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**Datasheet for the decision
of 5 May 2015**

Case Number: T 1265/12 - 3.3.03

Application Number: 03736789.3

Publication Number: 1517959

IPC: C08L67/06, C08F8/14, B05D3/02,
C08J5/08, C08J5/04, C08L67/00,
D04H1/64

Language of the proceedings: EN

Title of invention:
POLYESTER-TYPE FORMALDEHYDE FREE INSULATION BINDER

Patent Proprietor:
Georgia-Pacific Chemicals LLC

Opponents:
SAINT-GOBAIN ISOVER
ROCKWOOL INTERNATIONAL A/S

Headword:

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

Keyword:

Amendments -
allowable (main request and auxiliary requests 1, 2, 6: no)
Late-filed auxiliary requests -
admitted (auxiliary requests 21, 22: no)

Decisions cited:

T 0482/07, T 0296/96

Catchword:



**Beschwerdekammern
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Case Number: T 1265/12 - 3.3.03

**D E C I S I O N
of Technical Board of Appeal 3.3.03
of 5 May 2015**

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Decision under appeal: **Interlocutory decision of the Opposition
Division of the European Patent Office posted on
2 April 2012 concerning maintenance of the
European Patent No. 1517959 in amended form.**

Composition of the Board:

Chairman B. ter Laan
Members: O. Dury
 R. Cramer

Summary of Facts and Submissions

- I. The appeals of the patent proprietor and of opponent 2 lie against the decision of the opposition division posted on 2 April 2012 maintaining European patent No. 1 517 959 (application No. 03 736 789.3, based on international application WO 03/106561, filed as PCT/US2003/017279) in amended form according to the seventh auxiliary request filed on 23 December 2011.
- II. The application as filed contained 16 claims, of which the claims relevant for the present decision read as follows:
- "1. An aqueous binder composition for making glass fiber products comprising an aqueous mixture of a substantially infinitely water-dilutable or dispersible adduct of a monomeric polycarboxylic acid component and a monomeric polyol component."
- "5. The aqueous binder composition of claim 1 wherein the monomeric polycarboxylic acid component has a molecular weight less than 500 and has a plurality of carboxylic acid moieties."
- "7. The aqueous binder composition of claim 5 wherein the monomeric polyol component has a molecular weight less than 500 and has a plurality of hydroxyl groups."
8. The aqueous binder composition of claim 6 wherein the monomeric polyol component is selected from the group consisting of ... diethanolamine,"
- (The long list of chemical compounds indicated in claim 8 as originally filed is, apart from the presence

of diethanolamine, not relevant for the present decision)

"9. The aqueous binder composition of claim 8 wherein the monomeric polycarboxylic acid component and the monomeric polyol component have average functionalities of at least 2.5."

Claims 2-4, 6 and 10 were the only other claims directed to an aqueous binder composition and depended on claim 1.

A passage of paragraph [31] of the application as filed, which is relevant for the present decision, further read as follows:

"[31] In the broad practice of the present invention, the average functionality of either of the monomeric polycarboxylic acid component or the monomeric polyol component is at least 2.2, preferably at least 2.5, more preferably at least 3.0 and most preferably at least 3.5. It is particularly preferred to have the average functionality of each of the monomeric polycarboxylic acid component and the monomeric polyol component at least 2.2, preferably both at least 2.5 and most preferably both each 3.0. It is particularly contemplated that both components may have an average functionality of at least 3.0 and possibly at least 3.5."

III. The granted patent was based on 13 claims, of which the claims relevant for the present decision read as follows (in claim 1, additions compared to claim 1 as filed are indicated in **bold**, deletions in ~~strikethrough~~):

"1. An aqueous binder composition for making glass fiber products comprising ~~an aqueous mixture of~~ a substantially infinitely water-dilutable or dispersible thermosetting adduct of a monomeric polycarboxylic acid component **having a molecular weight of less than 750** and a monomeric polyol component **having a molecular weight of less than 750, or a substantially infinitely water-dilutable or dispersible ammonium salt of said thermosetting adduct, wherein at least one of the monomeric polycarboxylic acid component and the monomeric polyol component has an average functionality of at least 2.2 and wherein said adduct has residual carboxylic groups and an acid number of 100 or above.**"

"12. The aqueous binder composition of claim 2, wherein the monomeric polycarboxylic acid component has an average functionality of at least 3.0".

"13. The aqueous binder composition of claim 12, wherein the monomeric polyol component has an average functionality of at least 3.0."

- IV. Two notices of opposition against the patent were filed in which it was requested that the patent be revoked on the grounds of Art. 100 (a) EPC (both novelty and inventive step) and Art. 100 (c) EPC.

