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**Datasheet for the decision
of 27 January 2012**

Case Number: T 0109/08 - 3.3.02

Application Number: 99925867.6

Publication Number: 1005318

IPC: A61K 6/083

Language of the proceedings: EN

Title of invention:

Optimum particle sized hybrid composite

Patentee:

Kerr Corporation

Opponent:

3M ESPE AG

Headword:

Dental Composite/KERR

Relevant legal provisions:

EPC Art. 111(1), 111(2), 114, 83

Relevant legal provisions (EPC 1973):

EPC R. 67

Keyword:

"Admission of late-filed ground for opposition (yes) -
discretionary power exercised erroneously - remittal"

Decisions cited:

G 0007/93, T 0961/00

Catchword:

A board of appeal, when reviewing the opposition division's
exercise of discretion under Article 114(2) EPC, has the power
to overrule a decision not to admit a late-filed ground of

opposition, if the board concludes that the opposition division based its decision on manifestly incorrect technical assumptions or on an erroneous approach to applying said ground of opposition since this amounts to a misuse of the discretionary power under Article 114(2) EPC.



Case Number: T 0109/08 - 3.3.02

D E C I S I O N
of the Technical Board of Appeal 3.3.02
of 27 January 2012

Appellant: Kerr Corporation
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Decision under appeal: Decision of the Opposition Division of the
European Patent Office posted 2 November 2007
revoking European patent No. 1005318 pursuant
to Article 101(3)(b) EPC.

Composition of the Board:

Chairman: U. Oswald
Members: M. C. Ortega Plaza
L. Bühler

Summary of Facts and Submissions

I. European patent No. 1 005 318, based on international application No. WO 99/65453, was granted on the basis of twelve claims.

Claim 1 as granted reads as follows:

1. A dental composite comprising a resin base and about 11% by volume to about 80% by volume filler comprising a ground structural filler and a microfiller, wherein the ground structural filler comprises between about 10% by volume and about 70% by volume of the composite and comprises ground particles of mean particle size between about 0.05 μm and about 0.5 μm and wherein the microfiller comprises between 1 and 10.0% by volume of the composite and comprises particles of mean particle size of about 0.04 μm or less.

II. Opposition was filed and revocation of the patent in its entirety was requested pursuant to Article 100(a) EPC for lack of novelty and lack of inventive step.

III. The present appeal lies from a decision of the opposition division revoking the patent for lack of novelty of the subject-matter of claim 1 of all requests (Articles 102(1),(3) and 54 EPC 1973).

The opposition division did not admit the late-filed ground for opposition pursuant to Article 100(b) EPC into the proceedings since it could not see "any prima facie relevance in the late filed submissions concerning the ground of opposition under Article 100(b) EPC".

IV. The patent proprietor (appellant) filed an appeal against said decision and filed grounds of appeal. With the grounds of appeal it filed two auxiliary requests. The appellant requested that the decision of the opposition division be set aside and the patent be maintained as granted (main request) or, alternatively,

in amended form on the basis of one of the auxiliary requests. It also requested that oral proceedings be held.

- V. The respondent (opponent) filed counter-arguments to the grounds of appeal and it also filed additional documents. It also contested the reasoning in relation to sufficiency of disclosure in the opposition division's decision.

The respondent requested that the appeal be dismissed and that oral proceedings be held if the board did not intend to dismiss the appeal.

- VI. On 20 April 2011, the board sent a communication in which it expressed essentially the opinion that the board was charged to examine whether or not the opposition division had duly exercised its discretionary power under Article 114(2) EPC not to admit the late-filed ground for opposition pursuant to Article 100(b) EPC. The board also gave its analysis of the situation in the present case, in particular that the opposition division had erred when it decided not to admit the grounds under Article 100(b) EPC since the examination of sufficiency of disclosure was relevant for an objective assessment of novelty. Moreover, the board indicated that under these circumstances it intended to set aside the opposition division's decision and to remit the case to the department of first instance for further prosecution (Article 111 EPC). Finally, the board requested the parties to inform it whether under the circumstances depicted in its communication they maintained their request for oral proceedings.

