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**Datasheet for the decision
of 17 January 2014**

Case Number: T 1045/09 - 3.3.03

Application Number: 00960620.3

Publication Number: 1232198

IPC: C08G65/18, C08G59/24, C08G59/62

Language of the proceedings: EN

Title of invention:
UV-CURABLE COMPOSITIONS

Patent Proprietor:
Huntsman Advanced Materials (Switzerland) GmbH

Opponent:
DSM IP Assets B.V.

Headword:

Relevant legal provisions:
EPC Art. 123(2), 114(2)
RPBA Art. 13(1)

Keyword:
Amendments - undisclosed disclaimer broader than necessary -
not allowable
Late-filed request - request clearly allowable (no)

Decisions cited:

G 0003/89, G 0011/91, G 0001/93, G 0004/95, G 0001/03,
G 0002/03, G 0002/10, T 0425/98, T 0740/98, T 0500/00,
T 0997/06

Catchword:



**Beschwerdekammern
Boards of Appeal
Chambres de recours**

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Case Number: T 1045/09 - 3.3.03

**D E C I S I O N
of Technical Board of Appeal 3.3.03
of 17 January 2014**

Appellant: Huntsman Advanced Materials (Switzerland) GmbH
(Patent Proprietor) Klybeckstrasse 200
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Respondent: DSM IP Assets B.V.
(Opponent) Het Overloon 1
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Representative: Jansen, Cornelis Marinus
V.O.
Johan de Wittlaan 7
2517 JR Den Haag (NL)

Decision under appeal: **Decision of the Opposition Division of the
European Patent Office posted on 24 March 2009
revoking European patent No. 1232198 pursuant to
Article 101(3) (b) EPC.**

Composition of the Board:

Chairman B. ter Laan
Members: F. Rousseau
C. Brandt

Summary of Facts and Submissions

I. The appeal by the Patent Proprietors (Appellants) lies from the decision of the opposition division posted on 24 March 2009 revoking European patent No. 1 232 198 (based on European application No. 00 960 620.3, filed as international application PCT/EP2000/08748 on 7 September 2000 and published as WO2001/01985).

II. Claim 1 of the patent as granted read as follows:

"1. A curable composition comprising

- a) at least one oxetane compound;
- b) at least one polyfunctional cycloaliphatic epoxy compound;
- c) at least one multifunctional hydroxy compound, and
- d) at least one curing agent;

provided that the composition does not contain elastomer particles with an average particle diameter of 10-700 nm."

(emphasis added by the Board, indicating the difference with claim 1 as originally filed).

III. A notice of opposition had been filed in which the revocation of the patent in its entirety was requested on the grounds that its subject-matter lacked novelty and an inventive step, was insufficiently disclosed and extended beyond the content of the application as filed.

IV. The impugned decision was based on four sets of amended claims submitted by the Patent Proprietors with letter of 10 February 2009, claim 1 of each of which contained the same disclaimer as claim 1 as granted.

- V. According to the decision, the subject-matter of claim 1 of all requests contravened the requirements of Article 123(2) EPC on the ground that the proviso introduced during the examination procedure to restore novelty over WO 00/63 272 (D10) was an unallowable undisclosed disclaimer within the meaning of G 1/03. The opposition division held in essence that the compositions that had been disclaimed did not correspond to the disclosure of D10, thereby generating new subject-matter over the application as originally filed.
- VI. The patent proprietor lodged an appeal against that decision on 12 May 2009; the prescribed fee was paid on the same day.

With the statement setting out the grounds of appeal filed on 22 July 2009, the Appellants submitted a main request as well as two auxiliary requests, all consisting of two claims. The independent claims 1 of those requests read as follows:

Main request

- "1. A curable composition comprising
- a) at least one oxetane compound;
 - b) at least one polyfunctional cycloaliphatic epoxy compound;
 - c) at least one multifunctional hydroxy compound selected from the group consisting of ethylene glycol, diethylene glycol, triethylene glycol, higher polyoxyethylene glycols, propane-1,2-diol, propane-1,3-diol, butane-1,4-diol, higher polyoxytetramethylene glycol, neopentyl glycol, pentane-1,5-diol, hexane-1,6-diol, octane-1,8-

