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**D E C I S I O N**  
**of 6 May 1999**

**Case Number:** T 0660/95 - 3.3.3

**Application Number:** 88100598.7

**Publication Number:** 0278255

**IPC:** C08L 71/04

**Language of the proceedings:** EN

**Title of invention:**

Solvent-resistant, compatible polyphenylene ether-linear polyester blends

**Applicant:**

General Electric Company

**Opponent:**

-

**Headword:**

-

**Relevant legal provisions:**

EPC Art. 84, 123(2)

**Keyword:**

"Late-filed request - added subject-matter - not allowable"

**Decisions cited:**

T 0153/85

**Catchword:**

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Boards of Appeal

Chambres de recours

**Case Number:** T 0660/95 - 3.3.3

**D E C I S I O N**  
**of the Technical Board of Appeal 3.3.3**  
**of 6 May 1999**

**Appellant:** General Electric Company  
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New York 10022 (US)

**Representative:** Szary, Anne Catherine, Dr.  
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**Decision under appeal:** Decision of the Examining Division of the  
European Patent Office posted 23 March 1995  
refusing European patent application  
No. 88 100 598.8 pursuant to Article 97(1) EPC.

**Composition of the Board:**

**Chairman:** C. R. J. Gérardin  
**Members:** R. J. Young  
A. C. G. Lindqvist

## Summary of Facts and Submissions

I. European patent application No. 88 100 598.7 was filed, with 18 claims, on 18 January 1988, claiming a US priority of 4 February 1987 (US 10867) and was published under No. 0 278 255. Claim 1 read as follows:

"A resinous composition free from extraneous impact modifiers and comprising the following resinous components and any reaction products thereof, all percentage proportions being by weight of total resinous components:

(A) about 15-50% of a polyphenylene ether, or a blend thereof with at least one polystyrene;

(B) about 20-80% of at least one poly(alkylene dicarboxylate), the weight ratio of component A to component B being at most 1.2:1; and

(C) from 3% to about 50% of at least one polymer containing a substantial proportion of aromatic polycarbonate units and having a weight average molecular weight of at least about 40,000 as determined by gel permeation chromatography relative to polystyrene, or a blend thereof with a styrene homopolymer."

Claims 2 to 18 were dependent claims directed to elaborations of the composition according to Claim 1.

II. The application was refused by a decision of the Examining Division, dated 23 March 1995, for lack of inventive step with regard to the disclosure of D1:

EP-A-0 186 011. The decision was based on a set of Claims 1 to 11 filed on 10 November 1994 (letter dated 8 November 1994), Claim 1 of which read as follows:

"A resinous composition consisting of, based on the weight of the total composition

(A) 15-50% of a polyphenylene ether or a blend thereof with a polystyrene;

(B) 20-80% of a poly(alkylenedicarboxylate), the weight ratio (A):(B) being not greater than 1.2:1; and

(C) 3% to 50% of an aromatic polycarbonate having a weight average molecular weight at least about 40,000 as determined by gel permeation chromatography relative to polystyrene, or a blend thereof with a styrene homopolymer."

Claims 2 to 11 were dependent claims directed to elaborations of the composition according to Claim 1.

According to the decision, the subject-matter of Claim 1 differed from D1, the closest state of the art, which described a composition comprising, in addition to a polyphenylene ether, polybutylene terephthalate and aromatic polycarbonate, also triphenyl phosphate, trisnonyl phenylphosphite and wollastonite, only in the absence of the last three mentioned components. There was, however, no evidence that this distinction was associated with a technical effect. Consequently, the solution to the objective problem, which was the provision of further polyphenylene ether/poly(alkylene dicarboxylate)/polycarbonate compositions, was simply

not to use some of the components of the prior art composition, thereby accepting the consequences of the absence of such components for the physical properties of the compositions. It was the accepted case law of the Boards of Appeal that such a solution was not inventive.

III. On 18 May 1995, a Notice of Appeal against the above decision was filed, the prescribed fee being paid on the same day.

In the Statement of Grounds of Appeal filed on 25 July 1995, the Appellant argued in substance as follows:

- (a) At least one of the components which had to be omitted, according to the decision under appeal, from the composition according to D1, was the phosphorus-containing component, which was stated to be essential to that composition, although it was not essential to the composition according to the application in suit.
- (b) One of the components which, according to the decision under appeal, had to be present was, however, according to D1, merely a possible ingredient.
- (c) Whilst it was true that D1 contained compositions containing aromatic polycarbonates within the range claimed in the application in suit, there was no teaching in D1 to show that such materials had to be present to provide a composition according to the application in suit. On the

contrary, their significance had not been recognised in D1 and it could be said that any overlap in properties between the claimed compositions and those of D1 were attributable, at least in part, to the presence of the phosphorus-containing compounds which were essential in the compositions of D1.

- IV. With a communication issued on 4 December 1998, together with a summons to oral proceedings, the Board drew attention to certain deficiencies in the claims then on file, in particular under Article 84 EPC.
- V. The Appellant filed, with a letter received on 22 April 1999, two further sets of eleven claims, to form a first and a second auxiliary request respectively.
- VI. Oral proceedings were held on 6 May 1999. During the oral proceedings, the Appellant abandoned the previous main, and first and second auxiliary requests, and replaced them with two further sets of Claims 1 to 11, forming a new main and first auxiliary request, respectively.

