm, a notched Izod impact strength (ASTM D256 at room temperature) or [*sic*] of 25 kgf-cm/cm or greater and a flexural modulus (ASTM D790) of 29,000 kg/cm² or greater."

III. A notice of opposition against the patent was filed in which revocation of the patent on the grounds of Article 100(a) EPC (lack of inventive step) and Article

100(b) EPC was requested.

IV. The decision was based on the claims of the patent as granted as main request and three sets of claims as first to third auxiliary requests filed during the oral proceedings.

Claim 1 of the second auxiliary request differed from claim 1 as granted by the introduction of the following wording at the end of the claim:

"[...or greater], wherein the siloxane in the polycarbonate/siloxane components is present in an amount of from 1 to 4% by weight of the total composition and wherein the composition further comprises an additional thermoplastic that is not a polycarbonate, wherein the additional thermoplastic is an ABS rubber, and wherein the flame retardant is present in an amount of from 0.1 to 10% by weight of the total composition".

Claim 1 of the third auxiliary request differed from claim 1 of the second auxiliary request by specifying: "[...or greater] and wherein the siloxane in the polycarbonate siloxane copolymer is polydimethylsiloxane [wherein the siloxane in the....]"

V. According to the decision:

- Objections of added subject-matter raised by the opponent at the oral proceedings in respect of the auxiliary requests were not to be followed, because the subject-matter was derivable from the structure of dependency of the claims and from the compositions shown in the examples;

- None of the requests (main request and first to third auxiliary requests) met the requirements of sufficiency of disclosure. The details of this finding are not relevant for the present decision.

Accordingly the patent was revoked.

VI. The patent proprietor (appellant) filed an appeal against the decision.

VII. Together with the statement of grounds of appeal the appellant submitted a main request and two auxiliary requests whereby the main request and first auxiliary request corresponded to the aforementioned second and third auxiliary requests underlying the decision.

Attention was also drawn to an error in a table of the patent, the information relating to the correction thereof to be admitted to the proceedings as new technical data.

The second auxiliary request corresponded to the first auxiliary request with the additional requirement, introduced at the end of claim 1:

"and wherein the composition comprises a fluoropolymer".

VIII. In the rejoinder the opponent (respondent) maintained *inter alia* objections of added subject-matter and lack of sufficiency of disclosure in respect of all requests.

IX. The appellant made a further written submission concerning said matters.

X. On 30 January 2020 the Board issued a summons to oral proceedings.

In a communication it set out its preliminary position on the case.

In particular it was considered that none of the requests on file satisfied the requirements of Article 123(2) EPC.

XI. The respondent made a further written submissions with letter of 9 June 2020.

XII. With letter of 22 September 2020 the appellant filed an amended main request and three amended auxiliary requests.

The main request differed from the first auxiliary request as submitted with the statement of grounds of appeal by specifying in claim 1 that the amount of filler of 1-20 wt% was based on "the total composition".

The auxiliary requests are not of relevance for the present decision.

XIII. With letter of 20 November 2020 the respondent addressed the admittance and allowability of the newly filed requests.

XIV. Oral proceedings were held before the Board on 11 January 2021 by video conference, both parties having previously given their agreement conducting the

proceedings in this mode.

XV. The arguments of the appellant can be summarised as follows:

(a) Main request filed with letter of 22 September 2020
- admittance

The new request had been filed in reaction to the preliminary opinion of the Board which raised objections in respect of Article 123(2) EPC without indicating exactly which features did not find a basis in the original application. The amendment made - specifying that the content of resin was based on the total composition - was an attempt to meet the objection of the Board insofar as this was understood. The amendment had little or no technical or legal effect.

(b) Main request as filed with the statement of grounds of appeal - added subject-matter - general considerations

Three reasons spoke for acknowledging that this set of claims met the requirements of Article 123(2) EPC:

(i) Firstly the following aspects were of significance:

- The ground had been raised only at the oral proceedings before the opposition division and related only to amendments made compared to the claims as granted.
- The opposition division had held the requirements of Article 123(2) EPC to

have been met whereby the amendments made in examination were not addressed in reaching this conclusion.

