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Datasheet for the decision of 7 October 2025

Case Number: T 0189/23 - 3.3.03

Application Number: 17764498.6

Publication Number: 3296360

IPC: C08L67/02

Language of the proceedings: EN

Title of invention:
BIO-DEGRADABLE POLYESTER COMPOSITION

Patent Proprietor:
Kingfa Sci. & Tech. Co., Ltd.

Opponent:
BASF SE

Relevant legal provisions:
EPC Art. 100(a), 100(b), 111(1)
RPBA 2020 Art. 11, 12(2), 12(4)

Keyword:
Appeal case directed to facts on which decision was based (yes)
Amendment to case - evidence - suitability of amendment to address issues (yes)
Sufficiency of disclosure - undue burden (no)
Novelty - implicit disclosure (no)
Appeal decision - remittal to the department of first instance (yes)

Decisions cited:
G 0001/03, T 1845/14, T 0617/16, T 0409/17, T 2603/18

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Case Number: T 0189/23 - 3.3.03

D E C I S I O N
of Technical Board of Appeal 3.3.03
of 7 October 2025

Appellant: (Patent Proprietor)	Kingfa Sci. & Tech. Co., Ltd. No.33 Kefeng Road Science City Guangzhou Hi-tech Industrial Development Zone Guangzhou, Guangdong 510663 (CN)
Representative:	Dompatent Partnerschaft von Patent- und Rechtsanwälten mbB Deichmannhaus am Dom Bahnhofsvorplatz 1 50667 Köln (DE)
Respondent: (Opponent 2)	BASF SE Carl-Bosch-Strasse 38 67056 Ludwigshafen (DE)
Representative:	Meissner Bolte Partnerschaft mbB Patentanwälte Rechtsanwälte Postfach 86 06 24 81633 München (DE)
Decision under appeal:	**Decision of the Opposition Division of the European Patent Office posted on 22 November 2022 revoking European patent No. 3296360 pursuant to Article 101(3)(b) EPC.**

Composition of the Board:

Chairman	D. Semino
Members:	M. Barrère
	W. Ungler

Summary of Facts and Submissions

I. The appeal of the patent proprietor lies against the decision of the opposition division revoking European Patent No. 3 296 360. This decision was based on the patent as granted as the main request and six amended sets of claims filed as auxiliary requests I to VI with the reply to the notices of opposition.

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

D2: WO 2011/054896 A1
D3: Experimental report "Polymer composition according to WO 2011/054896 A1" dated 17 May 2021
D5: WO 2006/074815 A1
D7: EP 3 260 496 A1
D8: EP 3 260 497 A1
D9: EP 3 260 498 A1
D11: WO 2012/152820 A1
D12: WO 2014/075998 A1
D20: Declaration by Dr.Timothy D. Klots dated 8 September 2022
D21: Experimental report "polymer composition according to EP 3 296 360 B1" dated 9 September 2022
D22a: Joint press release by BASF and JohnsonDiversey dated 2 May 2006
D22b: BASF Financial Report 2006, published on 14 March 2007
D23: Safety data sheet of Joncryl® ADR 4368-C dated 20 September 2011

D25: Experimental report filed by the patent proprietor in opposition proceedings in relation to D7
D26: Experimental report filed by the patent proprietor in opposition proceedings in relation to D8
D27: Experimental report filed by the patent proprietor in opposition proceedings in relation to D9

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

- D20, D21, D22a, D22b, D23, D25, D26 and D27 were admitted into the proceedings.

- The subject-matter of claim 1 of the main request was novel in view of the disclosure of D2, D5, D7, D8, D9, D11 and D12.

- The opposed patent did not disclose the invention in a manner sufficiently clear and complete for it to be carried out by a person skilled in the art. This conclusion applied both to the main request and to auxiliary requests I to VI.

The patent was therefore revoked by the opposition division.

