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**Datasheet for the decision  
of 21 March 2019**

**Case Number:** T 1092/16 - 3.3.03

**Application Number:** 08735990.7

**Publication Number:** 2134777

**IPC:** C08K3/20, H01B3/30

**Language of the proceedings:** EN

**Title of invention:**

NANO-MODIFIED WIRE ENAMELS AND ENAMELLED WIRES THEREOF

**Patent Proprietor:**

ELANTAS GmbH

**Opponent:**

Essex Europe

**Relevant legal provisions:**

RPBA Art. 12(4), 13(1), 13(3)

**Keyword:**

Requests filed for the first time in appeal - admissible (no)



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Case Number: T 1092/16 - 3.3.03

**D E C I S I O N**  
**of Technical Board of Appeal 3.3.03**  
**of 21 March 2019**

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**Decision under appeal:** **Decision of the Opposition Division of the  
European Patent Office posted on 26 February  
2016 revoking European patent No. 2134777  
pursuant to Article 101(3) (b) EPC.**

**Composition of the Board:**

**Chairman** D. Semino  
**Members:** M. C. Gordon  
R. Cramer

## Summary of Facts and Submissions

- I. The appeal lies from the decision of the opposition division posted on 26 February 2016 revoking European patent number 2 134 777.
- II. The patent was granted with a set of 6 claims, whereby claim 1 read as follows:
- "Use of nanomaterials in wire enamel to improve the thermal properties of the wire enamel, **characterized in that**
- the polymer base of the wire enamel is selected from the group consisting of polyamideimide, polyester, polyesterimide, polyurethane and mixtures thereof, and **characterized in that**
- the nanomaterials are selected from the group consisting of nano-oxides, nano-metaloxides, metaloxides or hydrated oxides of aluminium, tin, boron, germanium, gallium, lead, transition metals, lanthanides, actinides and mixtures thereof, or the nanomaterial is selected from the group consisting of nano-oxides, nano-metaloxides, metaloxides or hydrated oxides of aluminium, silicon, titanium, zinc, yttrium, vanadium, zirconium, nickel and mixtures thereof."
- III. A notice of opposition against the patent was filed in which revocation of the patent in its entirety was requested.
- IV. During the course of the opposition proceedings a number of claim versions were submitted.

A main request and three auxiliary requests were filed with the response to the notice of opposition.

Claim 1 of the main request was modified compared to claim 1 of the patent as granted by limiting the wire enamel to single coat wire enamel and by specifying that the nanomaterial was added to the polymer base of the wire enamel composition prior to the application of the wire enamel and that the improved thermal properties were "at least enhanced cut-through value". In addition claim 1 of auxiliary request 1 limited the nanomaterials to the first group. In claim 1 of auxiliary request 2 the nanomaterial was further limited to nanoalumina. Claim 1 of auxiliary request 3 contained the further limitation of the polymer base to polyurethane.

With letter of 20 January 2016, two days before the oral proceedings before the opposition division, three sets of claims were filed as main request and auxiliary requests 1 and 2 to replace all previous requests.

Compared to granted claim 1 claim 1 of the main request included the limitation of the addition of the nanomaterial prior to the application of the wire enamel, defined the polyamideimide in product-by-process terms, limited the nanomaterials to the first group and included the specification of the cut-through value. Claim 1 of auxiliary request 1 differed from claim 1 of the main request by restriction of the nanomaterials to nanoalumina and deletion of the specification of the cut-through value. Claim 1 of auxiliary request 2 corresponded to claim 1 of the main request, in which the definition of the polymer base was wholly replaced by specifying that polyester wire enamels were used in a dual coat system base coat under a polyamideimide overcoat.

All requests of 20 January 2016 were not admitted by the opposition division.

The decision of the opposition division was instead based on two amended sets of claims filed as main request and auxiliary request 1 during the oral proceedings before the opposition division.

Claim 1 of the main request differed from claim 1 of the patent as granted in that the nanomaterials were restricted to nanoaluminas. Claim 1 of auxiliary request 1 was further restricted to single coat wire enamel.

- V. According to the decision the subject-matter of claim 1 of the main request satisfied the requirements of clarity, added subject-matter and sufficiency of disclosure but did not meet the requirements of novelty. Claim 1 of auxiliary request 1 did not comply with the requirements of Article 123(2) EPC.
- VI. Together with the statement of grounds of appeal the patent proprietor (appellant) submitted sets of claims forming a main request and 15 auxiliary requests.
- VII. In the reply to the statement of grounds the opponent (respondent) *inter alia* argued that none of the requests should be admitted to the procedure.
- VIII. In a communication the Board set out its preliminary assessment of the case. With respect to admittance of the sets of claims filed with the statement of grounds of appeal it was observed that over the course of the proceedings the appellant had adopted a number of differing approaches, e.g. in terms of the definition of the polyamideimide component.