- Furthermore the respondent itself only addressed the amendments made compared to the granted claims in their objections.

Under these circumstances the approach to added subject-matter should correspond to that followed in respect of unclear amendments undertaken in the procedure before grant in that any amendments already present in the granted claims should be disregarded for the purposes of examination of compliance with Article 123(2) EPC.

Consequently the examination in respect of Article 123(2) EPC should be restricted to those amendments made subsequently, taking the granted claims as the basis.

This was logical since in the present case Article 100(c) EPC had not been invoked as a ground of opposition. To now open up consideration of amendments made in the examination procedure to scrutiny under this Article would amount to introducing a new ground of opposition. It was requested to take an explicit decision on this matter, namely whether the patent as granted or the application as originally filed should form the basis for the examination of compliance with Article 123(2) EPC. It was requested that the patent as granted be taken as the basis for the examination of compliance.

Following this approach, i.e. excluding from consideration those amendments made

prior to grant, would lead to the conclusion that the requirements of Article 123(2) EPC were met since all three additional features of the claim compared to the patent as granted had a clear basis in the granted patent.

- (ii) The new version of the Rules of Procedure which entered into force on 1 January 2020 prescribed a convergent approach, such as had been applied by the Board in refusing to admit the newly filed main request. However the approach of the Board in respect of added subject-matter contravened this requirement by extending scrutiny to features introduced during the examination phase to which objection had not been made during the opposition proceedings.

- (iii) It was to be considered that the application, which had been drafted in the "USA Style" (letter of 22 September 2020, page 3, paragraphs 3 and 4), was a typical example of those relating to a new and inventive composition - giving broad coverage of the various components and alternatives and combinations thereof including the possibility of incorporating further components. The skilled person would not consider such a disclosure in the same narrow way a lawyer would, i.e. limited to what was derivable from the explicit wording of the description or structure of the claims but would consider all possibilities disclosed in all possible - technically sensible - permutations. The

examples would further be relied upon to understand what permutations of subject-matter were envisaged by the drafter and hence derivable from the application. Furthermore the latest three features introduced related to a refinement of a feature already present in the claims as granted.

- (c) Main request as filed with statement of grounds of appeal - added subject-matter - substantive considerations

The annex submitted with the letter of 22 September 2020 showed clearly the basis for the subject-matter of the operative claims in both the claims and description of the application as originally filed.

Reference could also be made to page 9, lines 5-7 providing the basis for the specified combination of phosphate with ABS.

The claims and description provided a basis for all possible combinations of features, even in the absence of a specific disclosure of each and every one. Similarly the examples supported this general disclosure of the description.

- (d) Auxiliary requests filed with the statement of grounds of appeal

If it were held that the main request did not meet the requirements of Article 123(2) EPC, it should be agreed that the same conclusion would necessarily apply to the auxiliary requests.

XVI. The arguments of the respondent can be summarised as follows:

- (a) Main request filed with letter of 22 September 2020
- admittance

The request was not admissible pursuant to Rule 80 EPC since it related to a clarification, but did not address a ground of opposition pursuant to Article 100 EPC.

- (b) Main request filed with statement of grounds of appeal - added subject-matter - general considerations

It was not disputed that the objection had been raised late. However once attention had been drawn to problems in respect of Article 123(2) EPC, it would have been incorrect for the opposition division not to consider this. The correct basis for the assessment of allowability of amendments was the application as originally filed, not the granted patent. In this respect the law was clear and there was no room for manoeuvre or for the alternative approaches as advocated by the appellant.

- (c) Main request as filed with statement of grounds of appeal - added subject-matter - substantive considerations

The approach of the appellant disregarded the requirement that a combination of features had to have a clear basis in the application as filed. The position that the correct reading was not that of a lawyer but of a technical specialist considering

more than what was directly and unambiguously disclosed was resisted.