IV. The patent proprietor (appellant) filed an appeal against said decision.

V. With the statement of grounds of appeal, the appellant filed the following documents:

D28: Excerpt of the textbook "Static Headspace-Gas Chromatography – Theory and Practice", Bruno Kolb and Leslie S. Ettre, Wiley-VCH Inc., 1997, ISBN 0-471-19238-4
D29: "Agilent 7697A Headspace Sampler – Advanced Operation", manual, 2011

VI. Opponent 1 (Novamont S.p.A., no longer party to the proceedings, see point 1.1, below) and opponent 2 (respondent) filed a rejoinder to the statement of grounds of appeal.

VII. On 6 December 2024, the parties were summoned to oral proceedings scheduled to take place on 10 October 2025.

VIII. With letter dated 13 January 2025, the respondent indicated that they did not intend to participate in the oral proceedings.

IX. On 17 April 2025, the Board issued a communication under Article 15(1) RPBA. In that communication, the Board expressed its preliminary intention to set aside the decision and to remit the case to the opposition division for further prosecution on the basis of the appellant's main request (point 12 of the communication).

X. On 8 August 2025, opponent 1 withdrew their opposition.

XI. With letter of 25 September 2025 the appellant clarified their main request.

XII. Thereafter the oral proceedings were cancelled.

XIII. The requests of the parties were as follows:

(a) The appellant requested that the decision under appeal be set aside and that the case be remitted to the opposition division for discussion of inventive step. In the alternative, the appellant requested maintenance of the patent in amended form on the basis of auxiliary requests I to VI all filed with the reply to the notices of opposition.

(b) The respondent requested dismissal of the appeal.

XIV. Claim 1 as granted (main request of the appellant) read as follows:

"1. A biodegradable polyester composition comprising following components in parts by weight:

i) 65 to 95 parts of the biodegradable aliphatic-aromatic polyester;

ii) 5 to 35 parts of the polylactic acid;

iii) 5 to 25 parts of the organic filler and/or the inorganic filler,

wherein based on a total weight of the biodegradable polyester composition, a weight content of glycidyl methacrylate is 0.05 ppm - 10 ppm."

The remaining claims of this request as well as the claims of auxiliary requests I to VI are not relevant to this decision.

XV. The parties' submissions, in so far as they are pertinent, may be derived from the reasons for the

decision below. The points of dispute that are relevant for the present decision are the following ones:

- the admittance of documents D20, D21, D22a, D22b, D23, D25, D26 and D27 into the proceedings (point 2. of the reasons);

- the admittance of documents D28 and D29 into the proceedings (point 3. of the reasons);

- the question of sufficiency of disclosure (point 4. of the reasons) and

- the novelty of the subject-matter of granted claim 1 in view of the disclosure of documents D2, D5, D7, D8, D9, D11 or D12 (point 5. of the reasons).

Reasons for the Decision

1. Procedural aspects

1.1 Opponent 1 is no longer party to the proceedings as a consequence of the withdrawal of the opposition. Any request or submission of opponent 1 filed before the withdrawal is therefore of no relevance for the present decision.

1.2 The appellant's main request is that the decison under appeal be set aside and the case be remitted to the opposition division on the basis of the patent as granted for the discussion of inventive step (statement of grounds of appeal, page 1, last paragraph; letter dated 25 September 2025, page 1). Oral proceedings were only requested as an auxiliary request (letter dated 25 September 2025, page 1). As the Board decided to allow the main request, the appellant's request for oral proceedings became moot.

1.3 The respondent initially requested oral proceedings in the event that the Board did not issue a decision dismissing the appeal (rejoinder, page 1, second paragraph). However, with letter dated 13 January 2025, the respondent stated that they did not intend to participate in the oral proceedings which, in line with the established jurisprudence, the Board interprets as a withdrawal of the request for oral proceedings (Case Law of the Boards of Appeal, 11th edition 2025, in the following "Case Law", III.C.5.3.3 b)).

