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Datasheet for the decision of 27 March 2024

Case Number: T 1891/22 - 3.3.03

Application Number: 14860471.3

Publication Number: 3070126

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Language of the proceedings: EN

Title of invention:
AROMATIC POLYCARBONATE RESIN MOLDING

Patent Proprietor:
Idemitsu Kosan Co., Ltd.

Opponent:
SABIC Global Technologies B.V.

Relevant legal provisions:
RPBA 2020 Art. 12(4), 12(6)
EPC R. 80
EPC Art. 123(2)

Keyword:
Late-filed evidence - error in use of discretion at first instance (yes) - admitted (yes)
Amendment occasioned by ground for opposition - (yes)
Amendments - extension beyond the content of the application as filed (yes)

Decisions cited:
T 0750/11, T 1797/16, T 0276/20

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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 1891/22 - 3.3.03

D E C I S I O N
of Technical Board of Appeal 3.3.03
of 27 March 2024

Appellant: (Patent Proprietor)	Idemitsu Kosan Co., Ltd. 1-1, Marunouchi 3-chome Chiyoda-ku Tokyo 100-8321 (JP)
Representative:	Hoffmann Eitle Patent- und Rechtsanwälte PartmbB Arabellastraße 30 81925 München (DE)
Respondent: (Opponent)	SABIC Global Technologies B.V. Plasticslaan 1 4612 PX Bergen op Zoom (NL)
Representative:	Sabic Intellectual Property Group Sabic Intellectual Property Department P.O. Box 3008 6160 GA Geleen (NL)
Decision under appeal:	**Decision of the Opposition Division of the European Patent Office posted on 15 June 2022 revoking European patent No. 3070126 pursuant to Article 101(3)(b) EPC.**

Composition of the Board:

Chairman	D. Semino
Members:	M. Barrère
	A. Bacchin

Summary of Facts and Submissions

I. The appeal of the patent proprietor lies against the decision of the opposition division revoking European patent No. 3 070 126. The contested decision was based on fifteen amended sets of claims as main request and auxiliary requests 1 to 14.

The opposition proceedings were based on the grounds for opposition in Article 100(a) EPC, in relation to inventive step (Article 56 EPC), and those in Article 100(b) and (c) EPC.

II. Claim 1 of auxiliary request 1 read as follows:

"1. An aromatic polycarbonate resin molded body, which is obtained by molding a resin molding material comprising an aromatic polycarbonate resin (A), wherein:

the aromatic polycarbonate resin (A) is produced by interfacial polycondensation method;

the resin molding material comprises (i) at least one selected from a polyether compound (b1) having a polyoxyalkylene structure and an acid-generating compound (b2), and (ii) an antioxidant (C);

the molded body has a thin-walled portion having a thickness of 0.5 mm or less;

the molded body has an *o*-hydroxyacetophenone content of 1 ppm by mass or less and a nitrogen

atom content of 15 ppm or less, measured as indicated in the description; and

the molded body is free of a coloring agent having an absorption maximum in a wavelength range of from 500 nm to 600 nm,

wherein the acid-generating compound (b2) is at least one selected from a boronic acid anhydride having an aromatic ring and a sulfonate having an aromatic ring,

wherein a content of the polyether compound (b1) is from 0.01 part by mass to 5 parts by mass with respect to 100 parts by mass of the aromatic polycarbonate resin (A),

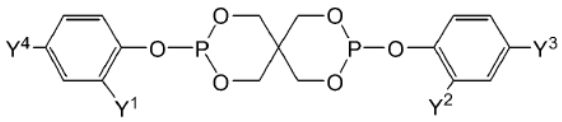
wherein a content of the acid-generating compound (b2) is from 0.0001 part by mass to 0.5 part by mass with respect to 100 parts by mass of the aromatic polycarbonate resin (A),

wherein the total content of the acid-generating compound (b2) is from 0.0001 part by mass to 0.5 part by mass with respect to 100 parts by mass of the aromatic polycarbonate resin (A), and

wherein the absorption maximum is determined using the conditions and equipment described in the description."

Claim 1 of auxiliary request 3 corresponded to claim 1 of auxiliary request 1 wherein the antioxidant (C) was:

"a pentaerythritol diphosphite compound represented by the following general formula (III),


(III)

in the formula, Y^1 to Y^4 each independently represent a hydrocarbon group having 6 or more carbon atoms".

