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**Datasheet for the decision
of 4 September 2014**

Case Number: T 2001/10 - 3.3.03
Application Number: 00921184.8
Publication Number: 1171502
IPC: C08G59/00, C08G65/18, G03C9/08,
G03F7/027
Language of the proceedings: EN

Title of invention:

RESIN COMPOSITION FOR PHOTOFABRICATION OF THREE DIMENSIONAL
OBJECTS

Patent Proprietor:

DSM IP Assets B.V.
JSR Corporation
Japan Fine Coatings Co., Ltd.

Opponent:

Huntsman Advanced Materials (Switzerland) GmbH

Headword:

Relevant legal provisions:

RPBA Art. 13(1)
EPC Art. 123(2), 123(3), 83, 111(1)

Keyword:

New main request and first auxiliary request admitted into the proceedings

Amendments - added subject-matter (no)

Belated objection that amended claims extend the protection - not admitted into the proceedings

Sufficiency of disclosure - (yes)

Remittal to the department of first instance - (yes)

Decisions cited:

T 0002/81, T 0925/98, T 0012/81, T 0727/00

Catchword:



**Beschwerdekammern
Boards of Appeal
Chambres de recours**

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Case Number: T 2001/10 - 3.3.03

**D E C I S I O N
of Technical Board of Appeal 3.3.03
of 4 September 2014**

Appellant: DSM IP Assets B.V.
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Decision under appeal: **Decision of the Opposition Division of the
European Patent Office posted on 29 July 2010
revoking European patent No. 1171502 pursuant to
Article 101(3) (b) EPC.**

Composition of the Board:

| | |
|-----------------|--------------|
| Chairman | M. C. Gordon |
| 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 29 July 2010 revoking European patent No. 1 171 502, filed as international application PCT/NL2000/000256 on 19 April 2000 and published as WO 2000/063272.

II. Claim 1 of the application as filed read as follows:

"1. Photocurable resin composition for photofabrication of three-dimensional objects comprising

- (A) 5-80 parts by weight of an oxetane compound,
- (B) 5-80 parts by weight of an epoxy compound,
- (C) 0,1-10 parts by weight of a photoacid generator,
- (D) 1-35 parts by weight of elastomer particles with an average particle diameter of 10-700 nm,
- (E) 0-35 parts by weight of a polyol compound,
- (F) 0-45 parts by weight of an ethylenically unsaturated monomer, and
- (G) 0-10 parts by weight of a radical photopolymerization initiator."

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

"1. Photocurable resin composition for photofabrication of three-dimensional objects comprising

- (A) 5-80 parts by weight of an oxetane compound,
- (B) 5-80 parts by weight of an epoxy compound,
- (C) 0,1-10 parts by weight of a photoacid generator,
- (D) 1-35 parts by weight of elastomer particles,
- (E) 0-35 parts by weight of a polyol compound,
- (F) 0-45 parts by weight of an ethylenically unsaturated monomer, and

(G) 0-10 parts by weight of a radical photopolymerization initiator,

wherein the elastomer particles (D) are core-shell particles having an average particle diameter of 10-700 nm.

- IV. The Opponent (Respondent) had requested in the notice of opposition the revocation of the patent in its entirety 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.
- V. The impugned decision was based on a set of amended claims submitted by the Patent Proprietor with letter of 12 August 2008 (main request), as well as two sets of amended claims originally submitted with letter of 18 June 2010 as auxiliary requests II and VI, before they were renumbered during the oral proceedings before the opposition division on 1 July 2010 as auxiliary requests I and II, all other auxiliary requests being withdrawn. Claim 1 of the main request read as follows:

"1. Photocurable resin composition for photofabrication of three-dimensional objects comprising

- (A) 10-80 wt% of an oxetane compound,
 - (B) 20-80 wt% of an epoxy compound,
 - (C) 0,1-10 wt% of a photoacid generator,
 - (D) 1-35 wt% of elastomer particles,
 - (E) 0-35 wt% of a polyol compound,
 - (F) 0-45 wt% of an ethylenically unsaturated monomer,
- and
- (G) 0-10 wt% of a radical photopolymerisation initiator,

wherein the elastomer particles (D) are core-shell particles having an average particle diameter of 10-700 nm and wherein the core is coated with a methyl methacrylate polymer or a methyl methacrylate/glycidyl methacrylate copolymer.

