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**Datasheet for the decision
of 20 March 2014**

Case Number: T 1931/11 - 3.3.09

Application Number: 03292798.0

Publication Number: 1424378

IPC: C09J163/10, C08F290/06

Language of the proceedings: EN

Title of invention:
Curable adhesive compositions containing reactive
multi-functional acrylate

Patent Proprietor:
Illinois Tool Works

Opponent:
fischerwerke GmbH & Co. KG

Headword:

Relevant legal provisions:
EPC R. 80
RPBA Art. 13

Keyword:
Amendment occasioned by ground for opposition - (no)
Late-filed requests - inadmissible

Decisions cited:
T 0127/85

Catchword:



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Case Number: T 1931/11 - 3.3.09

**D E C I S I O N
of Technical Board of Appeal 3.3.09
of 20 March 2014**

Appellant:
(Patent Proprietor)

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Respondent:
(Opponent)

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Decision under appeal:

**Decision of the Opposition Division of the
European Patent Office posted on 6 June 2011
revoking European patent No. 1424378 pursuant to
Article 101(3) (b) EPC.**

Composition of the Board:

Chairman: W. Sieber
Members: N. Perakis
R. Menapace

Summary of Facts and Submissions

I. Mention of the grant of European patent No. 1 424 378 in the name of Illinois Tool Works Inc. was published on 5 March 2008 (Bulletin 2008/10). The patent was granted with seven claims. Claim 1 read as follows:

"1. A curable adhesive composition for anchoring materials in or to concrete or masonry comprising:

- a. a polymerizable vinyl ester compound;
- b. an ethylenically unsaturated monomer reactive with said polymerizable vinyl ester,
- c. from 5 wt% to 10 wt% of reactive multifunctional acrylate;
- d. curing agent; and
- e. activator."

II. A notice of opposition was filed by fischerwerke GmbH & Co KG on the grounds that the claimed subject-matter was neither novel nor inventive (Article 100(a) EPC), that it extended beyond the content of the application as filed (Article 100(c) EPC) and that the European patent did not disclose the invention in a manner sufficiently clear and complete for it to be carried out by a person skilled in the art (Article 100(b) EPC).

III. By decision announced orally on 19 January 2011 and issued in writing on 6 June 2011, the opposition division revoked the patent. According to the opposition division:

- the main request submitted during the oral proceedings did not fulfil the requirements of Articles 123(2) and 84 EPC;

- auxiliary requests 1-3 also filed during those oral proceedings did not fulfil the requirements of Rule 80 EPC since further additional dependent claims 7 to 10 had been incorporated, which did not remove a ground for opposition (see appealed decision, paragraph 3.1).

IV. On 12 August 2011 the patent proprietor (in the following the appellant) filed an appeal against the decision of the opposition division and paid the appeal fee on the same day. The statement setting out the grounds of appeal was filed on 11 October 2011, including a main request and auxiliary requests 1 to 7.

Independent claim 1 and dependent claims 2, 3 and 6 to 9 of the main request read as follows:

"1. A curable adhesive composition for anchoring materials in or to concrete or masonry comprising:

- a. a polymerizable vinyl ester compound;
- b. an ethylenically unsaturated monomer reactive with said polymerizable vinyl ester,
- c. from 5 wt% to 10 wt% of reactive multifunctional acrylate;
- d. curing agent; and
- e. activator,

wherein said ethylenically unsaturated monomer reactive with said polymerizable vinyl ester comprises one or more of the following: an aliphatic vinyl compound, vinyl toluene, or a diene compound;

and

wherein said reactive multifunctional acrylate comprises a major proportion that is at least tri-functional."

"2. The curable adhesive composition of claim 1 wherein said aliphatic vinyl compound is chosen from one or more of: propene and butene chloride."

"3. The curable adhesive composition of claim 1 or 2 wherein said diene compound is chosen from one or more of: butadiene, isoprene, chloroprene, and pentadiene."

"6. The adhesive composition according to one or more of the preceding claims, wherein the composition comprises from 5 pbwa to 30 pbwa of reactive multifunctional acrylate."