Claim 1 of auxiliary request 6 corresponded to claim 1 of auxiliary request 3 wherein the content of antioxidant (C) was:

"from 0.005 part by mass to 1 part by mass with respect to 100 parts by mass of the aromatic polycarbonate resin (A)".

Claim 1 of auxiliary request 14 read as follows:

"1. An aromatic polycarbonate resin molded body, which is obtained by molding a resin molding material comprising an aromatic polycarbonate resin (A), wherein:

the aromatic polycarbonate resin (A) is produced by interfacial polycondensation method;

the resin molding material comprises (i) at least one selected from a polyether compound (b1) having a polyoxyalkylene structure and an acid-generating compound (b2), and (ii) an antioxidant (C);

the molded body has a thin-walled portion having a thickness of 0.5 mm or less;

the molded body has an *o*-hydroxyacetophenone content of 1 ppm by mass or less and a nitrogen atom content of 15 ppm or less, measured as indicated in the description; and

the molded body is free of a coloring agent having an absorption maximum in a wavelength range of from 500 nm to 600 nm,

wherein the acid-generating compound (b2) is at least one selected from a boronic acid anhydride having an aromatic ring and a sulfonate having an aromatic ring,

wherein a content of the polyether compound (b1) is from 0.01 part by mass to 5 parts by mass with respect to 100 parts by mass of the aromatic polycarbonate resin (A),

wherein a content of the acid-generating compound (b2), which is at least one selected from a boronic acid anhydride having an aromatic ring and a sulfonate having an aromatic ring, is from 0.0001 part by mass to 0.5 part by mass with respect to 100 parts by mass of the aromatic polycarbonate resin (A),

wherein the total content of acid-generating compound is from 0.0001 part by mass to 0.5 part by mass with respect to 100 parts by mass of the aromatic polycarbonate resin (A), and

wherein the absorption maximum is determined using the conditions and equipment described in the description."

The other requests underlying the contested decision are not relevant for the present decision.

III. The following documents were *inter alia* cited in the decision of the opposition division:

D12: Technical data sheet of MACROLEX® Violet R3 Gran
D13: Product data sheet of MACROLEX® Blue 3R
D14: Product data sheet of MACROLEX® Orange 3G
D15: Product data sheet of MACROLEX® Green 5B Gran
D16: Minutes of the oral proceedings before the opposition division in opposition case against EP 3 070 125
D17: Experimental report dated 16 February 2021
D18: Product brochure of Doverphos® S-9228 and Doverphos® S-9411
D19: US 5,364,895
D20: EP 2 792 711 A1
D20a: WO 2013/088796 A1
D21: Product brochure of TARFLON® polycarbonate

IV. The contested decision, as far as it is relevant to the present appeal, can be summarised as follows:

- Claim 1 of the main request did not comply with the requirements of Rule 80 EPC. The same applied to claim 1 of auxiliary requests 1 to 13.

- Claim 1 of auxiliary request 14 did not *prima facie* meet the requirements of Article 123(2) EPC and was on that basis not admitted into the proceedings for being clearly not allowable.

- Documents D12 to D20, D20a and D21 were not admitted into the proceedings.

V. With their statement of grounds of appeal, the patent proprietor (appellant) filed seven sets of claims as main request and auxiliary requests 1 to 6.

VI. Oral proceedings were held before the Board on 27 March 2024.

VII. The appellant requested that the decision under appeal be set aside and that the case be remitted to the opposition division for further prosecution on the basis of one of the claim sets of the main request or, subsidiarily, of auxiliary requests 1 to 6, all filed with the statement of grounds of appeal.

The opponent (respondent) requested that the appeal be dismissed or, in the alternative, that the case be remitted to the opposition division for further prosecution.

VIII. The main request and auxiliary requests 1 to 3 corresponded respectively to auxiliary requests 1, 3, 6 and 14 dealt with in the decision under appeal. Reference is made to point II. above for the exact wording of claim 1.

