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**Datasheet for the decision
of 27 September 2022**

Case Number: T 1162/20 - 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:

1. Wacker Chemie AG
2. Uzin Utz AG
3. Henkel AG & Co. KGaA

Headword:

Sealing composition/Bona

Relevant legal provisions:

RPBA 2020 Art. 13(1)
EPC Art. 123(3), 123(2), 111(1)

Keyword:

Amendment to appeal case - exercise of discretion
Amendments - broadening of claim (no) - extension beyond the
content of the application as filed (no)
Appeal decision - remittal to the department of first instance
(yes)

Decisions cited:

T 1360/11

Catchword:



Beschwerdekammern

Boards of Appeal

Chambres de recours

Boards of Appeal of the
European Patent Office
Richard-Reitzner-Allee 8
85540 Haar
GERMANY
Tel. +49 (0)89 2399-0
Fax +49 (0)89 2399-4465

Case Number: T 1162/20 - 3.3.05

D E C I S I O N
of Technical Board of Appeal 3.3.05
of 27 September 2022

Appellant: Bona GmbH Deutschland
(Patent Proprietor) Jahnstrasse 12
65549 Limburg an der Lahn (DE)

Representative: Müller, Eckhard
Mühlstrasse 9a
65597 Hünfelden-Dauborn (DE)

Respondent: Wacker Chemie AG
(Opponent 1) Hanns-Seidel-Platz 4
81737 München (DE)

Representative: Mieskes, Klaus Theoderich
Wacker Chemie AG
Intellectual Property
Hanns-Seidel-Platz 4
81737 München (DE)

Respondent: Uzin Utz AG
(Opponent 2) Dieselstrasse 3
89079 Ulm (DE)

Representative: Isarpatent
Patent- und Rechtsanwälte Barth
Charles Hassa Peckmann & Partner mbB
Friedrichstrasse 31
80801 München (DE)

Respondent: Henkel AG & Co. KGaA
(Opponent 3) Henkelstrasse 67
40589 Düsseldorf (DE)

Representative: Henkel AG & Co. KGaA
CLI Patents
Z01
40191 Düsseldorf (DE)

Decision under appeal: **Decision of the Opposition Division of the
European Patent Office posted on 10 March 2020
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. This appeal is against the opposition division's decision, dealing with three oppositions, to revoke European patent EP 2 135 852 B1. The patent in suit concerns a sealing composition, a method for preparing a sealing composition and the use of such a sealing composition.
- II. The opposition division found that the claims according to the then main request extended the scope of protection (Article 123(3) EPC), and that the claims according to the then pending seven auxiliary requests did not meet the requirements of Article 123(3) EPC or Article 123(2) EPC. The impugned decision followed earlier decision T 1146/17, in which this board, in an appeal against a first decision of the opposition division revoking the patent, had found the subject-matter of the main request to be sufficiently disclosed and had remitted the case for further prosecution.
- III. With their grounds of appeal, the patent proprietor (appellant) defended the patent in the form of the main and auxiliary requests dealt with in the impugned decision. With a further submission (received on 16 November 2020), they filed auxiliary requests VIII-XI.
- IV. With a communication dated 15 July 2022 the board informed the parties of its preliminary opinion that auxiliary request VIII appeared to meet the requirements of Article 123(2) and (3) EPC and that the case should be remitted to the opposition division for further prosecution since the grounds for opposition

relating to novelty and inventive step had not yet been dealt with.

- V. In reply to the board's communication, respondent 2 requested that auxiliary requests VIII-XI not be admitted into the appeal proceedings pursuant to Article 13(1) RPBA 2020.

Respondents 1 and 3 did not submit any requests with regard to auxiliary requests VIII-XI.

- VI. Oral proceedings before the board were held on 27 September 2022 by videoconference. Opponent 1 and opponent 3, now respondents 1 and 3, were not represented, as announced in advance. They had both requested a decision according to the state of the file.

During the oral proceedings, the appellant made the request filed as auxiliary request VIII on 16 November 2020 the main request, withdrew all higher-ranking requests and renumbered auxiliary requests IX-XI as auxiliary requests 1-3.