- VI. According to the reasons of the contested decision, claim 1 of the main request was based on eight passages of the description as originally filed defining concentration ranges for compounds (A) to (G), as well as on the passages of the description disclosing the additional restriction concerning the nature of the elastomer particles. This combination of features formed a novel, not originally disclosed constellation of subject-matter. The same in essence held true for claim 1 of each of the first and second auxiliary requests. Thus, the main, first and second auxiliary requests did not comply with the requirements of Article 123(2) EPC.
- VII. With the statement setting out the grounds of appeal of 29 November 2010, the Appellants submitted a main request, as well as five sets of auxiliary requests labelled I to V. The rejoinder of the Respondent was submitted with letter of 15 April 2011. Additional submissions of the Appellants were made with a letter of 3 July 2014.
- VIII. The Board sent a communication on 16 July 2014 in preparation to the oral proceedings in which the Board *inter alia* raised the issue of whether the definition of the core-shell particles provided in claim 1 of the main request and which corresponded to that given in claim 1 as granted found a basis in the application as originally filed.

IX. The Respondent made additional submissions with a letter of 1 August 2014. The Appellants with a letter of 1 August 2014, submitted additional claim requests as their auxiliary requests VI and VII, which were stated to be amended versions of previously filed auxiliary requests II and III. Auxiliary request VI consisted of claims reading as follows:

"1. Photocurable resin composition for photofabrication of three-dimensional objects comprising

an oxetane compound (A), wherein the content of the component (A) in the resin composition is 10-60 wt%, an epoxy compound (B), wherein the content of the component (B) in the resin composition is 20-70 wt%, a photoacid generator (C), wherein the content of the component (C) in the resin composition is 0.2-6 wt%, elastomer particles (D), wherein the content of the component (D) in the resin composition is 1-35 wt%, a polyol compound (E), wherein the content of the component (E) in the resin composition is 0-25 wt%, an ethylenically unsaturated monomer (F), wherein the content of the component (F) in the resin composition is 3-35 wt%, and a radical photopolymerisation initiator (G), wherein the content of the component (G) in the resin composition is 0.1-8 wt%,

wherein the elastomer particles (D) are core-shell particles having an average particle diameter of 10-700 nm and wherein the core is coated with a methyl methacrylate polymer or a methyl methacrylate/glycidyl methacrylate copolymer, and wherein the particles (D) are elastomer particles that have a core of partially crosslinked polybutadiene, polyisoprene, styrene/butadiene copolymer, styrene/isoprene copolymer,

butadiene/(meth)acrylate copolymer, styrene/butadiene block copolymer, or styrene/isoprene block copolymer.

2. Photocurable resin composition according to claim 1, wherein the oxetane compound (A) contains two oxetane rings.

3. Photocurable resin composition according to claim 1, wherein the epoxy compound (B) contains an epoxycyclohexylgroup or glycidylgroup.

4. Photocurable resin composition according to claim 1, wherein the photoacid generator is an aromatic onium salt.

5. Photocurable resin composition according claim 1, wherein polyol (E) contains from 2 to 6 hydroxyl groups.

6. Use of the photocurable resin composition as defined in any one of the preceding claims in the photofabrication of three dimensional objects.

7. A three dimensional object obtainable by photofabrication of the photocurable resin composition as defined in claims 1-5.

8. Use of the three dimensional object as defined in claim 7 for prototypes for mechanical parts."

X. The claims of Auxiliary request VII differed from those of Auxiliary Request VI solely in that the content of the component (A) in the resin composition was 20-60 wt % instead of 10-60 wt%.