Claim 1 of auxiliary request 4 read as follows:

"1. An aromatic polycarbonate resin molded body, which is obtained by molding a resin molding material comprising an aromatic polycarbonate resin (A), wherein:

the aromatic polycarbonate resin (A) is produced by interfacial polycondensation method;

the resin molding material comprises (i) a polyether compound (b1) having a polyoxyalkylene structure and (ii) an antioxidant (C);

the molded body has a thin-walled portion having a thickness of 0.5 mm or less;

the molded body has an *o*-hydroxyacetophenone content of 1 ppm by mass or less and a nitrogen atom content of 15 ppm or less, measured as indicated in the description; and

the molded body is free of a coloring agent having an absorption maximum in a wavelength range of from 500 nm to 600 nm, wherein

wherein a content of the polyether compound (b1) is from 0.01 part by mass to 5 parts by mass with respect to 100 parts by mass of the aromatic polycarbonate resin (A),

the resin molding material may optionally comprise an acid-generating compound (b2), the acid-generating compound (b2) being at least one selected from a boronic acid anhydride having an aromatic ring and a sulfonate having an aromatic ring,

wherein a content of the acid-generating compound (b2), if present, is from 0.0001 part by mass to 0.5 part by mass with respect to 100 parts by mass of the aromatic polycarbonate resin (A),

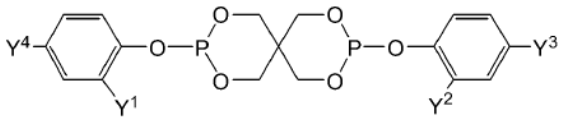
wherein the total content of acid-generating compound, if present, is from 0.0001 part by mass

to 0.5 part by mass with respect to 100 parts by mass of the aromatic polycarbonate resin (A), and

wherein the absorption maximum is determined using the conditions and equipment described in the description."

Claim 1 of auxiliary request 5 corresponded to claim 1 of auxiliary request 4 wherein the antioxidant (C) was:

"a pentaerythritol diphosphite compound represented by the following general formula (III),



(III)

in the formula, Y^1 to Y^4 each independently represent a hydrocarbon group having 6 or more carbon atoms".

Claim 1 of auxiliary request 6 corresponded to claim 1 of auxiliary request 5 wherein the content of antioxidant (C) was:

"from 0.005 part by mass to 1 part by mass with respect to 100 parts by mass of the aromatic polycarbonate resin (A)".

The remaining claims of these requests are not relevant to this decision.

IX. The appellant's submissions, in so far as they are pertinent to the present decision, may be derived from the reasons for the decision below. They were essentially as follows:

(a) Documents D12 to D20, D20a and D21

The decision of the opposition division not to admit documents D12 to D20, D20a and D21 into the proceedings should not be overturned.

(b) Main request

(i) Admittance

The main request complied with the requirements of Rule 80 EPC and should therefore be admitted into the proceedings.

(ii) Article 123(2) EPC

Claim 1 of the main request complied with the requirements of Article 123(2) EPC.

(c) Auxiliary requests 1 to 6

Claim 1 of auxiliary requests 1 to 6 complied with the requirements of Article 123(2) EPC.

X. The respondent's submissions, in so far as they are pertinent to the present decision, may be derived from the reasons for the decision below. They were essentially as follows:

(a) Documents D12 to D20, D20a and D21

The opposition division's decision not to admit documents D12 to D20, D20a and D21 into the proceedings should be set aside. Additionally, documents D12 to D15 should be admitted into the proceedings.

(b) Main request

(i) Admittance

The main request was filed late and did not comply with the requirements of Rule 80 EPC. It should therefore not be admitted into the proceedings.

(ii) Article 123(2) EPC

Claim 1 of the main request did not comply with the requirements of Article 123(2) EPC.

(c) Auxiliary requests 1 to 6

Claim 1 of auxiliary requests 1 to 6 did not comply with the requirements of Article 123(2) EPC.

Reasons for the Decision

1. Decision not to admit documents D12 to D20, D20a and D21

1.1 Documents D12 to D21 were filed by the opponent during the opposition proceedings within the time limit under Rule 116(1) EPC, whereas document D20a (the counterpart of D20 in Japanese) was filed a few days after that time limit. Since these documents were submitted after the opposition period laid down in Article 99(1) EPC, their admittance was subject to the discretion of the opposition division, which decided not to admit them into the proceedings due to lack of *prima facie* relevance. The respondent requested that the decision on admittance of the late-filed documents be overturned, essentially because it was insufficiently reasoned, to an extent that it was not possible for the respondent to assess whether the correct standards had been applied by the opposition division (rejoinder, pages 19 to 21, point 3.4).

