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**Datasheet for the decision
of 13 April 2021**

Case Number: T 1502/17 - 3.3.02

Application Number: 11729649.1

Publication Number: 2582234

IPC: A01N33/12, A01N43/653,
B27K3/52, A01P3/00, A01N59/20

Language of the proceedings: EN

Title of invention:

WOOD PRESERVATIVE COMPOSITIONS USEFUL FOR TREATING COPPER-
TOLERANT FUNGI

Patent Proprietor:

Arch Timber Protection Limited

Opponents:

BASF Wolman GmbH
Koppers Performance Chemicals Inc.
Marek, Frank

Headword:

Relevant legal provisions:

EPC Art. 84, 111(1), 123(2)
RPBA Art. 11, 12(4)

Keyword:

Admittance - claim request filed with the statement of grounds of appeal (yes)

Decisions cited:

G 0003/14

Catchword:



Beschwerdekammern

Boards of Appeal

Chambres de recours

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Case Number: T 1502/17 - 3.3.02

D E C I S I O N
of Technical Board of Appeal 3.3.02
of 13 April 2021

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Decision under appeal: **Decision of the Opposition Division of the
European Patent Office posted on 26 April 2017
revoking European patent No. 2 582 234 pursuant
to Article 101(3) (b) EPC**

Composition of the Board:

Chairman M. O. Müller
Members: P. O'Sullivan
 M. Blasi

Summary of Facts and Submissions

- I. The appeal of the patent proprietor (hereinafter appellant) lies from the decision of the opposition division to revoke European patent 2 582 234.
- II. Three opponents filed notices of opposition against the patent, invoking Article 100(a) (novelty and inventive step), (b) and (c) EPC.

In its decision the opposition division held *inter alia* that the claims of the (then) main request and auxiliary requests 1 and 2 contravened the requirements of Article 123(2) EPC.

- III. With the statement of grounds of appeal, the appellant filed sets of claims of a main request and auxiliary requests 1-9.
- IV. Replies to the statement of grounds of appeal were submitted by opponents 1 and 2 (hereinafter respondents 1 and 2).

Opponent 3 (respondent 3) did not file any submissions nor requests in appeal proceedings.

- V. With the communication pursuant to Article 15(1) RPBA the board set out its preliminary opinion. With regard to the main request (then: auxiliary request 4) the board noted the admittance thereof into the proceedings would depend on an assessment of the circumstances during opposition proceedings.
- VI. With the letter of 3 March 2021 the appellant filed sets of claims of a new main request and auxiliary

request 1 which were identical to auxiliary requests 4 and 2, respectively, filed with the statement of grounds of appeal. The main request and auxiliary request 1 filed with the statement of grounds of appeal were withdrawn.

VII. Oral proceedings scheduled in line with the corresponding requests of the parties were held on 13 April 2021 by videoconference in the absence of any objections by the parties. They took place in the presence of the appellant and respondents 1 and 2 and in the absence of respondent 3, who had stated with the letter of 10 December 2020 that he would not attend oral proceedings. During oral proceedings the appellant withdrew auxiliary requests 6-9 filed with the statement of grounds of appeal.

VIII. Requests

The appellant requested that the decision under appeal be set aside and that the board find the claims

- of the main request or auxiliary request 1 filed with letter dated 3 March 2021, or alternatively,
- of auxiliary request 2 underlying the appealed decision, or further alternatively,
- of auxiliary requests 3 or 5, both filed with the statement of grounds of appeal

to fulfil the requirements of Article 123(2) EPC. If one of those claim requests complied with Article 123(2) EPC, it requested remittal of the case to the opposition division for further prosecution.

Respondents 1 and 2 requested that the appeal be dismissed.

Respondent 1 requested that the main request filed with letter dated 3 March 2021 (auxiliary request 4 filed with the statement of grounds of appeal), and auxiliary requests 3 and 5 filed with the statement of grounds of appeal, not be admitted into the proceedings.

