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**Datasheet for the decision
of 28 March 2019**

Case Number: T 0352/16 - 3.3.03

Application Number: 05761208.7

Publication Number: 1758947

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C08J9/12

Language of the proceedings: EN

Title of invention:
FLEXIBLE POLYURETHANE FOAM

Patent Proprietor:
Fritz Nauer AG

Opponents:
Recticel

Relevant legal provisions:
RPBA Art. 13(1), 13(3)

Keyword:
Late-filed requests - admitted (no)



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Case Number: T 0352/16 - 3.3.03

D E C I S I O N
of Technical Board of Appeal 3.3.03
of 28 March 2019

Appellant: Fritz Nauer AG
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Decision under appeal: Decision of the Opposition Division of the
European Patent Office posted on 15 December
2015 revoking European patent No. 1758947
pursuant to Article 101(3)(b) EPC.

Composition of the Board:

Chairman D. Semino
Members: O. Dury
 C. Brandt

Summary of Facts and Submissions

- I. The appeal by the patent proprietor lies against the decision of the opposition division posted on 15 December 2015 revoking European patent No. 1 758 947.
- II. Two notices of opposition against the patent were filed, in which the revocation of the patent in its entirety was requested.
- III. Opponent 2 (BASF SE) withdrew its opposition during the opposition proceedings and is not party to the proceedings any more.
- IV. The contested decision was based on the main request filed with letter of 7 October 2015 and on the first and second auxiliary requests, both filed during the oral proceedings of 6 November 2015.

Claims 1 and 2 of the main request read as follows (in the present decision, the product-by-process definition of the prepolymer "which is made by reacting... ;", which is present in all requests defended by the appellant, was amended several times during the course of the proceedings and is relevant to the decision, is highlighted by the Board):

"1. A method of making a flexible polyurethane foam from a mixture of prepolymer and foam-forming ingredients, **wherein the prepolymer is made by reacting at least one polyol with at least one multifunctional isocyanate, wherein the at least one polyol consists only of wholly propylene oxide-derived polyols and wherein the at least one polyol is a triol**; wherein the prepolymer is a non-foamed polyol prepolymer having a

viscosity below 20,000 mPa.s as measured on a Brookfield Viscometer at a temperature of 25°C and having available OH groups made by reacting a proportion in the range 0.1% to 30% by weight of the theoretical amount of the isocyanate required to react with all available hydroxyl groups of the polyol, and the foam-forming ingredients comprise at least a multifunctional isocyanate and water."

"2. A method of making a flexible foam from a mixture of prepolymer and foam-forming ingredients, **wherein the prepolymer is made by reacting at least one polyol with at least one multifunctional isocyanate, wherein the at least one polyol consists only of wholly propylene oxide-derived polyols and wherein the at least one polyol is a triol**; wherein the prepolymer is a non-foamed polyol prepolymer having a viscosity in the range 7,000-50,000 mPa.s as measured on a Brookfield Viscometer at a temperature of 25°C and having available OH groups made by reacting a proportion in the range 30% to 99% by weight of the theoretical amount of the isocyanate required to react with all available hydroxyl groups of the polyol, and the foam-forming ingredients comprise at least a multifunctional isocyanate and water."

Claim 1 of the first auxiliary request was identical to claim 2 of the main request whereas claim 1 of the main request was no longer present.

Claim 1 of the second auxiliary request differed from claim 1 of the first auxiliary request in that

- it was specified that no water was purposefully or intentionally added in the production of the

prepolymer;

- a specific amount of water in the foam forming ingredient was indicated;
- the lower end of the range of viscosity was modified to read 15,000 mPa.s (instead of 7,000 mPa.s).

V. In the contested decision the opposition division *inter alia* held that:

- The main request satisfied the requirements of sufficiency of disclosure and of Article 123(2) (3) EPC but its claim 1 lacked novelty over D1 (US 5 063 253). In that respect, the conclusions of the opposition division regarding Article 123(2) EPC and novelty were reached considering that the feature "wherein the at least one polyol consists only of wholly propylene oxide-derived polyols and wherein the at least one polyol is a triol" only meant that one polyol had to be a propylene-oxide triol, contrary to the opinion of both the patent proprietor and opponent 1 according to which said feature meant that, when a mixture of polyols was used, all the polyols had to be wholly propylene oxide-derived triols (contested decision: page 6, beginning of section 2 and page 7, section 4).
- The first and second auxiliary requests fulfilled the requirements of Article 123(2) and (3) EPC, were novel over D1 but lacked an inventive step starting from D7 (US 4 546 122) as closest prior art.

VI. The patent proprietor (appellant) appealed the above decision. With the statement setting out the grounds for the appeal the appellant requested that the decision be set aside and the patent be maintained in amended form according to any of the main request or of the first to the fourth auxiliary requests filed therewith.