- V. The contested decision was based on a main request (maintenance of the patent as granted) and twelve auxiliary requests filed on 23 December 2011. According to that decision, the main request did not satisfy the requirements of Art. 123(2) EPC, auxiliary requests 1 and 2 were anticipated by both D1 (US 5 393 849) and D4 (EP-A-1 170 265) and auxiliary requests 3 and 4 did not satisfy the requirements of Rule 80 EPC. Auxiliary

requests 3 to 6 were further held to contravene the requirements of Art. 123(2) EPC. However, the seventh auxiliary request was considered to satisfy the requirements of the EPC.

The relevant claims of said auxiliary request 7 read as follows (in claim 1, additions compared to claim 1 as filed are indicated in **bold**, deletions in ~~strikethrough~~):

"1. An aqueous binder composition for making glass fiber products comprising ~~an aqueous mixture of~~ a substantially infinitely water-dilutable or dispersible thermosetting adduct of a monomeric polycarboxylic acid component **having a molecular weight of less than 750** and a monomeric polyol component **having a molecular weight of less than 750, wherein said adduct has residual carboxylic groups and an acid number of 100 or above, and wherein the monomeric polycarboxylic acid component has an average functionality of at least 3.0.**"

"11. The aqueous binder composition of claim 1, wherein the monomeric polyol component has an average functionality of at least 3.0."

VI. On 30 May 2012, opponent 2 lodged an appeal against the above decision. The prescribed fee was paid on the same day. In the statement of grounds of appeal filed on 1 August 2012, the opponent requested that the decision of the opposition division be set aside and that the patent be revoked. The following documents were also cited:

D8: Compendium of Chemical Terminology, Gold Book, Version 2.3, 2011-10-11, page 37 of 1622

D9: Definition of "Addukt" provided by Wikipedia,
retrieved on 19.01.12

By letter of 22 November 2012 opponent 2 submitted
additional arguments.

VII. On 7 June 2012, the patent proprietor lodged an appeal
against the above decision. The prescribed fee was paid
on the same day. In the statement of grounds of appeal
filed on 13 August 2012, the proprietor requested that
the decision of the opposition division be set aside
and that the patent be maintained in amended form
according to the main request or any of auxiliary
requests 1 to 20 filed therewith.

The relevant claims of the main request read as follows
(in claims 1 and 2, additions compared to claim 1 as
filed are indicated in **bold**, deletions in
~~strikethrough~~):

"1. An aqueous binder composition for making glass
fiber products comprising ~~an aqueous mixture~~ of a
substantially infinitely water-dilutable or dispersible
thermosetting adduct of a monomeric polycarboxylic acid
component **having a molecular weight of less than 750**
and a monomeric polyol component **having a molecular
weight of less than 750, wherein at least one of the
monomeric polycarboxylic acid component and the
monomeric polyol component has an average functionality
of at least 2.2 and wherein said adduct has residual
carboxylic groups and an acid number of 150 or above.**"

"2. An aqueous binder composition for making glass
fiber products comprising ~~an aqueous mixture~~ of a
substantially infinitely water-dilutable or dispersible
thermosetting adduct of a monomeric polycarboxylic acid

component **having a molecular weight of less than 750** and a monomeric polyol component **having a molecular weight of less than 750, wherein said adduct has residual carboxylic groups and an acid number of 100 or above, and wherein the monomeric polycarboxylic acid component has an average functionality of at least 2.5."**

"3. The aqueous binder composition of claim 1 or 2 wherein the monomeric polycarboxylic acid component has a molecular weight less than 500 and has a plurality of carboxylic acid moieties."

"6. The aqueous binder composition of claim 1 or 2 wherein the monomeric polyol component is selected from the group consisting of ..., diethanolamine,"

"13. The aqueous binder composition of claim 3, wherein the monomeric polycarboxylic acid component has an average functionality of at least 3.0."

"14. The aqueous binder composition of claim 13, wherein the monomeric polyol component has an average functionality of at least 3.0."

The subject-matter of claims 2, 3, 13 and 14 of auxiliary request 1 and of claims 1, 2, 12 and 13 of auxiliary request 2 was identical to that of claims 2, 3, 13 and 14 of the main request.

Claims 1, 2 and 12 of auxiliary request 6 were identical to claims 1, 2 and 11 of the seventh auxiliary request allowed by the opposition division. However, auxiliary request 6 comprised an additional claim 3, the wording of which corresponded to that of claim 6 as originally filed.

Each of auxiliary requests 1 to 20 contained a dependent claim directed to an aqueous binder composition comprising a monomeric polyol component defined according to claim 6 of the main request i.e. including diethanolamine.

Together with its rejoinder to the appeal of opponent 2, dated 2 May 2013, the patent proprietor submitted a corrected main request and first to twentieth auxiliary requests in replacement of the requests pending until then. Each of those requests corresponded to the main request and auxiliary requests 1 to 20, respectively, filed with the patent proprietor's statement of grounds of appeal in which in the dependent claims diethanolamine was deleted from the list of compounds defining the monomeric polyol component according to claim 6 of the main request.

