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File Number: T 580/89 - 3.3.3

Application No.: 82 305 285.7

Publication No.: 0 076 691

Title of invention: Anhydride polymers and imide polymers and processes for preparing them

Classification: C08F 8/32

D E C I S I O N  
of 28 April 1993

Proprietor of the patent: Rohm and Haas Company

Opponent: BASF Aktiengesellschaft

Headword:

EPC Article 101(1); Rule 55(c)

Keyword: "Power to examine and decide on the maintenance of a European patent dependent upon the extent to which it is opposed (Rule 55(c) EPC)



Case Number : T 580/89 - 3.3.3

**D E C I S I O N**  
of the Technical Board of Appeal 3.3.3  
of 28 April 1993

**Appellant :**  
(Opponent) BASF Aktiengesellschaft, Ludwigshafen  
Patentabteilung C6  
Carl-Bosch-Strasse 38  
W-6700 Ludwigshafen (DE)

**Representative :**

**Respondent :**  
(Proprietor of the patent) Rohm and Haas Company  
Independence Mall West  
Philadelphia  
Pennsylvania 19105 (US)

**Representative :**  
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Rohm and Haas (UK) Ltd  
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**Decision under appeal :** Interlocutory decision of the Opposition Division  
of the European Patent Office dated 28 August  
1989 concerning the maintenance of European  
patent No. 0 076 691 in amended form.

**Composition of the Board :**

**Chairman :** F. Antony  
**Members :** C. Gérardin  
W. Moser

## Summary of Facts and Submissions

- I. The mention of the grant of patent No. 76 691 in respect of European patent application No. 82 305 285.7 filed on 5 October 1982 and claiming priority of 7 October 1981 of an earlier application in the United States, was published on 10 September 1986 on the basis of 11 claims.

Claims 1 and 7 were directed to a process for producing a polymer containing glutaric anhydride units and Claims 2 to 6 to a polymer containing glutaric anhydride units obtainable by the process of Claim 1. Claims 8 to 10 concerned a process of imidising the polymer according to Claims 2 to 6 to form a polymer containing imide units, and Claim 11 related to an imide polymer obtainable by the process according to any of Claims 8 to 10.

- II. On 18 April 1987 the Appellant (Opponent) filed a Notice of Opposition against the grant of the patent and requested revocation thereof on the ground of lack of inventive step to the extent it concerned polymers with anhydride units (i.e. Claims 1 to 7). In support of this objection and in the course of the opposition procedure, several documents were submitted.
- III. In an interlocutory decision dated 28 August 1989 the Opposition Division held that there were no grounds of opposition to the maintenance of the patent on the basis of the following set of 11 claims:

Claims 1 to 7: process of imidising thermoplastic non-crosslinked polymer;

Claim 8: imide polymer obtainable by the process according to any preceding claim;

Claim 9: process for producing thermoplastic, non-crosslinked polymer containing glutaric anhydride units;

Claims 10 and 11: polymer containing glutaric anhydride units obtainable by the process of Claim 9.

- IV. On 25 August 1989 a third party presented observations under Article 115 EPC which did not reach the file until after the decision dated 28 August 1989 was taken. In the said observations it was first specified that the subject-matter of the claims concerning a polymer with anhydride units and the preparation thereof, was not novel; additionally, it was mentioned that the subject-matter of the claims directed to a polymer with imide groups and the preparation thereof, for a part was not novel and for a part did not involve an inventive step with regard to the teaching of several additional documents.
- V. The Appellant thereafter filed a Notice of Appeal on 8 September 1989 and paid the prescribed fee at the same time. The arguments presented in the Statement of Grounds of Appeal filed on 23 December 1989 relied exclusively on these additional documents and concerned mainly the claims directed to a polymer with anhydride units and the preparation thereof, whose subject-matter was said to be not novel or, in any case, not inventive.

Further, three of these documents were said to be a bar to patentability of the subject-matter of the claims directed to a polymer with imide groups and the preparation thereof, which had not been attacked in the Notice of Opposition.

