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**Datasheet for the decision
of 26 November 2015**

Case Number: T 1763/12 - 3.3.07

Application Number: 06776521.4

Publication Number: 1909742

IPC: A61K6/027, A61K6/083, C03C17/32

Language of the proceedings: EN

Title of invention:
DENTAL COMPOSITIONS CONTAINING A SURFACE-MODIFIED FILLER

Patent Proprietor:
3M Deutschland GmbH

Opponents:
Dentsply DeTrey GmbH
S & C Polymer Silicon- und Composite-Spezialitäten
GmbH

Relevant legal provisions:
EPC Art. 111(1), 114, 104(1)
RPBA Art. 13(1), 13(3), 16(1)(c)

Keyword:
Late-filed document - admitted (yes)
Remittal to the department of first instance - (yes)
Apportionment of costs - (yes)



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Chambres de recours**

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Case Number: T 1763/12 - 3.3.07

**D E C I S I O N
of Technical Board of Appeal 3.3.07
of 26 November 2015**

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Decision under appeal:

**Interlocutory decision of the Opposition
Division of the European Patent Office posted on
19 June 2012 concerning the maintenance of
European patent No. 1909742 in amended form.**

Composition of the Board:

Chairman J. Riolo
Members: A. Usuelli
 P. Schmitz

Summary of Facts and Submissions

- I. European patent No. 1 909 742, based on European patent application No. 06776521.4, was granted on the basis of thirty-one claims.

Claim 1 as granted read as follows:

"1. A hardenable dental composition comprising:
(a) a polymerizable component comprising an ethylenically unsaturated compound; and
(b) a first polyacid that is bonded to the surface of a filler"

- II. The patent was opposed on the grounds that its subject-matter lacked novelty and inventive step, it was not sufficiently disclosed and it extended beyond the content of the application as filed (Article 100(a), (b) and (c) EPC). The following documents were among those cited during the first-instance proceedings:

O2: EP 1 600 142 A1

O5: WO 98/38967 A1

O6: US 6,613,812 B2

- III. By an interlocutory decision posted on 19 June 2012, the opposition division maintained the patent in amended form. The decision was based on the patent as granted as the main request and on four auxiliary requests filed during the oral proceedings held on 10 May 2012.

Claim 1 of auxiliary request 4, which was allowed by the opposition division, differed from granted claim 1 *inter alia* by specifying that component (b) was

"a first polyacid that is bonded to the surface of a filler by covalent bonds".

- IV. In its decision, the opposition division held that the subject-matter of the main request did not comply with the requirements of Article 123(2,) EPC as claims 1, 13, 22 and 26 contained additional subject-matter.

Auxiliary requests 1 and 2 did not meet the requirements of Article 54(3) EPC, since claim 1 of both requests was anticipated by document O2.

The late-submitted auxiliary request 3 was not admitted into the opposition proceedings.

Auxiliary request 4 was considered to comply with the requirement of novelty. As to the requirement of inventive step, the opposition division considered that document O5 represented the closest prior art. Claim 1 of auxiliary request 4 differed from example 6 of O5 in that the polyacid was bonded to the surface of the filler by a covalent bond, while in O5 there was an ionic bond. The technical problem was to be seen in the provision of an alternative hardenable dental composition. The prior art did not disclose dental compositions comprising a polyacid bonded to the surface of a filler by covalent bonds. Thus, the subject-matter of claim 1 was not obvious.

- V. The patent proprietor (appellant-patent proprietor) and the opponents (appellant-opponent 1 and appellant-opponent 2) lodged an appeal against that decision.

With the statement setting out the grounds of appeal filed on 17 October 2012 the appellant-patent proprietor maintained the main request (i.e.

maintenance of the patent as granted) and submitted seven auxiliary requests. Auxiliary request 4 was identical to the request allowed by the opposition division. An additional auxiliary request, named auxiliary request 4A, was submitted on 26 February 2013.

In claim 1 of auxiliary requests 1 to 4, 4A and 5, component (b) was defined as in claim 1 of the request allowed by the opposition division (see point III above).