XI. In course of the oral proceedings held on 4 September 2014 the Respondent withdrew the objection raised in the rejoinder of 15 April 2011 that the Appeal was not admissible with regard to the Co-Patentees JSR Corporation and Japan Fine Coatings Co., Ltd. Moreover after the Board announced its preliminary opinion concerning the main and first to sixth auxiliary requests, the Appellants withdrew the main request and first to fifth auxiliary requests, the sixth and seventh auxiliary Requests being declared to form the new main and first auxiliary requests.

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

- a) The new main request and auxiliary request (former Auxiliary Requests VI and VII) had been submitted in response to the comments of the Board in the preliminary opinion. The amendments submitted did not extend the framework of discussion as established by the decision under appeal and by the statement setting out the grounds of appeal. Moreover, the Respondent could reasonably be expected to deal with the new requests without unacceptable procedural delay. The new main request and auxiliary request therefore should be admitted into the proceedings.

- b) Amended claim 1 was based on the various passages of the description (page 17, lines 12-15; page 21, lines 16-19; page 24, lines 18-21; page 27, lines 22-25; page 30, lines 31-23; page 35, lines 22-25 and page 37, lines 10-13) defining the preferred amounts of components (A) to (G) expressed in wt% by reference to the total amount of the composition. It was also referred to the general teaching of the invention on page 4, line 13 to

page 5, line 17, as well as to claim 1 of the application as filed. Basis for the definition of the elastomer particles (D) could be found in the application as filed on page 26, lines 12-20. The amended subject-matter did not present the person skilled in the art with new technical information vis-à-vis the application as filed. The requirements of Article 123(2) EPC were therefore fulfilled.

- c) The Respondent's objection that the amendment of the definition of the core-shell additive extended the scope of protection of the patent as granted was not convincing, because claim 1 as granted defined the amounts only in parts by weight, but not in wt% which by definition is of the total composition.

- d) The term "average particle diameter" was generally accepted in the technical field concerned and it was within the abilities of the skilled person to select an appropriate conventional method of particle size measurement. In addition, the Respondent had shown with the submission of 23 September 2008 that it was not difficult to identify and obtain core-shell particles having an average diameter of 100 nm. Hence, the objection of lack of sufficiency of disclosure was in fact a disguised objection of lack of clarity which was governed by Article 84 EPC, but not Article 83 EPC.

XIII. The Respondent's arguments can be summarised as follows:

- a) The set of claims according to the main request and auxiliary request (former Auxiliary Requests VI and VII) were late-filed. The amendment consisting in defining that the wt% referred to the amount in the composition could have been submitted earlier, as the objection which gave rise to said amendment had been already raised with the rejoinder to the statement setting out the grounds of appeal. Therefore, the new sets of claims should not be allowed into the proceedings.
- b) Amended claim 1 was the result of an arbitrary selection of features from various passages of the application as filed, namely the amounts of components (A) to (G) and the use of the specific core-shell particles defined by present component (D). That combination of features, however, was not directly and unambiguously derivable from the application as filed. According to the Case Law of the boards of appeal, the combination of only two specific embodiments disclosed at different places of the description was sufficient to form a novel, not originally disclosed subject-matter (T 12/81). A combination - unsupported in the application as filed - of one item from each of two lists of features meant that although the application could conceptually comprise the claimed subject-matter it did not disclose it in that particular individual form (T 727/00). Moreover, the definition of the core-shell particles could not be based on claim 5 of the application as filed, because the list of materials defining the core in claim 5 as filed was terminated by the conjunction "and", not however by "or" as presently defined. Accordingly, claim 5 as filed defined that the core was made of a combination of all the polymers

listed for the core in claim 5 as filed. Claim 1 of the main request therefore contravened the requirements of Article 123(2) EPC. The same applied for claims 2 to 5, whose features in combination with those of claim 1 had no basis in the application as filed.