The main request corresponded to the main request dealt with in the contested decision.

Claim 1 of the first auxiliary request differed from claim 1 of the main request in that the prepolymer was defined as follows:

"wherein the prepolymer is made by reacting one or more polyols with at least one multifunctional isocyanate, wherein the one or more polyols consist only of wholly propylene oxide-derived polyols and wherein the one or more polyols are triols".

Claim 2 of the first auxiliary request was identical to claim 2 of the main request filed with the statement of grounds of appeal i.e. to claim 2 of the main request dealt with in the contested decision.

Claim 1 of the second auxiliary request differed from claim 1 of the main request in that the prepolymer was defined as follows:

"wherein the prepolymer is made by reacting only one polyol with at least one multifunctional isocyanate, wherein the only one polyol consists only of wholly propylene oxide-derived polyols and wherein the only one polyol is a triol"

Claim 2 of the second auxiliary request was identical to claim 2 of the main request filed with the statement of grounds of appeal i.e. to claim 2 of the main request dealt with in the contested decision.

The third auxiliary request corresponded to the first auxiliary request dealt with in the contested decision.

Claim 1 of the fourth auxiliary request only differed from claim 1 of the third auxiliary request in that the lower end of the range of viscosity was modified to read 15,000 mPa.s (instead of 7,000 mPa.s).

- VII. In its reply to the statement of grounds of appeal opponent 1 (respondent) requested that the appeal be dismissed.
- VIII. The parties were summoned to oral proceedings with letter dated 11 July 2018.
- IX. Issues to be discussed at the oral proceedings were specified by the Board in a communication dated 25 October 2018. In particular, it was noted therein that the claims of the main request filed with the statement of grounds of appeal were interpreted in different manners by the opposition division and by the parties (see section V above, first subsection) and that the main request, in view of the different possible interpretations, did not appear to satisfy the requirements of Article 84 EPC (section 6). Further considerations were given in respect of Article 123(2) EPC for all pending requests (sections 7 and 11-14).
- X. With letter dated 25 February 2019 the appellant submitted new documents and experimental reports as

well as a revised main request and revised first to fourth auxiliary requests.

Claims 1 and 2 of the main request differed from claims 1 and 2, respectively, of the main request filed with the statement of grounds of appeal in that the prepolymer was defined as follows:

"wherein the prepolymer is made by reacting one or more polyols with at least one multifunctional isocyanate, wherein the one or more polyols consist only of wholly propylene oxide-derived polyols".

Claims 1 and 2 of the first auxiliary request differed from claims 1 and 2, respectively, of the main request filed with the statement of grounds of appeal in that the prepolymer was defined as follows:

"wherein the prepolymer is made by reacting one or more polyols with at least one multifunctional isocyanate, wherein the one or more polyols each consist only of wholly propylene oxide-derived polyols".

Claims 1 and 2 of the second auxiliary request differed from claims 1 and 2 of the second auxiliary request filed with the statement of grounds of appeal in that the prepolymer was defined as follows:

"wherein the prepolymer is made by reacting only one polyol with at least one multifunctional isocyanate, wherein the only one polyol consists only of wholly propylene oxide-derived polyols;"

Claim 1 of the third auxiliary request was identical to claim 2 of the main request filed with letter of 25 February 2019.

Claim 1 of the fourth auxiliary request only differed from claim 1 of the third auxiliary request filed with letter of 25 February 2019 in that the lower end of the range of viscosity was modified to read 15,000 mPa.s (instead of 7,000 mPa.s).

XI. With letter dated 15 March 2019 the respondent requested that the requests and submissions put forward by the appellant for the first time with letter of 25 February 2019 be not admitted into the proceedings.

XII. Oral proceedings were held on 28 March 2019 in the presence of both parties.

XIII. The appellant's arguments, insofar as relevant to the decision, may be summarised as follows:

(a) The operative main request was filed in response to the issues identified in the Board's communication, in particular in order to overcome the objection of lack of clarity and the new issue regarding Article 123(2) EPC raised by the Board in relation to the polyols being triol(s). The amendments made in claim 1 of the main request were mainly based on the wording of claim 1 of the first auxiliary request filed with the statement of grounds of appeal, whereby the "triol" feature, which was objected to pursuant to Article 123(2) EPC in the Board's communication, was deleted. These amendments were foreseeable and could not take the respondent by surprise. For these reasons, the main request should be admitted into the proceedings.

(b) The same arguments as for the main request applied to each of the first to the fourth auxiliary

requests.