"7. The adhesive composition according to claim 6, wherein the composition comprises from 10 to 25 pbwa of reactive multifunctional acrylate."

"8. The adhesive composition according to one or more of claims 1 to 3 and 5 to 7, wherein the reactive multifunctional acrylate comprises trimethylol propane triacrylate."

"9. The adhesive composition according to claim 8, wherein the reactive multifunctional acrylate is trimethylol propane triacrylate."

The appellant requested that the decision under appeal be set aside and that the patent be maintained on the basis of the main request, or alternatively on the basis of one of auxiliary requests 1 to 7. Additionally, it requested that the case be remitted to the first instance for further prosecution as the objections raised in opposition under Articles 83, 54 and 56 EPC had not been dealt with by the first instance, and that the appeal fee be reimbursed.

V. By letter dated 13 February 2012 the opponent (in the following the respondent) filed observations on the appeal. In particular, in points 5 and 6 (see below), it raised an objection under Rule 80 EPC concerning some additional dependent claims:

Point 5

"It is not conceivable on this side how claims 2 ... and 3 ... of the main request; and claims 2 ... and 3 of Auxiliary request 1 ...; and ... claims 2 and 3 of Auxiliary Request 2 ..., respectively, are justifiable under Rule 80. They do not contribute any patentability to the independent claims";

Point 6

"The appeal does not contest the rejection of the claims based on Rule 80 at the opposition stage. Instead, claims are filed which ... again do not comply with Rule 80 ... The public nor the opponent nor the Board of Appeal can be expected to tolerate any delays in the present proceedings and subsequent insecurities on the subject-matter of any possible claims and their unforeseeable scope of protection caused by inappropriate procedural actions and requests, and there was more than one opportunity to take care of Rule 80, Article 123(2) EPC and clarity issues during the proceedings so far."

VI. By letter of 19 February 2014 the appellant withdrew the request for remittal to the first instance and submitted further arguments concerning the requests on file. Regarding the objection previously raised under Rule 80 EPC it simply stated that the requests on file were admissible under Rule 80 EPC.

VII. Oral proceedings were held before the board on 20 March 2014.

During these oral proceedings the appellant submitted new requests, a main request and auxiliary requests 1-7, which were to replace the previous requests only if admitted into the proceedings. These new requests did not contain the dependent claims objected to. However, the board did not admit them into the proceedings.

Furthermore, the appellant withdrew its request for reimbursement of the appeal fee.

VIII. The relevant arguments put forward by the appellant in its written submissions and at the oral proceedings may be summarised as follows:

The requests filed with the grounds of appeal overcame the objection under Article 123(2) EPC which had led to the rejection of the main request by the opposition division.

The new requests, conditionally filed during the oral proceedings before the board, should be admitted into the proceedings. They were a *bona fida* attempt to overcome the objection under Rule 80 EPC and had been filed at an early stage of the oral proceedings. Furthermore, the amendments were straightforward, did not introduce any complexity and did not go against the requirement of procedural economy.

IX. The relevant arguments put forward by the respondent in its written submissions and at the oral proceedings may be summarised as follows:

The requests filed with the grounds of appeal infringed the requirements of Rule 80 EPC. The addition of dependent claims was not occasioned by any ground for opposition.

The new requests, conditionally filed during the oral proceedings before the board, should not be admitted into the proceedings because they had been filed very late. The objection under Rule 80 had already been raised before the opposition division and was now reiterated by the respondent in its observations on the appeal.

- X. The appellant requested that the decision under appeal be set aside and that the patent be maintained on the basis of the main request or one of auxiliary requests 1-7, all filed with the grounds of appeal dated 11 October 2011.

- XI. The respondent requested that the appeal be dismissed.

Reasons for the Decision

- 1. The appeal is admissible.

- 2. The main request
 - 2.1 Compared to the granted set of claims, the main request comprises **additional dependent claims** 2, 3, 6 to 9 (see point IV above), which correspond to specific embodiments of some of the features of independent claim 1.