1.4 The respondent's right to be heard is respected, since they had the opportunity to take position on all the issues on which this decision is based. In fact, the conclusions of the present decision were communicated to the parties well in advance of the date scheduled to hold oral proceedings (see Board's communication under Article 15(1) RPBA). Considering that no counter-arguments were put forward in reaction to that communication, there is no reason for the Board to deviate from the views expressed therein.

1.5 In view of this, the decision can be taken in writing and the oral proceedings were cancelled, as not deemed necessary.

2. Admittance of documents D20, D21, D22a, D22b, D23, D25, D26 and D27

2.1 D20, D21, D22a, D22b, D23, D25, D26 and D27 were submitted by the opponents with their letters dated 9 September 2022 and admitted into the proceedings by the opposition division (contested decision, points 3.6 and 4.5 of the Reasons).

2.2 The appellant contests the admittance of these documents for the following reasons:

- documents D20, D22a, D22b and D23 should have been filed with the notices of opposition (statement of grounds of appeal, page 3, point 1.2);

- documents D21, D25, D26 and D27 were not *prima facie* relevant to the question of sufficiency of disclosure (statement of grounds of appeal, pages 13 and 14, point 1.4).

2.3 The Board notes that documents D20, D21, D22a, D22b, D23, D25, D26 and D27 were not only admitted by the opposition division but also taken into account in the decision under appeal (page 12, first paragraph; page 16, second paragraph; paragraph bridging pages 16 and 17). According to a number of decisions to which the present Board agrees (Case Law, V.A.3.4.3 and in particular T 617/16, point 1.1.1 of the reasons or T 2603/18, points 1.1 and 1.2 of the reasons), the EPC does not provide a legal basis for excluding documents, requests or evidence on appeal if the contested decision was based on them. In view of the very aim of the appeal proceedings to review the decision under appeal in a judicial manner according to Article 12(2) RPBA, such submissions are automatically part of the appeal proceedings.

2.4 It follows that the Board does not have the discretion to retroactively exclude D20, D21, D22a, D22b, D23, D25, D26 and D27 from the proceedings.

3. Documents D28 and D29

3.1 D28 and D29 are new items of evidence filed by the appellant with the statement of grounds of appeal. Their admission to the proceedings, which is contested by the respondent, is subject to the discretionary power of the Board in accordance with Article 12 paragraphs (4) to (6) RPBA.

3.2 According to the appellant, D28 and D29 provide evidence of the common general knowledge of the skilled person in relation to Headspace-Gas Chromatography (HS-GC) (statement of grounds of appeal, page 4, penultimate paragraph and page 11). They were filed in reaction to the discussion that arose during the oral

proceedings and the decision of the opposition division (statement of grounds of appeal, page 3, second paragraph).

3.3 The admittance of D28 and D29 was contested by the respondent for the following reasons (rejoinder, page 2, penultimate paragraph to page 3, first paragraph):

- The patent proprietor did not explain how the circumstances of the appeal case would justify the admittance of D28 and D29.

- The issue of insufficient disclosure of the HS-GC analysis technique was raised in the notice of opposition of former opponent 1 and pursued throughout the entire opposition proceedings. D28 and D29 should have been filed during opposition proceedings in reaction to that objection.

3.4 In this respect, the Board notes that the finding of insufficient disclosure was largely based on D21, a document submitted by former opponent 1 only two months before the oral proceedings before the opposition division (see contested decision, point 4.3 on pages 16 and 17). Based on this document, the opposition division concluded that varying certain headspace parameters could significantly impact the results obtained. However, the opposed patent lacked essential details about the static HS-GC method for measuring GMA content.

3.5 In the Board's view, D28 and D29 provide evidence of common general knowledge in relation to the HS-GC analysis technique and therefore directly address a key issue which the opposition division derived from D21, namely whether the skilled person could be expected to

accurately measure the GMA content by the HS-GC method based on the teaching of the patent.