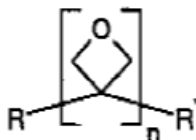
diol; quinitol, resorcitol, bis(4-hydroxy-cyclohexyl)methane, 2,2-bis(4-hydroxy-cyclohexyl)propane, cyclohexane dimethanol, 1,1-bis(hydroxymethyl)cyclohex-3-ene, 4,9-bis(hydroxymethyl)tricyclo[5,2,1,0^{2,6}]decane, pentaerythritol ethoxylate, tripropylene glycol, glycerol propoxylate, dendritic polyol, hydroxy terminated polybutadienes or polybutadiene polymers; 1,4-benzenedimethanol, 4,4'-bis(hydroxymethyl)biphenyl, glycerol, higher polyethylene glycol based on glycerol, higher polyoxypropylene glycol based on glycerol, pentaerythritol, higher polyethylene glycol based on pentaerythritol, higher polyoxypropylene glycol based on pentaerythritol; and
d) at least one curing agent

provided that the composition does not contain elastomer particles with an average particle diameter of 10-700 nm."

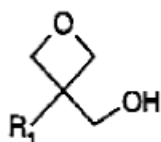
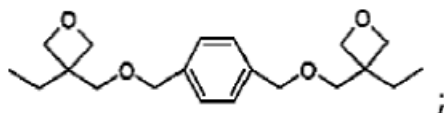
First auxiliary request

Claim 1 of the first auxiliary request differed from claim 1 of the main request in that the at least one oxetane compound was defined to be:

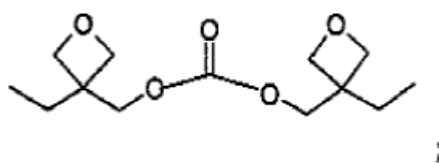
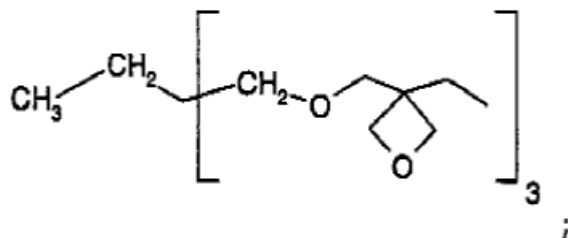
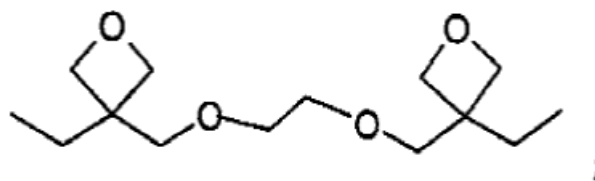
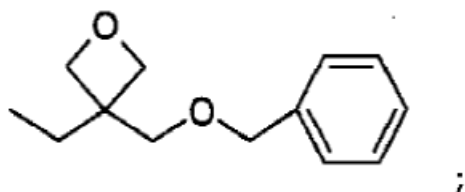
"selected from the group consisting of



wherein R and R' independently of one another represent aliphatic, cycloaliphatic, aromatic or araliphatic groups and n represents an integer from one to four;



with R₁ = methyl or ethyl



..

Second auxiliary request

Claim 1 of the second auxiliary request differed from claim 1 of the main request in that the at least one multifunctional hydroxy compound c) was defined to be:

"selected from the group consisting of ethylene glycol, diethylene glycol, triethylene glycol, propane-1,2-diol, propane-1,3-diol, butane-1,4-diol, neopentyl glycol, pentane-1,5-diol, hexane-1,6-diol, octane-1,8-diol; quinitol, resorcitol, bis(4-hydroxycyclohexyl)-methane, 2,2-bis(4-hydroxycyclohexyl)propane, cyclohexane dimethanol, 1,1-bis(hydroxymethyl)cyclohex-3-ene, 4,9-bis(hydroxymethyl)tricyclo[5,2,1,0^{2,6}]decane, pentaerythritol ethoxylate, tripropylene glycol, glycerol propoxylate, dendritic polyol, hydroxy terminated polybutadienes or polybutadiene polymers; 1,4-benzenedimethanol, 4,4'-bis(hydroxymethyl)biphenyl, glycerol;"

The wording of claim 2 of all of the main and the first and second auxiliary requests was identical to that of claim 6 as originally filed, reading as follows:

"2. Use of the curable composition according to claim 1 as adhesives, primers for adhesives, laminating and casting resins, molding compositions, putties and sealing compounds, potting and insulation compounds, as coatings or stereolithographic type applications".