VIII. In a first communication dated 24 June 2013 the Board set out its preliminary view of the case. Among other things the question of the admissibility of each of the patent proprietor's requests pursuant to Art. 12(2)(4) RPBA was raised. It was further questioned whether the deletion of diethanolamine from some dependent claims constituted an amendment that satisfied the requirement of Rule 80 EPC. Also, it was indicated that the support in the application as filed for the subject-matter now being claimed had not been indicated and that it was *inter alia* unclear to the Board where support could be found for specific claims of each of the pending requests. The patent proprietor was, thus, invited to identify, for each claim of the pending requests, all the passages relied upon as forming a basis in the application as originally filed

- for the amendments made, in particular for each combination of features being claimed.
- IX. By letter of 26 August 2013 the patent proprietor provided arguments in reply to the first communication of the Board.
- X. By letter of 6 October 2014 the parties were summoned to oral proceedings to be held on 5 May 2015.
- XI. In a second communication dated 5 March 2015 the Board set out its preliminary view of the case. The issues of the admissibility of each of the pending requests and the issue of Rule 80 EPC were again identified. Also, issues pursuant to Art. 123(2) EPC were indicated in respect of specific claims of all pending requests.
- XII. By letter dated 2 April 2015 the proprietor indicated that, should the Board find that the removal of diethanolamine from some dependent claims was not occasioned by a ground of opposition and therefore the requests containing this amendment were not admissible, then the Board should consider all those requests as if that amendment had not been made. For the sake of procedural efficiency, the patent proprietor however refrained from filing such requests anew.
- XIII. Opponent 1 indicated by letter of 17 March 2015 that they would participate at the oral proceedings and filed further arguments with letter of 26 March 2015.
- XIV. At the beginning of the oral proceedings held on 5 May 2015 in the presence of all parties, the proprietor withdrew the main request and the 20 auxiliary requests filed with letter of 2 May 2013 and requested that the patent be maintained in amended form

according to the main request or any of auxiliary requests 1 to 20, all as filed with the statement of grounds of appeal.

During the oral proceedings, following the announcement of the Board's conclusions regarding the main request and auxiliary requests 1 and 2 filed with the statement of grounds of appeal, the patent proprietor withdrew the auxiliary requests 3, 4, 5 and 7 to 20 then pending and filed new auxiliary requests 21 and 22. The patent proprietor further requested that the remaining requests be treated in the order: auxiliary request 21, then 6 and finally 22.

Auxiliary request 21 (11 claims) contained a single independent claim directed to an aqueous binder composition (claim 1, with only claims 2-7 depending thereon), the wording of which was identical to that of claim 1 of the main request. The wording of claims 2-7 was based on original claims 5-10.

Claim 1 of auxiliary request 22 (10 claims) read as follows (additions compared to claim 1 as filed are indicated in **bold**, deletions in ~~strikethrough~~):

"1. An aqueous binder composition for making glass fiber products comprising ~~an aqueous mixture of~~ a substantially infinitely water-dilutable or dispersible thermosetting adduct of a monomeric polycarboxylic acid component **having a molecular weight of less than 750** and a monomeric polyol component **having a molecular weight of less than 750, wherein said adduct has residual carboxylic groups and an acid number of 100 or above, and wherein both the monomeric polycarboxylic acid component and the monomeric polyol component have an average functionality of at least 3.0."**

Claims 2-6, dependent on claim 1, were the only other claims of auxiliary request 22 directed to an aqueous binder composition and were based on original claims 5-8 and 10 of the application as filed.

- XV. The patent proprietor's arguments relevant for the present decision may be summarised as follows:

Main request

- a) The operative main request, which was submitted anew at the beginning of the oral proceedings in order to take into account the Board's second preliminary opinion, only differed from the main request previously pending in that a dependent claim had been slightly amended, thereby returning to the main request filed together with the patent proprietor's statement of grounds of appeal. Such an amendment did not modify the main issues in dispute between the parties, in particular in respect of the independent claims.

- b) The patent proprietor had provided *bona fide* replies in respect of the issues identified in the Board's communications. Besides, considering that the Board's communications were merely provisional opinions, they were not binding. It was further not clear whether the issues identified therein amounted to objections at all. Therefore, it had been indicated in the patent proprietor's submission dated 2 April 2015 that, should the Board not deviate from its preliminary opinion regarding Rule 80 EPC, then the operative requests would be those filed with the statement of grounds of appeal. Under those circumstances, the

submission of conditional requests was appropriate and did not amount to an abuse of the procedure.

