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**Datasheet for the decision
of 14 October 2013**

Case Number: T 2532/11 - 3.3.05

Application Number: 03808928.0

Publication Number: 1554221

IPC: C01B33/148, C09C1/30,
C04B20/10, C04B41/50

Language of the proceedings: EN

Title of invention:
AQUEOUS SILICA DISPERSION

Patent Proprietor:
Akzo Nobel N.V.
Eka Chemicals AB

Opponent:
W.R. Grace & Co.-Conn.

Headword:
SILICA DISPERSION / AKZO NOBEL

Relevant legal provisions:
EPC Art. 21(1), 108 sentence 3
EPC R. 99(2), 101(1)
RPBA Art. 12(2) (a)

Keyword:
Admissibility of appeal - appeal sufficiently substantiated
(no)

Decisions cited:

G 0009/91, G 0010/91, G 0001/99, T 0220/83, T 0213/85,
T 0105/87, T 0145/88, T 0169/89, T 0729/90, T 0563/91,
T 0574/91, T 0045/92, T 0162/97, T 0717/01, T 0934/02,
T 0240/04, T 0570/07, T 1581/08

Catchword:



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Case Number: T 2532/11 - 3.3.05

D E C I S I O N
of Technical Board of Appeal 3.3.05
of 14 October 2013

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Decision under appeal: **Decision of the Opposition Division of the
European Patent Office posted on 19 October 2011
revoking European patent No. 1554221 pursuant to
Article 101(3)(b) EPC.**

Composition of the Board:

Chairman: G. Rath
Members: J.-M. Schwaller
C. Vallet

Summary of Facts and Submissions

- I. The appeal lies from the decision of the opposition division dated 19 October 2011 by which the European patent No. 1 554 221 was revoked.
- II. The opposition division ruled that
- claim 1 of the main request lacked novelty over D1d, which described a stable dispersion of colloidal silica;
 - auxiliary request 1 was late filed and thus was not admitted into the proceedings;
 - auxiliary request 2 did not comply with the requirements of Rule 80 EPC, because the introduction of the feature "*wherein the colloidal silica particles are present in an aqueous sol*" did not further limit the scope of claim 1;
 - the subject-matter of claims 1 and 8 of the auxiliary request 3 was not new over D4;
 - auxiliary request 4 did not comply with the requirements of Rule 80 EPC because the deletion of claim 6 as granted was not occasioned by any ground for opposition.
- III. In the notice of appeal filed on 12 December 2011, the patent proprietors (hereinafter "the appellants") requested that the decision be set aside and that the patent be maintained as granted.
- IV. With the statement setting out the grounds of appeal dated 27 February 2012, the appellants filed six new

sets of claims as main and auxiliary requests 1 to 5 and requested the maintenance of the patent in amended form on the basis of one of these requests. They also filed a further example supposed to illustrate the improved properties of the dispersion when used as a coating.

V. The appellants essentially argued as follows:

(1) The new main and first auxiliary requests were meant to create a distance between the claimed subject-matter and the prior art. They were thus in accordance with the requirements of Rule 80 EPC.

(2) The subject-matter claimed was novel over D1d through the limitation of the size of the colloidal silica particles to a range of from 5 to 40 nm. D1d disclosed the use of fine silicic acid powder mainly composed of SiO₂ and typically consisting of aggregates of particles of several 100 µm. Such aggregates could not be stably colloidally dispersed. D1d was furthermore silent on stable colloidal dispersions and their use for coating applications.

(3) Novelty over D2 was established because this document related to a silica-organic complex composition for the surface treatment of metals, without however requiring that aqueous silanised colloidal silica particles were provided before their admixing with an organic binder. There was thus no evidence that silanised colloidal silica dispersions were obtained, in particular none with a silane to silica weight ratio of 0.1 to 0.5.

(4) D3 did not disclose mixing silica with an organic binder in an aqueous medium. Furthermore, the silane to

silica weight ratio was outside the range claimed and the large-scaled particles obtained in D3 could not exist in a colloiddally dispersed stable state.

(5) D4 did not disclose a stable dispersion nor did the composition show a continuous phase. D4 was also silent on the combination of the weight ratio of silane to silica from 0.1 to 0.5 and on colloidal particle size having an average diameter from 5 to 40 nm.

(6) The appellants further explained why the claimed subject-matter was novel over documents D5 to D9 and inventive over documents D1 to D9. These issues however were not considered in the decision under appeal.

VI. With a letter dated 31 August 2012, the respondent requested that the newly filed requests not be admitted into the proceedings and that the admissibility of the appeal be put into question.