It was also observed with reference to Article 12(2) RPBA that, with the exception of the main request, no indication of the reasons for filing the amended requests had been provided, i.e. it was not explained how the amendments made would overcome the objections raised.

- IX. With letter of 26 November 2018 the appellant submitted two further auxiliary requests numbered 4a and 4b.
- X. With letter of 12 February 2019 the respondent argued against admittance of the two latest auxiliary requests, invoking Article 13(1) RPBA.
- XI. Oral proceedings were held before the Board on 21 March 2019.

At the start of the oral proceedings the appellant withdrew the auxiliary requests 1-3, 5-11 and 13-15, meaning that the following requests remained:

Main request  
Auxiliary request 4  
Auxiliary requests 4a, 4b  
Auxiliary request 12.

Claim 1 of the main request read as follows (amendments with respect to granted claim 1 in bold, deletion in strike-through):

"Use of nanomaterials in wire enamel to improve the thermal properties of the wire enamel, **which are temperature resistance measured as cut-through value, by adding a nanomaterial to the polymer base of the wire enamel composition prior to application of the**

**wire enamel** characterized in that the polymer base of the wire enamel is selected from the group consisting of polyamideimide, **which is prepared by directly reacting a tricarboxylic acid anhydride with a diisocyanate**, polyester, polyesterimide, polyurethane and mixtures thereof, and characterized in that the nanomaterials are selected from the group consisting of ~~nano-oxides, nano-metaloxides, metaloxides or hydrated oxides of aluminium, tin, boron, germanium, gallium, lead, transition metals, lanthanides, actinides and mixtures thereof, or the nanomaterial is selected from the group consisting of nano-oxides, nano-metaloxides, metaloxides or hydrated oxides of aluminium, silicon, titanium, zinc, yttrium, vanadium, zirconium, nickel and mixtures thereof~~ **nanoaluminas.**"

Claim 1 of auxiliary request 4 corresponded to claim 1 of the main request in which it was specified that the nanoaluminas "are treated with one or more coupling agents". In claim 1 of auxiliary request 4a it was further specified that the coupling agent belonged to a specific list. Claim 1 of auxiliary request 4b contained in addition to claim 1 of auxiliary request 4a the specification of quantity ranges for the polymer base, the nanomaterial and the further components of the wire enamel. Claim 1 of auxiliary request 12 corresponded to claim 1 of the main request in which the polymer base was redefined as being selected from the group consisting of "polyester wire enamels which are used in a dual coat system as base coat under a polyamideimide overcoat, whereby the polyamideimide is prepared by directly reacting a tricarboxylic acid anhydride with a diisocyanate" and it was specified

that the nanomodified enamels were used for each coating.

Following discussion and deliberation on the above requests, the appellant submitted a further request designated auxiliary request 16, whose claim 1 corresponded to granted claim 1 in which the nanomaterials were limited to nanoaluminas and it was specified that the nanomaterial was treated with one or more coupling agents being selected from a specific list.

XII. The arguments of the appellant, as far as relevant to the present decision, can be summarised as follows:

(a) Main request - admittance

The main request was an attempt to overcome the objections underlying the decision. This explained and justified why there had been no request corresponding to this submitted in the proceedings at first instance. The request had been submitted at the earliest point of the appeal proceedings and hence could not be considered as being late filed.

In particular the product-by-process formulation and definition of cut-through as the criterion for thermal resistance were directly intended to overcome the findings of the decision.

There could be no question of procedural abuse - a patent proprietor was entitled to adapt the approach by submitting and withdrawing requests as appropriate to the progress of the proceedings, i.e. in the light of the submissions of the opposing party and the position of the opposition division or board.



The combination of features now introduced potentially overcame the substantive objections raised. Hence the request should be admitted.

(b) Auxiliary requests 4, 4a, 4b - admittance

Regarding auxiliary request 4 claim 1 corresponded to claim 1 of the main request with introduction of features from a dependent claim. This was a legitimate approach and had been presented at the earliest point in the appeal proceedings. No claim corresponding to this subject-matter had been submitted at first instance. Auxiliary requests 4a and 4b represented progressive refinements of the feature introduced to auxiliary request 4. Even if auxiliary requests 4a and 4b were indisputably late filed, they refined a single feature which was central to the invention and were directed to overcoming the objections raised. Consequently the presentation of these requests could not be considered as surprising in any way and would not occasion any delay to the proceedings. Therefore auxiliary requests 4, 4a and 4b should be admitted.