XIV. The respondent's arguments, insofar as relevant to the decision, may be summarised as follows:

(a) By deleting the "triol" feature from the claims of the operative main request, the appellant effectively broadened the scope of the claims, which resulted in a divergence, instead of a convergence, of the subject-matter being claimed as compared to the main request filed with the statement of grounds of appeal. The filing of the operative main request at such a late stage of the proceedings amounted to an abuse of the proceedings since it did not leave sufficient time for the respondent to prepare its case properly. In such a situation, Article 13(3) RPBA did not leave any room for discretion to the Board regarding the admittance of requests. The appellant could have filed these requests earlier and should at least have reacted more promptly to the Board's communication, in which it had explicitly been made reference to the stipulations of Article 13(1) and (3) RPBA. In addition, the main request did not overcome all the objections raised against the requests filed with the statement of grounds of appeal. For these reasons, the main request should not be admitted into the proceedings.

(b) The same arguments as for the main request applied to each of the first to the fourth auxiliary requests.

XV. The appellant requested that the decision under appeal be set aside and that the patent be maintained in amended form according to any of the main request, or,

alternatively, of the first to fourth auxiliary requests, all requests filed with letter dated 25 February 2019.

The respondent requested that the appeal be dismissed. The respondent further requested that the requests and submissions (evidence, affidavit, experimental data and arguments) submitted for the first time with letter of 25 February 2019 not be admitted into the proceedings.

Reasons for the Decision

1. Admittance of the main request
 - 1.1 Since the main request was filed after the parties had been summoned to oral proceedings, its admittance into the proceedings is subject to the Board's discretion pursuant to Article 13(1) RPBA and underlies the additional stipulations of Article 13(3) RPBA.
 - 1.2 According to the case law, it is a matter for each party to submit all facts, evidence, arguments and requests relevant for the enforcement or defence of his rights as early and completely as possible, in particular in *inter partes* proceedings in order to act fairly towards the other party and, more generally, to ensure due and swift conduct of the proceedings (Case Law of the Boards of Appeal of the EPO, 8th edition, 2016, IV.E.4.1.2 and 4.1.4).
 - 1.2.1 As compared to claims 1 and 2 filed with the statement of grounds of appeal, claims 1 and 2 of the operative main request were modified as follows:

(a) the expression "wherein the at least one polyol consists only of wholly propylene oxide-derived polyols" was replaced by "wherein the one or more polyols consist only of wholly propylene oxide-derived polyols";

(b) the feature "and wherein the at least one polyol is a triol" was deleted.

1.2.2 Regarding amendment (b), the deletion of the feature "wherein the at least one polyol is a triol" effectively expands the scope of the operative claims in the sense that, contrary to the main request filed with the statement of grounds of appeal, all the polyols now defined in operative claims 1 and 2 could e.g. be diols. In that respect, it was not contested by the appellant, in particular at the oral proceedings before the Board, that the subject-matter now being claimed does not constitute a limitation of the subject-matter defined in the claims filed with the statement of grounds of appeal (and defended in front of the opposition division) and effectively, at least in respect of the nature of the polyol(s), diverges from the subject-matter claimed in the main request filed with the statement of grounds of appeal. As a consequence, amendment (b) may have some impact on the issues in dispute between the parties, in particular in respect of Article 54 EPC and Article 56 EPC, which may have required that new issues be discussed for the first time at the oral proceedings before the Board and/or that the oral proceedings be postponed to give the respondent sufficient time to prepare its defence properly, the latter being contrary to the stipulations of Article 13(3) RPBA.

Under these circumstance, admitting the main request

into the proceedings would neither be in line with the requirement for procedural efficiency (Article 13(1) RPBA), nor be fair to the respondent.

- 1.2.3 During the oral proceedings before the Board, the appellant argued that amendment (b) was made in order to reply to an objection pursuant to Article 123(2) EPC which had been raised for the first time in the Board's communication (section 7.2).

However, in said passage of the communication (section 7.2: second and third paragraphs), it was first indicated that the appellant had not replied to the respondent's objection according to which the subject-matter of claim 1 of the main request filed with the statement of grounds of appeal was not supported by the application as filed because it was not stated anywhere in the application as filed that, when a mixture of polyether polyols was used, each of these polyether polyols were required to be wholly or at least predominantly propylene oxide derived (reply to the statement of grounds of appeal: page 3, first five paragraphs). It was then indeed indicated in the same section of that communication that it was questionable that the application as filed provided a valid support for the combination of features according to which all the polyols should be "wholly propylene oxide-derived polyols" and "wherein the at least one polyol is a triol" (section 7.2 of the Board's communication: starting from the fourth paragraph). In that respect, questioned by the Board, it was agreed by the appellant during the oral proceedings before the Board that the first aspect of the issue regarding Article 123(2) EPC identified in the Board's communication, namely whether the application as filed provided a valid support for a mixture of polyether