Respondent 2 requested that the main request and auxiliary request 1 filed with letter dated 3 March 2021 (auxiliary requests 4 and 2, respectively, filed with the statement of grounds of appeal), and auxiliary requests 3 and 5 filed with the statement of grounds of appeal, not be admitted into the proceedings, or alternatively, if admitted, and if the board decided that one or more of the claim requests met the requirements of Article 84 and Article 123(2) EPC, that the case be remitted to the opposition division to consider the issues of sufficiency of disclosure, novelty and inventive step.

Respondent 2 also requested that the board order acceleration of the proceedings before the opposition division.

IX. Independent claim 1 of the main request reads as follows:

"1. A method for protecting wood from decay by copper-tolerant fungi, comprising applying thereto a biocidal copper compound, a 1,2,4-triazole compound and a salt containing a didecyl quaternary ammonium cation; wherein the biocidal copper compound is selected from basic copper (II) carbonate, copper (II) acetate, copper (II) sulphate pentahydrate, copper (II) oxide, copper (I) oxide, copper HDO, and copper pyrrithione."

- X. The arguments of the respondents, insofar as relevant to the present decision, may be summarised as follows:

The main request was not to be admitted into the proceedings pursuant to Article 12(4) RPBA 2007 since it should have been filed in the proceedings before the opposition division.

- XI. The arguments of the appellant, insofar as relevant to the present decision, may be summarised as follows:

The main request was to be admitted into the proceedings. It was aimed at overcoming objections which had first been raised during oral proceedings before the opposition division.

Reasons for the Decision

Main request

1. Admittance - Article 12(4) RPBA 2007

- 1.1 The set of claims of the main request was first submitted with the appellant's statement of grounds of appeal as auxiliary request 4, and subsequently refiled as main request with the letter dated 3 March 2021.

Under Article 12(4) RPBA 2007, which applies to the present case according to Article 25(2) RPBA 2020, the board has the power to exclude from the proceedings *inter alia* requests which could have been presented in opposition proceedings even though they were submitted with the statement of grounds of appeal or the reply,

relate to the case under appeal and meet the requirements of Article 12(2) RPBA 2007.

- 1.2 The respondents were of the view that the main request could and should have been submitted during opposition proceedings, at the latest during oral proceedings before the opposition division. It was therefore not to be admitted into proceedings.

The appellant argued to the contrary that the circumstances were such that it could not reasonably have been expected to submit the claims of the present main request during opposition proceedings.

- 1.3 For the assessment of whether the main request could and should have been filed in opposition proceedings, the following details of the procedural history of the case were considered relevant by the board.

- 1.3.1 With the reply to the notices of opposition dated 14 June 2016, the appellant filed sets of claims of a new main request and auxiliary request 1. Claim 1 of the (then) main request reads as follows:

*"1. A method for protecting wood ~~or other cellulosic material~~ from decay by copper-tolerant fungi, comprising applying thereto a biocidal ~~metal~~ **copper** compound, a 1,2,4-triazole compound and a salt of a didecyl quaternary ammonium cation."* (strike through and bold text representing deletion and addition, respectively, compared to claim 1 of the application as filed)

Claim 1 of the (then) auxiliary request 1 reads as follows:

"1. A method for protecting wood ~~or other cellulosic material~~ from decay by copper-tolerant fungi, comprising applying thereto **an aqueous formulation comprising** a biocidal ~~metal~~ **copper** compound, a 1,2,4-triazole compound and a salt of a didecyl quaternary ammonium cation." (strike through and bold text representing deletion and addition, respectively, compared to claim 1 of the application as filed)

- 1.3.2 In the communication accompanying the summons to oral proceedings dated 1 August 2016, the opposition division stated that it had no objections under Article 123(2) EPC with regard to the (then) first auxiliary request.
- 1.3.3 With the letter dated 6 February 2017 (page 1), respondent 2 objected that claim 1 of the (then) first auxiliary request failed to meet the requirements of Article 123(2) EPC on the grounds that the amendment "an aqueous formulation comprising a biocidal copper compound, a 1,2,4-triazole compound and a salt of a didecyl quaternary ammonium cation" did not find basis in the relevant passage of the application as filed cited by the appellant (page 10, lines 12-15). Specifically, the respondent objected that
- in contrast to the cited passage, the claims were not limited to the use of an emulsified formulation of 1,2,4-triazole; and
 - the cited passage had no requirement for the final formulation to contain water, as implied by the term "aqueous" in the claim.

