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**Datasheet for the decision  
of 6 March 2019**

**Case Number:** T 1146/17 - 3.3.05

**Application Number:** 09007575.5

**Publication Number:** 2135852

**IPC:** C04B41/49, C08G18/10,  
C09J175/00

**Language of the proceedings:** EN

**Title of invention:**

A sealing composition, a method for preparing a sealing composition and the use of such a sealing composition

**Patent Proprietor:**

Bona GmbH Deutschland

**Opponents:**

Wacker Chemie AG  
Uzin Utz AG  
Henkel AG & Co. KGaA

**Headword:**

Sealing composition/Bona

**Relevant legal provisions:**

EPC Art. 83  
EPC R. 103(1)(a)

**Keyword:**

Sufficiency of disclosure - (yes)  
Reimbursement of appeal fee - (no)

**Decisions cited:**

T 0541/09, T 0030/15

**Catchword:**



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Case Number: T 1146/17 - 3.3.05

**D E C I S I O N**  
**of Technical Board of Appeal 3.3.05**  
**of 6 March 2019**

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**Decision under appeal:**      **Decision of the Opposition Division of the  
European Patent Office posted on 23 March 2017  
revoking European patent No. 2135852 pursuant to  
Article 101(3) (b) EPC.**

**Composition of the Board:**

**Chairman**                    E. Bendl  
**Members:**                 S. Besselmann  
                                  R. Winkelhofer

## **Summary of Facts and Submissions**

- I. The present appeal lies from the decision of the opposition division to revoke European patent No. 2 135 852. The patent in suit concerns a sealing composition.
- II. The opposition division found that the patent in amended form according to the main request and auxiliary requests 1-5 lacked sufficiency of disclosure (Article 83 EPC).
- III. In the decision under appeal, *inter alia*, an experimental report (D5P) submitted by the patent proprietor during opposition proceedings was referred to.
- IV. With its appeal, the patent proprietor (appellant) maintained the main request and auxiliary requests 1-5 as filed during opposition proceedings, and additionally explained that its right to be heard had been violated, requesting a reimbursement of the appeal fee.
- V. Opponents 1-3 (respondents 1-3) filed replies to the appeal.
- VI. Oral proceedings were held on 6 March 2019. Respondents 1 and 3 did not attend the oral proceedings.
- VII. The independent claims of the main request relate to a sealing composition (claim 1), a method for preparing it (claim 6) and its use (claim 12). These claims read as follows:

"1. Sealing composition comprising

- a) an alkyltriethoxysilane in an amount of 1 to 10 percent by weight (wt-%);
- b) an aminosilane preferably in an amount of 1 to 5 percent by weight (wt-%);
- c) optional silica preferably in an amount of up to 50 percent by weight (wt-%) and/or pyrogenic silica preferably in an amount of 0.1 to 30 percent by weight (wt-%);
- d) a silane functional polymer with a molecular weight in the range of 500 to 20000 g/mol;
- e) optional a catalyst in an amount of 0 to 2 percent by weight (wt-%) and
- f) calcium and/or magnesium carbonate preferably in an amount up to 50 percent by weight (wt-%)."

"6. Method for preparing a sealing composition according to claim 1 comprising the following steps:

- a) mixing the components
  - i) an alkyltriethoxysilane,
  - ii) an aminosilane,under protective gas (argon, nitrogen) for 10 min;
- b) then adding
  - iii) a precipitated calcium carbonate,
  - iv) silica, and/or pyrogenic silica;
- c) mixing under static vacuum to a temperature up to 50 to 80 °C preferably by heating or agitation;
- d) then adding the silane functional polymer preferably without fillers, and continuing the mixing procedure under vacuum;
- e) then adding the catalyst;
- f) continuing mixing under vacuum for another 1 to 5 minutes;
- g) filling the ready mixed material in buckets, bags or other containers."

*"12. Use of the sealing composition according to any one of claims 1 to 5 for sealing building materials, in particular for sealing of cement based floors, such as floors constructed of concrete."*

VIII. The appellant's arguments, as far as relevant for the present decision, may be summarised as follows:

The molecular weight would have been understood as the number average molecular weight and was not an essential feature. The claimed compositions differed from known compositions only in the nature of component (a). The functions of the other components were generally known, and standard formulations were available. The invention could therefore be carried out without undue burden.