(c) Auxiliary request 12 - admittance

This was directed to a dual coat composition. A claim of this nature had never been submitted at first instance and represented a new attempt to create a distinction over the cited prior art documents, and furthermore did not complicate the proceedings. Hence auxiliary request 12 should be admitted.

(d) Auxiliary request 16

This consisted of a single claim and was based on the main request before the opposition division which was found to comply with the requirements of added subject-matter, clarity and sufficiency of disclosure with an amendment to overcome the objections of lack of novelty. No new issues arose by presentation of this claim, however this did not present an obstacle to the respondent submitting further documents to attack these claims in the further proceedings.

The - undisputed - late filing of this request could be explained by the fact that the appellant had assumed, in the light of the communication of the Board, that the main request would be admitted to the procedure. Therefore auxiliary request 16 should be admitted.

XIII. The arguments of the respondent, as far as relevant to the present decision, can be summarised as follows:

(a) Main request - admittance

The requests had been submitted late in the context of the entire proceedings. The patent proprietor had adopted a plurality of different and non-convergent approaches during the course of the opposition proceedings, inserting and deleting features, at least one set of which was submitted very late.

Many of the features in the present main request had been in earlier requests in the opposition proceedings which were then replaced and so were

not in the claims ultimately decided upon.

Thus no decision was possible at first instance on certain of the features now present in the claims on appeal.

The appeal was thus directed not to overturning the decision but adopted an alternative route, i.e. in effect changed the case to be answered.

In the context of the appeal proceedings there was no justification for withdrawing in toto the previous requests and submitting completely different requests containing features which had previously been present in the course of the opposition proceedings but then removed. In view of this the main request should not be admitted.

(b) Auxiliary requests 4, 4a, 4b - admittance

The same arguments applied as for the main request since these three requests were based on the same features as the main request, i.e. features which had been variously advanced then withdrawn during the course of the opposition proceedings.

Auxiliary requests 4a and 4b were even later and should not be admitted under the provisions of Article 13(1) RPBA.

(c) Auxiliary request 12

A claim directed to dual coat systems had only been submitted during the opposition proceedings in a request filed two days before the oral proceedings before the opposition division which had not been admitted into the proceedings. It represented an

entirely new approach, as during opposition proceedings claims directed to a single coat composition had been advanced. On this basis auxiliary request 12 should not be admitted.

(d) Auxiliary request 16

This request contained a collocation of features never before presented in the proceedings and consequently a modification to the necessary argumentation at the latest possible stage. In particular the request did not represent a combination of features or requests hitherto considered potentially necessitating a new approach and new documents. Accordingly it should not be admitted under Article 13(1) and (3) RPBA.

XIV. The appellant requested that the decision under appeal be set aside, that one of the sets of claims of the main request or auxiliary request 4 filed with the statement of grounds of appeal, of auxiliary requests 4a or 4b filed with the letter of 26 November 2018, or of auxiliary request 12 filed with the statement of grounds of appeal, be found to meet the requirements of Articles 54, 84 and 123(2) EPC and Rule 80 EPC, and that the case be remitted to the department of first instance on this basis. Alternatively it was requested that auxiliary request 16 be admitted into the proceedings and the case be remitted to the department of first instance for examination of compliance of auxiliary request 16 with the requirements of the EPC.

XV. The respondent requested that the appeal be dismissed and that none of the appellant's requests be admitted into the proceedings.  
It further requested that if auxiliary request 16 be

admitted into the proceedings and were found to meet the requirements of Articles 84 and 123(2) EPC, the case be remitted to the department of first instance for further prosecution and a different apportionment of costs be ordered.

## **Reasons for the Decision**

### 1. Main request - admittance

Under Article 12(4) RPBA the Board *inter alia* has the power to hold inadmissible requests which in spite of having been filed with the statement of grounds of appeal could have been presented in the first instance proceedings. This provision is therefore relevant for the main request which was filed at that stage.

#### 1.1 Claim 1 of the main request includes most limitations in claim 1 of the main request and auxiliary request 2 filed with the reply to the notice of opposition (addition of the nanomaterial prior to application of the wire enamel, enhanced cut-trough value as improved thermal property, nanomaterials restricted to nanoalumina), which requests were later withdrawn, together with a limitation included for the first time in the main request filed two days before the oral proceedings before the opposition division (the definition of the polyamideimide in product-by-process terms), which request was not admitted due to its late filing.

Of all these amendments only the limitation to nanoalumina was present in claim 1 according to the requests decided upon by the opposition division, all other amendments not having been further pursued.

1.2 It is clear therefore that in spite of the fact that all amendments had already been taken into consideration by the appellant in opposition proceedings, most of them were not pursued, so that the opposition division not only could not take a decision on a request in the current form, but could not even take position on the relevance and the criticality of the features which are now reinserted.