- 1.3.4 With the letter of the appellant also dated 6 February 2017, the above main request was withdrawn, and a set of claims of a new main request was filed in which independent claim 1 was identical to claim 1 of the above auxiliary request 1 (letter, point 7). Further sets of claims of auxiliary requests 1-9 were also filed. The respective independent claim 1 of auxiliary requests 1-7 was identical to claim 1 of the new main request, while independent claim 1 of the respective auxiliary requests 8 and 9 was limited by reference to specific fungi from which the wood was protected. For all requests therefore, the respective independent claim 1 recited "an aqueous formulation comprising a biocidal copper compound, a 1,2,4-triazole compound and a salt of a didecyl quaternary ammonium cation".
- 1.3.5 With a further letter dated 27 March 2017, the appellant filed a set of claims of auxiliary request 10 in response to the objection of respondent 2 under Article 123(2) EPC submitted with the letter dated 6 February 2017. Independent claim 1 of this request was identical to independent claim 1 of auxiliary request 1 filed with the reply to the notices of opposition dated 14 June 2016 (*supra*) with the exception that the term "an emulsified" was added preceding "1,2,4-triazole". Further arguments were submitted rebutting both objections submitted by respondent 2 under Article 123(2) EPC (*supra*).
- 1.3.6 Oral proceedings before the opposition division took place on 4 April 2017. Although during oral proceedings the appellant withdrew the main request filed with the letter dated 6 February 2017, replacing it with auxiliary request 1 as filed with the same letter, the respective independent claim 1 was identical (minutes

of oral proceedings, 2.1). Thus, claim 1 of the (then) main request in oral proceedings was identical to claim 1 of auxiliary request 1 filed with the reply to the notices of opposition with the letter dated 14 June 2016, recited above.

1.3.7 The opposition division concluded in oral proceedings that the main request did not fulfill the requirements of Article 123(2) EPC. After the chairman mentioned that the same objection would appear to apply to auxiliary requests 2-9 on file, said requests were withdrawn by the appellant, and a set of claims of a new auxiliary request 1 was filed in which independent claim 1 was identical to independent claim 1 of auxiliary request 10 filed with the letter of 27 March 2017 (see annex to the contested decision).

1.3.8 According to the contested decision (section 3.4), claim 1 of auxiliary request 1 did not meet the requirements of Article 123(2) EPC vis à vis the passage cited as basis therefor (page 10, lines 12-15 of the application as filed), *inter alia* for the following reasons:

- (i) the claims did not require the biocidal copper compound to be present in solution, in contrast to the cited passage;
- (ii) the cited passage concerning a method of preparation wherein an emulsified formulation of the 1,2,4-triazole is added to an aqueous solution was not equivalent to the presence of emulsified 1,2,4-triazole in the final formulation - in particular since emulsions did not necessarily remain stable over time.

The corresponding objections underlying reasons (i) and (ii) were raised by the respondents for the first time during oral proceedings before the opposition division (see minutes, points 3.2, 5.2 and 5.3).

1.3.9 Oral proceedings before the opposition division were then adjourned for approximately 40 minutes, after which the appellant filed a set of claims of a new auxiliary request 2 comprising an amended independent claim 1 which attempted to overcome reason (i), above. This request was also found to contravene Article 123(2) EPC for reason (ii) provided for the auxiliary request 1, above, namely that the preparation method with an emulsified formulation was not equivalent to the presence of an emulsified 1,2,4-triazole in the end product.

1.4 The board notes from the foregoing that nothing in the filing behaviour of the appellant during opposition proceedings points to a tactical strategy to delay proceedings as alleged by respondent 2. On the contrary, the facts indicate that the appellant attempted to overcome objections raised, both in written proceedings and during oral proceedings, by way of filing new claim requests in response thereto. With regard to the first of the above-mentioned objections raised for the first time in oral proceedings, the board notes that the expression "an aqueous formulation comprising" was introduced with independent claim 1 of auxiliary request 1 filed with the reply to the notices of opposition, and as noted by the respondents, was present in the independent claim 1 of all further claim requests filed in opposition proceedings. The respondents however waited until the day of oral proceedings to raise the corresponding objection.

