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**Datasheet for the decision
of 14 December 2017**

Case Number: T 1613/15 - 3.3.05

Application Number: 02729368.7

Publication Number: 1360146

IPC: C01B33/148

Language of the proceedings: EN

Title of invention:

PROCESS FOR THE PREPARATION OF AQUEOUS SUSPENSIONS OF ANIONIC COLLOIDAL SILICA HAVING A NEUTRAL PH AND APPLICATIONS THEREOF

Patent Proprietor:

AZ Electronic Materials USA Corp.

Opponent:

Akzo Nobel Chemicals International B.V.

Headword:

Anionic colloidal silica/AZ

Relevant legal provisions:

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

Keyword:

Amendments - allowable (yes)

Late-filed facts - admitted (no)

Decisions cited:

T 0926/12

Catchword:



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Case Number: T 1613/15 - 3.3.05

D E C I S I O N
of Technical Board of Appeal 3.3.05
of 14 December 2017

Respondent: AZ Electronic Materials USA Corp.
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Appellant: Akzo Nobel Chemicals International B.V.
(Opponent) Velperweg 76
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Representative: Akzo Nobel IP Department
Velperweg 76
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Decision under appeal: Interlocutory decision of the Opposition
Division of the European Patent Office posted on
29 June 2015 concerning maintenance of European
patent No. 1360146 in amended form

Composition of the Board:

Chairman E. Bendl
Members: G. Glod
O. Loizou

Summary of Facts and Submissions

- I. The appeal of the opponent (hereinafter the appellant) lies from the opposition division's interlocutory decision regarding European patent EP-B1-1 360 146 that the then second auxiliary request met the requirements of the EPC.

The only independent claim of this request reads as follows:

"1. A process for the preparation of an aqueous suspension of anionic colloidal silica having a neutral pH, which is stable over time and comprising individualized particles of colloidal silica which are not bound to one another by siloxane bonds, characterized in that an aqueous suspension of anionic colloidal silica comprising individualized particles of colloidal silica which are not bound to one another by siloxane bonds and having a basic pH in the range from 8.5 to 11, a specific surface in the range from 20 m²/g to 700 m²/g, a particle diameter in the range from 4 nm to 150 nm and having a percentage of silica of ≥ 5 % by weight is mixed with an aqueous suspension of anionic colloidal silica comprising individualized particles of colloidal silica which are not bound to one another by siloxane bonds and having an acid pH in the range from 2 to 3.5, a specific surface in the range from 20 m²/g to 700 m²/g, a particle diameter in the range from 4 nm to 150 nm and having a percentage of silica of ≥ 5 % by weight."

Claim 2 is dependent on claim 1 and describes a preferred embodiment thereof.

II. The following documents were among those cited in the decision under appeal.

D1: US-A-3 673 104

D3: US-A-5 458 812

III. In its statement of grounds of appeal the appellant raised objections only under Article 123(2)/(3) EPC with respect to the request found allowable by the opposition division.

IV. In its communication under Article 15(1) RPBA, the board was of the preliminary opinion that the grounds for opposition did not prejudice the maintenance of the patent as granted.

V. By letter of 3 October 2017, the appellant filed further observations, including objections under Article 56 and Rule 80 EPC.

VI. Oral proceedings took place on 14 December 2017. In the course thereof the patent proprietor (hereinafter the respondent) withdrew the appeal that it had also lodged against the impugned decision.

VII. The arguments of the appellant which are relevant to the present decision may be summarised as follows:

The proprietor's request, as a fifth auxiliary request, that the patent in suit be maintained on the basis of the set of claims found allowable by the opposition division should not be admitted, since it was late-filed and furthermore did not fulfil the requirements of Rule 80 EPC.

The application as filed made a clear distinction between mixing and reacting. The expressions "is mixed with" and "is reacted with" defined process steps which had a different technical meaning, whereby the first encompassed the latter. The omission of the term "is reacted with" in claim 1 was not directly and unambiguously derivable from the application as filed, so the requirements of Article 123(2) EPC were not met.

Further, the requirements of Article 123(3) EPC were not met, since claim 2 of the claims as granted, now combined with claim 1, required a reaction to take place.

The Article 56 EPC objection had been raised in the letter of 3 October under point 3.1. The reason why it was only raised at that stage of the proceedings was that there had been staff changes within the appellant's IP department.

VIII. The arguments of the respondent which are relevant to the present decision may be summarised as follows:

The request to maintain the patent in suit as upheld by the opposition division formed the basis of the appellant's (opponent's) appeal, and it was obvious that this request would be defended by the patent proprietor.

The opposition division correctly stated that "mixed with" and "reacted" were used as synonyms, and the requirements of Article 123(2)/(3) EPC were met.

The original appeal of the appellant was based only on Article 123(2)/(3) EPC (see the respondent's letter of 23 March 2016, point 2).

IX. The appellant requested that the impugned decision be set aside and that the patent be revoked in its entirety.

The respondent requested that the appeal be dismissed.

Reasons for the Decision

1. Admissibility of the sole request

The appeal of the patent proprietor, which was withdrawn during the oral proceedings, was originally directed towards the opposition division's interlocutory decision with the aim of having the opposition division's decision set aside and the patent maintained as granted as a main request. Further requests (auxiliary requests 1 to 4) had been filed that were broader in scope than those found allowable by the opposition division. The patent proprietor never declared that he abandoned the request held allowable by the opposition division. On the contrary, the patent proprietor also filed a reply to the appeal of the opponent and requested, inter alia, that the appeal be dismissed, thus defending the claims held allowable by the opposition division.