- c) Considering that the present main request only differed from the main request filed with letter of 2 May 2013 in the subject-matter of a dependent claim, the assessment of the prior art would be the same, independently of the set of requests considered. In addition, all the features of the main request were already in the granted claims and in the requests submitted in the first instance. In particular, independent claims 1 and 2 of the main request focused on two specific combinations of the acid number of the adduct and/or the functionality of the polycarboxylic acid and the polyol components, which issue had been at stake during the whole of the proceedings, in particular in respect of novelty over D1 and D4.
- d) For those reasons, the main request should be allowed to the proceedings.
- e) Regarding Art. 123(2) EPC, claim 1 was based on the combination of claim 1 with passages of paragraphs [16], [28], [30], [31] and [39] of the application as filed. In that respect, it was derivable from the application as filed that all the terms "adduct", "polyester", "polyester binder", "polyester binder resin" were equivalent. Considering that the term "adduct" in the patent in suit was not used in accordance with its literal meaning according to either D8 or D9, those documents were not relevant. Therefore, the acid number indicated in paragraph [39] of the application as filed in respect of "polyester" was to be understood as applicable to the "adduct"

according to claims 1 and 2. It was further clear from the patent specification, in particular the examples, that the acid number was used to measure the reaction progress i.e. it referred to the reaction mixture comprising the partial reaction product and unreacted monomers. Since all the features now present in the claims were indicated as preferred embodiments in the application as filed, their combination would have been contemplated by the skilled person.

The same passages of the application as filed also provided a basis for the combination of features defined in claims 2, 13 and 14.

For those reasons, the requirements of Art. 123(2) EPC were satisfied.

Auxiliary requests 1 and 2

- f) The same arguments as for the main request were valid in respect of auxiliary requests 1 and 2.

- g) Auxiliary requests 1-2 were part of a set of 20 auxiliary requests consisting of two similar groups of 10 requests each, which only differed in the wording of one feature, necessary in order to address the issue of Art. 123(2) EPC raised by the opponents in respect of the meaning of the terms "adduct" and "polyester resin". Depending on the Board's conclusion on that point, only one set of requests would effectively need to be discussed. Therefore, there were not as many auxiliary requests to be dealt with as it might seem.

- h) Auxiliary requests 1-2 as well as the other auxiliary requests were characterised by various combinations of ranges of the acid number of the adduct and/or the functionality of the polycarboxylic acid and the polyol components defined in claims 1 and 2 of the main request, which issue had been at stake during the whole of the proceedings. Therefore, the auxiliary requests were neither diverging, nor too numerous, nor too complicated.
- i) For those reasons, auxiliary requests 1-2 should be allowed to the proceedings.

Auxiliary request 21

- j) Auxiliary request 21 corresponded to the main request but claims 2, 13 and 14 were deleted in order to take into account the Board's conclusion in respect of Art. 123(2) EPC on the main request. Considering that the opposition division had decided positively on Art. 123(2) EPC, the patent proprietor was surprised about the outcome of the proceedings and had made use of the first opportunity to react. During the oral proceedings the patent proprietor admitted that the situation as indicated in the Board's communications may not have been properly assessed.
- k) It should be taken into account that auxiliary request 21 was filed after withdrawal of many pending requests, which was done to streamline the proceedings.

Auxiliary request 6

- l) Apart from the additional dependent claim 3 which had been erroneously deleted during the oral proceedings before the first instance, auxiliary request 6 was identical to auxiliary request 7 allowed by the opposition division.

- m) Auxiliary request 6 had been initially filed together with the statement of grounds of appeal and should be admitted to the proceedings for the same reasons as the main request.

- n) Regarding Art. 123(2) EPC, the subject-matter now being defined was based on the combination of a preferred embodiment for the polycarboxylic acid functionality with the broadest range for the acid number initially disclosed. The skilled person would have envisaged such a combination, which was also supported by examples 6 and 7. During the oral proceedings before the Board the patent proprietor acknowledged that all examples of the application as filed were performed using polycarboxylic acid and polyol components both having a functionality higher than 3.0.

Auxiliary request 22

- o) Auxiliary request 22 was filed, as was auxiliary request 21, in order to deal with the Art. 123(2) EPC objection raised by the Board. Support for the amendment could be found in paragraph [31] in combination with the same passages of the application as filed as cited for the main request. The subject-matter now being claimed was narrower than both that of the granted

claims and that allowed by the first instance. It further represented a genuine attempt to focus on the core of the invention. The reason for the Art. 123(2) EPC objection raised by the Board only became apparent during the oral proceedings so that the patent proprietor had not had the opportunity to react any earlier.

XVI. The opponents' arguments relevant for the present decision may be summarised as follows:

Main request

- a) The main request initially filed with the patent proprietor's statement of grounds of appeal had been effectively replaced by the main request filed with letter of 2 May 2013. The operative main request had therefore to be seen as having been withdrawn and as being newly filed during the oral proceedings before the Board, which was very late. The opponents and the Board were effectively confronted twice with a new case.
- b) The operative main request was neither based on granted claims nor on subject-matter already discussed in the first instance proceedings. In fact, the patent proprietor attempted to present a new case on appeal, which was not allowable.
- c) The operative main request was submitted in order to address a Rule 80 EPC issue, which had already been identified in both communications of the Board. The patent proprietor had had many opportunities to file such a request earlier, which he had chosen not to do, thereby leaving the Board and the opponents in doubt as to what would

be discussed during the oral proceedings. That was not a proper conduct, in particular in view of the high number of auxiliary requests being submitted. It was the patent proprietor's duty to submit its full case as soon as possible.