Specifically:

claim 2 requires that the aliphatic vinyl compound (one possibility for component b of claim 1) is selected from one or more of propene chloride and butene chloride;

claim 3 requires that the diene compound (another possibility for compound b of claim 1) is chosen from one or more of: butadiene, isoprene, chloroprene, and pentadiene;

claims 6 and 7 concern the content of the reactive multifunctional acrylate of claim 1 in the composition, which is from 5 pbwa to 30 pbwa and from 10 pbwa to 25 pbwa, respectively;

claim 8 further requires that the reactive multifunctional acrylate of claim 1 should comprise trimethylol propane triacrylate; and

claim 9 requires that the reactive multifunctional acrylate of claim 1 should be trimethylol propane triacrylate.

- 2.2 Regarding these additional dependent claims, reference is made to Rule 80 EPC which stipulates that the description, **claims** and drawings may be amended, provided that the amendments are occasioned by a ground for opposition under Article 100.

However, amending the granted set of claims by inserting new dependent claims does not help to overcome the lack of patentability objection (in this particular case lack of inventive step) of independent

claim 1. According to common sense, the assessment of the patentability of an independent claim, in this particular case of independent claim 1, is based on its subject-matter irrespective of the patentability of the specific embodiments of dependent claims. Consequently, the additional dependent claims could not overcome the lack of patentability of independent claim 1.

Furthermore, the patent proprietor has not provided any explanation during the written appeal proceedings or at the oral proceedings before the board regarding this matter. It is noted that the issue of Rule 80 EPC was raised during the proceedings before the opposition division and was the reason for rejecting the then pending auxiliary requests (see point III above).

Thus the insertion into the granted set of claims of the above identified additional dependent claims has not been occasioned by a ground for opposition; it is merely an unacceptable later improvement of the patent (e.g. T 127/85, OJ 1989, 271).

Since new dependent claims 2, 3, 6 to 9 infringe the requirements of Rule 80 EPC, the main request is not patentable.

3. Auxiliary requests 1-7

None of the auxiliary requests complies with Rule 80 EPC because each of them comprises dependent claims which were not present in the granted set of claims, namely:

- auxiliary request 1: claims 2, 3 and 5-8;
- auxiliary request 2: claims 2-4, 6 and 7;
- auxiliary request 3: claims 4-7;

- auxiliary request 4: claims 3-6;
- auxiliary request 5: claims 2, 4 and 5;
- auxiliary request 6: claims 3-6; and
- auxiliary request 7: claims 2, 4 and 5.

Consequently none of the auxiliary requests is patentable.

4. As regards the appellant's further main and auxiliary requests submitted conditionally during the oral proceedings to replace the requests on file, the board exercised its discretion under Article 13(1) RPBA not to admit these new requests into the proceedings for the following reasons:

- The appellant reacted to the objection under Rule 80 for the first time during the oral proceedings before the board;
- The same objection had already been raised by the opposition division and was the reason for rejecting the then auxiliary requests (see point III above);
- The appellant in its reply to the respondent's comments (letter dated 19 February 2014; point VI above) did not provide any explanations as to why it considered that the requirements of Rule 80 EPC were satisfied.

To summarise, during the whole written proceedings before the board the appellant has neither shown any willingness to overcome the deficiency under Rule 80 EPC which had already been an issue in the appealed decision and was criticised by the respondent during the written proceedings, nor provided any

argument why it considered that the objection was not justified. Under these circumstances the admission of the appellant's new (and conditional) requests at this late stage of the proceedings was considered inappropriate in view of the criteria set out in Article 13(1) RPBA.

This finding is not altered by the fact that the decision under appeal erroneously referred to Rule 80 EPC with regard to the then pending auxiliary request 1. As correctly pointed out by the appellant, that auxiliary request 1 did actually not contain dependent claims not complying with Rule 80 EPC. For the purpose of deciding on the admissibility of the new requests filed during the oral proceedings it was sufficient that the opposition division's reference to Rule 80 EPC was correct as to the then pending auxiliary requests 2 and 3.

Order

For these reasons it is decided that:

The appeal is dismissed.

The Registrar:

The Chairman:



M. Cañueto Carbajo

W. Sieber

Decision electronically authenticated