The right to be heard had been violated because key arguments of the opposition division's reasoning, which had led the opposition division to deviate from its provisional opinion, had not been discussed during the oral proceedings. This concerned specifically the arguments referring to the vast number of experiments necessary representing an undue burden.

IX. The respondents' arguments, as far as relevant for the present decision, may be summarised as follows:

How to determine the molecular weight of the silane functional polymer (component d) was not known. In line with T 541/09, it was therefore not possible to identify a suitable silane functional polymer, which was an essential feature of the invention. The reference to commercial materials by their trademarks in paragraph [0029] of the patent specification did not

remedy this deficiency because the properties of these materials were not known and could be changed over time.

Moreover, the application only provided some details regarding the individual components but contained no single specific example of a composition.

It was therefore not possible to reproduce the invention and obtain the desired effects of the invention without undue burden.

The appellant's experimental report D5P showed that the invention as originally disclosed could not be carried out across its whole scope. D5P constituted a verifiable fact. For this reason, and in view of the decision taken by the opposition division, the burden of proof was now on the appellant to demonstrate that the invention had been sufficiently disclosed. In this regard, reference was made to T 30/15

The right to be heard had not been violated.

- X. The appellant requests that the decision under appeal be set aside and that the patent be maintained on the basis of the main request or, alternatively, one of auxiliary requests 1-5, all filed on 7 August 2015. In addition, it requests reimbursement of the appeal fee.

Respondents 1-3 request that the appeal be dismissed.



## Reasons for the Decision

### *Main request*

1. Sufficiency of disclosure
  - 1.1 The claimed invention relates to a sealing composition, its method of preparation and its use. The sealing composition is defined as comprising components (a), (b), (d) and (f), optionally, also (c) and (e). The respondents' objections, *inter alia*, concern component (d), defined as silane functional polymer with a molecular weight in the range of 500 to 20000 g/mol.

The application as filed neither specifies whether the molecular weight is, for example, the number or weight average. Nor does it describe the associated measuring method. It is undisputed that different molecular weight definitions and measuring methods may lead to different results.

However, in the present case, this is a question of clarity rather than sufficiency of disclosure. There is no indication that the skilled person would have needed to determine the molecular weight using a specific method to provide the claimed sealing composition. There is also no indication that precise control of the molecular weight would have been necessary to carry out the invention.

The present case therefore differs from T 541/09 cited by respondent 2, where the absence of a measuring method for the weight average molecular weight had the consequence that the claimed process could not be

controlled to result in a molecular weight within the required, narrow range.

Moreover, the skilled person is taught in the granted patent that functional polymers, having the required molecular weight, are commercially available from various suppliers (see paragraph [0029] of the patent specification). While the commercial materials are referred to by their trademarks, there is no indication that the reproduction of the invention would have depended on the use of a specific proprietary product. Hence, the question whether the composition or availability of such a proprietary product might change over time is not relevant in the present case.

Thus, the skilled person would have been able to provide component (d).

- 1.2 The other components defined in claim 1 are also commercial materials and thus would have been readily available to the skilled person (paragraphs [0030], [0033], [0035], [0036], and [0038] of the patent specification).
- 1.3 Even without a specific working example illustrating the claimed composition, there can be no doubt that the skilled person would have been able to combine, for example, mix, the individual components to provide the claimed composition.
- 1.4 It was argued with reference to D5P that the invention could not have been carried out across the entire scope of the claim. Specifically, D5P was said to show that the use of methoxysilanes as component (a) was unsuitable for carrying out the invention but that this had not been disclosed on the filing date.

However, the invention as presently claimed is limited to compositions comprising an alkyltriethoxysilane as component (a).

Moreover, D5P was filed in support of arguments relating to inventive step and aims to show beneficial effects, in terms of improved rheological properties, associated with the selection of a specific component (a).

Whether such beneficial effects are obtained may be an issue of inventive step. However, in the present case, it is not relevant for sufficiency of disclosure of the claimed composition. This also applies to whether a certain beneficial effect, or the role of a specific component for such an effect, was foreshadowed in the application as filed. The claimed composition is merely required to be a sealing composition.