3.6 In view of the fact that D28 and D29 address a central question of the decision, which was based on late-filed evidence from former opponent 1, the Board finds it appropriate to exercise its discretion under Article 12(4) RPBA by admitting these documents into the proceedings.

Main request (patent as granted)

4. Sufficiency of disclosure

4.1 Claim 1 as granted is directed to a biodegradable polyester composition comprising the following components in parts by weight:

i) 65 to 95 parts of biodegradable aliphatic-aromatic polyester;
ii) 5 to 35 parts of polylactic acid;
iii) 5 to 25 parts of organic filler and/or inorganic filler,

wherein based on a total weight of the biodegradable polyester composition, a weight content of glycidyl methacrylate is 0.05 ppm - 10 ppm (the relevant feature for the following discussion is emphasised by the Board).

4.2 In the decision under appeal, the opposition division found that the claimed invention was insufficiently disclosed for it to be carried out by the person skilled in the art (points 4.1 to 4.4 of the Reasons). The opposition division's reasoning can be summarised as follows:

- The opposed patent did not provide sufficient guidance for accurately determining the GMA content in the polyester composition, a crucial technical feature for achieving the claimed surface properties of the film material.

- Although the patent described the components and general preparation methods, it lacked detailed parameters for the static HS-GC method used to measure the GMA content (in particular the heater temperature and the equilibration time). Experimental evidence (D21 and D25 to D27) showed that variations in these parameters could significantly affect the results, reinforcing the doubts raised by the opponents.

- The examples of the patent also failed to address this deficiency, as they provided only the final GMA content without disclosing the initially added amount or the exact headspace test conditions used. This made it impossible for a skilled person to reliably reproduce the results or verify whether their compositions met the GMA content defined in claim 1.

- Ultimately, this lack of a clear and complete technical teaching placed an undue burden on the skilled person. Hence, the invention could not be performed with the necessary reliability to solve the technical problem.

4.3 The appellant essentially argued that the person skilled in the art could indeed determine whether a biodegradable polyester composition met the GMA content requirement defined claim 1. They supported this with

D28, which outlined the principles of static HS-GC and explained that equilibrium conditions were essential for accurate measurements. Once equilibrium was reached, variations in temperature or equilibration time only affected sensitivity, not the test result itself.

The appellant further contended that document D21 failed to show whether an equilibrium was achieved, so that the differences in results between "Set A" and "Set B" were irrelevant. Likewise, D25 to D27 only highlighted expected changes in sensitivity with temperature and time, not an inability to measure GMA content accurately. Setting up HS-GC was part of common general knowledge (as supported by D29). A skilled person would therefore know how to configure and run the method without explicit guidance in the patent.

On this basis, the appellant concluded that the opposed patent disclosed the invention in a manner sufficiently clear and complete for it to be carried out by the person skilled in the art.

4.4 The respondent agreed with the conclusion of the opposition division that, in light of the evidence on file, the method of determination of the GMA content as provided in the patent was deficient, since the relevant test parameters were not defined, with the consequence that the skilled person was unable to determine whether a given composition had a GMA weight content of 0.05 to 10 ppm and thus could not reliably provide a polyester composition in accordance with claim 1 (rejoinder, point 3 on pages 2 and 3). While contesting the admittance of documents D28 and D29, they did not take position on them.

4.5 The main point of dispute in the context of sufficiency of disclosure is whether the person skilled in the art has sufficient information in the contested patent alone or in combination with the common general knowledge to determine whether or not a polymeric composition comprises 0.05 to 10 ppm of GMA. In that regard, it is not disputed that the method to be used is the static HS-GC analysis technique described in paragraphs [0010], [0029] and [0030] of the opposed patent. The respondent's contention is that the opposed patent lacked detailed parameters for the static HS-GC method (in particular the equilibration time and heater temperature). The skilled person would therefore not be able to measure accurately the GMA content and therefore to reproduce the claimed invention.