It essentially argued as follows:

(1) None of the new sets of claims presented on appeal corresponded to any of the claims pursued in the first instance proceedings so that the case was entirely new. This was against the principles laid down by the case law of the Enlarged Board of Appeal in particular in G 1/99 which stated that the appeal procedure was a judicial review of the decision taken by the first instance and did not have the purpose of allowing a party to set up a completely new case before the board.

(2) The main, first and second auxiliary requests were late filed; therefore they did not meet the requirements of Article 12(4) RPBA and should be rejected as inadmissible. Specifically, these requests

contained a feature limiting the average particle diameter to the most preferred range of from 5 to 40 nm, which apparently aimed at overcoming a lack of novelty over D1. An attempt to introduce, at a late stage of the first instance proceedings, this type of feature (in terms of the broader range of 3 to 50 nm) had been rightfully rejected by the opposition division. The requests containing this feature were even more likely to be rejected at the appeal stage.

(3) The respondent further argued that the new sets of claims did not meet the requirements of Article 123(2) EPC. In the main request, the features combination "*average particle diameter ranging from 5 to 40 nm*" and "*the weight ratio of silane to silica [is] from 0.1 to 0.5*", itself combined with the features added in the course of the opposition proceedings led to a claimed embodiment that was not directly and unambiguously disclosed in the application as filed. In a similar situation, decision T 1511/07 found that this type of combination represented added-matter.

(4) In the first auxiliary request, added-matter was seen in the introduction of the disclaimer "*the organic binder is not a synthetic latex based on emulsions of silicone resins and/or polymers*", which amounted to a selection in two lists of classes of materials, which was contrary to the jurisprudence established in particular in decisions G 0002/10 and T 1068/07. The same remark applied to the second and fifth auxiliary requests which contained the same disclaimer.

(5) In the third auxiliary request, the disclaimer "*the coating applications exclude coatings of woven textiles*" was not in accordance with the description on page 7, lines 16 to 25, and thus also not in accordance

with decision G 0002/10. The same applies to the fourth auxiliary request.

(6) The respondent further discussed the clarity of the disclaimers under Article 84 EPC. It also developed a substantial argumentation denying novelty and inventive step of the sets of claims, in particular over the content of documents D1, D2 and D4.

- VII. With the summons to oral proceedings, the board expressed its preliminary opinion that the appeal as well as the new requests dated 27 February 2012 appeared to be inadmissible.
- VIII. With letter dated 7 June 2013, the appellants contested the board's preliminary opinion, stating in particular that the appeal was based on the implicit acceptance of the first instance decision and that the claims were designed to overcome the objections in the decision. Concerning the case law that the board quoted in its communication, it argued that it concerned cases which were materially different from the one at issue. As to the question whether the new requests could have been filed earlier, it argued that it "was surprised by several turns of events and this caused him to to conduct the case as he did".
- IX. With letter dated 13 September 2013, the respondent reiterated its position that neither the appeal nor the newly filed requests met the admissibility requirements.
- X. During the oral proceedings of 14 October 2013, the admissibility issues were discussed.

XI. After closing of the debate, the chairman established the requests of the parties as follows:

- The appellants requested that the decision under appeal be set aside, that the appeal be held admissible and that the patent be maintained on the basis of one of the sets of claims filed with the grounds of appeal.

- The respondent requested that the appeal be rejected as inadmissible and alternatively, that the sets of claims filed with the grounds of appeal as a main request and auxiliary requests 1 to 5 be rejected as inadmissible.

Reasons for the Decision

ADMISSIBILITY OF THE APPEAL

1. Formal requirements

The appeal complies with the time limits for filing the notice of appeal and the statement of grounds of appeal. The appeal fee was paid in due time.

2. The statement of grounds of appeal

2.1 The legal framework

2.1.1 For an appeal to be admissible, it has to comply with the requirements of Article 108, Rule 99(2) and Rule 101(1) EPC.

Article 108, third sentence, EPC, requires that:
"Within four months of notification of the decision, a

statement setting out the grounds of appeal shall be filed in accordance with the Implementing Regulations."

Rule 99(2) EPC provides that *"In the statement of grounds of appeal the appellants shall indicate the reasons for setting aside the decision impugned, or the extent to which it is to be amended and the facts and evidence on which the appeal is based"*.

Rule 101(1) EPC provides that *"If the appeal does not comply with Articles 106 to 108, Rule 97 or Rule 99, paragraph 1(b) or (c) or paragraph 2, the Board of Appeal shall reject it as inadmissible"*.