The features of operative claim 1 were scattered throughout unrelated parts of the claims and description of the application with no pointer to the combination thereof as now defined.

(d) Auxiliary requests filed with the statement of grounds of appeal

Similarly the subject-matter thereof had no basis in the application as filed. In particular there was no general basis for the combination of polysiloxane with ABS.

XVII. The appellant requested that the decision under appeal be set aside and the case be remitted to the opposition division for further prosecution on the basis of the main request or one of the first to third auxiliary requests all as filed with letter of 22 September 2020.

In the alternative, if the main request was not admitted to the proceedings, it was requested that the case be remitted to the opposition division for further prosecution on the basis of the main request or one of the two auxiliary requests submitted with the statement of grounds of appeal.

XVIII. The respondent requested that the appeal be dismissed. In addition it was requested that the requests filed with letter of 22 September 2020 and the new technical data relating to correction of Table 1 of the patent not be admitted to the proceedings.

Reasons for the Decision

1. Main request filed with letter of 22 September 2020 - admittance

The summons to oral proceedings was issued on 30 January 2020, and thus after entry into force of the revised Rules of Procedure of the Boards of Appeal. According to Article 13(2) thereof, amendments to a party's case made after issue of a summons to oral proceedings should not be taken into account in the absence of "exceptional circumstances" justified by "cogent reasons".

No such "exceptional circumstances" were invoked by the appellant, nor can the Board identify any.

Indeed the objection of added subject-matter in respect of the set of claims forming the second auxiliary request before the opposition division - which became the main request underlying the statement of grounds of appeal - had been raised at the oral proceedings before the opposition division (Minutes, point 34) and again by the respondent in the reply to the statement of grounds of appeal (section II.a). The Board in its communication essentially followed this objection. Even if, as argued by the appellant, the specific features concerned were not explicitly named in the communication, the Board identified from which claims the various features of the amended claim had been derived. Furthermore it was observed that since the concerned claims were not interdependent, the question to be addressed was whether the resulting combination of subject-matter had a basis in the application as filed. Furthermore, and crucially, no new aspects or objections were raised by the Board compared to those

considered by the opposition division and the respondent.

Thus no "exceptional circumstances" which would justify admittance of the amendment to the case presented with the statement of grounds of appeal can be identified.

As a consequence the main request of 22 September 2020 is not admitted to the proceedings.

2. In the letter of 22 September 2020 the appellant requested admittance of the main request submitted therewith. If this request were not admitted, then remittal was requested on the basis of the requests filed with the statement of grounds of appeal. These requests were maintained at the oral proceedings before the Board.

Since the main request of 22 September 2020 was not admitted, then in accordance with the request of the appellant the sets of claims to be considered are those filed with the statement of grounds of appeal.

3. Main request filed with the statement of grounds of appeal
- 3.1 Article 123(2) EPC - Extent of scrutiny and general considerations

The appellant raised three aspects in this respect which in the following are *paraphrased in italics*:

- 3.1.1 *In the present case examination for compliance with Article 123(2) EPC should be restricted to those amendments made in the opposition procedure, analogously to the approach taken in respect of*

amendments introducing a lack of clarity. Therefore it was requested that the analysis of compliance with the requirements according to Article 123(2) be based on the patent as granted rather than on the application as originally filed.

The argument in support of a form of "parallelism" between treatment of unclear features and added subject-matter/unallowable amendments introduced pre-grant proposed by the appellant (see section XV.(b).(i), above) fails since it disregards the fact that in contrast to added subject-matter/extension beyond the content of the application as originally filed lack of clarity is not one of the grounds of opposition according to Article 100 EPC.