- c) Since the term "comprise" imposed an open definition on the composition according to claim 1, the limitation introduced concerning the specific core or shell material resulted in the definition of compositions which could contain more core-shell particles of an average particle diameter of 10-700 nm than was allowed by claim 1 as granted. Therefore, the subject-matter of claim 1 as amended extended beyond the content of the patent as granted.

- d) The invention was insufficiently disclosed because the patent in suit neither defined the meaning of the term "average particle diameter", which could refer to number, length, volume or weight average particle diameter, nor the method to be employed to determine that value, whereby various known methods had been demonstrated to provide significantly different results.

- e) Alternatively, this lack of definition of terms "average particle diameter" and the method to be employed to determine that value would lead to the conclusion that claim 1 lacked clarity.

XIV. 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 (former auxiliary request VI), or alternatively on the basis of the

auxiliary request (former auxiliary request VII), both submitted with letter of 1 August 2014.

XV. The Respondent requested that the appeal be dismissed.

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

Reasons for the Decision

1. The appeal is admissible.

Admissibility of the new main request and auxiliary request (former auxiliary requests VI and VII)

2. The Respondent requested that the sets of claims according to the main request and the auxiliary request not be admitted into the proceedings, because they were late-filed. According to Article 13(1) RPBA, any amendment to a party's case after it has filed its grounds of appeal or reply may be admitted and considered at the Board's discretion. The discretion shall be exercised having regard to the principle of fair proceedings, taking account of the circumstances of the case in view of inter alia the complexity of the new subject-matter submitted, the current state of the proceedings and the need for procedural economy.

3. The claims of the main and auxiliary requests correspond to those of former auxiliary requests II and III, amended by incorporation of (i) the definition of the core of the core-shell particles from claim 5 of said former requests into claim 1 and (ii) defining that the wt% for compounds (A) to (G) relates to the amount of those compounds in the resin composition, in

- accordance with the wording used in the description of the application as filed.
4. Amendment (i) was prompted, according to the submissions of the appellant, by the doubts first expressed by the Board in the communication sent in preparation to the oral proceedings as to whether the definition of the core shell particles provided in former Auxiliary Requests II and III was disclosed in the application as filed. That amendment, which was submitted about two weeks after the Board's communication, is therefore not only in direct response to the Board's observation, but also necessary to meet said Board's objection as shown in point 9 below.
 5. Amendment (ii) which in contrast could have been submitted earlier, does not result in an extension of the framework of debate, as it merely specifies the definition intended for the term "wt%" used in the former claims, in line with the corresponding indication provided in the statement of grounds of appeal (point IV, 1). Moreover, the Respondents in view of the nature of amendment (ii) and the fact that it was submitted one month before the oral proceedings had sufficient opportunity to present comments on it, without causing any delay in the proceedings. Hence, the board has no reason to disregard the present requests in view of amendment (ii).
 6. Hence, the board, in exercise of its discretion under Article 13(1) RPBA, admits the new main request and auxiliary request into the proceedings.

Main Request

Article 123(2) EPC

7. The test to be applied when examining whether any amended claim infringes Article 123(2) EPC is whether the amendment to the claim results in the skilled person being presented with new technical information which he would not derive directly and unambiguously, using common general knowledge, from the application as filed.
8. The subject-matter of claim 1 of the main request differs from that of claim 1 of the application as filed solely with respect to the definition of the amount of the various components (A) to (G) and the nature of the elastomeric particles (D).
9. More specifically, the amount of the various components (A) to (G) in the composition is no longer specified in parts by weight, i.e. not merely in relation to each other but relative to the total weight of the composition in accordance with the various passages of the application as filed relating to those compounds mentioned below.
10. According to page 27, lines 13-15, the content of the component (A) in the resin is preferably 10-80 wt%, and still more preferably 20-60 wt%. According to established jurisprudence (cf. Case Law of the Boards of Appeal of the EPO, 7th Edition, 2013, II.E.1.7.1; in particular T 2/81: point 2 of the headnotes, OJ EPO 1982, 394; and T 925/98 of 13 March 2001: No. 2 of the reasons, not published in OJ EPO), the disclosure of a quantitative range of values (e.g. for concentrations or temperatures) together with an included preferred

