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**Datasheet for the decision
of 31 August 2006**

Case Number: T 0332/04 - 3.3.05

Application Number: 98101836.9

Publication Number: 0856494

IPC: C03C 25/26

Language of the proceedings: EN

Title of invention:

Binding agent for mineral wool and mineral wool product bonded therewith

Patentee:

SAINT-GOBAIN ISOVER

Opponent:

Rockwool International A/S

Headword:

Bound mineral wool/ISOVER

Relevant legal provisions:

EPC Art. 123(2), (3)

EPC R. 57a

Keyword:

"Allowability under Art. 123 EPC (yes)"

"Admissibility of a dependent claim under R. 57a EPC (yes)"

Decisions cited:

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Catchword:

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Case Number: T 0332/04 - 3.3.05

D E C I S I O N
of the Technical Board of Appeal 3.3.05
of 31 August 2006

Appellant: SAINT-GOBAIN ISOVER
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Representative: Winter, Brandl, Fürniss, Hübner Röss, Kaiser,
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Respondent: Rockwool International A/S
(Opponent) Hovedgaden 584
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Decision under appeal: Decision of the Opposition Division of the
European Patent Office posted 23 December 2003
revoking European patent No. 0856494 pursuant
to Article 102(1) EPC.

Composition of the Board:

Chairman: M. Eberhard
Members: J.-M. Schwaller
J. Willems

Summary of Facts and Submissions

- I. The appeal was lodged by the patentee against the decision of the opposition division posted on 23.12.2003 revoking European Patent EP-B-0856494.
- II. In the decision, the opposition division held that the addition of the feature "*whereby said binding agent has a concentration in the mineral wool product, relative to the fiber mass, of about 0.1% to 10%*" in claim 1 according to the main request filed with letter of 07.08.02 was contrary to the requirements of Article 123(2) EPC. It also considered that claim 1 of the auxiliary request (as filed during the oral proceedings of 25.11.03) did not meet the requirements of Article 123(2) EPC.
- III. With the grounds of appeal dated 14.04.2004, the appellant (patentee) filed three new sets of claims, respectively as main, 1st and 2nd auxiliary requests.

Claim 1 of the main request differs from that of the main request of the contested decision by the absence of the feature identified in item II. above. Claim 1 and dependent claim 10 of the main request read as follows:

*"1. A bound mineral wool product, characterized by being bonded with a binding agent containing, relative to its dry mass:
about 2.5 to 70% of at least one thermoplastic homo- or copolymer cross-linkable with phenolic resin,
about 10 to 95% of at least one phenolic resin,*

about 2.5 to 70% of a flameproofing agent, wherein said flameproofing agent is selected from ammonium phosphates, about 1 to 50% stabilizers."

"10. Mineral wool product according to any one of claims 1 to 9, characterized by selecting the stabilizers from metal oxide nanogels and/or glass particles".

- IV. In a communication, the board expressed *inter alia* the preliminary opinion that the claims of the main request appeared to meet the requirements of Article 123(2) EPC.

The board also observed that the set of amended claims filed during the opposition procedure with the letter dated 07.08.2002 was considered as an attempt by the patentee to delimit the patent in order to overcome objections raised in the notice of opposition and that by such a limitation, the appellant did not irrevocably abandon broader subject-matter. The board, referring to the jurisprudence, indicated that in a situation where the patentee was appealing against the revocation of his patent because an independent claim lacked the requirements of Article 123(2) EPC, he should be allowed to abandon this version and in particular to delete the non-allowable amendment from said claim, the new version having of course to meet the requirements of Article 123(3) EPC.

- V. During the oral proceedings which took place on 31 August 2006, the appellant withdrew its request for reimbursement of the appeal fee.

The respondent recognized that claim 1 of the main request met the requirements of Article 123(2) EPC but contested the admissibility of dependent claim 10 thereof under Rule 57a EPC as well as its allowability under Article 123(2) EPC. After discussion of these issues, he withdrew the objection under Article 123(2) EPC.

VI. The appellant essentially presented the following arguments:

Claim 1 of the main request was based on claims 18, 1, 11 and 5 of the application as filed and dependent claim 10 on claims 11 and 18 as originally filed.

The subject-matter of dependent claim 10 of the main request being furthermore included in claim 11 of the granted patent as a preferred embodiment, and the granted claims also including a combination of claim 11 with the bound mineral wool product of claim 13, dependent claim 10 was to be admitted in the set of claims of present main request. Its presence therein was therefore not in breach with Rule 57a EPC.

VII. The respondent submitted in writing that claim 1 of the main request was broader than amended claim 1 filed in response to the notice of opposition and that said request threw proceedings back to the stage existing before 07.08.2002. He nevertheless recognized during the oral proceedings that there was no legal basis preventing such a situation.