- VI. The Respondent (Patentee) then offered to dispose of the appeal by deleting the claims relating to anhydride polymers and the preparation thereof, arguing that the Board should not express any opinion as to the alleged invalidity of the unopposed claims directed to imide

polymers. To do so would entail an examination contrary to Article 114(1) EPC as interpreted by the Board of Appeal 3.3.1 in case T 9/87 (OJ EPO 1989, 438).

VII. In response to this, the above third party submitted further observations, wherein the obligation of the EPO vis-à-vis the public to examine the facts of its own motion pursuant to Article 114(1) EPC was emphasised; reference was in this context made in particular to the case T 156/84 (OJ EPO 1988, 372), wherein the Board of Appeal 3.4.1 had reached the conclusion that the principle of examination by the EPO of its own motion took precedence over the possibility of disregarding facts or evidence not submitted in due time. This followed from the EPO's duty vis-à-vis the public not to grant or maintain patents which it was convinced were not legally valid.

VIII: The Appellant requested that the decision under appeal be set aside and the patent be revoked.

The Respondent requested that the patent be maintained on the basis of Claims 1 to 8 filed on 23 April 1990.

IX. The Board, considering that the above issue concerned an important point of law within the meaning of Article 112(1)(a) EPC, decided on 29 August 1991 to refer the following questions of law to the Enlarged Board of Appeal (reference number G 9/91):

1. "Is the power of an Opposition Division or, by reason of Rule 66(1) EPC, of a Board of Appeal to examine and decide on the maintenance of a European patent under Articles 101 and 102 EPC dependent upon the extent to which the patent is opposed in the Notice of Opposition pursuant to Rule 55(c) EPC?"

2. "If the answer to the first question should be affirmative, are there any exceptions to such dependence?"

X. The answers given by the Enlarged Board of Appeal in its decision G 9/91 "Power to examine/ROHM AND HAAS of 31 March 1993 (to be published) read as follows:

"The power of an Opposition Division or a Board of Appeal to examine and decide on the maintenance of a European patent under Articles 101 and 102 EPC depends upon the extent to which the patent is opposed in the notice of opposition pursuant to Rule 55(c) EPC. However, subject-matters of claims depending on an independent claim, which falls in opposition or appeal proceedings, may be examined as to their patentability even if they have not been explicitly opposed, provided their validity is prima facie in doubt on the basis of already available information."

#### Reasons for the Decision

1. The Board has stated in its decision of 29 August 1991 that the appeal is admissible and that the current wording of the claims does not give rise to any objections under Article 123 EPC.
2. Claims 1 to 8 filed on 23 April 1990 are directed, on the one hand, to a process of preparation of imide units containing polymers (Claim 1) as well as preferred embodiments thereof (dependent Claims 2 to 7) and, on the other hand, to imide units containing polymers obtainable by a process according to any preceding claim (Claim 8). This corresponds to the subject-matter which was not

opposed in the Notice of Opposition of 18 April 1987, the latter being strictly limited to the claims related to anhydride groups containing polymers and to the preparation thereof.

According to the answer given by the Enlarged Board of Appeal in its decision G 9/91, the power of an Opposition Division or a Board of Appeal to examine and decide on the maintenance of a European patent under Articles 101 and 102 EPC depends upon the extent to which the patent was opposed in the Notice of Opposition pursuant to Rule 55(c) EPC. It follows that in the present case this Board, which is bound by the conclusions reached by the Enlarged Board of Appeal in G 9/91, has no power to examine the patentability of the subject-matter as defined in present Claims 1 to 8, in particular whether the criteria of novelty and inventive step are met with regard to the teaching of the additional documents submitted by the third party.

3. There are thus no obstacles to the maintenance of the patent in suit on the basis of these claims and the adapted description filed simultaneously.

**Order**

**For these reasons, it is decided that:**

1. The decision under appeal is set aside.
  
2. The case is remitted to the first instance with the order to maintain the patent on the basis of Claims 1 to 8 and the description filed on 23 April 1990.

**The Registrar:**

  
E. Görgmaier

**The Chairman:**

  
F. Antony