4.6 In that respect, the Board concurs with the appellant for the following reasons:

4.6.1 As regards sufficiency of disclosure, an invention has to be disclosed in a manner sufficiently clear and complete for it to be carried out by the skilled person, without undue burden, on the basis of the information provided in the patent specification, if needed in combination with the skilled person's common general knowledge. In the following, the Board will therefore examine the alleged missing details and assess whether their absence would indeed prevent the skilled person from carrying out the invention without undue burden.

Equilibration time

4.6.2 With regard to the equilibration time, the Board agrees with the appellant that the person skilled in the art can rely on the common general knowledge as evidenced

by D28 and D29. It is known from D28 (page 3, first paragraph of section 1.2) that the equilibrium of a volatile compound between the gas phase and the condensed phase is in principle a prerequisite for an accurate measurement of that compound by HS-GC. Hence, even if the opposed patent does not specify how long the thermostatting should last, the skilled person cannot ignore that it should be sufficient to reach an equilibrium between the condensed phase and the gas phase. Therefore, the Board considers that the skilled person does not need any specific instruction but can adjust the time depending on the temperature and the compound to be quantified as shown on page 119, figure 4-1 of D28.

Equilibrium temperature

4.6.3 It is also well known that the vapour pressure and partition coefficient of a given volatile compound are related to the equilibrium temperature, as described in point 2.3.1 of D28: the higher the equilibrium temperature, the higher the vapour pressure (see for instance page 21, figure 2.2 of D28). This means that a change in temperature affects the GMA vapour pressure, i.e. the content of GMA in the gas phase. In other words, increasing temperature is expected to increase the GMA content in the gas phase which results in an increased sensitivity (or response factor) of the measurement. However, since the person skilled in the art would use the same conditions when measuring the actual sample and the calibration standards (which are needed for quantification), the response factor should have no influence on the results obtained based on a standard curve (see D28, page 60, first paragraph of point 3.4.1). This implies that, in principle, the same GMA content should be measured regardless of the

temperature, provided that an equilibrium is reached between the gas phase and the condensed phase.

4.6.4 While D21 showed that the response factor was influenced by the sample thermostatting conditions (temperature and equilibration time), this experimental report does not disclose the GMA content derived from a standard calibration curve. It is therefore not possible to conclude that the skilled person would obtain different GMA contents under different thermostatting conditions.

Although it is true that the response factor at 190°C reported in D21 is lower than the response factor at 150°C (contrary to the theoretical considerations put forward by the appellant), this could also be explained by an insufficient equilibration time (30 minutes at 190°C vs. 50 minutes at 150°C). In any case, the evidence on file is insufficient to explain the reason for these differences.

Accordingly, the Board cannot rely on D21 to draw any conclusion on the effect of temperature on the GMA content.

Further remarks

4.6.5 In the decision under appeal declarations D25 to D27 filed by the appellant in opposition proceedings relating to patent applications D7 to D9 were additionally cited to confirm the need to specify the headspace temperature and time in order to reliably perform the measurement. It was stated therein that:

> "*It is well known in the art that the higher the headspace temperature and the longer the headspace*

time, the larger the test data will be." (see D25, page 3 first paragraph; D26, page 2, penultimate paragraph; D27, page 2, last paragraph)

In the Board's view the cited passage is ambiguous as it is not clear whether the "test data" refer to the response factor or to the organic volatile content derived from a calibration curve. Therefore, it seems difficult to rely on these declarations as evidence that the GMA content would depend on the HS-GC measurement conditions.