In claim 1 of auxiliary requests 6 and 7, it was additionally specified that in component (b), the covalent bonds were made via linking groups consisting of aminoalkyltrialkoxysilanes.

VI. The Board issued a communication pursuant to Rule 15(1) RPBA on 5 August 2015. In relation to the assessment of inventive step, the Board substantially agreed with the assessment made by the opposition division. In particular, it considered that document O5 was the closest prior art and that the dental compositions claimed in the auxiliary requests differed from the compositions of O5 mainly in that a polyacid was bonded to the surface of a filler by covalent bonds.

VII. With letter of 23 November 2015, appellant-opponent 2 submitted the following document:

O6A: US 5,332,429

VIII. During the oral proceedings held on 26 November 2015, the appellant-patent proprietor withdrew its main request.

The debate was restricted to the admissibility of document O6A into the appeal proceedings and to the possibility of remitting the case to the first instance for further prosecution.

The appellant-opponents observed that O6A was *prima facie* highly relevant in respect of all the requests, and remarked that this document was already discussed in O6. They expressed the view that the admittance of O6A would not result in a fresh case, since this document merely provided more details about a method for treating glass particles which had already been disclosed in O6. Accordingly, the admittance of O6A did not have increase the complexity of the case. For that reason, there was also no need to remit the case to the first instance or to postpone the oral proceedings.

The appellant-patent proprietor substantially argued that O6A was not *prima facie* highly relevant and that appellant-opponent 2 had not provided any valid reason justifying the late filing of this document. It furthermore observed that document O6 referred to O6A, without clearly indicating which of the various methods for treating glass particles disclosed therein was considered relevant. In its opinion, there was no reason for admitting O6A if its content was merely a clarification of the disclosure of O6. The admittance of O6A would put the appellant-patent proprietor in a disadvantageous position, since it had had no time to react to the new situation. Therefore, in the event of admittance of O6A, the case should be remitted to the first instance and the costs incurred by the appellant-patent proprietor borne by appellant-opponent 2. As an alternative, the oral proceedings should be postponed to give the appellant-patent proprietor sufficient time to react to the filing of O6A.

- IX. The appellant-patent proprietor requested not to admit O6A into the proceedings. If it was admitted, the case should be remitted to the department of first instance and appellant-opponent 2 should bear the patent proprietor's costs. If document O6A was admitted and the case not remitted, the oral proceedings before the Board should be postponed in order to give it sufficient time for a proper reaction. Additionally, it requested that the decision under appeal be set aside and that the patent be maintained based on auxiliary requests 1 to 4 filed on 17 October 2012, auxiliary request 4A filed on 26 February 2013 or auxiliary requests 5 to 7 filed on 17 October 2012.
- X. The appellant-opponents requested that document O6A be admitted into the proceedings, that the case not be remitted to the department of first instance and that the patent be revoked.

Reasons for the Decision

1. Admittance of document O6A

Appellant-opponent 2 submitted document O6A on 23 November 2015, i.e. three days before the scheduled date for the oral proceedings.

1.1 *Relevance of document O6A*

- 1.1.1 In the decision under appeal the opposition division observed that in the available prior art according to Article 54(2) EPC there was no disclosure of a dental composition comprising a polyacid bonded to the surface of a filler by covalent bonds (paragraph 14). The subject-matter of auxiliary request 4 (identical to

current auxiliary request 4) was considered inventive in view of this feature.

1.1.2 In its communication pursuant to Article 15(1) RPBA issued on 5 August 2015, the Board substantially endorsed the approach followed by the opposition division. In particular, it was observed that the main point of discussion during the oral proceedings was whether the skilled person would have modified the products of document O5 by providing a composition in which the polyacid was covalently bonded to the surface of a filler.

1.1.3 Document O6A describes the preparation of products in which a polyacid is bonded via a linker to the surface of a filler. In particular in example 13 (column 13, lines 15 to 23 and Table V), the polyacid-substituted triethoxysilane derivative obtained in preparatory example 3 is reacted with the fluoroaluminosilicate (FAS) glass of preparatory example 6. Thus, in an analogous manner to the process disclosed in [0116] of the patent in suit, the process of example 13 of O6A involves the reaction between a triethoxysilane derivative and a glass material.