In the view of the board, a contradiction arises in the argument of the respondents that the appellant could have devised and submitted the set of claims of the present main request during the short break provided therefor in oral proceedings, while at the same time the respondents themselves raised objections for the first time during oral proceedings which could have been submitted well in advance.

- 1.5 With regard to the reason (ii), the term "emulsified" in claim 1 was first introduced with claim 1 of auxiliary request 10 filed with letter dated 27 March 2017, approximately one week before oral proceedings. Therefore, although raising an objection regarding said term during oral proceedings was justified, the filing of said request only one week before oral proceedings was also justified given that it was submitted as a direct response to the objections raised by respondent 2 with the letter of 6 February 2017 (*supra*).

The appellant was thus confronted with new objections for the first time during oral proceedings. In response to those objections, it filed a further claim request (then auxiliary request 2) during oral proceedings, claim 1 of which also recited "an emulsified 1,2,4-triazole". Despite constituting a reasonable attempt to overcome these objections, the opposition division found the newly filed auxiliary request 2 to contravene the requirements of Article 123(2) EPC. In particular it was only during oral proceedings and with the issuance of the reasoned decision of the opposition division that it became apparent that the cited passage on page 10, lines 12-15 of the application as filed would not be accepted as appropriate basis for a claim reciting a formulation comprising an emulsified

1,2,4-triazole. In view of this, the board understands the rationale of the appellant according to which only at this point in the procedure was it apparent that further considerations were required. In particular, in the view of the board, overcoming said objection was not a straightforward matter which the appellant could have reasonably been expected to achieve at short notice during oral proceedings.

1.6 It is true as argued by the respondents, that in opposition proceedings only claim requests were pursued comprising independent claims reciting the expression "an aqueous formulation comprising", and that by deletion of this expression, the filing of the main request represented a change in the direction pursued by the appellant. However, as set out above, the need for a change in direction was a direct consequence of new objections raised for the first time during oral proceedings before the opposition division, and is therefore justified.

1.7 For these reasons the board concluded that the filing of the (present) main request with the appellant's statement of grounds of appeal constituted an acceptable and legitimate reaction to the circumstances in opposition proceedings, in particular to new developments during oral proceedings before the opposition division.

Hence, in the view of the board, the submission of the the main request during oral proceedings before the opposition division could not reasonably have been expected.

1.8 The respondents also argued that during opposition proceedings, a large number of claim requests were on

file and the respondents could not have been expected to submit objections in writing concerning each and every claim request for each and every issue.

The fact remains however, that the appellant was confronted with new objections during oral proceedings and as set out above, could not reasonably have been expected to file the present main request during those proceedings. Moreover, although there were indeed a number of claim requests on file at the beginning of oral proceedings before the opposition division, most of those requests shared an identical independent claim 1 (e.g. the sets of claims of the main request and auxiliary requests 1-7 filed with the letter of 6 February 2017).

- 1.9 Respondent 1 also submitted that contested claim 1 comprised two amendments compared to the main request underlying the contested decision, namely the deletion of "an aqueous formulation comprising", and the addition of the subject-matter of granted claim 7 concerning the nature of the specific biocidal copper compounds. These amendments were to be treated separately, since only the first was intended to overcome objections relating to Article 123(2) EPC, while the second was not. The complete rephrasing of claim 1 was not to be considered *bona fide*, since compared to the situation in the proceedings before the opposition division, it led to a complete change in the appellant's line of defence.

The appellant argued that the amendments in contested claim 1 of the main request were not to be treated separately, but were linked. Specifically, the deletion of the expression "an aqueous formulation comprising" in claim 1 required a new approach to establish novelty

over prior art under Article 54(3) EPC, and thus the limitation in claim 1 to the subject-matter of granted claim 7 was a necessary consequence of the first amendment.