polyols wherein each of these polyether polyols were wholly propylene-oxide derived, which is still valid for amendment (a) indicated in section 1.2.1 above, was never replied to in writing by the appellant, in particular not in their last submission dated 25 February 2019. Therefore, the appellant, when filing the operative main request, failed to substantiate why said request satisfied the requirements of Article 123(2) EPC and why it effectively overcame the respondent's objection raised in the rejoinder to the statement of grounds of appeal (and indicated in the Board's communication). Should the main request be admitted into the proceedings, the appellant's arguments in that respect would have had to be heard for the first time at the oral proceedings before the Board, although an objection in that respect had been made at the outset of the appeal proceedings, which runs counter to the need for procedural economy.

In addition, no valid reason was given by the appellant why the operative main request was filed only one month prior to the oral proceedings, whereby the Board's communication had been sent about 5 months before the date of the oral proceedings. In doing so, the appellant did not leave much time to the respondent to prepare properly its case, in particular in view of the issue indicated in section 1.2.2 above.

For these reasons, the appellant's argument according to which the operative main request constituted a direct reply to the Board's communication does not justify the filing of that request only one month before the date of the oral proceedings.

- 1.2.4 The appellant argued that the main request was also submitted as an attempt to overcome the objection

pursuant to Article 84 EPC put forward by the respondent in its rejoinder to the statement of grounds of appeal and identified in the Board's communication as relevant for the main request filed with the statement of grounds of appeal.

However, the filing of a new request at such a late stage in a case where a relevant objection (here pursuant to clarity) was known from the beginning of the appeal proceedings does not satisfy the requirements of due process and the need for economy of the proceedings. In that respect, it makes no doubt that the appellant could have replied to that objection earlier, e.g. in direct reply to the respondent's rejoinder to the statement of grounds of appeal, after having received the summons to oral proceedings or, at the latest, in direct reply to the Board's communication, which was sent about 5 months before the date of the oral proceedings. Under such circumstances, also the objection pursuant to Article 84 EPC raised against the main request filed with the statement of grounds of appeal cannot justify the filing of the operative main request only one month before the oral proceedings before the Board.

1.3 In view of the above, the Board finds it appropriate, in the circumstances of the present case, to exercise its discretion under Article 13(1) RPBA and its power under Article 13(3) RPBA by not admitting into the proceedings the operative main request.

2. Admittance of the first to the fourth auxiliary requests

The claims of each of the first to the fourth auxiliary requests were all modified, as compared to the claims

of the first to the fourth auxiliary requests filed with the statement of grounds of appeal, *inter alia* so that the polyol(s) defined therein do not mandatorily comprise a "triol" any more, in a similar manner as was done for the main request. In addition, it is further noted that, in its letter dated 25 February 2019, although the appellant indicated that the subject-matter being claimed satisfied the requirements of Article 123(2) EPC, no substantiation was given regarding where a direct and unambiguous basis in the application as filed could be found for the specific combination of features so being defined in the operative claims. In that respect, it was in particular indicated in the Board's communication which criteria had to be satisfied (section 7.1) and which issues appeared to be relevant (sections 11-14). Under such circumstances and in the absence of any additional arguments (as compared to the main request) put forward by the appellant, in particular at the oral proceedings before the Board, these auxiliary requests suffer the same deficiencies as identified above in respect of the main request regarding the broadening in scope, the short time left to the respondent to react and the lack of motivation regarding Article 123(2) EPC. As a consequence, each of these auxiliary requests is bound to share the same fate regarding its admittance into the proceedings as the main request.

3. In reaching the above decisions, it is further taken into account that it is settled case law that parties should participate actively in the appeal proceedings, in particular in *inter partes* proceedings (as in the present case), which means that the parties and their representatives are responsible for the conduct of their case and it is for them to submit the necessary arguments to support their case on their own initiative

and at the appropriate time (Case Law, *supra*, IV.F.3.13.7). In the Board's view, by filing only one month before the date of the oral proceedings a set of amended requests, which are not convergent with any of the requests formerly defended in the proceedings and for which no substantiation regarding Article 123(2) EPC was filed, although objections in that respect (which are still valid for the operative requests) were raised at the outset of the appeal proceedings, the appellant did not participate actively in the proceedings. Such a conduct is both contrary to the stipulations of the Rules of Procedure of the Boards of Appeal and not in line with the Board's case law.

4. Considering that none of the appellant's main request and first to fourth auxiliary requests is admitted into the proceedings, the appeal is to be dismissed.

Order

For these reasons it is decided that:

The appeal is dismissed.

The Registrar:

The Chairman:



S. Lichtenvort

D. Semino

Decision electronically authenticated