1.2 According to the established case law, in particular decision G 7/93 (OJ EPO 1994, 775), point 2.6 of the reasons, Boards of Appeal should only overturn discretionary decisions of the first instance department if it is concluded that the said department exercised its discretion according to the wrong principles, or without taking into account the right principles or in an unreasonable way. This case law has been codified in Article 12(6) RPBA. In accordance with this provision, the board shall not admit, *inter alia*, items of evidence not admitted in the proceedings

leading to the decision under appeal, "unless the decision not to admit them suffered from an error in the use of discretion".

1.3 D12 to D21 were not admitted into the proceedings since they were not pertinent to the outcome of the opposition proceedings (point 5.3 of the grounds for the decision). In particular, the decision was taken after all requests of the patent proprietor were found to be either not admissible under Rule 80 EPC or not admitted into the proceedings for other reasons and even after revocation of the patent (minutes of the oral proceedings, page 2, point 7). It is furthermore not apparent that any discussion took place as to the admittance of these documents.

1.4 In the Board's view, the decision of the opposition division is not reasonable and furthermore infringes the opponent's right to be heard for two reasons:

(a) Firstly, the decision was apparently taken without giving the opponent any opportunity to explain why these documents should have been admitted (minutes of the oral proceedings, page 2, point 7).

(b) Secondly, the decision to exclude D12 to D21 from the proceedings was taken after all claim requests were found not to be allowable and on the ground that these documents were not "pertinent to the outcome of the present proceedings" (decision, page 11, point 5.3; minutes of the oral proceedings, page 2, point 7). In the present case, the decision under appeal was limited to specific issues under Rule 80 and Article 123(2) EPC. However, these documents were filed to address other objections raised by the opponent under Article 123(2) EPC and

objections under Article 56 EPC, which have not been addressed by the opposition division and which could become relevant in appeal proceedings or in case of a remittal to the opposition division. In other words, while a decision on admittance of documents D12 to D21 was not necessary in the proceedings which lead to the decision under appeal, it is not excluded that these documents could still be relevant in these appeal proceedings or upon remittal to the opposition division. It was therefore not reasonable to exclude these documents pre-emptively during the first instance opposition proceedings, as it deprived the opponent of fairly defending their case at a later stage of the proceedings. The opposition division should not have decided on admittance of these documents.

1.5 As the decision not to admit D12 to D20, D20a and D21 into the proceedings is not reasonable and adversely affects the opponent's right to be heard, the Board decided to set aside that part of the decision, leaving their admittance open for further consideration in the course of the proceedings, if necessary.

2. Admittance of documents D12 to D15

2.1 For the assessment of the compliance with Article 123(2) EPC, the respondent requested that documents D12 to D15 be admitted into the proceedings.

2.2 D12 to D15 had been filed by the opponent within the time limit set under Rule 116(1) EPC and in reaction to the preliminary opinion of the opposition division. The purpose of these documents was to further substantiate their objections under Article 123(2) EPC regarding the following feature of claim 1:

> "the molded body is free of a coloring agent having an absorption maximum in a wavelength range of from 500 nm to 600 nm".

In particular, these documents illustrated the transmission curves of various commercial colouring agents and supported the argument that a combination of colourants could lead to an absorption maximum in a wavelength range of from 500 nm to 600 nm (letter dated 17 March 2022, page 5, last paragraph).

2.3 During the oral proceedings before the Board, the appellant contested the admittance of D12 to D15 because these documents were late filed and not *prima facie* relevant for the decision. In particular, D13 was irrelevant as it concerned a colouring agent which was excluded from the scope of claim 1 because it was characterised by an absorption maximum in the wavelength range of 500 nm to 600 nm (D13, page 4, transmission curve).

2.4 The Board acknowledges that a central argument of the respondent was that:

> "the absence of a coloring agent having an absorption maximum in a wavelength range of from 500 nm to 600 nm" (feature (i))

did not imply that the moulded body according to claim 1 was

> "free of an absorption maximum in a wavelength range of from 500 nm to 600 nm" (feature (ii)).

This argument was particularly relevant at least in the context of an objection under Article 123(2) EPC, since feature (ii) appears to have been replaced by feature (i) in the claims on file. In view of the fact that D12 to D15 concern different colouring agents with different transmission spectra (having or not an absorption maximum between 500 nm and 600 nm), these documents are considered to be *prima facie* relevant for the assessment of the compliance with Article 123(2) EPC.