4.6.6 In conclusion, the Board considers that the skilled person does not need any specific instruction to select an equilibration time and temperature in order to measure the GMA content of a polymeric composition using HS-GC. As noted above, it is common general knowledge that the equilibration time needs to be sufficient to achieve an equilibrium between the condensed phase and the gas phase. As regards the equilibration temperature, it is also common general knowledge that it should not have any influence on the measured content of a volatile compound provided that the samples and the standards (for the calibration curve) are all measured under the same conditions, as would be done by the skilled person without the need of any further instruction. In any event, the respondent has not shown that the GMA content would depend on the thermostatting conditions provided that an equilibrium is achieved. Instead the evidence available on file relate to the response factor which is not the same.

4.6.7 Last but not least, even if it were concluded that the GMA content would be dependent on the thermostatting conditions (which is not the Board's view), it should also be shown that this dependency goes beyond a mere

clarity issue. This has also not been made credible by the respondent.

4.6.8 In the contested decision (see page 14, penultimate paragraph), the opposition division additionally considered that the provision of a polymeric composition comprising 0.05 to 10 ppm of GMA was essential to solve the problem of the invention which is to obtain a film material having improved surface properties. This argument has not been maintained by the respondent in their written submissions and the Board does not see any reason to find it relevant in the context of sufficiency of disclosure. For the sake of completeness, it is pointed out that the effect of the GMA content on the surface properties is not expressed in the claims but is only part of the problem to be solved (opposed patent, paragraphs [0003] and [0004]). According to established case law, the ability of the skilled person to solve that problem by reproducing what is claimed is not a suitable criterion for assessing sufficiency of disclosure when, as in the present case, the problem is not part of the definition of the claimed subject-matter (see G 1/03, reason 2.5.2, third paragraph, second sentence; T 1845/14, point 9.8 of the reasons; T 409/17, point 3.3.3 of the reasons).

4.7 Consequently, on the basis of common general knowledge, the Board has no reason to consider that a person skilled in the art would not be able to reproduce the invention as defined in the claims without undue effort and in particular to measure the GMA content using HS-GC chromatography. Therefore it is concluded that the requirements of sufficiency of disclosure are met.

5. Novelty

5.1 According to the respondent, the subject-matter of operative claim 1 lacks novelty over each of documents D2, D5, D7 to D9, D11 and D12 (rejoinder, page 3, second paragraph).

5.2 The central point of dispute between the parties is whether the compositions of the prior art contain 0.05 to 10 ppm of GMA as required by claim 1.

5.3 In that respect, the line of argument put forward by the respondent can be summarised as follows (rejoinder, point 4 on pages 3 to 7):

- Documents D2, D5, D7 to D9, D11 and D12 disclosed compositions comprising a calculated amount of GMA in the range of 0.05 ppm to 10 ppm or at least overlapping with that range.

- Even if some GMA was lost during processing (due to evaporation or reaction with the other components), its content would still remain within the range defined in operative claim 1.

5.4 The appellant agreed with the opposition division that novelty should be acknowledged, given that there were reasonable doubts about the exact amount of GMA in the compositions of the prior art (contested decision, point 3.5 of the reasons). GMA was not explicitly mentioned in the cited documents, and it was questionable whether it was present at all. In addition, the calculated amounts of GMA put forward by the respondent were purely speculative. The boiling point of GMA was 189°C, a temperature well above room temperature. Therefore, it was completely unpredictable

to what extent GMA, if present, evaporated from the composition over time (letter of the appellant dated 20 December 2023, page 3, third paragraph).

5.5 With regard to the GMA content, the Board agrees with the appellant and the opposition division for the following reasons:

5.5.1 For the sake of clarity, the Board, following the order in which the documents were dealt with in the decision under appeal, addresses first novelty with respect to document D7 and then assesses whether the conclusion reached for that document applies to the other cited documents.

5.5.2 D7 discloses polyester compositions comprising, among other components, Joncryl® ADR 4370, a copolymer of styrene and GMA (see embodiments 2 and 7 of Table 1). Former opponent 1 calculated that the initial GMA content present in these compositions (added through the Joncryl polymer) was 3–30 ppm (see the rejoinder of former opponent 1, pages 23 and 24, paragraphs 127 and 128). The respondent also considered that the step of compounding the components at 150 to 250°C was not relevant for the assessment of novelty (rejoinder, page 6, penultimate paragraph).