By contesting the opposition division's decision, the appellant has made this request the object of its appeal to be reviewed by the board during appeal proceedings.

The board therefore has no doubt that in the present case both the appellant and the respondent considered the set of claims found allowable by the opposition

division to be part of the appeal procedure.

In view of the patent proprietor's re-introduction of this request as a fifth auxiliary request during oral proceedings and of the appellant's objection to its admission into the proceedings, for the sake of completeness and extreme caution the board heard arguments from both sides on this point.

However, even assuming that the cited set of claims was meant to be withdrawn and replaced by the later-filed requests, its re-introduction is, according to current case law of the boards of appeal, in principle admissible provided that it has never been explicitly abandoned and the department examining the case has admitted its re-introduction (see T 926/12, Reasons 1).

In the current case none of the requirements concerning the complexity of the amendments, the state of the proceedings or procedural economy (Rule 13(1) RPBA) would speak against its re-introduction, as the opponent had in its grounds of appeal already taken position on this request, which was narrower in scope than those then on file. For the same reasons, adjournment of the oral proceedings would not be necessary (Article 13(3) RPBA). Furthermore, the department of first instance too had already decided on exactly this set of claims.

Thus, the board does not see any reason not to admit the set of claims at issue.

2. Admissibility of the objections under Rule 80 and Article 56 EPC (Article 13(1) RPBA)

2.1 No objection under Rule 80 EPC was raised either before the opposition division or in the statement of grounds of appeal relating to the set of claims now at issue, i.e. the claims as found admissible by the opposition division. Such an objection was first made in the letter of 3 October 2017.

According to Article 13(1) RPBA, discretion over the admittance of amendments to a party's case is to 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.

According to the established case law, new facts, documents and evidence would be considered to have been filed in due time if their filing was a reaction to a change in the case. Further case law also relates to the relevance of the late-filed submissions.

In the present case the Rule 80 EPC objection is not occasioned by a change of the case, no reasons for its late introduction have been given, and the board cannot see its *prima facie* relevance.

Therefore, the board does not admit the Rule 80 EPC objection into the proceedings.

2.2 The Article 56 EPC objection was also not raised with the statement of grounds of appeal, and therefore the opposition division's findings were not contested by the appellant. This was also indicated in the respondent's letter of 23 March 2016 (point 2). It was only in replying to the communication under Article 15(1) RPBA that the appellant in its letter of 3 October 2017 (point 3.1) referred to an inventive step objection against the combination of claims 1 and 2 of

the patent as granted. However, it did not give any reasons why the objections were only raised at that point of the procedure. The board cannot see any either, since the communication did not raise any new point with respect to the opposition division's findings on inventive step that would justify the submission of the arguments at such a late point in the proceedings.

According to the established case law, a change of the appellant's representative is not, as argued during oral proceedings, a justification for late submissions either (Case Law of the Boards of Appeal of the EPO, 8th edition 2016, IV.C.1.3.18).

Since the Article 56 EPC objection is also not occasioned by a change of the case and is not considered *prima facie* relevant, it is not admitted into the proceedings.

3. Article 123(2) EPC

The requirements of Article 123(2) EPC are met for the following reasons:

Claim 1 of the present request is a combination of claims 1 and 2 of the application as filed, with the exception that the wording "is reacted" present in original claim 2 has been omitted. The question arises whether this leads to subject-matter not directly and unambiguously derivable by the skilled person, using common general knowledge, from the application as filed.

In the present case, the expression "mixed" was used for the addition of an aqueous suspension having a

basic pH to an aqueous suspension having an acidic pH with the goal of obtaining a neutral aqueous suspension. The skilled person would immediately recognise that the basic suspension will react with the acid suspension to yield the neutral suspension. Hence, in the context of the present application, the wording "mixed" implies an acid-base reaction. The wording "reacted" present in claim 2 of the application as filed would not have been given a different meaning than the acid-base reaction, especially since claim 2 was dependent on claim 1 and the whole application relates to the production of a neutral aqueous suspension. This is also reflected in examples 1 to 3, where a basic aqueous suspension was simply added to an acid aqueous suspension with stirring (i.e. mixing) to obtain a neutral aqueous suspension.

As a consequence, the wordings "mixed" and "reacted" have the same meaning to the skilled person in the context of the patent in suit, and so the omission of "reacted" is not contrary to the requirements of Article 123(2) EPC.

4. Article 123(3) EPC

The requirements of Article 123(3) EPC are met for the following reasons:

Claim 1 is a combination of claims 1 and 2 of the patent as granted, with the exception that the wording "is reacted" present in claim 2 has been omitted. As indicated by the appellant, the wording "mixed" allegedly has a broader meaning than "reacted". Following this line of argument, there can be no extension of the scope of protection, because claim 1

of the patent as granted contained the broad term and has been further limited by features of claim 2.

Based on the appellant's interpretation, the situation might possibly have been different if claim 1 as granted had contained the allegedly narrow wording "reacted", dependent claim 2 as granted the broader wording "mixed" and claim 1 now only contained "mixed". That situation, however, does not apply here.

In any case, as established above, "reacted" and "mixed" have the same meaning in the present context, and so there is no difference in scope independently of the presence of "reacted" or "mixed" in claim 1.

Order

For these reasons it is decided that:

The appeal is dismissed

The Registrar:

The Chairman:



L. Stridde

E. Bendl

Decision electronically authenticated