Furthermore according to the case law of the Enlarged Board G 9/91 (OJ EPO 1993, 408) section 19 of the reasons which also relates to the appeal procedure (see section 17 of the reasons) it is stated:

"In order to avoid any misunderstanding, it should finally be confirmed that in case of amendments of the claims or other parts of a patent in the course of opposition or appeal proceedings, such amendments are to be fully examined as to their compatibility with the requirements of the EPC (e.g. with regard to the provisions of Article 123(2) and (3) EPC)."

This law thus requires that, in case of amendments in opposition or appeal proceedings, full examination of the amendments (and therefore in particular of the claims resulting from the amendments) is to be undertaken on appeal. There is no stipulation that the ground of Article 100(c) EPC has to have been invoked

in the notice of opposition.

Once it is established that the fulfilment of the requirements of Article 123(2) EPC has to be examined, the wording of the Article itself ("The ... European patent may not be amended in such a way that it contains subject-matter which extends beyond the content of the application as filed.") does not give any room for taking anything different than the application as filed as the basis for analysing compliance. Any different analysis, in particular analysis of the fulfilment of the requirements based on the patent as granted, would have no legal basis and be contrary to the explicit wording of the European Patent Convention.

Consequently the first contention of the appellant cannot be followed and the request of the appellant that the analysis of the fulfilment of the requirements according to Article 123(2) be based on the patent as granted rather than on the application as originally filed is refused.

- 3.1.2 *The approach of the Board was inconsistent with the approach foreseen in the Rules of Procedure in the version which entered into force in 2020 since it was incompatible with the "convergent approach" as had in fact been followed by the present Board in its decision not to admit the main request of September 2020.*

The Rules of Procedure are secondary law and cannot serve to override higher ranked law, such as that of the Enlarged Board and indeed the highest law namely the European Patent Convention itself. Furthermore the stipulations of the Rules of Procedure embodying the "convergent approach" - which wording is not found in

the Rules - apply to the parties and not to the boards.

Accordingly this contention also cannot be followed.

- 3.1.3 *The application was "typical" of many relating to new and inventive compositions which are drafted in the "USA style" and should therefore be read accordingly as disclosing also combination of features of dependent claims even if they are not dependent on each other to the extent that they are technically sensible.*

The first part of this contention cannot be disputed. It is true that applicants in different patent systems tend to formulate claim dependencies in different ways, namely mostly dependent only on the independent claims, with chains of dependencies or with multiple dependencies, and that this may be related to different requirements of the different patent systems. In the present case the appellant (then applicant) may have chosen to follow a combination of the first and the second approach in view of the requirements of the US patent system.

However, this was a deliberate choice of the appellant (then applicant) and there is no legal basis in the EPC for applying different requirements, or in particular for applying differently the requirements of Article 123(2) EPC, according to that choice.

Indeed, it cannot be disregarded that the choice of how to formulate the claim dependencies has consequences in respect of the disclosure which is provided to the skilled person by a patent application. While with a direct chain of dependencies a disclosure of a combination of features present in the different dependent claims so connected is generally provided,

this is clearly not the case with a plurality of single dependencies from a single independent claim. The situation may be somewhat intermediate in the case of multiple dependencies, e.g. in the case where each succeeding claim is dependent on all preceding claims. In this scenario formally many different combinations are possible and the question of whether a specific combination of features resulting from multiple selections is directly and unambiguously derivable from the disclosure in the application as filed may have to be answered.

In any case it must be examined whether the combinations of features present in the amended claims are directly and unambiguously derivable from the whole of the application as originally filed, as required by Article 123(2) EPC and the established case law and no different criterion can be used in view of a deliberately selected drafting style.

For these reasons also the third contention of the appellant also cannot be followed.

- 3.1.4 In summary the three contentions of the appellant as set out above amount to inviting the Board to depart from the law of the EPC, either as set out in the convention itself or that developed further by the Enlarged Board.

The Board, as an organ of the European Patent Organisation is by definition bound by the EPC and it is the purpose, duty and function of the Board to apply said law and nothing different.