- VII. With a letter dated 17 June 2011 the respondent requested the board to "decide on the appeal by exercising its power within the competence of the department which was responsible for the decision appealed according to Article 111(1) EPC". Moreover, it informed the board that it maintained its request for oral proceedings.
- VIII. With a letter dated 22 June 2011 the appellant informed the board that it did not object to the case being remitted to the opposition division and that under the circumstances depicted in the board's communication dated 20 April 2011 it withdrew its request for oral proceedings. It also filed a "complete" version of the first auxiliary request containing all claims.
- IX. In view of the respondent's response dated 17 June 2011 the appellant clarified in a letter dated 20 July 2011 that it maintained its request for oral proceedings in the event that the case was not going to be remitted to the opposition division for consideration of the issues under Article 100(b) EPC. Moreover, it also expressed the view that if the board intended to hold oral proceedings it should not decide on the issues pursuant to Article 100(b) EPC, because that would deprive the appellant of the opportunity to defend its patent at two levels of jurisdiction.
- X. The parties were summoned to oral proceedings in view of the fact that the respondent had maintained its request for oral proceedings and disagreed with the remittal. The summons were sent with a brief communication by the board explaining the situation.

- XI. In response to the board's communication sent as an annex to the summons to the oral proceedings, the respondent filed a letter dated 15 December 2011 withdrawing its previous request for oral proceedings.
- XII. The appellant (patent proprietor) requested that the decision under appeal be set aside and the patent be maintained as granted (main request) or, alternatively, in amended form on the basis of the two auxiliary requests on file. Moreover, it requested remittal to the department of first instance if the assessment of the grounds for opposition under Article 100(b) EPC had to take place.
- The respondent (opponent) requested that the appeal be dismissed. It also requested that the case not be remitted to the department of first instance for further prosecution.
- XIII. The parties were informed with EPO Form 3017 dated 10 January 2012 that the oral proceedings appointed for 2 February 2012 were cancelled.

Reasons for the Decision

1. The appeal is admissible.
2. *Adequate opportunity to comment on the grounds of the decision*
 - 2.1 The parties had the opportunity to file observations in relation to the board's intention to set aside the

decision under appeal and to remit the case to the department of first instance (the reasons for the board's intention were given in detail in its communication dated 20 April 2011).

2.2 Additionally, both parties withdrew their requests for oral proceedings contingent upon the case being remitted to the department of first instance for assessment of the grounds for opposition under Article 100(b) EPC.

2.3 In view of the above the board cancelled the oral proceedings and informed the parties accordingly.

3. *Scope of the examination of the appeal*

3.1 The respondent took issue with the opposition division's conclusion not to admit the late-filed ground of opposition (Article 100(b) EPC-lack of sufficiency of disclosure) into the proceedings. It requested that the relevance of this ground be considered by the board and admitted into the appeal proceedings.

3.2 Under Article 107, first sentence, EPC a party can only appeal if it is adversely affected by the decision of the first instance. A party is adversely affected if a decision does not accede to its requests (established jurisprudence; see T 961/00 of 9 December 2002, point 1 of the Reasons). In the present case the patent was revoked in accordance with the respondent's request. Therefore, the respondent was not in a position to file an appeal with the sole object of securing the admission of a fresh ground of opposition into the

proceedings even though its request to admit the new ground of opposition pursuant to Article 100(c) EPC had been rejected by the opposition division. According to Article 107, second sentence, EPC the respondent is however party to the appeal proceedings as of right. In accordance with the principle of equal and fair treatment of all parties, the respondent must be able to challenge, in reply to the admissible appeal by the proprietor, the way the opposition division exercised its discretion when not admitting the late-filed ground of opposition, so as not to be put at an unfair disadvantage given the appellant's legitimate attempt to reverse the decision revoking the patent. The board has therefore the power and duty to decide whether the opposition division's conduct of the proceedings amounted to a violation of Article 114(2) or Article 113(1) EPC.

4. *Fresh ground of opposition - review of exercise of discretionary power*

4.1 If the way in which a department of first instance has exercised its discretion on a procedural matter is challenged in an appeal, it is not the function of a board of appeal to review all the facts and circumstances of the case as if it were in the place of the department of first instance, and to decide whether or not it would have exercised such discretion in the same way. A board of appeal should only overrule the way in which a department of first instance has exercised its discretion if the board concludes that it has applied the wrong principles, or not taken account of the right principles, or has acted in an unreasonable way (G 7/93, OJ 1994, 775, point 2.6 of

the Reasons). The board therefore is in the first place charged with reviewing the opposition division's exercise of its discretion under Article 114(2) EPC. A failure to exercise sound, reasonable and legal discretion does not however need to amount to bad faith, intentional wrong doing, or unsound conduct of the proceedings to justify an appeal board reviewing the exercise of discretionary power by a department of first instance.

