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**Datasheet for the decision
of 9 May 2011**

Case Number: T 0242/10 - 3.3.09

Application Number: 06254840.2

Publication Number: 1764382

IPC: C08J 3/24

Language of the proceedings: EN

Title of invention:

Dual cure compositions, methods of curing thereof and articles therefrom

Applicant:

GENERAL ELECTRIC COMPANY

Headword:

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Relevant legal provisions:

EPC Art. 111(1)

Keyword:

"Main request: withdrawn"

"First auxiliary request: remittal for further prosecution"

Decisions cited:

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Catchword:

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Case Number: T 0242/10 - 3.3.09

D E C I S I O N
of the Technical Board of Appeal 3.3.09
of 9 May 2011

Appellant: GENERAL ELECTRIC COMPANY
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Schenectady, NY 12345 (US)

Representative: Illingworth-Law, William Illingworth
Global Patent Operation - Europe
GE International, Inc.
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Decision under appeal: Decision of the Examining Division of the
European Patent Office posted 17 September 2009
refusing European patent application
No. 06254840.2 pursuant to Article 97(2) EPC.

Composition of the Board:

Chairman: W. Sieber
Members: J. Jardón Álvarez
R. Menapace

Summary of Facts and Submissions

- I. This appeal lies from the decision of the examining division dated 17 September 2009, refusing European patent application No. 06 254 840.9.
- II. The decision under appeal was based on a set of three claims filed with letter dated 20 August 2008. The claims read as follows:

"1. A dual cure composition having structural units derived from a composition comprising:

at least one UV opaque filler comprising carbon fibers, carbon black, carbon nanotubes, silicon carbide, boron nitride, titanium dioxide, zirconium oxide, chalk, calcium sulfate, barium sulfate, calcium carbonate, silicates, talc, mica, kaolin, silica, magnesium hydroxide, polymer powder, polymer fiber, or combinations thereof;

at least one curable monomer comprising at least one ethylenic unit or cyclic ether unit or mixture thereof;

at least one photoinitiator; and

at least one thermal initiator."

"2. A method of making a cured dual cure composition comprising:

(i) providing a dual cure composition comprising:

at least one UV opaque filler comprising carbon fibers, carbon black, carbon nanotubes, silicon carbide, boron nitride, titanium dioxide, zirconium oxide, chalk, calcium sulfate, barium sulfate, calcium carbonate, silicates, talc, mica, kaolin, silica, magnesium hydroxide, polymer powder, polymer fiber, or combinations thereof;

at least one curable monomer comprising at least one ethylenic unit or cyclic ether unit or mixture thereof;

at least one photoinitiator; and

at least one thermal initiator; and

(ii) exposing the dual cure composition to radiation of a wavelength made available from a radiation source to at least partially photocure the composition, and to provide an exotherm sufficient to initiate thermal curing to form a cured composition; wherein the cured composition is at least 0.1 millimeter thick."

"3. The method of claim 2 wherein the radiation source if (*sic*) turned off before complete curing is achieved."

III. The examining division refused the application, because the subject-matter of claim 1 did not meet the requirements of Article 54(2) EPC having regard to the disclosure of the document:

D4: EP 1 092 744 A1.

The examining division held that the claimed compositions were disclosed in claim 1 of D4 in combination with the list of fillers and fibres of paragraphs [26]-[27], from which only a single selection was necessary.

- IV. On 20 November 2009 the applicant (appellant) filed a notice of appeal and paid the appeal fee on the same day. The statement setting out the grounds of appeal was filed on 27 January 2010.

With the statement setting out the grounds of appeal the appellant filed a main request and two auxiliary requests. The appellant further requested oral proceedings "before any decision to confirm the Examining Division's Decision to Refuse the application is taken".

The claims of the main request corresponded to the claims before the examining division except that in claims 1 and 2 the "at least one photoinitiator" was amended to read "at least one UV activated photoinitiator" and the typographical error in claim 3 "if" was corrected to "is".

The first auxiliary request included only two claims, which corresponded to claims 2 and 3 of the request before the examining division (point II above) renumbered now as claims 1 and 2 (but including the correction of the typographical error in previous claim 3).

- V. On 9 February 2011 the board dispatched the summons to oral proceedings scheduled to take place on 27 May 2011.

In the annexed communication pursuant to Article 15(1) of the Rules of Procedure of the Boards of Appeal, the board indicated that, in its preliminary opinion, the main request was not allowable because the subject-matter of claim 1 did not satisfy the requirements of Article 123(2) EPC. The board also stated that further objections against claim 1 would probably arise in relation to novelty and inventive step in view of document D4.

Finally, the board noted that the first auxiliary request no longer included a claim referring to a dual cure composition and that no objections had been raised by the examining division against the claims of the first auxiliary request. Under these circumstances remittal of the case for further prosecution appeared to be appropriate, if the first auxiliary request became relevant.

- VI. With a letter dated 26 April 2011, the appellant withdrew its main request and requested that the application proceed on the basis of the claims of the first auxiliary request filed with the letter dated 27 January 2010.

Reasons for the Decision

1. The appeal is admissible.
2. The examining division refused the application because the subject-matter of the then pending claim 1 directed to a dual cure composition was not novel over D4. The examining division in its decision did not raise any

- objections against claims 2 and 3 of the then pending request.
3. The claims of the highest ranking request now on file, i.e. the first auxiliary request, correspond to claims 2 and 3 before the examining division and no longer contain a claim directed to a dual cure composition.
 4. This restriction has the effect that the reasons given in the decision under appeal for refusing the application do not apply any longer.
 5. Thus, the board considers that the amendments made by the appellant are essential in the sense that claims 1 and 2 of the first auxiliary request generate a fresh case not yet addressed in examination proceedings and requiring re-examination.
 6. The board has informed the appellant in the annex to the summons to oral proceedings of its intention to remit the case to the examining division if the first auxiliary request became relevant. In the reply to the board's communication, the appellant did not raise an objection against such a remittal.
 7. Under these circumstances, in particular the examination not having been concluded, the board considers it appropriate to exercise the power conferred on it by Article 111(1), second sentence, second alternative, EPC to remit the case to the examining division for further prosecution based on the present first auxiliary request.

Order

For these reasons it is decided that:

1. The decision under appeal is set aside.

2. The case is remitted to the examining division for further prosecution on the basis of claims 1 and 2 of the first auxiliary request filed with letter dated 27 January 2010.

The Registrar:

The Chairman:

G. Röhn

W. Sieber