Claim 1 of the main request reads as follows:

"A resinous composition consisting of, based on the weight of the total composition

- (A) 15-50% of a polyphenylene ether or a blend thereof with a homopolystyrene wherein the polystyrene is present in an amount of from 5-50% by weight of the blend;

(B) 20-80% of a poly(alkylenedicarboxylate), the weight ratio (A):(B) being not greater than 1.2:1; and

(C) 3% to 50% of an aromatic polycarbonate having a weight average molecular weight of at least about 40,000 as determined by gel permeation chromatography relative to polystyrene, or a blend thereof with a styrene homopolymer wherein the styrene homopolymer is present in an amount of less than 50% by weight of the blend;

and optionally;

(D) 0.1-5 parts per 100 parts of resinous components (A), (B) and (C) of at least one compound selected from compounds containing at least one cyanurate or isocyanurate moiety and compounds containing a plurality of epoxide moieties;

(E) 0.01-7.5% by weight of component (B) of an ester-carbonate exchange suppressing agent; and

(F) an antioxidant."

Claims 2 to 11 are dependent claims directed to elaborations of the composition according to Claim 1.

The auxiliary request differs from the main request only in the wording of Claim 1, in which (i) the reference, in the definition of component (A), to "homopolystyrene" has been replaced by a simple reference to "polystyrene"; and (ii) all reference to a blend with a styrene homopolymer has been deleted from

the definition of component (C).

- VII. The Appellant requested that the decision under appeal be set aside and that a patent be granted on the basis of Claims 1 to 11 of the main request or alternatively Claims 1 to 11 of the auxiliary request, both filed during the oral proceedings.

### **Reasons for the Decision**

1. The appeal is admissible.
2. *Admissibility of requests*

It is the established case law of the Boards of Appeal of the EPO that the Board may refuse to consider requests which are late-filed, unless they are such as to be clearly allowable (T 0153/85, OJ EPO 1988, 001).

- 2.1 The Appellant was advised, in the communication issued on 4 December 1998 accompanying the summons to oral proceedings, i.e. five months before the oral proceedings took place, of deficiencies in the claims then on file and invited to file any further amended sets of claims/description at least one month before the date set for oral proceedings (paragraph 4 of the communication). The two further sets of claims, filed in response to this communication were, however, only received on 22 April 1999, i.e. less than one month before the date set for oral proceedings, no reason being given as to why this had not been done earlier (section V., above). These requests must, therefore, be



considered late-filed. They were, however, themselves abandoned during the oral proceedings held on 6 May 1999, and replaced by two further sets of claims which formed the final requests underlying the present decision (section VI., above). These requests are, consequently, a *fortiori* to be regarded as late-filed.

2.2 It remains to be established if the latter requests are clearly allowable.

2.3 Main request

Whereas, according to Claim 1 of the application as originally filed, the percentages of the components (A), (B) and (C) of the "resinous composition" were defined as being "by weight of total resinous components" (section I., above), the numerically identical percentages of the same components in the composition according to present Claim 1, which may additionally contain the optional components (D), (E) and (F), are stated to be "based on the weight of the total composition" (section II., above). In this connection, although there is no doubt that components (A), (B) and (C), which are polymeric, are "resinous" components, closer examination of the further optional components (D), (E) and (F) reveals that not all of these are polymeric.

2.3.1 In particular, component (D), which is defined as being selected from "compounds containing at least one cyanurate or isocyanurate moiety and compounds containing a plurality of epoxide moieties", may be *inter alia* cyanuric chloride, or triethyl cyanurate, which are not polymeric species, or a homopolymer or

copolymer of glycidyl acrylate or glycidyl methacrylate, which are polymeric species (application as filed, page 18, lines 5 to 11; printed specification, page 8, lines 42 to 47).

2.3.2 Furthermore, component (E), the ester-carbonate exchange suppressing agent, may, according to the description, be a hydroxybenzophenone, methyl salicylate or sodium or potassium dihydrogen phosphate, none of which is polymeric (application as filed, page 13, lines 22 to 27; printed specification, page 7, lines 19 to 22).

2.3.3 Finally, component (F), an antioxidant, the chemical nature of which is not further specified in the application as filed except that it is conventional (Examples 17 to 20), cannot be assumed to be polymeric.

2.3.4 In summary, the percentages of the components (A), (B) and (C) in present Claim 1 are based on a total of components which include non-resinous as well as resinous components.

2.3.5 Consequently, in the case that the composition according to present Claim 1 contains all, or even more than one of the optional components (D), (E) and (F), the amounts of the components (A), (B) and (C) corresponding to the percentages given in present Claim 1 will be different from the amounts corresponding to the identical percentages in Claim 1 as originally filed. Consequently, present Claim 1 defines a different composition of components (A), (B) and (C) from that according to Claim 1 as originally filed.

2.3.6 It was put to the Appellant at the oral proceedings that there was no basis in the application as originally filed for the newly defined percentages of the components (A), (B) and (C). The Appellant was unable to point to a basis for this new subject-matter in the documents of the application as originally filed.

2.3.7 Consequently, the amendment comprises added subject-matter in contravention of Article 123(2) EPC.

2.3.8 In other words, the main request is not allowable.

2.4 Auxiliary request

The same situation arises, *mutatis mutandis*, in respect of Claim 1 of the auxiliary request. Consequently, the auxiliary request is not allowable.

3. In view of the above, there is no allowable, let alone clearly allowable request on file. It is consequently superfluous for the Board to consider the substantive arguments of the Appellant.

## **Order**

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

The appeal is dismissed.

The Registrar:

The Chairman:

E. Görgmaier

C. Gérardin