

Internal distribution code:

- (A) [] Publication in OJ
(B) [] To Chairmen and Members
(C) [X] To Chairmen

D E C I S I O N
of 28 January 1999

Case Number: T 0401/95 - 3.3.1

Application Number: 87114280.8

Publication Number: 0263432

IPC: C07C 69/96

Language of the proceedings: EN

Title of invention:

Method for preparing aromatic bischloroformate compositions and polycarbonates

Patentee:

General Electric Company

Opponent:

Bayer AG, Leverkusen Konzernverwaltung RP Patente Konzern

Headword:

Polycarbonates/GENERAL ELECTRIC

Relevant legal provisions:

EPC Art. 64(2), 114(2), 123(3)

Keyword:

"Jurisdiction of Board of Appeal on issues arising from a request rejected by the first instance (yes) - Board not bound by decision of first instance on each separate issue"

"Change from product claim to claim to using that product for producing another product (not allowable) - extension of protection"

Decisions cited:

G 0002/88, T 0406/86, T 0295/87, T 0327/92, T 0840/93, T 0583/95

Catchword:

-



Europäisches
Patentamt

European
Patent Office

Office européen
des brevets

Beschwerdekammern

Boards of Appeal

Chambres de recours

Case Number: T 0401/95 - 3.3.1

D E C I S I O N
of the Technical Board of Appeal 3.3.1
of 28 January 1999

Appellant: General Electric Company
(Proprietor of the patent) 1 River Road
Schenectady
NY 12345 (US)

Representative: Grever, Frederik
General Electric Plastics B.V.
P.O. Box 117
4600 AC Bergen op Zoom (NL)

Respondent: Bayer AG, Leverkusen
(Opponent) Konzernverwaltung RP
Patente Konzern
Bayerwerk
51368 Leverkusen (DE)

Representative: Jönsson, Hans-Peter, Dr. Dipl.-Chem.
Patentanwälte
von Kreisler Selting Werver
Postfach 10 22 41
50462 Köln (DE)

Decision under appeal: Interlocutory decision of the Opposition Division of
the European Patent Office posted 28 March 1995
concerning maintenance of European patent No. 0 263 432
in amended form.

Composition of the Board:

Chairman: A. J. Nuss
Members: R. Freimuth
S. C. Perryman

Summary of Facts and Submissions

- I. The Appellant (Proprietor of the patent) lodged an appeal against the interlocutory decision of the Opposition Division which found that European patent No. 263 432 could be maintained in the form as amended during opposition proceedings according to the third auxiliary request, but that it did not satisfy the requirements of the EPC in the form as amended according to any request preceding that request.
- II. Notice of Opposition had been filed by the Respondent (Opponent) requesting revocation of the patent as granted for lack of novelty and lack of inventive step. The patent as granted comprised 23 claims, i.e. two independent process claims 1 and 10 for preparing bischloroformate and polycarbonate respectively, claims 2 to 9 and 11 to 22 depending thereon and a single product claim 23, which read as follows:
- "23. A linear polycarbonate end-capped with the residue of a monohydroxy aromatic compound, characterized in that it is free of diaryl carbonate."
- III. The decision under appeal was based on four alternative sets of claims as amended during opposition proceedings. The set of claims according to the main request comprised three independent use claims 23 to 25, but no product claim. The use claims of that request had been substituted for the sole product claim as granted, these claims reading as follows:
- "23. Use of a linear polycarbonate end-capped with a

residue of a monohydroxy aromatic compound free of diaryl carbonate in the molding of parts using rapid cycle times.

24. Use of a linear polycarbonate end-capped with a residue of a monohydroxy aromatic compound free of diaryl carbonate in the molding of parts without physically or optically flawed surfaces.

25. Use of a linear polycarbonate end-capped with a residue of a monohydroxy aromatic compound free of diaryl carbonate in the molding of optical disks."

IV. The Opposition Division held that the use claims were not open to an objection under Article 123(3) EPC. However, the subject-matter of those claims was found not to be novel.

On the other hand, the Opposition Division decided that Appellant's third auxiliary request not containing any use or product claim, would satisfy the requirements of the EPC.

V. In a communication pursuant to Article 11(2) of the rules of procedures of the Boards of Appeal which was annexed to the summons to attend oral proceedings, the Board informed the parties that it intended to discuss particularly the matter of Article 123(3) EPC during oral proceedings with respect to the use claims as amended according to the main request as submitted during opposition proceedings.