- d) It was derivable from both communications of the Board that the subject-matter of the operative main request was not allowable e.g. pursuant to Art. 123(2) EPC. In that respect, the patent proprietor had failed to indicate in writing where the support in the application as filed was to be found for the specific combination of features defined in the operative claims, again leaving the Board and the opponents to guess where a basis could be found.
- e) The main request was part of a set of a very high number of requests, which were not all convergent. The Board and the opponents were here, too, left to guess what in fact constituted the invention, which was not not allowable, in particular taking into account the unclarity which claims would actually be pursued during oral proceedings: those filed with the statement of grounds of appeal or those filed with letter of 2 May 2013.
- f) For those reasons, the main request should not be admitted to the proceedings.
- g) Regarding Art. 123(2) EPC, the patent proprietor's argumentation in respect of claim 1 relied on the combination of original claim 1 with five different passages from the description. According to EPO case law, it was not allowable to use the description as a reservoir and arbitrarily combine

features originally disclosed independently. Besides, the feature "said adduct has ... an acid number of ..." was not disclosed as such in the application as filed. Paragraph [31] of the application as filed defined acid numbers for the polyester resin, not the adduct. In that respect, the application as filed used both terms "adduct" and "polyester resin" separately and there was no clear indication that both terms represented the same thing. According to D8 and D9, a polyester was not an adduct. Also, since auxiliary requests 1 to 10 were drafted using the term "adduct" and auxiliary requests 11 to 20 using the term "polyester resin", also for the patent proprietor those terms appeared to have different meanings.

The same was valid for the dependent claims. For each of claims 2, 13 and 14 further selections within the ambit of the original application were required. Paragraph [31] in particular disclosed that it was preferred that both the polycarboxylic acid and the polyol components exhibit a high functionality, which was not reflected in claims 1 and 2.

Therefore, the requirements of Art. 123(2) EPC were not satisfied.

Auxiliary requests 1 and 2

- h) The same arguments were valid as for the main request.
- i) Auxiliary requests 1-2 were part of a set of 20 auxiliary requests, which were filed on the day of the oral proceedings in replacement of a previous

set of 20 other auxiliary requests. In that respect, the patent proprietor did not follow a single line of argumentation, with many non-converging requests, which left the opponents in doubt as to what exactly the proprietor saw as the invention. None of the auxiliary requests was in fact identical to any of the requests submitted before the first instance. In particular, many requests were directed to different new combinations of specific ranges of various features. The opponents were confronted with a very large amount of requests and left to guess what the argumentation of the patent proprietor might be during the oral proceedings.

- j) For those reasons, auxiliary requests 1-2 should not be allowed to the proceedings.

Auxiliary request 21

- k) Auxiliary request 21 was filed very late. It could and in fact should have been filed much earlier in the proceedings, in particular at the latest after receipt of any of both communications of the Board in which the relevant issues pursuant to Art. 123(2) EPC had been clearly indicated. It was the patent proprietor's duty to address those issues as soon as possible, which had not been done. Therefore, auxiliary request 21 should not be admitted to the proceedings.

Auxiliary request 6

- l) Auxiliary request 6 was not identical to any request submitted during the first instance and should, thus, not be admitted to the proceedings

because of its late filing. Auxiliary request 6 in particular contained a claim 3 that had been deleted on purpose in auxiliary request 7 allowed by the opposition division.

- m) The same objections as for the main request applied to auxiliary request 6, in particular because the value of the polycarboxylic acid functionality was arbitrarily selected within all the possibilities disclosed in paragraph [31] of the application as filed. There was no support in the application as filed for the specific combination of features now being claimed.

Auxiliary request 22

- n) Auxiliary request 22 should not be admitted to the proceedings for the same reasons as auxiliary request 21. The reasons supporting the Art. 123(2) EPC objection had been known for a long time and the patent proprietor should not be given the opportunity to wait until the very last moment to react and unduly delay the proceedings. Also, it should be considered that many other auxiliary requests had already been filed.

XVII. The appellant/patent proprietor requested that the decision under appeal be set aside and that the patent be maintained in amended form according to the main request or any of auxiliary requests 1, 2 or 6, filed with the statement of grounds of appeal, or auxiliary requests 21 or 22 filed during the oral proceedings.

The appellant/opponent 2 requested that the decision under appeal be set aside and that the European patent be revoked.

The respondent/opponent 1 requested that the appeal by the patent proprietor be dismissed.