2.1.2 As to the content of the statement of grounds, Article 12(2) RPBA requires that: *"The statement of grounds of appeal and the reply shall contain a party's complete case. They shall set out clearly and concisely the reasons why it is requested that the decision under appeal be reversed, amended or upheld and should specify expressly all the facts, arguments and evidence relied on."*

2.2 The case law

2.2.1 The case law of the Boards of Appeal has consistently considered it to be incumbent on an appellant, in order to meet the admissibility requirements, to explain in detail why it considers the decision under appeal to be wrong, be it entirely or in part, thus imposing a direct and clear link between the contested decision and the grounds for appeal.

2.2.2 In decisions G 0009/91 and G 0010/91, point 18 of the reasons, the Enlarged Board of Appeal held that *"The purpose of the appeal procedure is mainly to give the*

losing party the possibility of challenging the decision of the Opposition Division on its merits".

In the French version: "*... de contester le bien-fondé de la décision*".

In the German version: "*... die Entscheidung sachlich anzufechten.*"

The same wording was used in decisions G 0004/93 (point 5 of the reasons) and G 0001/99 (point 6.1 of the reasons).

It is thus clear that the appeal proceedings **aim at contesting a decision.**

2.2.3 In decision G 0001/99 (point 6.1 of the reasons), the Enlarged Board of Appeal further pointed out that: "*Indeed, issues outside the subject-matter of the decision under appeal are not part of the appeal.*" and that "*... within the limits of what in the subject-matter of the decision under appeal adversely affects it, it is **the appellant who in the notice of appeal determines the extent to which amendment or cancellation of the decision under appeal is requested.***" (emphasis added by the board).

2.2.4 It follows from this that the appeal proceedings are confined to the subject-matter of the first instance proceedings and therefore that the statement of grounds of appeal should at least discuss this subject-matter. The need for the above-mentioned link (see point 2.2.1) is thus not only confirmed but also clarified in terms of its closeness.

2.2.5 The case law further defines the content of the statement of grounds of appeal in such a way that it must specify the legal or factual reasons why the impugned decision should be set aside. The arguments must be clearly and concisely presented to enable the board (and the other party) to understand immediately why the decision is alleged to be incorrect, and on which facts the appellant bases its arguments, without first having to make investigations on their own (see in particular the decisions T 0220/83 (OJ EPO 1986, 249), T 0213/85 (OJ EPO 1987, 482), T 0145/88 (OJ EPO 1991, 251), T 0169/89 and T 1581/08).

2.2.6 Moreover, it is also established case law that grounds sufficient for the admissibility of an appeal must be analysed in detail vis-à-vis the main reasons given for the contested decision (see T 0213/85, OJ EPO 1987, 482; T 0169/89; T 0045/92 and T 0570/07).

2.3 The present case in view of the cited case law

2.3.1 In the present case, the appellants submitted on 27 December 2011 a document entitled "Statement of Grounds of Appeal".

It can however be clearly seen that these submissions do not contain any reference to the impugned decision, let alone any explanation as to why this decision should be wrong and thus be set aside.

2.3.2 The board understands from the content of said statement that the appellants do not contest the finding of the opposition division as to:

- the lack of novelty of the main request over D1d;

- the lack of novelty of the third auxiliary request over D4;
- the lack of compliance with Rule 80 EPC of the second and fourth auxiliary requests;
- the reasons for the late-filing of the first auxiliary request.

2.3.3 Thus, none of the main grounds for revocation of the patent presented in the impugned decision was addressed in the statement of grounds of appeal.

Therefore, by applying the above cited case law, it should be concluded that the appeal has to be rejected as inadmissible for lack of compliance with the above-mentioned provisions of the EPC.

2.4 Newly filed requests

2.4.1 The question arises whether newly filed requests can be seen as implicit grounds of appeal, or in other words, whether there is a link between the decision and the grounds.

2.4.2 A statement of grounds of appeal supported by amended claims may define, at least implicitly, the extent to which the appellant wishes the decision under appeal to be set aside.

The issue however is whether the grounds are understandable and sufficiently linked to the contested decision in order to form an admissible appeal.

2.4.3 The board is aware of a substantial body of case law where the sufficiency of the grounds was examined for the question of admissibility in relation to the filing of new claims. There are several decisions in which a

relatively lenient position was adopted towards the appellants, in the sense that the appeals were deemed to be admissible if the competent board was able to **infer** from the particulars of the case the presumed intentions of the appellant and the probable reasons underlying its actions, see in particular decisions T 0162/97, point 1.1.2 of the reasons, (not published in OJ); T 0574/91, point 1.2 of the reasons; T 0729/90, point 1.2 of the reasons; T 0563/91, point 1.2 of the reasons.