narrower range also directly discloses the two possible part-ranges lying within the overall range on either side of the narrower range. Hence a simple combination of the preferred narrower range and one of these part-ranges is also unequivocally derivable and is supported by the disclosure. The claimed range for the content of compound (A) in the resin composition, i.e. 10-60 wt% therefore complies with the requirement of Article 123(2) EPC.

11. Furthermore, the preferred amounts of components (B), (C), (D), (E), (F) and (G) now defined in claim 1 are indicated on page 21, lines 16-19, page 24, lines 20, page 27, line 24, page 30, line 23, page 35, line 24 and page 37, line 12 respectively of the application as filed, to be those now defined in present claim 1.
12. The preferred amounts are disclosed in the indicated passages as being necessary to best achieve photocurability of the resin composition and mechanical strength of the resulting three dimensional object, in line with the goal of the claimed invention defined in particular on page 1, lines 8-12 of the application as filed.
13. In addition, the elastomeric particles have been restricted to those preferred, in accordance with the disclosure of claim 5 and page 26, lines 13-20 of the application as originally filed, namely particles in which a core of partially crosslinked polybutadiene, polyisoprene, styrene/butadiene copolymer, styrene/isoprene copolymer, butadiene/(meth)acrylate copolymer, styrene/butadiene block copolymer, or styrene/isoprene block copolymer is coated with a methyl methacrylate polymer or a methyl methacrylate/glycidyl methacrylate copolymer. In this respect, the skilled reader of the

application as filed would recognize that the term "and" as the end of line 7 of originally filed claim 5 was incorrect because, to comply with this wording, a core-shell additive would have to contain, in combination, seven different types of polymers for the core. Consequently the skilled person would understand that the term "and" should instead read "or", consistently with the passage from page 25, line 27 to page 26, line 20 and confirmed by the examples of the application as filed in which the core-shell particles contain a core made out of a single polymer contained in that list, namely partially cross-linked styrene/butadiene copolymer.

14. Hence, the amendments carried out, i.e. in respect of the amounts of the various compounds as well as the choice of the elastomeric compounds, merely exclude amounts for each of the compound (A) to (H), as well as elastomeric compounds (D), which are disclosed according to the general description in the application as filed to be less preferred, when carrying out the invention defined in claim 1 of the application as filed. Those restrictions therefore do not result in new technical information, i.e. information which was not provided by the application as filed. In other words, it is apparent from the application as filed that within the scope of original claim 1 a more preferred general teaching as now defined by claim 1 of the main request was also contemplated, i.e. was directly and unambiguously disclosed.

15. The Respondent invoked decisions T 12/81 and T 727/00 in support of the argumentation that amended claim 1 which was based on several selections within the teaching of the application as filed did not meet the requirements of Article 123(2) EPC. According to point

13 of the Reasons of decision T 12/81 "If on the other hand two classes of starting substances are required to prepare the end products and examples of individual entities in each class are given in two lists of some length, then a substance resulting from the reaction of a specific pair from the two lists can nevertheless be regarded for patent purposes as a selection and hence as new". The present case however does not relate to the question of whether a specific product obtainable from the reaction of two individual substances, each being disclosed in a list of some length, is disclosed in the application as filed. The present situation relates to the introduction of various limitations resulting in a sub-group of compositions, whereby each of said limitations and their combination, either explicitly or implicitly, is disclosed in the application as filed. Case T 0727/00 concerns as shown in point 1.1.4 of the reasons for the decision a double arbitrary selection within two lists of features. The rationale behind that decision is not applicable to the present case which concerns subject-matter resulting from multiple selections within the general teaching of the original disclosure that are not arbitrary but directed by a clear pointer disclosed in the application as filed. In that respect, the sole criterion used by the opposition division and the Respondent, i.e. the number of amendments held to have been combined to arrive at the amended claimed subject-matter, is not decisive in order to assess whether the claimed subject-matter extends beyond the content of the application as filed. What is required is an analysis of whether the claimed subject-matter is explicitly or implicitly, but directly and unambiguously, disclosed in the application as filed is an assessment of the overall technical circumstances of the individual case under consideration, taking into

