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**D E C I S I O N**  
**of 28 August 2002**

**Case Number:** T 0408/99 - 325

**Application Number:** 90914242.4

**Publication Number:** 0504146

**IPC:** B29C 49/22

**Language of the proceedings:** EN

**Title of invention:**

Method of preparing a polyester preform for a polyester bottle

**Patentee:**

Constar International Atlanta Inc.

**Opponent:**

Schmalbach-Lubeca AG

**Headword:**

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**Relevant legal provisions:**

EPC Art. 123(2)

**Keyword:**

"Subject-matter extending beyond the content of the application as filed (yes)"

**Decisions cited:**

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**Catchword:**

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**Case Number:** T 0408/99 - 3.2.5

**D E C I S I O N**  
**of the Technical Board of Appeal 3.2.5**  
**of 28 August 2002**

**Appellant:**  
(Opponent)

Schmalbach-Lubeca AG  
Kaiserswerther Strasse 115  
D-40880 Ratingen (DE)

**Representative:**

Leonhard, Frank Reimund, Dipl.-Ing.  
Leonhard, Olgemöller, Fricke  
Patentanwälte  
Postfach 10 09 57  
D-80083 München (DE)

**Respondent:**  
(Proprietor of the patent)

Constar International Atlanta Inc.  
Drake Drive 5375  
Atlanta, GA 30336 (US)

**Representative:**

Smulders, Theodorus A. H. J., Ir.  
Vereenigde  
Postbus 87930  
NL-2508 DH Den Haag (NL)

**Decision under appeal:**

**Decision of the Opposition Division of the  
European Patent Office posted 9 February 1999  
rejecting the opposition filed against European  
patent No. 0 504 146 pursuant to Article 102(2)  
EPC.**

**Composition of the Board:**

**Chairman:** W. Moser  
**Members:** W. R. Zellhuber  
P. E. Michel

## Summary of Facts and Submissions

- I. The appellant (opponent) lodged an appeal against the decision of the Opposition Division rejecting the opposition against the European patent No. 0 504 146.
- II. Opposition was filed against the patent as a whole and based on Article 100(a) EPC (lack of novelty, Article 54 EPC, and lack of inventive step, Article 56 EPC), Article 100(b) EPC and Article 100(c) EPC. The Opposition Division held that the grounds for opposition did not prejudice the maintenance of the patent in suit.
- III. Oral proceedings were held before the Board of Appeal on 28 August 2002.

The respondent (patent proprietor), although duly summoned by the Board, was not represented at these proceedings.

- IV. The appellant requested that the decision under appeal be set aside and that the European patent No. 0 504 146 be revoked.

The respondent requested that the appeal be dismissed.

- V. Claim 1 of the patent in suit as granted reads as follows:

"1. A method of preparing a polyester preform for further processing into a polyester bottle, said method comprising the following sequence of steps:

producing a polyester preform for a bottle by

extrusion or injection moulding;

applying a coating of a material that lowers the coefficient of friction of the polyester on the outer surface of the said preform to reduce damage to the preform resulting in surface defects of the bottle, due to mutual contact of the preforms;

allowing the coating to dry;

transporting the dried, coated preforms and

storing the said dried coated preforms."

VI. In the written procedure and during oral proceedings, the appellant argued essentially as follows:

In the application as filed, the feature of drying of a coating was disclosed only in combination with coatings in the form of aqueous emulsions, which appeared reasonable since drying had to be construed as meaning reducing the water content. Liquid coatings not containing water need not be dried.

According to claim 1 of the patent in suit, however, any coating should be allowed to dry, emulsions as well as paraffin waxes, oils, silicon oils and other fats. Drying of the latter, however, was not disclosed in the application as filed.

Moreover, the expression "allowing to dry" used in claim 1 of the patent in suit as granted included passive and active drying. However, the option of passive drying of a coating was not disclosed in the application as filed.

Claim 1 had thus been amended in such a way that it contained subject-matter which extended beyond the content of the application as filed.

VII. In the written procedure, the respondent argued essentially as follows:

In the statement setting out the grounds of appeal, the appellant had raised a new issue based on Article 123 EPC, which was thus not admissible.

As for the rest, the appellant's arguments were without merit. The liquid coating could be in the form of an aqueous emulsion or in the form of a wax which was liquid at the temperature of use (10 - 75°C). Either way, the coating was applied in a liquid form and had to dry. Thus, the drying step related to the drying of the coating itself and not, as contended by the appellant, specifically to the reduction of the water content of the emulsion of a specific embodiment. There was no statement in the patent in suit that waxes, oils and fats should not be dried.

## **Reasons for the Decision**

### *Extension (Article 123(2) EPC)*

1. The ground of opposition according to Article 100(c) EPC was mentioned in the notice of opposition, was subject of the opposition procedure, was a point of discussion during the oral proceedings before the Opposition Division, and was subject of the impugned decision. Accordingly, the ground of opposition according Article 100(c) EPC was introduced in the course of the opposition procedure.

Consequently, the objections raised with respect to the requirements of Article 123(2) EPC have to be considered.

In the Board's view, the fact that, during the appeal procedure, the appellant referred to further features, which, allegedly, were not disclosed in the application as filed ("allowing the coating to dry"), is tantamount to bringing forward further arguments rather than introducing a new ground of opposition.

2. The step of drying the coating is disclosed in the application as filed in the following passages:

- page 2, line 36 to page 3, line 14: "In a preferred embodiment of the invention the coating is applied in liquid form - namely, as an aqueous emulsion - to the preforms ... The application of the emulsion is followed by drying of the preforms. Drying may for instance be effected by ...";
- page 4, lines 14 to 18: "While still warm, these preforms were then sprayed with a 0.5% by weight emulsion of polypropylene wax in water. After drying, the preforms were handled and processed to form bottles in the same manner as in the Comparative Example";
- claim 6: "... wherein the coating is applied by spraying the preform with or immersing the preform in an aqueous emulsion of the coating agent, optionally followed by drying the treated preform."

Accordingly, drying of a coating is disclosed in the application as filed only in combination with applying a coating in the form of an aqueous emulsion.

3. The method according to claim 1 of the patent in suit, comprises the steps of applying a coating of a material on the outer surface of a preform and allowing the coating to dry. Claim 1 thus does not specify whether the coating is in the form of an aqueous emulsion or not. Therefore, claim 1 of the patent in suit comprises the new aspect that any coating, whether in the form of an aqueous emulsion or not, is allowed to dry.

Furthermore, according to the application as filed, cf. claim 6 of the application as filed, the step of drying is denoted as being optional. Thus, it is not directly and unambiguously derivable from the application as filed that any form of coating necessarily requires drying.

4. Consequently, the fact that coatings in general, thus also coatings which are not in form of an aqueous emulsion, should be allowed to dry is not disclosed in the application as filed.

Consequently, claim 1 of the patent in suit has been amended in such a way that it contains subject-matter which extends beyond the content of the application as filed. Therefore, the patent in suit as granted does not meet the requirements of Article 123(2) EPC.

**Order**

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

1. The decision under appeal is set aside.
2. The patent is revoked.

The Registrar:

The Chairman:

M. Dainese

W. Moser