While it is correct that D12 to D15 were filed late (only two months before the oral proceedings, but still within the given time limit under Rule 116(1) EPC), the Board considers their filing as a timely and legitimate reaction to the preliminary opinion of the opposition division, which deemed the opponent's argument under Article 123(2) EPC unconvincing (letter dated 17 March 2022, page 4, first full paragraph with reference to the preliminary opinion of the opposition division, page 3, point 2.1.1.7).

2.5 Under these circumstances, the Board finds it appropriate to exercise its discretion under Article 12(4) and (6) RPBA by admitting document D12 to D15 into the proceedings.

Main request

3. Admittance into the proceedings

3.1 The present main request corresponds to auxiliary request 1 dealt with in the decision under appeal. The opposition division held that this request was not admissible because an amendment of claim 1 did not

comply with the requirements of Rule 80 EPC (contested decision, page 10, points 3.1 and 3.2).

Specifically, claim 1 of the main request was characterised by the following features:

> (iii) "a content of the acid-generating compound (b2) is from 0.0001 part by mass to 0.5 part by mass with respect to 100 parts by mass of the aromatic polycarbonate resin (A)"

and

> (iv) "the total content of the acid-generating compound (b2) is from 0.0001 part by mass to 0.5 part by mass with respect to 100 parts by mass of the aromatic polycarbonate resin (A)" (emphases here and below added by the Board)

The opposition division considered that features (iii) and (iv) were identical in scope. Consequently, the introduction of a non limiting feature (feature (iv)) in claim 1 as granted was not justified under Rule 80 EPC (contested decision, page 8, point 2.4).

3.2 While the respondent endorsed the findings of the opposition division, the appellant took the view that Rule 80 EPC did not place any restriction as to the form of amendments a patent proprietor can make to address objections raised. Amendments under Rule 80 EPC were formally admissible as long as they constituted an attempt to overcome a ground for opposition.

3.3 In that respect, the Board agrees with the appellant for the following reasons:

3.3.1 According to Rule 80 EPC, the description, claims and drawings of a European patent may be amended, provided that the amendments are occasioned by a ground for opposition under Article 100 EPC, even if that ground has not been invoked by the opponent.

In the present case, the Board considers that a distinction should be made between the purpose of an amendment submitted by the patent proprietor and whether the amendment is actually suitable to overcome an objection.

In agreement with the appellant, Rule 80 EPC does not require that the amendment actually overcomes a ground for opposition, which is a separate matter to be settled as part of the ensuing substantive examination, but merely that it is occasioned by a ground for opposition. For this reason Rule 80 EPC is also considered as a provision concerning admissibility of an amendment, which is not depending on the discretion of the deciding organ, as it must be assessed at any stage in the proceedings, irrespective of the time at which the amendment is filed (see e.g. T 750/11, reasons 2.3.2; T 1797/16, reasons 2.9 and T 276/20, Reasons 2.4).

3.3.2 The appellant initially introduced feature (iv) in claim 1 in order to overcome an objection under Article 123(2) EPC (corresponding to a ground for opposition under Article 100(c) EPC) raised by the opponent in the notice of opposition (page 7, point 3.2) while fulfilling at the same time the requirements of Article 123(3) EPC.

It was the position of the patent proprietor that feature (iv) introduced a further limitation in claim 1

and was therefore suitable to achieve this purpose (contested decision, point 2.5 of the reasons). While the opposition division did not agree with the fact that feature (iv) was limiting, the purpose of this amendment was nevertheless clearly related to a ground for opposition (under Article 100(c) EPC).

3.3.3 Therefore, irrespective of whether feature (iv) is suitable to overcome an objection of the opponent, the Board considers that this amendment was occasioned by a ground for opposition and therefore complies with Rule 80 EPC. Admittance is thus not barred under Rule 80 EPC.

3.4 The respondent further requested that the present main request not be admitted into the proceedings (rejoinder to the statement of grounds of appeal, page 11, second full paragraph) as it was late-filed and was not *prima facie* allowable (as stated at the oral proceedings before the Board).