XVIII. The Board announced its decision at the end of the oral proceedings.

Reasons for the Decision

1. The appeals are admissible.

Main request and auxiliary requests 1-2

2. Admissibility

2.1 Although each of the main request and auxiliary requests 1-2 had been initially filed with the patent proprietor's statement of grounds of appeal, they had been replaced by the main request and auxiliary requests 1-2 filed with letter of 2 May 2013. The operative main request and auxiliary requests 1-2 are therefore to be considered as being all filed after oral proceedings had been arranged and after the communication of the Board setting out its preliminary view of the case had been received, so that their admissibility has to be assessed pursuant to Art. 13(1) and 13(3) RPBA. In that respect, Art. 13(1) RPBA specifies a non-exhaustive list of factors that may be considered by the Board in exercising its discretion for admitting requests filed after the statement of grounds of appeal or reply to the opponent's statement of grounds of appeal.

2.2 The operative main and auxiliary requests 1-2 only differ from the main and auxiliary requests 1-2 filed with letter of 2 May 2013 in the reinsertion of the compound "diethanolamine" from a list of alternatives indicated in a dependent claim, thereby returning to the main and auxiliary requests 1-2 filed with the patent proprietor's statement of grounds of appeal.

However, dependent claims can normally not serve to restrict the scope of the independent claims they refer to. In the present case, the dependent claims as amended in the requests filed with letter of 2 May 2013 do not restrict or change the scope of the independent claims since they are formulated as preferred embodiments of the independent claims. In particular, the amendments made in the dependent claims can not serve to define or restrict the subject-matter falling under the independent claims, contrary to the patent proprietor's view. Therefore, the amendment of the dependent claims does not affect the patentability issues of the independent claims to be discussed during the proceedings.

2.3 In the present case, the patent proprietor, in its submission of 2 April 2015, indicated clearly the intention to possibly go back to the initial requests, should the Board not deviate from its preliminary opinion regarding the non-conformity with Rule 80 EPC. In that respect, although the patent proprietor could and should have inferred from the reasoning indicated in both communications of the Board that the requests would be held unallowable, there is no evidence of a deliberate abuse of procedure.

2.4 Although the main request and the auxiliary requests are directed to subject-matter that was not discussed

in the first instance proceedings, the subject-matter now being claimed deals with aqueous binder compositions defined in a similar manner as in the granted claims and are in particular characterised by various combinations of specific ranges of three parameters already present in the granted claims, namely the acid number of the adduct and the functionality of the polycarboxylic acid and of the polyol components. As the patent proprietor has filed an appeal, it is justified that he tries to improve his case, in particular by filing requests amended in response to the decision of the first instance together with the statement of grounds of appeal, in accordance with the stipulations of Art. 12(2)RPBA.

2.5 The amendment consisting of the reinsertion of "diethanolamine" was not such that it raised an issue which the Board or the opponents could not reasonably be expected to deal with without adjournment of the oral proceedings. Therefore, there is no reason not to admit the main request or auxiliary requests 1-2 pursuant to Art. 13(3) RPBA.

2.6 For those reasons, the Board, exercising its discretionary power, decided to admit each of the main and auxiliary requests 1-2 to the proceedings (Art. 13(1) RPBA).

3. Main request

3.1 Art. 123(2) EPC

3.1.1 Claim 2 corresponds to claim 1 as originally filed with the following amendments:

- (a) deletion of "an aqueous mixture" before "a substantially infinitely...";
- (b) addition of "thermosetting" before "adduct";
- (c) addition of a minimum molecular weight of 750 for the polycarboxylic acid component;
- (d) addition of a minimum molecular weight of 750 for the polyol component;
- (e) addition of "wherein said adduct has residual carboxylic groups and an acid number of 100 or above";
- (f) addition of "wherein the monomeric polycarboxylic acid component has an average functionality of at least 2.5".

3.1.2 Amendment (a) was not objected to by the opponents and can be considered to be implicitly disclosed because claim 1 is directed to "an aqueous binder".

Support in the application as filed for each of amendments (b), (c) and (d) may be found as follows:

- (b) line 7 of paragraph [0016];
- (c) paragraph [0028], the value of 750 defining the broadest range in the sense of the application as filed;
- (d) paragraph [0030], the value of 750 defining the broadest range in the sense of the application as filed;

Regarding amendment (e), paragraph [39] read in combination with paragraph [36] of the application as filed discloses that the polyester resin binder of the invention is prepared by reacting the monomeric polycarboxylic acid and monomeric polyol components in order to form a water soluble i.e. substantially infinitely water dilutable or dispersible resin (see in particular the first sentence of both paragraphs). It is further indicated in paragraph [39] that the reaction is in particular conducted such that there are residual carboxylic groups in the polyester resin and that preferably the reaction is allowed to proceed such that the acid number of the polyester resin does not fall below about 100, preferably 150, most preferably 200. Therefore, paragraph [39] of the application as filed provides, as an alternative within various other embodiments, a support for a polyester resin prepared from a polycarboxylic acid and a polyol components and having an acid number of 150 or above.