The examples of D5P therefore do not constitute any evidence that it may not have been possible to carry out the invention across the entire scope of claim 1. To the contrary, the examples of D5P which relate to a composition of present claim 1, including an alkyltriethoxysilane, rather support the conclusion that the claimed sealing composition could have been provided and that the invention could have been carried out.

- 1.5 While claim 1 does encompass a huge number of possible compositions, there is consequently no indication or proof that the invention could not have been carried out across the entire scope of the claim and that the skilled person would have needed to conduct a research programme to provide the sealing compositions of

claim 1 or would have been faced with other undue burden.

- 1.6 Respondent 2 has also argued that the burden of proof had shifted to the appellant to show that the invention had been sufficiently disclosed. In this respect, it relied on T 30/15. Additionally, the respondent stressed that D5P constituted a verifiable fact demonstrating lack of sufficiency of disclosure.

T 30/15 deals in the first place with an appellant's obligations to present its complete case in the statement of grounds of appeal and to set out all the reasons why the decision under appeal should be reversed (Article 12(2) RPBA). In the present case, the appellant has complied with these obligations. Even assuming that, nevertheless, the question of burden of proof arose, there were no substantive argument or verifiable fact that would justify its shift to the appellant. Experimental report D5P - as outlined above - does not support the alleged conclusion of lack of sufficiency of disclosure (see point 1.4).

- 1.7 For the reasons indicated, the skilled person would have been able to provide the sealing compositions according to claim 1 based on the disclosure of the application as filed and common general knowledge.
- 1.8 There have been no objections specific to the method of claim 6 or the use defined in claim 12. There is no apparent reason why the skilled person would not have been able to carry out the method of claim 6 or use the claimed sealing composition in accordance with claim 12 or the subject-matter defined in the dependent claims.

- 1.9 Thus, the invention has been sufficiently disclosed (Article 83 EPC).

*Reimbursement of the appeal fee*

2. Alleged procedural violation

2.1 It is undisputed that the issue of sufficiency of disclosure had been discussed during opposition oral proceedings. What the appellant criticised was that key arguments of the opposition division's reasoning, in its opinion, had not been discussed. These arguments were considered crucial because they had led the opposition division to deviate from their provisional opinion. The appellant therefore sees its right to be heard violated and requests a refund of the appeal fee.

2.2 The appellant's objection concerned specifically the part of the reasoning referring to the vast number of experiments necessary, representing an undue burden in the opposition division's view, as set out on page 11 of the opposition division's decision, last two paragraphs, and page 12, first paragraph.

2.3 The minutes of oral proceedings before the opposition division ("minutes") show that sufficiency of disclosure has been extensively discussed. Whether the skilled person would be faced with an undue burden was addressed (see page 4 of the minutes, lines 24-26). The central aspects in this regard were alleged difficulties linked to the identification of suitable silane functional polymers for use as component (d). Reference was also made to the enormous number of possibilities of this component (see page 4 of the minutes, lines 16-17).

2.4 The criticised part of the decision under appeal refers to the need for over 500,000 experiments and takes into consideration the number of choices linked to the multi-component nature of the composition.

2.5 The board agrees that the criticised part of the decision under appeal thus involves a shift of focus to the multi-component nature of the composition, of which component (d) is merely one component. However, the essence remains the same, namely, that a high number of experiments is necessary, which is considered an undue burden. The difficulties linked to the identification of a suitable component (d) remain an essential element of the reasoning, see item 2 of the decision under appeal. The specific reference to 500,000 experiments merely serves to illustrate the "enormous number of possibilities".

Therefore, no substantial procedural violation has occurred which would justify a reimbursement of the appeal fee.

*Remittal of the case*

3. The appealed decision solely concerned arguments with regard to sufficiency of disclosure. To give the parties the opportunity to present their case before two instances, the board exercises its discretion according to Article 111(1) EPC and remits the case to the opposition division for continuation of the procedure, as requested by the appellant.

**Order**

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

The decision under appeal is set aside. The case is remitted to the department of first instance for further prosecution.

The Registrar:

The Chairman:



C. Vodz

E. Bendl

Decision electronically authenticated