In an even broader interpretation, it was held that an appeal was sufficiently substantiated and that the requirements of Article 108, third sentence EPC were satisfied, even though the board did not state any specific reasons why the contested decision was wrong. The reasoning was that

- there was a change in the subject of the proceedings due to the filing of new claims together with the statement of grounds; and that
- the statement of grounds set out in detail why the raised grounds for opposition did not prejudice the maintenance of the patent as amended on the basis of these new claims (cf. in particular T 0717/01, point 2 of the reasons; T 0934/02, point 2 of the reasons, referring to J xx/87, OJ EPO 1988, 323, point 1.4 and T 0105/87).

2.4.4 In the board's view, it is certainly arguable that appeals should be decided primarily on their substance, and that parties should be given the possibility to argue their case without overly strict formal requirements. However, procedural principles have to be considered.

2.5 The principle of free disposition

2.5.1 Even assuming that laborious sequences of exercises would tell the reader what the appellant's case against the decision might be, such conjecture is exactly what the statement of appeal is designed to prevent: the purpose of the statement of grounds, together with the notice of appeal is to define the scope of the appeal. This definition lies within the discretion of the appellants as a part of the principle of free disposition.

2.5.2 Without prejudice to provisions of Article 114 EPC, which are of limited application in opposition proceedings, the board of appeal has the duty to assess whether the appeal is well-founded within the frame of the case as presented by the appellants but it cannot guess what the arguments are, let alone, provide arguments in lieu of the appellants.

2.6 The power of the board of appeal

2.6.1 Conversely, the principle of free disposition does not extend to such a point that it should allow the appellants to build a new case, disconnected from the case as it stood during the first instance proceedings, so as to render the decision under appeal purposeless. **The EPC's provisions do not give the appellants the power to set aside the decision under appeal of its own volition,** which would obviously be the case if it had the opportunity to modify its requests beyond the subject-matter of the first instance proceedings. In other words, the power conferred by Article 21(1) EPC to the boards of appeal to review decisions shall not be transferred to the appellants. In the same way, decision T 0240/04 (point 16.3 of the reasons) already

stated as regards new claims not sufficiently connected to the subject-matter of the one previously filed: "*In einer solchen Situation den neuen Antrag zuzulassen würde einem Patentinhaber praktisch die Möglichkeit geben, nach Belieben eine Zurückverweisung an die Erstinstanz zu erzwingen. Dies würde den Einsprechenden benachteiligen und wäre auch nicht verfahrensökonomisch.*"

Although the present issue relates to the admissibility of the appeal and not to the admissibility of new requests, the obligation to contest the decision of the first instance remains. Whether the appeal is only supported by new sets of claims or the decision under review has not been contested in the appeal proceedings, the end effect is the same: the board and the respondent in the first place are facing a new case which leads to the issue of remittal, in order to ensure a double degree of jurisdiction.

- 2.6.2 In regard of all these considerations above, the present board is of the opinion that a **direct link** must be maintained between the decision under appeal and the statement of grounds of appeal.

The appellant cannot escape its obligation to explain why it does not agree with the decision, be it only in part. The appellant is not correct in its view, because the very nature of appeal proceedings is and remains the **contestation** of a decision.

This does not mean that the appellant shall be denied the right to file amended claims, but it must provide arguments in order to explain what is/are the issue(s) in the decision it considers to be erroneous and provide arguments and evidence to support its view. The

amendments made to the claims in order to remove the grounds of the decision under appeal constitute **an implicit acceptance** of the decision and therefore cannot be regarded as grounds for appeal in the sense of Article 108, second sentence EPC.

2.7 The requests of the present case

2.7.1 In the present case, as the appellant confirmed in its latest submissions, the reasons for filing a modified main request and five auxiliary requests were based on the assumption that the decision of the opposition division was right in its findings that the opposed patent as granted and as modified in the course of first instance proceedings was not novel over D1 and D4, or as regards auxiliary requests 1, 2 and 4, that these requests were not formally admissible.

The aim of the present appeal is thus to gain an opportunity to get the patent maintained in amended form through new claims making the revoked patent compliant with the reasons given by the opposition division, or through the introduction of new features thus forming different embodiments of the alleged invention which were never discussed before regarding their compliance with the requirements of the EPC.

2.7.2 Accordingly, even when considering the issue of admissibility in the light of the less strict case law, the board considers that the statement of grounds of appeal in the present case does not comply with the above mentioned legal provisions of the EPC.

2.7.3 Consequently, the appeal must be rejected as inadmissible.

Order

For these reasons it is decided that:

The appeal is rejected as inadmissible.

The Registrar:

The Chairman:



C. Vodz

G. Rath

Decision electronically authenticated