During the proceedings, the question arose whether said passage of the application as filed, which discloses acid numbers of the "polyester resin" provided a basis for an "adduct", according to the wording of the operative claims, having an acid number of 100 or above.

In that respect, in paragraph [23] of the application as filed it is indicated that "the term acid number is a measure of the free carboxylic acid content of a polyester resin binder". It is further derivable from e.g. paragraphs [24] and [27] of the application as filed that the expression "substantially infinitely water dilutable or dispersible adduct of a monomeric polycarboxylic acid component ... and a monomeric

polyol component" are used to designate the reaction mixture of said components (optionally together with monocarboxylic acids and/or monoalcohol as indicated in paragraphs [34]-[35]). Said reaction mixture is also referred to in other passages of the application as filed as "polyester binder resin", "polyester binder", "polyester resin binder" and/or "polyester resin composition". That reading of the terms "adduct" and "acid number" is further confirmed by the examples of the application as filed.

The definitions of "adduct" given in D8 and D9, which were relied upon by the opponents, are not compatible with the reaction product of a monomeric polycarboxylic acid component and a monomeric polyol component specified in the operative claims. Therefore, there is no reason to give the term "adduct" a different meaning than that given in the patent specification, which is equivalent to the term polyester resin.

Under these circumstances, the use of the term "adduct" in the feature "said adduct has ... an acid number of 100 or above" of claims 1-2 is directly and unambiguously derivable from paragraph [39] of the application as filed and does not lead to an infringement of Art. 123(2) EPC.

Regarding amendment (f), various ranges for the functionality of either or both of the monomeric polycarboxylic acid and the monomeric polyol components are disclosed in paragraph [31] of the application as filed (see above, section II), including the value of 2.5 specified in claim 2. However, the feature of a functionality of at least 2.5 for the polycarboxylic acid component only, without any limitation to the functionality of the polyol component, is not

specifically disclosed and can only be arrived at by considering that only the functionality of the polycarboxylic acid component is limiting (not only the polyol component, nor the combination of both components) and choosing among the various possible ranges a functionality of at least 2.5.

- 3.1.3 It is concluded from the above analysis that the subject-matter of claim 2 can at most be arrived at by combining various passages of the application as filed.

According to the EPO case law, for assessing if the requirements of Art. 123(2) EPC are met in the case of multiple amendments being made, it has to be determined whether such a combination of features emerges from the application as filed (T 482/07 section 3.4.2 of the reasons) or whether the skilled person would seriously contemplate combining the different features (T 296/96). In that respect, the description is not to be seen as a reservoir from which features pertaining to separate embodiments can be freely and randomly combined in order to create a certain embodiment.

In the present case, there is no pointer in the application as filed to the specific combination of features according to claim 1, in particular to the combination of paragraphs [16], [28], [30], [31] and [39] of the description, more particularly to the specific combinations of features (e) and (f) indicated above. In that respect, there is no hint that the functionality of the polycarboxylic acid component alone might have had any particular relevance, in particular not for the adducts defined with the remaining features of claim 2 and being defined in above amendments (b) and (e). In particular, the examples cannot serve as support for the subject-matter

at that level of generality since they were all carried out using specific polycarboxylic acid and polyol components, each of them having a functionality of at least 3 (i.e. according to one of the preferred embodiments disclosed in paragraph [31] of the application as filed) and all leading to adducts having acid numbers higher than 300 (preferred embodiment disclosed in paragraph [39], page 11, line 2 of the application as filed). The teaching of paragraph [31] of the application as filed, of the examples and of e.g. dependent claim 9 further appears to suggest that the combination of both the polycarboxylic acid and the polyol components having a high functionality was preferred, which is not reflected in claim 2.

Not only is there no pointer in the application as filed to the combination of features now being specified in claim 2, but the patent proprietor has also not shown why the skilled person would have seriously contemplated combining the different features. In that respect, although some features of amendments (a) to (f) may correspond to preferred features, such is not the case for amendment (b) and no justification was provided why the skilled person would have been motivated to concentrate on those specific features while not considering other preferred features such as e.g. the molecular weight of the monomeric components or their respective amounts or the use of a resin in the form of a salt (original claims 4-10).

Under these circumstances, the amendments of claim 2 are not directly and unambiguously derivable from the application as filed.

3.1.4 Claim 13, which is dependent on claim 3, further characterises the adduct by imposing that the

functionality of only the polycarboxylic acid should be at least 3.0 and that the molecular weight of the polycarboxylic acid component should be of less than 500.

Although the application as filed may provide a basis for those amendments (paragraph [31]; preferred embodiment according to original paragraph [28] and/or original claim 5), the subject-matter so being defined can, similarly to claim 2, at most be arrived at after performing a series of combinations within the ambit of the application as filed. It was not shown that there was any pointer to said combination nor that the skilled person would have had good reason to concentrate on said specific combination of features.