The board finds the appellants explanation in this regard reasonable and notes in particular that it was not contested by the respondents. Thus, the fact remains that the filing of the set of claims of the main request with the statement of grounds of appeal, as set out above, can only be seen as a reasonable and legitimate reaction to the outcome of the opposition proceedings.

- 1.10 Respondent 1 furthermore submitted that the main request was "based on" a request which had been withdrawn in opposition proceedings (the main request filed on 14 June 2016). According to established case law, claim requests corresponding to requests filed but withdrawn during first instance proceedings should not be admitted into proceedings.

However, the board notes that claim 1 of the main request is different from claim 1 of said withdrawn request in the incorporation therein of claim 7 as granted, and therefore said request cannot be considered to correspond to said withdrawn request. The respondent's argument in this regard is therefore moot.

- 1.11 Having regard to the considerations set out above, the board decided to admit the main request into the proceedings pursuant to Article 12(4) RPBA 2007.

2. Article 123(2) EPC

No objections under Articles 123(2) EPC were raised by the respondents, either in written appeal proceedings or during oral proceedings before the board.

Claim 1 of the main request is directed to a combination of claims 1 and 7 as granted with the following amendments:

- deletion from claim 1 of "or other cellulosic material";
- the insertion of "(II)" between "basic" and "copper carbonate" taken from claim 7; and
- the deletion of "copper (II) hydroxide" from the list taken from claim 7.

The board is of the view that these amendments meet the requirements of Article 123(2) EPC. Since this was not contested by the respondents, there is no need for the board to provide reasons in this regard. Nevertheless, by way of explanation, the board notes that "copper" in "basic copper carbonate" refers exclusively to the copper (II) ion, and the insertion of "(II)" is therefore a mere clarification.

3. Article 84 EPC

No objections under Article 84 EPC were raised by the respondents, either in written appeal proceedings or during oral proceedings before the board.

Since as set out above, the amendments to the main request are based on the claims as granted, the claims may be examined for compliance with the requirements of Article 84 EPC only to the extent that the amendment

introduces a non-compliance (see decision G 3/14, OJ EPO 2015, A102, order).

The board is of the view that no lack of clarity arises from the amendments made with respect to the claims as granted.

The requirements of Article 84 EPC are therefore fulfilled.

4. Remittal - Article 111(1), second sentence, EPC and Article 11 RPBA 2020

In the communication of the board pursuant to Article 15(1) RPBA, in line with the requests of the appellant and respondent 2, the board expressed its intention to remit the case to the opposition division for further prosecution in the event that one of the claim requests on file was found to meet the requirements of Article 123(2) and 84 EPC. As set out above, the board came to the conclusion that the claims of the main request meet these requirements.

During oral proceedings no objections were raised in relation to the board remitting the case to the opposition division. The board notes also that the contested decision dealt solely with the issue of compliance with Article 123(2) EPC and that none of the further grounds for opposition raised with the notices of opposition were addressed therein. Furthermore, none of the written submissions filed by the parties in appeal proceedings, in particular also those of respondent 1 which did not request remittal, addressed said further grounds. Consequently, the board had no basis on which to consider said further grounds, and accordingly decided to remit the case to the opposition

division for further prosecution pursuant to Article 11 RPBA 2020.

5. Acceleration of proceedings before the opposition division

At the oral proceedings, respondent 2 further requested that the board order acceleration of the proceedings before the opposition division on the grounds that without acceleration, continued opposition proceedings and possible subsequent appeal would lead to an excessively long duration of the proceedings before the EPO.

The board decided to reject this request.

According to Article 10(2)(a) EPC, the President of the European Patent Office is *inter alia* responsible for the adoption of internal administrative instructions, including the Guidelines for Examination, which *inter alia* address the acceleration of opposition proceedings.

The board considers it therefore as being for the opposition division to decide on whether or not to accelerate the proceedings before it, either *ex officio* or upon a reasoned request submitted to it by one of the parties.

Order

For these reasons it is decided that:

1. The decision under appeal is set aside.
2. The case is remitted to the opposition division for further prosecution on the basis of claims 1 to 9 of the main request filed with letter dated 3 March 2021.

The Registrar:

The Chairman:



N. Maslin

M. O. Müller

Decision electronically authenticated