3.5 The Board notes that no such request was made during the oral proceedings before the opposition division. Neither did the opposition division make any consideration on "late filing" of the then auxiliary request 1 (present main request), which was filed within the time limit for submissions in preparation of the oral proceedings under Rule 116(1) EPC, but limited its decision on the application of Rule 80 EPC. Indeed, it is apparent from the minutes (page 1, paragraph 4) that the opponent at the time objected to the admittance of other requests, but not of the present main request. In any event, even if the respondent's arguments, which were limited to the *prima facie* allowability of the main request, were taken into account by the Board in the exercise of its discretion

under Article 12(6) RPBA, the Board finds that without any further details, this objection cannot convince.

3.5.1 For these reasons, the Board considers that feature (iv) of claim 1 does not contravene the requirements of Rule 80 EPC and finds it appropriate to exercise its discretion under Article 12(4) and (6) RPBA by admitting the main request into the proceedings.

4. Article 123(2) EPC

4.1 Claim 1 of the main request is directed to an aromatic polycarbonate resin moulded body which is, *inter alia*:

> (i) "free of a coloring agent having an absorption maximum in a wavelength range of from 500 nm to 600 nm"

4.2 The respondent objected to the replacement of the following feature of claim 1 as originally filed:

> (ii) "free of an absorption maximum in a wavelength range of from 500 nm to 600 nm"

by feature (i).

In particular, according the respondent, features (i) and (ii) were not equivalent and there was no basis in the application as filed for replacing one by the other. In that respect, reference was made to documents D12 to D15 disclosing colouring agents excluded by feature (i) of present claim 1 but which could be allowable to achieve feature (ii).

4.3 The appellant contested the respondent's submissions regarding the lack of basis in the application as filed

for feature (i) (statement of grounds of appeal, page 12, points c) and d)). They argued that original claim 1 and paragraph [0012] of the application provided support for this feature. In particular, it was specified in this paragraph that the moulded body of the invention could be obtained without blending a colouring agent. This amendment was also supported by comparative example 4 of the application as filed which concerned a composition comprising a colouring agent having an absorption maximum between 500 nm to 600 nm while all examples according to the invention did not contain this compound.

Additionally, they stated that the term "coloring agent" encompassed any compound with an absorption maximum in the specified range, as confirmed by the measurement methods described in the application.

During the oral proceedings before the Board, the appellant further argued that feature (ii) had been replaced with feature (i) due to a clarity objection raised in a third party observation. In this objection, the third party had pointed out that feature (ii) corresponded to a result to be achieved and that the applicant should instead have specified the feature necessary to achieve that result (i.e. the absence of colouring agent having an absorption maximum in a wavelength range of from 500 nm to 600 nm corresponding to feature (i)).

4.4 As noted previously, claim 1 as originally filed is limited by feature (ii). In fact, this feature limits the scope of all original claims. Turning to the description as filed, it can also be derived therefrom that the "molded body of the present invention" must be free of an absorption maximum between 500 nm and 600 nm

(paragraphs [0007], [0009] and [0012]). Consequently, in the Board's view, feature (ii) is clearly an essential feature of the claimed invention as filed. The examples according the invention are also in line with this interpretation as none of them is characterised by an absorption maximum between 500 nm and 600 nm (see table 1, examples 1 to 11).

Paragraph [0012] of the original application further specifies the meaning of feature (ii):

> "the phrase "free of an absorption maximum in the wavelength range of from 500 nm to 600 nm" means that when 6 g of an aromatic polycarbonate resin moulded body is dissolved in 50 mL of methylene chloride, and the absorption spectrum of the solution is measured with a quartz cell having an optical path length of 5 cm and a UV-visible spectrophotometer by a transmission method, no absorption maximum is present in the wavelength range of from 500 nm to 600 nm."

This method makes it clear that the absence of an absorption maximum is to be measured on the whole body and not on specific substances.

4.5 Considering that feature (ii) is an essential feature of the claimed invention as originally filed, the Board needs to assess whether it can be replaced by feature (i) as argued by the appellant.

In this respect, the Board does not contest that feature (i) as such can be derived from the first paragraph on page 6 of the description as filed. However, the Board agrees with the respondent that features (i) and (ii) are not equivalent in scope.