The same is also valid in respect of claim 14, dependent on claim 13. In that respect, also the examples are not considered to provide a support for the amendment made at that level of generality.

Therefore, the amendments of claims 13 and 14 are not directly and unambiguously derivable from the application as filed.

4. Auxiliary requests 1-2

Claims 2, 13 and 14 of auxiliary request 1 and claims 1, 12 and 13 of auxiliary request 2 are identical to claims 2, 13 and 14, respectively, of the main request. Therefore, those claims suffer from the same deficiencies as the corresponding claims of the main request.

5. For those reasons, the main request and auxiliary requests 1-2 do not fulfil the requirements of Art. 123(2) EPC and are not allowable.

Auxiliary request 21

6. Admissibility

Considering that auxiliary request 21 was filed during the oral proceedings before the Board, its admissibility has to be assessed.

- 6.1 According to the patent proprietor, auxiliary request 21 was filed in reaction to the Board's conclusion on Art. 123(2) EPC.

However, said objection had already been raised twice in the communications issued by the Board by stating that it appeared questionable where a support in the application as filed could be found for the subject-matter corresponding to that of claims 2, 13 and 14 of the present main request (first communication: section 6.2; second communication: section 7.1.2). The reasons underlying the issue were also clearly indicated as being related to the question if the specific combination of features being claimed was directly and unambiguously disclosed in the application as filed (first communication: section 6.1; second communication: section 7.1.1). The other objection of the opponents related to the meaning of the term "adduct" was also addressed and the possible acceptance of the patent proprietor's line of argumentation was indicated (second communication: section 7.1.3). Therefore, the patent proprietor had been given at least three possibilities to react to said objection and to submit a - possibly allowable - set of claims,

namely after each communication and after having received the summons to the oral proceedings. In that respect, taking into account that it is unusual for a Board to issue a communication under Art. 17 RPBA prior to a communication under Art. 15(1) RPBA, the patent proprietor should have been aware that the issues indicated in the first communication were highly relevant for the proceedings. Instead of making use of those opportunities, the patent proprietor has deliberately decided to wait until the very last moment - namely after hearing the Board's conclusion on Art. 123(2) EPC in respect of the main and auxiliary requests 1-2 - before submitting an auxiliary request that attempted to address the concerns of the Board. In these circumstances, admitting auxiliary request 21 at such a late stage would run counter to procedural economy and would not be fair to the other parties.

The voluntary withdrawal by the patent proprietor of a number of pending auxiliary requests can not be considered as a factor influencing the decision on the admissibility of auxiliary request 21. It is the duty of the patent proprietor to present its complete case as soon as possible.

- 6.2 Therefore, auxiliary request 21 was not admitted to the proceedings (Art. 13(1) RPBA).

Auxiliary request 6

7. Admissibility

Similar to the main request, auxiliary request 6 was initially filed together with the patent proprietor's statement of grounds of appeal and submitted anew at the beginning of the oral proceedings before the Board.

Apart from its claim 3, dependent on claim 1, which had been deleted during the oral proceedings before the first instance, auxiliary request 6 corresponds to auxiliary request 7 allowed by the opposition division.

For the same reasons as for the main request, the Board decided to admit auxiliary request 6 to the proceedings (Art. 13(1) RPBA).

8. Art. 123(2) EPC

Claim 1 of auxiliary request 6 differs from claim 2 of the main request in that the functionality of the polycarboxylic acid component was modified to "at least 3.0" instead of "at least 2.5".

Support for said value of "at least 3.0" is provided in paragraph [31] of the application as filed and in the same manner as for the value of "at least 2.5" (see above section II). Therefore, the same conclusion as for claim 2 of the main request equally applies to claim 1.

The same is also valid in respect of claim 12, which corresponds to claim 14, depending on claim 2, of the main request.

For those reasons, auxiliary request 6 does not satisfy the requirements of Art. 123(2) EPC and is not allowable.

Auxiliary request 22

9. Admissibility

Like auxiliary request 21, auxiliary request 22 was filed during the oral proceedings before the Board and, according to the patent proprietor, in reaction to the Board's conclusion on Art. 123(2) EPC on the main request.

However, for the same reasons as for auxiliary request 21, admitting auxiliary request 22 to the proceedings would have run against the principle of procedural economy and fair treatment of all parties, especially in the present circumstances of the case where the patent proprietor waited until the very last moment to react to reasoned objections raised by the Board well in advance of the oral proceedings.

For that reason, auxiliary request 22 was not admitted to the proceedings (Art. 13(1) RPBA).

10. Since none of the patent proprietor's main and auxiliary requests 1, 2 and 6 is allowable and neither of auxiliary requests 21-22 is admissible, the patent in suit has to be revoked.

Order

For these reasons it is decided that:

1. The decision under appeal is set aside.
2. The patent is revoked.

The Registrar:

On behalf of the Chairman
(according to Art. 8(3) RPBA):



B. ter Heijden

O. Dury

Decision electronically authenticated