VI. At the oral proceedings held on 28 January 1999, the Appellant defended the maintenance of the patent in

suit in amended form on the basis of the main request as submitted during opposition proceedings and on the basis of the auxiliary request as submitted on 28 January 1999. The difference between the claims according to the main request and those according to the auxiliary request consisted exclusively in amendments to the use claims 23 to 25, which read according to the latter request as follows:

"23. Use of a linear polycarbonate end-capped with a residue of a monohydroxy aromatic compound free of diaryl carbonate for avoiding problems in the molding of parts using rapid cycle times.

24. Use of a linear polycarbonate end-capped with a residue of a monohydroxy aromatic compound free of diaryl carbonate for avoiding physically or optically flawed surfaces in the molding of parts.

25. Use of a linear polycarbonate end-capped with a residue of a monohydroxy aromatic compound free of diaryl carbonate for avoiding the problem of regularity of shape in the molding of optical disks."

VII. The **Appellant** argued that the matter of Article 123(3) EPC as regards the use claims 23 to 25 of the main request was not within the Board's scrutiny. In the decision under appeal the Opposition Division found those claims to satisfy the requirements thereof. The Appellant being the sole appealing party, the principle prohibiting a *reformatio in peius* applied in the present appeal. The Board was therefore bound by the decision under appeal in that matter and prevented from deciding upon against the Appellant.

As to the substance, the Appellant submitted that the subject-matter of the use claims 23 to 25 according to either request did not extend the protection conferred by the patent as granted, thus complying with the requirements of Article 123(3) EPC. The use claims according to the main request substituted for the sole product claim as granted directed to polycarbonate, which was allowable, since an amendment of a granted claim directed to a product into a claim directed to the use of that product for a particular purpose was not open to objection under Article 123(3) EPC (see decision G 2/88, OJ EPO 1990, 93, Headnote II). Those use claims should not be read as being directed to the use of polycarbonate to produce another product, particularly due to their wording "**in** the molding of". Consequently they were not to be considered as process claims within the meaning of Article 64(2) EPC which extended the protection conferred to the product directly obtained by that process. The use claims according to the auxiliary request were redrafted in order to express more precisely the use of the polycarbonate for a particular purpose and not for producing another product. Those redrafted use claims should be admitted into the appeal proceedings, though filed very late during oral proceedings, since the possible need for such claims only became apparent on receipt of the Board's communication.

VIII. The **Respondent** submitted that the principle prohibiting a *reformatio in peius* did not apply in the present appeal with respect to Appellant's main request, since the Opposition Division rejected that request . Therefore the matter of Article 123(3) EPC as regards the use claims 23 to 25 of the main request was within

the Board's jurisdiction.

As to the substance, the Respondent argued that the use claims 23 to 25 as amended according to the main request offended the requirements of Article 123(3) EPC. Those use claims were directed to the use of polycarbonate to produce another product, e.g. optical disks. The latter products were protected by those use claims pursuant to Article 64(2) EPC, but were not within the protection conferred by the patent as granted. The use claims according to the auxiliary request should not be admitted into the proceedings at this belated stage as, otherwise, so the Respondent's complaint, he would have had no opportunity to search for state of the art challenging those fresh claims. Furthermore the feature of "avoiding problems in the molding of...", freshly incorporated into the use claims according to the auxiliary request, was not clear contrary to the requirements of Article 84 EPC, since the problems to be avoided remained completely undefined. Moreover that amendment to the claims did not overcome the objection pursuant to Article 123(3) EPC, those use claims being still directed to the use of polycarbonate to produce another product.

- IX. The Appellant requested that the decision under appeal be set aside and that the patent be maintained on the basis of the main request as submitted during opposition proceedings (main request) or the auxiliary request submitted at the oral proceedings on 28 January 1999 (first auxiliary request) or as further auxiliary request that the auxiliary request submitted on 28 January 1999 be referred to the first instance for further examination (second auxiliary request).

The Respondent requested that the appeal be dismissed.

- X. At the end of the oral proceedings the decision of the Board was given orally.

Reasons for the Decision

1. The appeal is admissible.
2. *Jurisdiction of the Board of Appeal*

Having regard to the main request, the Appellant disputed the power of the Board to reopen and to decide on the matter of Article 123(3) EPC as regards the use claims 23 to 25 which was decided by the Opposition Division in Appellant's favour. Since the Respondent did not appeal against that decision, the principle of prohibiting *reformatio in peius* applied.

However, Appellant's view ignores the fact that the Opposition Division found those use claims to contravene the requirements of the EPC due to lack of novelty and rejected therefore the main request. The Opposition Division having taken upon the main request a decision adverse for the Appellant, there is nothing the Board can refuse the Appellant in deciding upon that request, which the Opposition Division has not already denied it. Consequently the principle of prohibiting *reformatio in peius* is not violated.

