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**Datasheet for the decision  
of 4 August 2020**

**Case Number:** T 2839/19 - 3.3.03

**Application Number:** 12198249.0

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C03C17/28, F16L59/02,  
F16L59/14, C09D167/04

**Language of the proceedings:** EN

**Title of invention:**

Binders and materials made therewith

**Applicant:**

Knauf Insulation GmbH

**Relevant legal provisions:**

EPC Art. 123(2), 84, 111(1)

**Keyword:**

Amendments - allowable (yes)  
Claims - clarity - main request (yes)  
Appeal decision - remittal to the department of first instance  
(yes)



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Case Number: T 2839/19 - 3.3.03

**D E C I S I O N**  
**of Technical Board of Appeal 3.3.03**  
**of 4 August 2020**

**Appellant:** Knauf Insulation GmbH  
(Applicant) One Knauf Drive  
Shelbyville, IN 46176-1496 (US)

**Representative:** ARC-IP  
ARC-IP sprl  
Rue Emile Francqui 4  
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**Decision under appeal:** **Decision of the Examining Division of the  
European Patent Office posted on 23 April 2019  
refusing European patent application No.  
12198249.0 pursuant to Article 97(2) EPC.**

**Composition of the Board:**

**Chairman** M. C. Gordon  
**Members:** D. Marquis  
W. Ungler

## **Summary of Facts and Submissions**

- I. The appeal lies with the decision of the examining division posted on 23 April 2019 to refuse the application number 12 198 249.0.
- II. Claim 1 of the application as filed read:
- "1. A composition comprising a collection of matter and a binder, the binder comprising melanoidin products of a dehydrated reaction between a carbohydrate and an amine base, the melanoidin products being cross-linked with a polycarboxylic acid".
- III. The decision was based on a main request and on a first to third auxiliary requests filed on 6 November 2018 as well as on the fourth to fifth auxiliary requests filed during the oral proceedings before the opposition division on 6 December 2018.
- IV. The decision of the examining division, as far as it is relevant to the present appeal proceedings, can be summarized as follows:
- (a) The passage on page 4 of the divisional application as filed mentioning the manufacture of fiberglass insulation products disclosed a binder comprising an ammonium salt of a polycarboxylic acid and a reducing sugar carbohydrate. That passage did not form a valid basis for the binder defined in claim 1 of the main request as comprising an amine and a carbohydrate. The main request did not meet the requirements of Article 123(2) EPC.

(b) Since claim 1 of auxiliary requests 1-3 defined the same binder as the main request, these auxiliary requests too failed to meet the requirements of Article 123(2) EPC.

(a) While the amendments made to claim 1 of auxiliary request 4 met the requirements of Article 123(2) EPC, the dependent claims did not find a basis in the application as filed. In particular, the definition of the amount in fiberglass found on page 4 concerned a fiberglass mat that was not a feature of the present set of claims. Also, the passage on page 17 of the divisional application as filed did not form a valid basis for claim 13 of auxiliary request 4.

V. The applicant (appellant) lodged an appeal against that decision and submitted a main request as well as the first to fifth auxiliary requests. These requests were later withdrawn during the oral proceedings before the Board and were replaced by a new main request containing only one claim that read:

"1. A material comprising: a collection of matter; and a binder disposed on the matter; wherein:  
- the material is formaldehyde free;  
- the binder consists of (i) at least two Maillard reactants and (ii) a silicon-containing compound; and  
- the collection of matter includes glass fibers".

VI. The arguments of the appellant can be summarized as follows:

Main request

- (a) The wording of claim 1 of the new main request corresponded word for word to that used in the description on page 55, lines 12-16 of the application as filed. The main request met the requirements of Article 123(2) EPC.

VII. The appellant requested that the decision under appeal be set aside and that the case be remitted to the examining division for further prosecution.

### **Reasons for the Decision**

Main request

2. Admittance of the main request

2.1 The main request filed by the appellant at the oral proceedings before the Board contains only one claim that corresponds to claim 1 of the fourth auxiliary request submitted with the statement of grounds of appeal, the dependent claims of that request having been deleted to solve an objection of lack of basis in the application as filed. The Board has no objection against the admittance of the main request which is based on the fourth auxiliary request that was already in the proceedings.

3. Article 123(2) EPC

3.1 The wording of claim 1 of the main request corresponds to the wording of the passage on page 55, lines 12-16 of the application as filed disclosing, as feature 23, a material comprising a collection of matter; and a binder disposed on the matter; wherein the material is

formaldehyde free; and the binder includes (i) at least two Maillard reactants and (ii) a silicon-containing compound.

3.2 That passage of the description as originally filed also defines feature 24 by reference to the previous feature 23 as a material wherein the collection of matter includes glass fibers. Claim 1 of the main request therefore finds a basis in the application as filed. The main request meets the requirements of Article 123(2) EPC.

3.3 The requirements of Article 84 EPC are also met.

4. Remittal to the examining division

4.1 The examining division's decision in respect of the fourth auxiliary request, i.e. that on which the current request is based, considered only Article 123(2) EPC. Novelty and inventive step still have to be examined and the board notes that a number of documents have been cited in the search report. Although there is no absolute right to have an issue decided upon by two instances, it is also not the function of the board to consider and decide upon issues which have not been examined at all by the department of first instance. Considering the request for remittal of the appellant, the board finds it appropriate to exercise its discretion under Article 111(1) EPC and remit the case to the first instance for further prosecution.

## Order

### For these reasons it is decided that:

1. The decision under appeal is set aside.
2. The case is remitted to the Examining Division for further prosecution.

The Registrar:

The Chairman:



B. ter Heijden

M. C. Gordon

Decision electronically authenticated