VII. The rejoinder of the Respondents was submitted with a letter of 01 December 2009. Additional submissions by the Respondents were made with letters of 25 May 2012 and 13 December 2013.

VIII. By letter dated 27 November 2013 the Appellants filed further written submissions.

IX. Oral proceedings before the Board took place on 17 January 2014 in the course of which a third auxiliary request consisting of two claims was submitted, claim 1 of which read as follows:

"1. A curable composition consisting of

- a) at least one oxetane compound;
- b) at least one polyfunctional cycloaliphatic epoxy compound;
- c) at least one multifunctional hydroxy compound selected from the group consisting of ethylene glycol, diethylene glycol, triethylene glycol, propane-1,2-diol, propane-1,3-diol, butane-1,4-diol, neopentyl glycol, pentane-1,5-diol, hexane-1,6-diol, octane-1,8-diol; quinitol, resorcitol, bis(4-hydroxycyclohexyl)methane, 2,2-bis(4-hydroxycyclohexyl)propane, cyclohexane dimethanol, 1,1-bis(hydroxymethyl)cyclohex-3-ene, 4,9-bis(hydroxymethyl)tricyclo[5,2,1,0^{2,6}]decane, pentaerythritol ethoxylate, tripropylene glycol, dendritic polyol, hydroxy terminated polybutadienes or polybutadiene polymers; 1,4-benzenedimethanol, 4,4'-bis(hydroxymethyl)biphenyl, glycerol; and
- d) at least one curing agent."

The wording of Claim 2 of the third auxiliary request was identical to that of the higher ranking requests.

X. The Appellants' arguments can be summarised as follows:

- a) Applying retroactively the interpretation of the law proposed by decisions G 1/03 and G 2/03 taken on 8 April 2004 to a claim containing a disclaimer introduced on 2 June 2003 would be "a clear violation of the principles of "bona fide" and "legal certainty", on which the EPC is based".
- b) Independent claim 1 of D10 disclosed the use of "elastomer particles with an average particle diameter of 10-700 nm". In disclaiming the use of those additives, novelty was restored over D10, without disclaiming more than necessary, as it could be derived from D10 that those elastomeric particles could be used in general. Furthermore, example 7 of D10 was novelty destroying for the claim without the disclaimer.
- c) Moreover, the disclaimer did not provide any technical contribution and therefore did not provide any advantage for the Applicants. Relying on decision G 1/93, it was therefore concluded that the disclaimer was allowable.
- d) As to the reasons for filing the third auxiliary request, it had not been clear from the outset of the appeal proceedings that the presence of the disclaimer in claim 1 as granted would lead to such a severe problem. In fact, the third auxiliary request had been submitted in view of the Board's communication received one month before the oral proceeding.
- e) Moreover, the claims of the third auxiliary request differed from those of the second

auxiliary request only in that the disclaimer had been deleted, the term "comprising" had been replaced by the wording "consisting of", which in view of decisions T 425/98 and T 997/06 was allowable, and glycerol propoxylate had been deleted from the list of the multifunctional hydroxy compounds in order to restore novelty over example 7 of D10.

- f) The amendments carried out overcame the existing objection under Article 123(2) EPC. Furthermore, the filing of the new request did not unnecessarily prolong the opposition proceedings, as no decision had been taken on novelty and inventive step and the case would have to be remitted anyway for the examination of those opposition grounds. Hence, the third auxiliary request should be admitted to the proceedings.

XI. The Respondents' arguments can be summarised as follows:

- a) The disclaimer present in all requests submitted with the statement setting out the grounds of appeal removed far more than required to restore novelty over D10. Even in the absence of the disclaimer, Example 7 of D10 did not destroy the novelty of the subject-matter now being claimed. Furthermore, the disclaimer removed compositions that did not contain a photoacid generator and compositions that contained amounts of oxetane compound, epoxy compound, polyol compound, ethylenically unsaturated monomers or amounts of elastomer particles having an average particle diameter of 10-700 nm in an amount different from that specified in claim 1 of D10. Also, some of

the uses defined in claim 2 were not even disclosed in D10.

The disclaimer did not therefore meet the criteria set out in decision G 1/03 of the Enlarged Board of Appeal. Hence, neither the main request nor the first or second auxiliary request were allowable under Article 123(2) EPC.