- 4.2 The opposition division did not admit lack of sufficiency of disclosure as a late-filed ground for opposition since it considered that it was not *prima facie* relevant, i.e. would not prejudice the maintenance of the patent, for the reasons given in point I of "Reasons for the decision".
- 4.3 An inspection of the file shows that the opponent raised an objection of lack of sufficiency of disclosure with its letter dated 16 August 2007 **as a reaction to the preliminary view expressed by the opposition division** in its communication sent as an annex to the summons to oral proceedings under the heading "Novelty". In particular, the opposition division stated the following in said communication: "In principle, the opponent did not demonstrate that the amounts presented in the various documents in wt.% correspond to the amounts presented in the contested patent in vol.%. In order to calculate the amounts in vol.% **it seems to be necessary to determine the density of the composite, the polymer matrix and the filler materials**". (emphasis added)

By saying this the opposition division overlooked the fact that the patent in suit does not contain any definition in relation to the density of the composite (bulk density, apparent density). Moreover, claim 1 as granted does not contain any definition in relation to the chemical nature or physical form of the resin base and does not specify either the chemical nature and constitution of the filler materials. The claim merely contains some definitions in relation to particle sizes (in a non-limitative way by means of the definition of ranges preceded by the term "comprises") which had also been contested, and the "product-by-process"-like term "ground", i.e. obtainable by grinding. In fact, the resin base may include, according to the description, commercially available monomers of very different chemical natures. These might, or might not be, polymerized or cured in the dental composite, with the corresponding volume shrinkage (and differences in the density after shrinkage). The filler materials for their part are to be chosen from a broad palette of materials with a broad variety of tamped volumes resulting in different densities of the composite, contrary to the **simplistic understanding** stated in the opposition division's decision (page 6) that "in dentistry similar materials having a similar density are used".

- 4.4 In its response dated 16 August 2007 to the opposition division's communication, the opponent justified its failure to file earlier the grounds pursuant to Article 100(b) EPC as follows: during examination proceedings the relative contents of the filler in the dental composite introduced in the amended and eventually granted claim 1, expressed as %by volume,

had been treated by the applicant and the examining division as if they were amounts. Therefore, on the basis of this understanding of the claimed subject-matter it had initially based its opposition on a lack of novelty since the dental composite claimed contained comparable amounts of filler in terms of bulk as those in the prior-art documents which were expressed as %by weight.

- 4.5 The board has investigated the correctness of the opponent's allegation mentioned in point 4.4 above. As a matter of fact, the definition of the composite in claim 1 as granted as a dental composite comprising a resin base and **about 11% by volume to about 80% by volume filler** relates to a definition which was introduced during examination proceedings and which derived from the **arithmetical addition** of two independent ranges for load volumes of the particular filler materials defined in originally filed claims 1 and 7 (between about 10% by volume and about 70% of a ground structural filler, and between about 1% and about 10% by volume of microfiller). This amendment was introduced by the applicant and accepted by the examining division, as if it involved the mere addition of amounts. However, it appertains to the common technical knowledge that when adding load volumes of two filler materials of different particle sizes the filler component with smaller particle size fills the interstices between the bigger particles of the other filler component (as is acknowledged in lines 19-20 on page 14 of the application as filed). Thus, the total volume of filler in the composite taken as the result of the arithmetical addition of the load volumes of the

different filler materials contradicts the common technical understanding and the original disclosure.

- 4.6 The opponent further stressed in its letter dated 16 August 2007 that there were essential differences between a bulk volume and a tamped volume and that the patent in suit did not contain any reference to a method of measuring the volume of the filler contained in the dental composite expressed in claim 1.

Moreover, the opponent stated in said letter that the specific examples A, B and C in the patent in suit expressed the amounts of filler components in %by weight in the composite, and that the only place where %by volume could be found was in the tables as "load volume %".