- VII. The independent claims of (what is now) the main request relate to a sealing composition (claim 1), to a method for preparing it (claim 6) and to its use (claim 12). They read as follows:

"1. Sealing composition comprising
a) an alkyltrimethoxysilane and/or an alkyltriethoxy silane and/or an alkyldimethoxymethylsilane and/or an alkyldiethoxyethylsilane in an amount of 1 to 10 percent by weight (wt-%) wherein the alkyltrimethoxy silane and/or the alkyltriethoxysilane and/or the alkyldimethoxymethylsilane and/or the alkyldiethoxy

ethylsilane is 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 alkyltrimethoxysilane and/or an alkyltriethoxysilane and/or an alkyldimethoxymethylsilane and/or an alkyldiethoxyethylsilane wherein the alkyltrimethoxysilane and/or the alkyltriethoxysilane and/or the alkyldimethoxymethylsilane and/or the alkyldiethoxyethylsilane is 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."

Dependent claim 2 reads as follows (the amendment with respect to claim 2 as originally filed has been highlighted by the board):

"2. Sealing composition according to claim 1, wherein an alkyltriethoxysilane ~~alkylsilane~~ is used and the alkyl is a linear or branched alkyl."

Dependent claims 3-5 and 7-11 relate to further particular embodiments.

VIII. The appellant's arguments relevant to the present decision can be summarised as follows.

Admitting the main request was equitable because the appellant had not been confronted with the alleged violation of Article 123(3) EPC until the oral proceedings before the opposition division, nearly five years after the request concerned had been filed. Time had been needed to assess the relevant case law. When reviewing the case law in response to the respondents' replies to the appeal, decision T 1360/11 had been identified. The claims had been reworded on the basis of the approach set out in that decision to avoid the alleged violation of Article 123(3) EPC. No new

technical feature had been added. The main request was thus not an amendment to the appellant's case. In any case the provisions of Article 13(1) RPBA 2020 were also fulfilled because the claims clearly overcame the objection without giving rise to any new issues. Respondent 2's objection contesting the admission of the main request should be disregarded pursuant to Article 13(2) RPBA 2020.

- IX. Of the respondents, only respondent 2 made submissions regarding (what is now) the main request. Their arguments relevant to the present decision can be summarised as follows.

The requirements of Article 13(1) RPBA 2020 for admitting the main request were not fulfilled. The appellant should have made the amendments during the oral proceedings before the opposition division or when filing the statement of grounds of appeal. This would not have been difficult because the appellant could have reviewed the case law earlier. The late filing could not be justified on account of the relevant decision being retrieved late. The appellant failed to set out that the amendments did not give rise to new objections.

Respondent 2 did not raise any objections under Article 123(2) and (3) or Article 84 EPC.

- X. The appellant requests that the contested decision be set aside and the patent be maintained as amended on the basis of the main request, filed as auxiliary request VIII on 16 November 2020, or, alternatively, on the basis of one of auxiliary requests 1-3, filed as auxiliary requests IX to XI on 16 November 2020.

The respondents request that the appeal be dismissed.

Reasons for the Decision

1. Article 13(1) RPBA 2020

- 1.1 Under Article 13(1) RPBA 2020, any amendment to a party's appeal case after filing the grounds of appeal or reply is subject to the party's justification for its amendment and may be admitted only at the board's discretion.

The main request proposes an amended claim wording to address an objection, so it constitutes an amendment to the appellant's case. It was filed after the grounds of appeal. Thus, the provisions of Article 13(1) RPBA 2020 apply and it may be admitted and considered only at the board's discretion.

- 1.2 The request *prima facie* follows the approach of T 1360/11 (Reasons 3.11) and thus overcomes the principal issue under discussion, namely the violation of Article 123(3) EPC, without giving rise to any new objections. None of the respondents raised any objections under Article 123(2) and (3) or Article 84 EPC.