- b) The present disclaimer provided a technical contribution as it was too broad. Thus, the exception provided by G 1/93 did not apply in the present case.
- c) The Respondents had been surprised by the late submission of the third auxiliary request, which furthermore was not clearly allowable under Rule 80 EPC and Article 123(2) EPC. In particular, the combination of the wording "consisting of" and the group of selected multifunctional hydroxy compounds defined in claim 1 of that request did not appear to be disclosed in the application as originally filed. Therefore, the third auxiliary request should not be admitted to the proceedings.

XII. The Appellants requested that the decision under appeal be set aside and the patent be maintained on the basis of the claims of the main request, or alternatively of the first or second auxiliary request, all submitted with letter of 22 July 2009, or on the basis of the third auxiliary request submitted during the oral proceedings on 17 January 2014.

XIII. The Respondents requested that the appeal be dismissed.

XIV. At the end of the oral proceedings, the decision of the Board was announced.

Reasons for the Decision

1. The appeal is admissible.

Main Request

2. The central issue with respect to the main request relates to the question whether the presence of the disclaimer "provided that the composition does not contain elastomer particles with an average particle diameter of 10-700 nm" constitutes added subject-matter in the sense of Article 123(2) EPC.

Procedural issues

3. The finding of the Opposition Division that the present disclaimer was unallowable with respect to the requirements of Article 123(2) EPC is based on decision G 1/03 (OJ 2004, 413) of the Enlarged Board of Appeal.

Examination proceedings in the present case were stayed until decision G 1/03 was issued and this at the Applicants' request submitted with letter of 2 June 2003 by which they introduced said disclaimers. Examination was resumed after issuance of decision G 1/03 and a patent was eventually granted on 07 June 2006, i.e. more than two years after publication of decision G 1/03, which had left ample time for to the Applicants to reconsider their position with respect to the issue of disclaimers and to amend

their request if they had wished so. Therefore, the Appellants' argument that a retroactive application of decision G 1/03 to the present disclaimer represented "a clear violation of the principles of "bona fide" and "legal certainty", on which the EPC is based," is factually incorrect and for that reason already fails to convince. Under these circumstances, it is not necessary to address in detail the question of the applicability of G 1/03 to the present case. For the sake of completeness, reference is nevertheless made to decisions T 0500/00 of 17 June 2004 and T 0740/98 of 9 November 2004. Those decisions ruled that the principle of good faith could not be invoked against the application of the principles concerning the allowability of disclaimers laid down in G 1/03 to pending cases, which ruling is also applied by the present Board.

Main Request - Allowability of the disclaimer

4. It is undisputed that that the present disclaimer is an undisclosed disclaimer within the meaning of G 1/03 aiming at restoring novelty over the disclosure of D10, which is prior art pursuant to Article 54(3) EPC. According to decision G 1/03, a disclaimer that is not disclosed in the application as filed may be allowable in order to restore novelty by delimiting a claim against state of the art under Article 54(3) and (4) EPC (Headnote points 2 and 2.1). Furthermore, according to point 2.6.5 of the Reasons, a disclaimer may serve exclusively the purpose for which it is intended and nothing more. In the case of a disclaimer concerning conflicting applications, its purpose is to establish novelty with respect to a prior application in the sense of Article 54(3) EPC.

4.1 Claim 1 of the main request, in addition to the disclaimer introduced before grant, contains further restrictions introduced on opposition / appeal, regarding the definition of the multifunctional hydroxy compound. However, the Board considers it appropriate to focus first on the question whether the disclaimer in the absence of those additional limitations, i.e. as introduced before grant, was already allowable.

4.1.1 One of the criteria to be applied for assessing the allowability of a disclaimer, which aims at restoring novelty, is that it should not remove more than is necessary in order to do so (see G 1/03, Headnote and point 2.2). Hence, the first step in assessing the allowability of the present disclaimer is to identify the disclosure in D10 that anticipated the subject-matter of claim 1 before the introduction of the disclaimer, i.e. claim 1 as originally filed.