5.5.3 It is not disputed by the parties that GMA is both a volatile and a somewhat reactive compound. However, the respondent's objection is based on the assumption that GMA does not significantly react and volatilise during the processing of the compositions of D7 (at 140°C to 240°C according to paragraph [0031]). This alleged fact is not supported by evidence and is also inconsistent with the assertion of former opponent 1 that the GMA content inevitably decreases over time. The Board

therefore has no reason to consider that the GMA content in the examples of D7 should remain essentially constant during processing and should be in the range of 0.05 to 10 ppm.

5.5.4 The respondent also argued that the examples in the patent show that GMA did not disappear entirely during processing (rejoinder, page 6, last paragraph). While this is true, the initial amount of GMA added to the compositions given as examples is not specified. Therefore, no conclusion can be drawn from these examples regarding the degree of GMA loss during processing.

5.5.5 Under these circumstances, in the absence of suitable evidence that the compositions of D7 implicitly contained 0.05 to 10 ppm of GMA, the subject-matter of granted claim 1 is considered to be novel in view of the disclosure of D7. The same conclusion applies *mutatis mutandis* to D5, D8, D9, D11 and D12, all of which are based on theoretical calculations that assume there is no loss of GMA during the storage and processing of the components that make up the composition, rather than on experimental evidence. For the sake of completeness, the respondent further argued that, at least during the initial stages of the compounding step in example 2 of D11, the GMA would not have had the opportunity to escape. Therefore, at these early stages, the composition of example 2 corresponded to that defined in claim 1. This argument is, however, not convincing. The source of GMA in example 2 of D11 is a masterbatch. As observed by the opposition division (see contested decision, page 12, third paragraph), given the high processing temperature of the masterbatch, it cannot be assumed that its GMA content would be sufficient to reach 0.05 ppm to 10 ppm

in the composition of example 2, even assuming no loss of GMA during the initial processing stages.

5.5.6 As to D2, an experimental reproduction of its example 1 was additionally present on file (see D3, page 2, point 2). It revealed a GMA content of 1.13 ppm in the copolyester composition and 0.54 ppm in the film derived from that composition (see D3, page 6, table 2).

5.5.7 It is not disputed that the only source of GMA in the compositions of D2 comes from the residual monomer present in the styrene-GMA copolymer. However, as noted by the opposition division, D2 does not specifically mention the styrene-glycidyl methacrylate copolymer used in example 1 of D2. It follows that the amount of GMA initially present in the said copolymer is not known and that it is not possible to reproduce said example in order to determine the GMA content (contested decision, page 9, first full paragraph). Accordingly, the GMA content calculated on the basis of document D3 is speculative, so that the subject-matter of granted claim 1 is novel over the disclosure of D2.

5.6 Consequently, the arguments of the respondent provide no reason for the Board to overturn the opposition division's decision regarding novelty (contested decision, point 3.5 of the reasons).

6. Remittal

6.1 As noted above (points 4. and 5. of the reasons), the Board concluded that the objections of lack of sufficiency of disclosure and lack of novelty did not prejudice maintenance of the opposed patent as granted.

Therefore, the next issues to be discussed are the pending objections of lack of inventive step.

6.2 In view of the fact that these objections have not been addressed at all in the decision under appeal, which the Board sees as constituting special reasons in the sense of Article 11 RPBA, the Board exercises its discretion to remit the case to the opposition division for further prosecution, in particular to address the matter of inventive step (Article 111(1) EPC).

Order

For these reasons it is decided that:

1. The decision under appeal is set aside.

2. The case is remitted to the opposition division for further prosecution.

The Registrar: The Chairman:

D. Hampe D. Semino

Decision electronically authenticated