Indeed, the mere absence of a colouring agent having an absorption maximum in the 500 to 600 nm wavelength region (corresponding to feature (i)) does not imply that the moulded body will likewise have no absorption maximum in said range (corresponding to feature (ii)), and *vice versa* (rejoinder to the statement of grounds of appeal, page 22, last paragraph). In other words, a composition may be free of a colouring agent having an absorption maximum in the 500 to 600 nm wavelength region but have an absorption maximum in that region due to the combined absorption of the components present in the composition. Conversely, a composition may contain a colouring agent having an absorption maximum in the 500 to 600 nm wavelength region but have no absorption maximum in that region due to the combined absorption of the components present in the composition.

Therefore, in view of the fact that feature (i) is not equivalent to essential feature (ii), present claim 1 covers materials which were not encompassed by the application as filed (i.e. materials having an absorption maximum in the 500 to 600 nm wavelength region but no colouring agent having an absorption maximum in that range). Consequently, the scope of present claim 1 goes beyond the content of the application as filed.

4.6 The appellant additionally argued that the absence of a colouring agent having an absorption maximum between 500 to 600 nm was to be measured on the whole body according to the method specified in paragraph [0012] of the application as filed.

This interpretation is, however, not supported by a normal reading of feature (i), which only requires the absence of a colouring agent having said absorption maximum. Consequently, it makes no doubt for the skilled person that no colouring agent (taken individually) should be characterised by this property and not the moulded body as a whole. Whilst it is true that claim 1 of the main request specifies that the absorption maximum is determined "using the conditions and equipment described in the description", it does not state that the absorption spectrum is to be measured on the composition of the moulded body as a whole, and the Board has no reason to believe that this should be the case.

4.7 During the oral proceeding, the appellant further contended that feature (ii) was unclear as argued in a third party observation during examination proceedings and that the true object of the invention was a moulded body not comprising any bluing colouring agent corresponding to feature (i). In other words, the Board derives from the appellant's submission that the skilled person would have understood from the application as filed that feature (ii) should be replaced by feature (i).

The interpretation put forward by the appellant is, however, not supported by the original application. First, the Board has *prima facie* no reason to hold feature (ii) to be unclear. In fact, should that be the case, the description as filed provides a clear guidance on how to determine the presence or absence of an absorption maximum for the whole body (see the method specified in paragraph [0012] of the application as filed).

Moreover, the Board has also no reason to consider that feature (ii) was incompatible with the purpose of the invention as filed. Instead, as explained previously (point 4.4 above), feature (ii) is considered to be an essential feature of the claimed invention. While the absence of a colouring agent having an absorption maximum in the 500 to 600 nm range (feature (i)) might be a further objective of the invention or a preferred embodiment, there is no basis for replacing feature (ii) with feature (i).

The appellant referred to comparative example 4 of the original application to argue that the presence of a colouring agent with an absorption maximum between 500 and 600 nm was clearly excluded from the scope of the invention. While this may be true, it should also be noted that the moulded body of comparative example 4 is also characterised by the presence of an absorption maximum in the 500 to 600 nm range, which means that both features (i) and (ii) are absent in this example. Consequently, it cannot be derived from comparative example 4 that feature (ii) is optional or could be replaced by feature (i).

4.8 In summary the Board considers that:

feature (ii) is an essential feature of the invention according to the application as filed,

features (i) and (ii) are not equivalent in scope,

the replacement of feature (ii) by feature (i) in present claim 1 has no basis in the application as filed and extends to subject-matter which was not originally covered.

4.9 For these reasons, claim 1 of the main request does not comply with the requirements of Article 123(2) EPC.

Auxiliary requests 1 to 6

5. In auxiliary requests 1 to 6, claim 1 is limited by feature (i) while feature (ii) is absent. However, as noted previously in the context of the main request (point 4. above), the replacement of feature (ii) by feature (i) extends to subject-matter which was not covered by the application as filed.

Therefore, claim 1 of each of auxiliary requests 1 to 6 does not comply with the requirements of Article 123(2) EPC and these requests are not allowable.

6. As none of the appellant's requests complies with the requirements of Article 123(2) EPC, there is no need to deal with any other issue. In particular, there is no need to deal with the appellant's conditional request for remittal to the opposition division for further prosecution, since that request does not become active. The appeal is therefore to be dismissed.

Order

For these reasons it is decided that:

The appeal is dismissed.

The Registrar: The Chairman:

D. Hampe D. Semino

Decision electronically authenticated