4.1.2 Claim 1 of D10 discloses photocurable resin compositions for photofabrication of three-dimensional objects, comprising (A) 5-80 parts by weight (pbw) of an oxetane compound, (B) 5-80 pbw of an epoxy compound, (C) 0,1-10 pbw of a photoacid generator, (D) 1-35 pbw of elastomer particles with an average particle diameter of 10-700 nm, (E) 0-35 pbw of a polyol compound, (F) 0-45 pbw of an ethylenically unsaturated monomer, and (G) 0-10 pbw of a radical photopolymerization initiator. Claim 2 defines the oxetane compound (A) to contain two oxetane rings, whereas claim 3 specifies that the photocurable resin composition according to claims 1 or 2 contain an epoxycyclohexylgroup or a glycidylgroup as epoxy compound (B).

- 4.1.3 The Appellants referred to Claim 1 of D10 as being novelty destroying for claim 1 as originally filed. However, claim 1 of D10 does not require to use a polyol, it being an optional measure as confirmed by seven of the eight exemplified compositions of D1 (Table page 44). Nor does D10 require to select at the same time an epoxy compound containing an epoxycyclohexylgroup from the two classes of epoxy compounds defined in claim 3, let alone a "polyfunctional cycloaliphatic compound", since such a group of compounds is neither defined nor implied by claim 3. Therefore claim 1 and also claim 3 of D10 by themselves do not constitute an anticipatory disclosure for the subject-matter of claim 1 as originally filed.
- 4.1.4 The Appellants also referred to Example 7 of D10 as being novelty destroying for the claim 1 as originally filed. However, Example 7 of D10 merely describes a specific novelty destroying composition comprising 40 pbw of 1,4-bis(3-ethyl-3-oxetanylmethoxy) methylbenzene (as oxetane compound), 30 pbw of 3,4-epoxycyclohexylmethyl-3',4'-epoxycyclohexanecarboxylate and 5 pbw of bis(3,4-epoxycyclohexylmethyl)adipate (i.e. a mixture of polyfunctional cycloaliphatic epoxy compounds), 5 pbw of propylene oxide-modified glycerol (as polyfunctional hydroxy compound) and 2 pbw of triallylsulfonium hexafluoroantimonate (as a curing agent), 10 pbw of 1,6-hexanediol diglycidyl ether and 6 pbw of specific elastomer core-shell particles with an average particle diameter of 200 nm.
- 4.1.5 Since the disclaimer contained in granted claim 1 disclaims all compositions containing elastomer particles with an average particle diameter of 10-700 nm, it excludes more than is necessary in order to restore novelty over example 7 of D10.

4.1.6 The Appellants did not point out a broader disclosure emerging from D10 that would lie between that of example 7 and that provided by the claims of D10 and would be novelty destroying for claim 1 as filed. Therefore, the Board can only conclude that the present disclaimer was in every respect broader than required in order to restore novelty over Example 7 of D10.

4.2 Moreover, the definition of the disclaimer in granted claim 1 is arbitrary in the sense that many other negative limitations could have been envisaged in an attempt to restore novelty over D10, e.g. by excluding specific components used in example 7 of D10. It follows from the second paragraph of point 3 of the Reasons of G 1/03 (*loc. cit.*) that the rationale behind the criteria that "The disclaimer should not remove more than is necessary to restore novelty or to disclaim subject-matter excluded from patentability for non-technical reasons" is that "The necessity for a disclaimer is not an opportunity for the applicant to reshape his claims arbitrarily".

It follows from the arbitrary character of the present broad disclaimer in claim 1 as granted that there was no legal justification within the meaning of G 1/03 (*loc. cit.*) for it to be allowable. The further amendments now inserted in claim 1, in the form of a restriction of the definition of the multifunctional hydroxy compound, do not change the arbitrariness of the disclaimer and therefore cannot render it allowable.

4.3 The same conclusion holds true for claim 13 as granted (identical in wording to claim 2 of the present main request), which by virtue of the reference to claim 1 also contained the same disclaimer. The presence of the

disclaimer in claim 13 was even less justifiable than for claim 1, because, apart from stereolithographic applications, D10 did not disclose the uses defined in claim 13.

5. The appellants also cited decision G 1/93. That decision concerns the relationship between paragraphs 2 and 3 of Article 123 EPC in the situation of the patentee being caught in a so-called "inescapable trap" between the requirements of those paragraphs, when a limiting feature added before grant cannot be deleted or replaced by any other feature properly disclosed in the application as filed (emphasis added by the Board) without extending the protection conferred by the patent.