Furthermore, the principle of prohibiting *reformatio in peius* cannot be construed to apply separately to each

matter and each issue decided by the Opposition Division. If an appeal is lodged against an adverse decision of the first instance about the main request, then the whole request is before the Board of Appeal and within its jurisdiction (see decisions T 327/92, point 1 of the reasons; T 583/95, point 2 of the reasons; neither published in OJ EPO). It is the Board's power and duty pursuant to Article 111(1) and 102 (3) EPC to decide for itself upon each matter and each issue with regard to the main request and the Board is not bound by any finding of the decision under appeal. Thus, the Board is empowered to reopen and to decide upon matters which have been an issue before the Opposition Division, i.e. in the present case the matter of Article 123(3) EPC of the use claims of the main request.

For these reasons, in the Board's judgement, the Appellant's objections to the jurisdiction of the Board have no legal basis and are to be rejected.

Main request

In view of the above conclusion in point 2, the use claims 23 to 25 as amended according to the main request are to be examined as to all requirements of the EPC raised in the opposition, including the matter of Article 123(3) EPC.

3. *Admissibility*

The substitution of the use claims 23 to 25 for the sole product claim as granted is designed to overcome the novelty objection raised by the Respondent-Opponent

against the latter claim. Therefore that amendment can be considered as occasioned by a ground of opposition and so necessary, and the Board exercises due discretion to admit the use claims as amended according to the main request into the appeal proceedings (see decisions T 295/87, OJ EPO 1990, 470, point 3 of the reasons; T 406/86, OJ EPO 1989, 302, point 3.1 of the reasons).

4. *Amendments (Article 123(3) EPC)*

4.1 The patent in suit in the form as granted comprised a sole product claim directed to a linear polycarbonate end-capped with the residue of a monohydroxy aromatic compound free of diaryl carbonate, and process claims for preparing that polycarbonate or bischloroformate being the precursor of the former. The patent in suit in the form as amended now comprises use claims substituting for that sole product claim. The use claim 25 relates for example to the use of that polycarbonate "in the molding of optical disks" (see point III above).

4.2 There are basically two different types of claim, namely a claim to a physical entity, e.g. a product, and a claim to a physical activity, e.g. a process for producing a product. Furthermore, a claim including both a feature relating to a physical entity and a feature relating to a physical activity, e.g. a use of a product, is also possible (see decision G 2/88, loc cit., point 2.2. of the reasons). The various different possible classifications of claim are generally referred to as the categories of claim. Therefore, the proposed amendment of the patent in suit as granted

according to the main request consists in a change of the category of the claims, i.e. a switch from a product claim to a use claim.

4.3 Article 123(3) EPC requires that the claims of a patent may not be amended during opposition proceedings in such a way as to extend the protection conferred. This applies to all amendments including the change of the category of claim. In order to decide whether or not the change of the category in the patent in suit satisfies that requirement, it is necessary to compare the protection conferred by the claim before amendment, i.e. as granted, with that of the new claim after amendment, by taking also into account the category of the respective claim.

4.3.1 The protection conferred by a claim directed to a product *per se* is absolute upon such product. The product claim, thus, confers protection to that product wherever it exists and whatever its context and therefore for all uses of that product (see decisions G 2/88, loc cit., point 5 of the reasons). In the present case, the product claim of the patent in suit as granted, i.e. before amendment to the use claims, confers **absolute protection** to the **particular polycarbonate** as defined therein and for all uses of that particular polycarbonate.

4.3.2 This leads the Board to observe that there are two different categories of use claim, namely

- (i) the use of a physical entity to achieve an effect,
and

(ii) the use of a physical entity to produce a product.

A use claim of the latter category (ii) is to be considered as a process claim comprising physical steps for producing the product using the physical entity with the consequence that this type of use claim is a process claim within the meaning of Article 64(2) EPC. Pursuant to that article of the EPC, the product insofar as it is directly obtained by that process, is also protected. Hence, the product, when obtained by that process for producing the product, is within the scope of protection conferred by that type of use claim (see decision G 2/88, loc cit., point 5.1 of the reasons). In the present case, the use claim 25 after the amendment is directed to the use of the particular polycarbonate "in the molding of optical disks". That use claim belongs to the latter type (ii) as defined above since it comprises the physical step of molding for producing a product, i.e. the optical disks. Thus, use claim 25 confers protection to the claimed use of that particular polycarbonate and, additionally, to the optical disks directly obtained by the molding process pursuant to Article 64(2) EPC.