- account the nature and extent of the disclosure in the application as filed.
16. Consequently, claim 1 of the main request satisfies the requirement of Article 123(2) EPC.
 17. The Respondents also argued that claims 2 to 5 did not comply with the requirements of Article 123(2) EPC, as their features in combination with those of new claim 1 were not disclosed in the application as filed. The Board notes that the features defined in present claims 2 to 5 correspond to those defined in original claims 2 to 4 and 6, respectively, all those claims being dependent on claim 1 as filed. Accordingly, and in the absence of any indication to the contrary, the more preferred teaching emerging from the description of the application as filed applies not only to claim 1 as filed, but also to its dependent claims. Therefore, the features of present claims 2 to 5 when read in combination with claim 1 as amended do not constitute added matter. The same holds true for additional claims 6 to 8, the features of which are defined in original claims 7 to 9.
 18. The Board is therefore satisfied that the claims of the present main request meet the requirements of Article 123(2) EPC.

Article 123(3) EPC

19. The Respondent argued that new claim 1 would not be allowable having regard to the requirements of Article 123(3) EPC, because the limitation to specific core or shell material would allow the composition of present claim 1 in view of its open definition "comprising" to contain more core-shell particles than

allowed by claim 1 as granted. That objection which was first raised at the oral proceedings before the Board, could have been raised against the former Main and Auxiliary Requests I to III and V submitted with the statement setting out the grounds of appeal, which requests also contained a restriction of the definition of the core-shell particles in combination with an open definition of the composition. This objection is therefore late filed and the question arises whether it should be allowed into the proceedings. First of all, the Respondent failed to provide any example of an embodiment of the present claims which would not fall within the ambit of the claims as granted. Secondly, the minimum amount now defined in claim 1 for component (A), namely 10 wt% based on the total composition, imposes in view of the other minima for compounds (B), (C) and (E) to (G), in total 23.3 wt%, a maximum amount of any core-shell particles having an average diameter of 10 to 700 nm, i.e. those defined by feature (D) and any additional core-shell particles of a different chemical nature, but having the same average particle diameter, of 66.7 wt%. This shows that the maximum ratio of core-shell particles having an average diameter of 10 to 700 nm to each of the other constituents of the resin composition allowed by present claim 1 is within the limits defined by the claims as granted. Hence the belated argument raised at the oral proceedings that the amended definition of the core-shell particles resulted in an extension of the scope of protection is *prima facie* irrelevant and not allowed into the proceedings by the Board, in exercise of its discretion under Article 13(1) RPBA.

20. Taken into consideration that no other objections under Article 123(3) EPC request were raised against claim 1 of the new main request, the Board is satisfied the

claims as amended are in keeping with the requirements of that article.

Sufficiency of disclosure

21. It is established jurisprudence of the Boards of Appeal that the requirements of sufficiency of disclosure are only met if the invention, i.e. as defined by the terms of the claim(s), can be performed by a person skilled in the art throughout the whole area claimed without undue burden, using common general knowledge and having regard to further information given in the patent in suit.