This is due to a deliberate choice of the appellant, who decided to withdraw all requests filed with the reply to the notice of opposition and filed new ones at such a late stage (two days before the oral proceedings) that they were not admitted.

The impossibility for the opposition division to decide both on a request in the current form and on the relevance and criticality of most of the features now inserted is therefore the direct consequence of the deliberate strategy of the appellant.

Moreover, the Board fails to see the main request as a legitimate and appropriate reaction to the decision, as it combines features which were already considered by the appellant, but no longer maintained in the requests on which the opposition division was called to decide.

In view of this the Board comes to the conclusion that, if the appellant intended to defend the patent in the current form, it not only could, but should have done so already before the opposition division.

1.3 On this basis the Board considers it appropriate to make use of its power under Article 12(4) RPBA to hold the main request inadmissible.

2. Auxiliary requests 4, 4a, 4b - Admittance

2.1 Claim 1 of auxiliary request 4, which was also filed with the statement of grounds of appeal, corresponds to claim 1 of the main request with the addition of a feature taken from a dependent claim (treatment of the nanoaluminas by coupling agents) which was never considered in opposition and whose relevance to overcoming the objections maintained in the decision was not explained in the statement of grounds of appeal.

The situation therefore is the same as for the main request with the further deficiency that the appellant failed to provide reasons for the further amendment contrary to the stipulations of Article 12(2) RPBA.

Therefore for at least the same reasons as detailed for the main request the Board considers it appropriate to make use of its power under Article 12(4) RPBA to hold auxiliary request 4 inadmissible.

2.2 Auxiliary requests 4a and 4b were filed with letter of 26 November 2018 after oral proceedings had been summoned by the Board and a communication had been sent to the parties. Their admittance therefore falls under the discretion of the Board according to Article 13 RPBA.

The Board can find no justification for such a late filing, in particular as no new objections were raised in the communication of the Board, but only a preliminary opinion was given.

Moreover, claim 1 according to those requests corresponds to claim 1 of auxiliary request 4 with further limitations (a list of specific coupling agents and quantity ranges for the different components) which were never submitted in opposition and appeared for the first time in appeal.

As the criteria for admitting late filed requests become stricter as long as the proceedings advance and no justification for the late filing has been provided or can be found, the Board in view of the reasons already outlined for the previous requests finds it appropriate to exercise its discretion under Article 13(1) RPBA by not admitting auxiliary requests 4a and 4b into the proceedings.

3. Auxiliary request 12 - Admittance

- 3.1 Claim 1 of auxiliary request 12, which was filed with the statement of grounds of appeal, corresponds to claim 1 of the main request with the addition of a further feature (a "dual coat" system) which was only introduced in auxiliary request 2 filed two days before the oral proceedings before the opposition division and not admitted by the opposition division as late filed.

The situation is therefore the same as for the main request, and exacerbated by the introduction of a feature which runs contrary to the line defended in all requests filed with the reply to the notice of opposition (all limited to "single coat" wire enamel) and also decided upon by the opposition division (the main request was not limited in this respect, but auxiliary request 1 related to "single coat" wire enamel) and therefore represents a complete change of approach in appeal.



3.2 In view of this and of the reasons given for the main request the Board considers it appropriate to make use of its power under Article 12(4) RPBA to hold auxiliary request 12 inadmissible.

4. Auxiliary request 16 - Admittance

4.1 Auxiliary request 16 was only filed at the oral proceedings before the Board after the decision had been announced that the previous requests had not been admitted.

The Board can find no justification for such a late filing, as the decision on admittance of the previous requests by the Board follows a request of the respondent which was already submitted with the reply to the statement of grounds of appeal.

Moreover, also auxiliary request 16 proposes a new combination of features which was never defended before the opposition division. In particular claim 1 of auxiliary request 16 corresponds to claim 1 of the main request decided upon by the opposition division with the limitation that the nanomaterial is treated with a coupling agent (as in auxiliary request 4 filed with the statement of grounds of appeal for which no reason for the amendment was given) and the specification of a list of coupling agents (as in auxiliary request 4a filed only after the summons to oral proceedings and the communication of the Board).

The presence of a new combination of features never proposed in this form would put both the Board and the opposing part in the situation of not being able to deal with it without adjournment of the oral

proceedings (as confirmed by the request of both parties to remit the case if the request is admitted).

4.2 In view of this the Board decides under Article 13(1) and (3) RPBA not to admit auxiliary request 16 into the proceedings.

5. As none of the appellant's requests is admitted into the appeal proceedings the appeal is to be dismissed.

### **Order**

### **For these reasons it is decided that:**

The appeal is dismissed.

The Registrar:

The Chairman:



B. ter Heijden

D. Semino

Decision electronically authenticated