The Appellant argued that the use claims as amended were of the former type (i) as defined above, i.e. directed to the use of that polycarbonate to achieve an effect, particularly due to their wording "**in** the molding of...". However, use claim 25 as amended does not indicate any effect to be achieved, but its subject-matter relates exclusively to a physical activity, i.e. molding. Irrespective of whether or not the wording of that use claim makes use of the preposition "in", its subject-matter nevertheless

relates to the physical activity of molding. Therefore, Appellant's arguments cannot convince the Board and use claim 25 as amended is still found to belong to the type (ii) of use claim as defined above.

4.3.3 In the present case, when comparing the protection conferred by the categories of claim before (point 4.3.1) and after (point 4.3.2) amendment, it is clear that the protection conferred after amendment extends beyond that conferred before, contrary to the requirements of Article 123(3) EPC: the optical disks directly obtained by the molding process are not protected before the amendment of the claims of the patent in suit, but is now protected as a result of the amendment.

4.4 Consequently, in the Board's judgement, the change of category from the product claim as granted to the use claim 25 as amended, in the present case, extends the protection conferred. For these reasons, claim 25 offends Article 123(3) EPC and the main request is rejected.

First auxiliary request

5. *Admissibility*

5.1 The first auxiliary request was filed at the end of oral proceedings before the Board and comprises substantial amendments to the use claims 23 to 25, *inter alia* the incorporation of the fresh feature "**for avoiding problems**" in claim 23.

5.2 The purpose of the appeal procedure *inter partes* is mainly to give the losing party the possibility of challenging the decision of the first instance. The appealing Proprietor of the patent, unsuccessful before the Opposition Division, thus has the right to have the rejected requests reviewed by the Board of Appeal. If he wants, however, other requests to be considered, admission of these requests into the proceedings is a matter of discretion of the Board of Appeal, and is not a matter of right (see decision T 840/93, OJ EPO 1996, 335, point 3.1 of the reasons). For exercising due discretion in respect of the admission of requests by the appealing Proprietor of the patent that were not before the Opposition Division, it is established case law of the boards of appeal that crucial criteria are whether or not the amended claims of those requests are clearly allowable and whether or not those amended claims give rise to fresh issues which the other party, i.e. the Respondent-Opponent, can reasonably be expected to deal with properly without unjustified procedural delay.

5.2.1 The fresh amendment "for avoiding problems" made to claim 23 is designed to indicate the purpose of that use claim, i.e. the effect to be achieved. However, the problems to be avoided remain undefined and completely vague with the consequence that this amended claim contravenes the requirement of clarity pursuant to Article 84 EPC. Furthermore, the problems to be avoided in freshly amended claim 23 are those occurring "in the molding of parts". On page 1, lines 28 and 29 the application as filed discloses, however, the aim of avoiding the problems occurring in **removing** molded parts from the mold, which contrasts to the amendment

made. Hence, that amendment to claim 23 represents subject-matter which extends beyond the content of the application as filed, contrary to the requirements of Article 123(2) EPC.

Thus, the first auxiliary request is clearly not allowable as claim 23 satisfies neither the provisions of Article 84 EPC, nor the provisions of Article 123(2) EPC.

5.2.2 Further, amended claim 23 takes up the feature of avoiding problems in the molding of parts which becomes now the essential purpose of that use claim, whereas that feature is merely mentioned in the description of the patent in suit and had never formed before the basis for any claim. Moreover, the problems in the molding of parts are characterised in the description of the patent in suit as occurring only occasionally; thus, avoiding those problems was not considered essential for the invention. Therefore the Respondent could not reasonably be expected to prepare himself for dealing with such issues and search for new documents or submit other evidence for challenging the patentability of that claim.

Thus, the Board concurs with Respondent's objections that the first auxiliary request comprising those amended use claims gives rise to fresh issues not yet addressed which the Respondent could not be expected to respond at the oral proceedings, whereas to give him time to respond would have led to undue procedural delay.

5.3 For all these reasons, the Board exercises its

discretion not to admit the first auxiliary request into the proceedings.

Second auxiliary request

6. Since the first auxiliary request is not admitted into the proceedings *inter alia* for not meeting the requirements of Articles 84 and 123(2) EPC, the second auxiliary request requesting the first auxiliary request to be referred back to the first instance for further prosecution must also be refused, as only a request which is unobjectionable on the issues that the Board has decided can be remitted to the first instance for further prosecution in relation to other issues not yet decided by the Board.

Order

For these reasons it is decided that:

The appeal is dismissed.

The Registrar:

The Chairman:

E. Görgmaier

A. Nuss