- 5.1 As recalled in decision G 2/10 (see point 4.3 of the Reasons), it is evident from the context of G 1/93 that by introducing the "technical contribution" criterion the Enlarged Board did not intend to modify the general definition of the requirements of Article 123(2) EPC established in opinion G 3/89 and decision G 11/91, but that it only sought a way of avoiding the potentially fatal consequences of the patentee being caught in the "inescapable trap".

However, it is not apparent to the Board, and it was not argued by the parties, that the present case would concern such a situation. On the contrary, it is clear that claim 1 as granted could have been redrafted in a form not containing a disclaimer while restricting the scope of claim 1; this is illustrated by the additional auxiliary request submitted by the Appellants during the oral proceedings.

Therefore, the Appellants cannot successfully rely on decision G 1/93 for maintaining the disclaimer in claims 1 and 2 as granted.

6. For those reasons the main request does not comply with Article 123(2) EPC.

First and second auxiliary requests

7. Both the first and the second auxiliary request contain the same disclaimer as the main request so that, for the same reasons, those requests do not fulfil the requirements of Article 123(2) either.

Third auxiliary request

8. The Appellants' third auxiliary request was submitted at the beginning of the oral proceedings, more than four years after having received the reply of the Respondents to the statement setting out the grounds of the appeal. This request therefore represents an amendment to the Appellants' case that may be admitted and considered at the Board's discretion as stipulated by Article 13(1) Rules of Procedure of the Boards of Appeal ("RPBA"). Some of the criteria that a board has to apply in exercising its discretion to admit and consider amendments to a party's case, are defined in Article 13(1) RPBA, namely complexity of the subject-matter submitted, the current state of the proceedings and the need for procedural economy.

- 8.1 The Appellants' justification for the late filing of the new request was that it was in reaction to the Board's communication received one month before the oral proceedings, as before that communication it had

not been clear that the presence of the disclaimer in claim 1 as granted would lead to such a severe problem.

8.2 This justification cannot be accepted, because the issue addressed in the Board's communication whether the disclaimer introduced in claim 1 as originally filed removed more than necessary to restore novelty over D10, had been amply discussed in the Respondents' rejoinder and it had been the main reason in the contested decision for refusing all requests. In decision G 4/95 it is recalled that both opposition and opposition appeal procedures are primarily written procedures. In principle, oral proceedings are scheduled at a point in time within an opposition or opposition appeal procedure when the written submissions of all parties, including the written presentation of facts and evidence by all parties, are complete. In the present case, the Appellants, if they considered it necessary, should have submitted one or more additional set(s) of claims in order to overcome the objections raised by the Respondents that the disclaimer introduced in claim 1 as filed extended the subject-matter beyond the content of the application as filed, at the latest after having received those submissions of the Respondents. The Appellants chose, however, to file an additional request only at the beginning of the oral proceedings.

8.3 The question also arises whether it is immediately evident that the new request would overcome the existing objection that the claimed subject-matter extends beyond the content of the application as originally filed. As indicated in claim 6 as originally filed (the wording of which corresponds to present independent use claim 2), the curable compositions of claim 1 as originally filed could be used in various

applications, as adhesives, primers for adhesives, laminating and casting resins, moulding compositions, putties and sealing compounds, potting and insulation compounds, or as coatings or in stereolithographic type applications.

8.4 The application as filed however does not indicate a preference to use compositions consisting of the four specific components a), b), c) and d), let alone in connection with the uses defined in claim 1, for which suitable additives might need to be used. The Appellant in particular did not point out any passage in the application as filed according to which compositions consisting of components a), b), c) and d) would be preferred in which the multifunctional hydroxyl compound is as now defined in claim 1, i.e. selected from the more general description of the multifunctional hydroxyl compounds provided at the middle of page 5 to page 7, line 7 of the application as filed.

8.5 Hence, the amendments now being proposed cannot be considered as directly and unambiguously derivable, using common general knowledge, from the whole of the application as filed. Therefore, it is not apparent that the amendments proposed to claim 1 would overcome the existing objection that the claimed subject-matter extends beyond the content of the application as originally filed.

8.6 Since the late-filed third auxiliary request has been submitted in the absence of a proper justification and *prima facie* has not been shown to overcome the existing objection, it is not admitted to the appeal proceedings under Article 114(2) EPC in conjunction with Article 13(1) RPBA.

Order

For these reasons it is decided that:

The appeal is dismissed.

The Registrar:

The Chairman



E. Goergmaier

B. ter Laan

Decision electronically authenticated