At the oral proceedings, he argued that dependent claim 10 should be rejected as inadmissible, because it

was absent from the claims of the patent in suit and its addition to the set of claims of all the requests thus contravened Rule 57a EPC.

VIII. The appellant requested that the decision under appeal be set aside and the case be remitted to the first instance for further prosecution on the basis of the claims now on file (i.e. as filed with the grounds of appeal).

The respondent requested that the appeal be dismissed.

Reasons for the Decision

Main request

1. Rule 57a EPC

The respondent objected under this Rule to the introduction of dependent claim 10 into the set of amended claims according to the main request, arguing that it was absent from the claims of the patent in suit.

According to the established jurisprudence of the Boards of Appeal before and after entry into force of Rule 57a EPC, the addition of new dependent claims having no counterpart in the granted patent is neither appropriate nor necessary to meet a ground for opposition and is therefore not admissible (see Case Law of the Boards of Appeal, 4th edition, 2001, VII.C. 10.1.4, e.g. T 794/94, point 2.2.4 of the reasons and

T 674/96, point 3.10 of the reasons). The present board shares this view.

In the present case, claim 11 of the granted patent reads as follows:

"A binding agent according to any one of claims 1 to 10, characterized by containing, relative to its dry mass:

*about 2.5 to 70 % thermoplastic polymer,
about 10 to 95 % phenolic resin,
about 2.5 to 70 % flameproofing agent, and
about 1 to 50 % stabilizers, particularly metal oxide nanogels and/or glass particles;
in particular ..."*.

It can be seen therefrom that the feature of present dependent claim 10, namely that the stabilisers are selected from metal oxide nanogels and/or glass particles, was indeed present in the set of claims as granted, since it was included in said claim 11 as preferred embodiments for the stabilizers therein defined in a generic way. It is noted that the subject-matter of said claim 11 was furthermore disclosed in the granted claims in combination with that of claim 13, since the latter is related to a *"bound mineral wool product, characterised by being bonded with the binding agent according to one of claims 1 to 12"*. Accordingly, since the part of granted claim 11 (i.e. the amounts of thermoplastic polymer, phenolic resin, flameproofing agent and stabilizers) to which said preferred embodiments were associated has now been introduced into independent claim 1 of the main request, the recitation of said preferred embodiments into a dependent claim 10 corresponds to preferred

features already stated in the granted claims and thus is not in breach with Rule 57a EPC. Dependent claim 10 is therefore considered admissible.

2. Article 123(2) and (3) EPC

The allowability under this Article of the set of claims according to the main request has no longer been disputed. The board considers that the requirements of Article 123(2)(3) EPC are fulfilled as well for the following reasons:

The introductory part of claim 1 of this request has its basis in claim 18 of the application as filed which read: "*A bound mineral wool product, characterised by being bonded with the binding agent according to one of claims 1 to 16*". The other features of claim 1 have their basis in claims 1, 11 and 5 as originally filed. Because of the dependency of claim 18 as filed to anyone of claims 1 to 16, the combination of the subject-matter of claim 18 as filed with that of claims 1, 11 or 5 is allowable. Claim 11 as filed being furthermore dependent *inter alia* on claim 5 as filed and the latter claim *inter alia* on claim 1, the combination of features of claim 1 of the main request thus derives directly and unambiguously from claims 18, 1, 11 and 5 of the application as filed.

Dependent claims 2-15 have their basis in the application as filed as follows:

- claim 2 to 9 correspond to claims 2 to 9 as filed;
- claim 10 derives from claim 11 as filed, in which the metal oxide nanogels and/or glass particles

were preferred embodiments for the stabilizers defined therein;

- claims 11, 12, 13, 14 and 15 derive respectively from claims 11, 12, 19, 20 and 21 as filed.

The scope of protection conferred by claims 1-15 of this request having furthermore not been extended over that of the claims of the patent in suit, for the above reasons, the requirements of Article 123(2) and (3) EPC are fulfilled.

3. Remittal

Since the decision to revoke the patent only dealt with the allowability of the amended claims under Article 123(2) EPC, and as the opposition division has not yet ruled on the outstanding issues regarding the claims of the present request, in particular novelty and inventive step, the Board considers it appropriate to exercise its power conferred by Article 111(1) EPC to remit the case to the first instance for further prosecution.

Order

For these reasons it is decided that:

The decision under appeal is set aside

The case is remitted to the first instance for further prosecution on the basis of the set of claims filed as main request with letter of 14 April 2004 (grounds of appeal)

The Registrar:

The Chairman:

C. Vodz

M. Eberhard