- 4.7 It is manifest that Table 3 expresses for the composites of examples A, B and C the "load weight %" for the filler as the total amount (which results from arithmetical addition of the amounts expressed as %by weight of the three different filler materials employed), and further states a "**load** volume %" for the filler *in toto* (emphasis added) but does not give any value for any content of the separate filler materials as %by volume of the composite.

- 4.8 In view of the analysis made in points 4.2 to 4.7 above it is apparent that the opposition division exercised its discretion in an unreasonable way, since the opposition division's reasoning for considering the ground of opposition pursuant to Article 100(b) EPC to be *prima facie* not relevant **disregards all the essential technical aspects mentioned above, which are**

manifestly relevant for an objective evaluation of the novelty of the subject-matter claimed.

The opposition division's approach reduced the relevance of Article 100(b) EPC to a mere reproduction of the specific examples. Such an approach is not correct in the present case since there is a gap, created by an apparent lack of explicit technical information in the patent in suit, between the particular reproduction of the individual examples and the extrapolation of this specific teaching when trying to reproduce the generic dental composite defined in claim 1 as granted. It is **not immediately evident** how this gap can be filled from the content of the description and the general knowledge of the skilled person.

4.9 Therefore, the arguments put forward by the opponent with its letter of 16 August 2007 **justified** the late filing of the grounds pursuant to Article 100(b) EPC and raised **reasonable doubts** as to the sufficiency of disclosure of the subject-matter claimed in the granted claims. Therefore, the late-filed ground for opposition should have been admitted into the proceedings.

4.10 Furthermore, as the opposition division did not admit the ground of lack of sufficiency of disclosure into the proceedings, it endorsed the conversion (brought by the opponent as a subsidiary argument) of %by wt. values into %by vol. values based on an **artificial conversion factor** calculated from the relationship between the load weight% and the load volume% for the filler appearing in Table 3 of the patent in suit, and

concluded by analogy that there was a lack of novelty vis-à-vis document D5 (EP-A-0 677 286).

- 4.11 The appellant (patentee) has contested the technical correctness of these calculations in its grounds of appeal.

The respondent replied that this argumentation made it clear that the ground of opposition pursuant to Article 100(b) EPC should be admitted into the proceedings. Moreover, the opponent submitted further documents and technical information about the density of particular materials used as constituents for the fillers of the prior art.

- 4.12 From the analysis made in points 4.3 to 4.9 above it is apparent that the opposition division **did not take into proper consideration all the facts and arguments bearing on the issue of the late-filed ground of opposition**. Rather, it based its assessment of the admissibility of the late-filed ground of opposition and consequently also its finding of lack of relevance on **manifestly wrong technical assumptions and on an erroneous approach to applying Article 100(b) EPC**. This amounts to an unsound exercise of discretion (Article 114(2) EPC) which in the board's opinion justifies the reversal of the decision in suit.

5. Having regard to the fact that the full and correct assessment of sufficiency of disclosure of the claimed subject-matter **has not yet taken place** because the opposition division declined to admit this ground of opposition, the dispute in relation to novelty of the claimed "invention" has been **artificially overburdened**

in the present appeal by a manifest lack of explicit information in the patent in suit concerning some of the technical features in the claims as granted.

6. *Article 111(1) EPC*

6.1 As regards the respondent's request that the case should not be remitted to the department of first instance since the board may exercise any power within the competence of the department which was responsible for the decision appealed, the following has been considered (Article 111(1) EPC). As expressed in the board's communication sent as an annex to the summons to oral proceedings, the issue of substantive examination of the grounds for opposition pursuant to Article 100(b) EPC -yet to be undertaken- is not a minor one in the present case. The board is convinced that a hypothetical assessment of the other opposition grounds is devoid of meaning before sorting out that matter.

6.2 Moreover, the board considers that the present situation, in which the appealed decision is based on manifestly wrong technical assumptions which lead to the revocation of the patent for lack of novelty, justifies that the substantive examination of the grounds for opposition under Article 100(b) EPC being dealt with at two instances.

6.3 Consequently, the board sets aside the decision under appeal and remits the case to the opposition division for further prosecution and in particular for a substantive examination of the grounds pursuant to Article 100(b) EPC (Article 111(2) EPC).

Order

For these reasons it is decided that:

1. The decision under appeal is set aside.

2. The case is remitted to the department of first instance for further prosecution.

The Registrar:

The Chairman:

N. Maslin

U. Oswald