- 1.3 The objection under Article 123(3) EPC against the previous claim wording had not been raised for the first time during the appeal proceedings, so the appellant should in principle have responded to it at the latest with the statement of grounds of appeal. Furthermore, the late filing cannot be justified by the fact that the appellant had not previously been aware of decision T 1360/11, from which a possible solution could be derived. However, the circumstances of this

case as a whole are unusual in that the objection under Article 123(3) EPC had been raised for the first time during the second oral proceedings before the opposition division and concerned a request which had then been on file for more than four years (points 1.5 and 2 of the minutes of the oral proceedings before the opposition division on 5 February 2020). It thus took several procedural stages, including first appeal proceedings, before opponent 2 identified the Article 123(3) EPC issue. In light of this, it is to be accepted that addressing this issue was not straightforward either and required some time.

- 1.4 During the oral proceedings before the opposition division, the appellant made serious attempts to address the then fresh objection by amending the claims, with all the amendments aimed at providing a formally acceptable claim wording for the same intended subject-matter. The request under consideration is a further attempt along these lines, directed at the same intended subject-matter, and thus does not present the other parties or the board with complex new issues.
- 1.5 The request was filed less than two months after the respondents' replies to the appeal, within the period specified under Article 15(1) RPBA 2020 during which summons are not normally sent, and before the board had commenced its handling of the case. Thus, the late filing in this case caused no procedural delays either. The respondents for their part chose not to reply to the filing of this request; respondent 2 did reply, but only in reaction to the board's preliminary opinion more than 1.5 years later.

- 1.6 In light of the above, taking this request into consideration was not detrimental to procedural economy.
 - 1.7 In conclusion, the circumstances of this case as a whole justify admitting and considering the request, notwithstanding the question of whether respondent 2's objection to this is admissible under Article 13(2) RPBA 2020.
2. Article 123 EPC
 - 2.1 By contrast with the former main request dealt with in the impugned decision, claim 1 under consideration here has retained the definition of "a)" from claim 1 as granted: (*"a) an alkyltrimethoxysilane and/or an alkyltriethoxysilane and/or an alkyldimethoxymethylsilane and/or an alkyldiethoxyethylsilane in an amount of 1 to 10 percent by weight (wt-%)"*). Claim 1 under consideration has been limited in comparison with claim 1 as granted by additionally specifying *"wherein the alkyltrimethoxysilane and/or the alkyltriethoxysilane and/or the alkyldimethoxymethylsilane and/or the alkyldiethoxyethylsilane is an alkyltriethoxysilane in an amount of 1 to 10 percent by weight (wt-%)"*.
 - 2.2 In retaining the definition of "a)" from claim 1 as granted in claim 1 under consideration, the appellant has followed the approach of T 1360/11 (Reasons 3.11), and the claim does not encompass embodiments in which the total amount of alkyltriethoxysilane in combination with alkyltrimethoxysilane and/or alkyldimethoxymethylsilane and/or alkyldiethoxyethylsilane is greater than 10 wt-%. Thus, there is no extension of the scope of protection.

This also applies to independent claims 6 and 12 due to the back-reference to claim 1.

The requirements of Article 123(3) EPC are therefore met.

- 2.3 The claims as granted were based on the claims as originally filed.

Limiting component "a)" to alkyltriethoxysilane involves a single selection from a list of specifically disclosed alternatives (claim 1 as originally filed). No further selection has been made. In particular, the alkyl being a linear or branched alkyl (claim 2) was disclosed in relation to every alkylalkoxysilane mentioned (page 6, last paragraph of the application as originally filed). Claim 2 has been brought in line with amended claim 1.

- 2.4 Independent claim 6 has also been adapted to claim 1. This claim is furthermore limited due to the back-reference to claim 1.

- 2.5 The requirements of Article 123(2) EPC are therefore also met.

3. Article 84 EPC

- 3.1 The parties did not raise any objection under Article 84 EPC, nor does the board see any clarity issues.

4. Remittal

- 4.1 The grounds for opposition relating to novelty and inventive step have not yet been dealt with. In view of the primary object of the appeal proceedings to review the decision under appeal in a judicial manner (Article 12(2) RPBA 2020), the circumstances of this case, in which the opposition division has not decided on these grounds for opposition, qualify as a special reason for remittal under Article 11 RPBA 2020. The case is therefore to be remitted to the opposition division for further prosecution (Article 111(1) EPC).

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.

The Registrar:

The Chairman:



C. Vodz

E. Bendl

Decision electronically authenticated