Cement samples are prepared by mixing the treated glass of example 13 with liquid A, i.e. a composition comprising *inter alia* the ethylenically unsaturated monomer 2-hydroxyethyl methacrylate (see Table IV).

1.1.4 Thus, document O6A is highly relevant in particular in relation to the feature which is considered in the appealed decision and in the communication of the Board as the feature distinguishing the invention over the disclosure of the closest prior art. In other words, the teaching of document O6A addresses the "gap"

between the teaching of O5 and the subject-matter of claim 1 of all the pending requests before the Board.

1.1.5 As observed by all parties, document O6A is briefly discussed in document O6, which was cited during the opposition period. However, O6 does not provide any detail about the specific treatments of FAS glasses described in O6A and referred to above. Nor does O6 refer to the specific examples of O6A which are relevant in the context of the present case. Thus, document O6 does not have the same relevance as the late-submitted document O6A.

1.2 *Criteria for the admittance of a late-filed document*

1.2.1 Article 13(1) RPBA stipulates that "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 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."

Furthermore, according to Article 13(3) RPBA "amendments sought to be made after oral proceedings have been arranged shall not be admitted if they raise issues which the Board or the other party or parties cannot reasonably be expected to deal with without adjournment of the oral proceedings."

In the context of deciding on the admission of a late-filed document Article 114 EPC is also relevant. It stipulates that the European Patent Office shall examine the facts of its own motion (Article 114(1) EPC) and that it may disregard facts or evidence which are not submitted in due time (Article 114(2) EPC).

Although the purpose of the appeal proceedings is in the first place to review the first instance decision, Article 114(1) EPC also applies in appeal proceedings and cannot be ignored. This is clear from Article 23 RPBA which stipulates that the application of the Rules of Procedure cannot result in a situation which would be incompatible with the spirit and purpose of the Convention.

- 1.2.2 In the exercise of its discretion under Article 114(2) EPC and Article 13(1) RPBA, the Board has to balance on the one hand the need to avoid an unnecessary prolongation of the proceedings, which is derivable from the criteria set out in Articles 13(1) and (3) RPBA, and on the other hand the public interest that requires that only valid European patents should be granted and maintained in force. The latter is safeguarded by the principle of examination by the office of its own motion enshrined in Article 114(1) EPC.

For the reasons discussed above, the disclosure of document O6A is likely to have an impact on the patentability of all the pending requests. The introduction of this document does not open a completely new line of argumentation but closes a gap underlined in the decision of the opposition division and thus is in reply thereto.

Under such circumstances, the Board considers that the need to assess the validity of the patent in suit with respect to this document must prevail over any other principle.

1.3 *Conclusion*

In view of the above considerations, the Board in the exercise of its discretion decides to admit document O6A into the appeal proceedings.

2. Remittal to the first instance

The appellant-patent proprietor has requested that the case be remitted to the opposition division in case document O6A was admitted.

In order to give the appellant-patent proprietor sufficient time to react to the new evidence and in order not to deprive it of the possibility of being heard by the two instances, the Board allows its request. The case is therefore remitted to the department of first instance for further prosecution (Article 111(1) EPC).

3. Apportionment of the costs

Appellant-opponent 2 did not give any reason why document O6A was submitted only at such a late stage of the proceedings and why it could not file this document earlier. The consequence was that the discussion at the oral proceedings before the Board was limited to the issue of admittance of O6A without considering any substantive matter. This would have been avoided if the document had been filed earlier.

Accordingly, the Board considers it to be equitable that the expenses incurred by the appellant-patent proprietor in connection with the oral proceedings be borne by appellant-opponent 2 (Article 104(1) EPC, Article 16(1)(c) RPBA).

Order

For these reasons it is decided that:

1. Document O6A is admitted into the proceedings.
2. The case is remitted to the department of first instance for further prosecution.
3. The costs of the appellant-patent proprietor for the oral proceedings before the Board shall be borne by appellant-opponent 2.

The Registrar:

The Chairman:



S. Fabiani

J. Riolo

Decision electronically authenticated