Accordingly the Board cannot accommodate the appellant

in the manner proposed.

3.2 Added subject-matter - substantive considerations

Claim 1 of the main request corresponds to granted claim 1 up to the wording "flexural modulus...or greater", 5 lines from the end (line numbering based on the claim in the format as submitted by the appellant). Claim 1 as granted corresponds in its turn to original claim 1 with several amendments including in particular the indication of specific mineral fillers, the limitation of the flame retardant component to one comprising a phosphate based flame retardant and the specification of a quantity range for the mineral filler (1 to 20%). It is first examined whether a direct and unambiguous disclosure of the features added after grant in combination is to be found in the application as originally filed. As this is not the case (see below) a more detailed analysis also relating to the features added before grant and the overall combination is not necessary.

The first added feature specifying that the siloxane in the polycarbonate siloxane copolymer is present in an amount of 1-4% by weight of the total composition was present in original claim 4. This was in turn dependent on claim 2 which specified siloxane being present in the more general range of 0.5 to 6% by weight and mineral filler in an amount 1-20 % by weight. Accordingly the combination of the defined amounts of filler and siloxane is based on the original disclosure.

The next feature specifies the presence of an additional thermoplastic that is not a polycarbonate but is an ABS rubber. Original claim 5 - dependent on

claim 1 - specified the presence of an additional thermoplastic not being polycarbonate.

The requirement that this "non-PC" polymer be ABS is disclosed in original claim 7, which in turn is a special case of the polymers defined in original claim 6, which claim was dependent on claim 5. Accordingly there is no objection to this feature in isolation.

The final feature of the claim specifies that the flame retardant is present in an amount of 1-10 wt% which has a basis in original claim 19 which is dependent on the corresponding claim 1.

Thus claim 1 of the main request is a combination of the features of original claim 1 with (among others, see the amendments before grant discussed above) those of the following chains of claims linked by dependency:

4-->2,

7-->6-->5 and

19

whereby in each chain the lowest numbered claim is dependent on claim 1.

The consequence is that whilst for each of the above-noted features of the claim in isolation a basis can be found in the claims as originally filed, there is no disclosure therein of the claimed combination.

In addition to the original claims, the appellant provided reference to individual passages of the description, where the features are disclosed in isolation, in an annex to its letter of 22 September 2020 and to the passage on page 9, lines 5-7 during the oral proceedings before the Board. In addition the examples were cited.

Reference to passages of the description where the individual features are cited can however not lead to any different conclusion by the Board in the absence of any arguments on the side of the appellant regarding the combination of features.

With regard to the passage on page 9 lines 5-7 of the application as originally filed and its relevance for the combination of a phosphate based flame retardant and ABS, this passage does not refer specifically to ABS but more generally to "alkylaromatic copolymers" and states that when such are present it is preferable for the "flame retardant to comprise an organic phosphate flame retardant". This in turn is more specific than the claim which requires only a "phosphate based flame retardant". Accordingly this passage of the description cannot provide a basis for the presence of ABS in combination with a phosphate based flame retardant, and even less for the combination with the other features of the claim not mentioned therein.

The examples, invoked by the appellant cannot serve to provide a basis for the subject-matter as claimed since these by necessity each disclose a specific combination of components in specific amounts, but not the required generality.

The conclusion is that the main request does not meet the requirements of Article 123(2) EPC.

4. First and second auxiliary requests as filed with the statement of grounds of appeal

As explicitly acknowledged by the appellant the further amendments made to these requests were not directed to

addressing the matter of added subject-matter and resulted in no change to the assessment in respect of this provision of the EPC.

Accordingly these share the fate of the main request with the consequence that they also do not meet the requirements of Article 123(2) EPC.

Order

For these reasons it is decided that:

The appeal is dismissed.

The Registrar:

The Chairman:



B. ter Heijden

D. Semino

Decision electronically authenticated