22. In the absence of any definition in the patent in suit of the exact meaning of "average particle diameter" or of the specific method to be used for determining that parameter, the "average particle diameter" defining compound (D) in present claim 1 must be interpreted as encompassing any definition of that parameter and any method for its measurement which can be said to be standard in the art concerned. It was not disputed that core-shell polymers having the constituents defined in present claim 1 and an "average particle diameter" whether number, length, volume or weight average particle diameter in the range of 10 to 700 nm, as determined by a conventional method in the art, would also be available to the skilled person wishing to perform the invention as defined by the terms of claim 1. It was not disputed either that compounds (A), (B), (C), (E), (F) and (G) defined in present claim 1 would also be available to the skilled person, so that compositions comprising compounds (A) to (G) could be prepared by the skilled person. The objection that the invention was not sufficiently disclosed to be carried out by the skilled person is merely based on the

argument that neither the term "average particle diameter", nor the method to be employed to determine that property were defined, it being further argued that various known methods existed for the determination of particle size which provided significantly different results. The Respondent's objection thus boils down to the objection that the boundaries of the claims are not clearly defined, which however is a matter of Article 84 EPC, not sufficiency of disclosure.

23. Thus, noting that claim 1 does not contain any limiting features with respect to specific curing properties of the resin composition or with respect to specific properties of the obtained three dimensional object such as those properties recited in paragraph [0010] and [0011] of the patent in suit, the Board in the absence of further arguments in support of lack of sufficiency concludes that the invention as defined by the terms of the claims of the main request is sufficiently disclosed to be carried out by the skilled person.

Remittal

24. The following questions have been referred to the Enlarged Board of Appeal by Board 3.2.08 in decision T 0373/12:

"1. Is the term "amendments" as used in decision G 9/91 of the Enlarged Board of Appeal (see point 3.2.1) to be understood as encompassing a literal insertion of (a) elements of dependent claims as granted and/or (b) complete dependent claims as granted into an independent claim, so that opposition divisions and boards of appeal are

required by Article 101(3) EPC always to examine the clarity of independent claims thus amended during the proceedings?

2. If the Enlarged Board of Appeal answers Question 1 in the affirmative, is then an examination of the clarity of the independent claim in such cases limited to the inserted features or may it extend to features already contained in the unamended independent claim?
 3. If the Enlarged Board answers Question 1 in the negative, is then an examination of the clarity of independent claims thus amended always excluded?
 4. If the Enlarged Board comes to the conclusion that an examination of the clarity of independent claims thus amended is neither always required nor always excluded, what then are the conditions to be applied in deciding whether an examination of clarity comes into question in a given case?"
25. This referral is pending under Nr. G 3/14. In view of the clarity objection raised against the definition of the elastomeric particles in present claim 1, the outcome of the present case might depend on the answer provided by the Enlarged Board of Appeal in case G 3/14. Considering that additional grounds of opposition were raised, namely lack of novelty and lack of inventive step, the Board considers it appropriate to exercise its power conferred on it by Article 111(1) EPC to remit the case to the Opposition Division for further prosecution, in particular for assessment of novelty and inventive step, as well as clarity if necessary and depending on the conclusion arrived at by the Enlarged Board of Appeal in case G 3/14.

26. As already indicated in paragraph 24 above the feature "average particle diameter" of present claim 1 must be interpreted broadly as including any definition of that parameter and method for its measurement which can be said to be standard in the art concerned. The absence of any additional information concerning the meaning of "average particle diameter" or of any specific method to be used for determining that parameter may result in a larger number of elastomeric particles meeting the requirements of "average particle diameter" of 10 to 700 nm, than would be the case where a specific definition or measurement method were given. This will have to be taken into consideration, should the "average particle diameter" be held to distinguish the claimed subject-matter from the prior art and/or considered essential for solving a technical effect vis-à-vis the closest prior art.

Order

For these reasons it is decided that:

1. The decision under appeal is set aside.
2. The case is remitted to the first instance for further prosecution.

The Registrar:

The Chairman:



B. ter Heijden

M. C. Gordon

Decision electronically authenticated