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**Datasheet for the decision  
of 7 February 2023**

**Case Number:** T 1617/20 - 3.3.02

**Application Number:** 06006748.5

**Publication Number:** 1840145

**IPC:** A01N25/28, A01N43/80,  
B01J13/16, C08G18/76,  
C08G18/28, C08G18/38

**Language of the proceedings:** EN

**Title of invention:**

ACETYLENE CARBAMIDE DERIVATIVES-POLYUREA POLYMERS AND  
MICROCAPSULES AND FORMULATIONS THEREOF FOR CONTROLLED RELEASE

**Patent Proprietor:**

FMC Corporation

**Opponent:**

Rotam Limited

**Headword:**

**Relevant legal provisions:**

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

RPBA 2020 Art. 12(3), 12(4), 12(5), 12(6)

**Keyword:**

Amendment to appellant's case - admitted (yes)  
Late-filed request - error in use of discretion at first instance (yes) - main request admitted (yes)  
Amendments - main request - added subject-matter (no)  
Clarity - main request (yes)  
Reply to statement of grounds of appeal - party's complete case (no) - objection not substantiated  
Remittal to the opposition division (yes)

**Decisions cited:**

G 0007/93, T 0222/16, T 0879/18

**Catchword:**

*Prima facie* allowability under Article 123(2) EPC of a late-filed amended claim request may be a valid criterion to be used by the opposition division when deciding on the admittance of this claim request. However, using this criterion, to object for the first time at oral proceedings to a feature of the late-filed claim request that was already present in higher-ranking claim requests and had never been objected to before, not even when deciding on the allowability or admittance of those higher-ranking claim requests, goes against the principles of fairness and good faith (see point 2.6.11 of the reasons).



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Case Number: T 1617/20 - 3.3.02

**D E C I S I O N**  
**of Technical Board of Appeal 3.3.02**  
**of 7 February 2023**

**Appellant:** FMC Corporation  
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**Representative:** Inspicos P/S  
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**Respondent:** Rotam Limited  
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**Decision under appeal:** **Decision of the Opposition Division of the  
European Patent Office posted on 19 May 2020  
revoking European patent No. 1840145 pursuant to  
Article 101(3) (b) EPC.**

**Composition of the Board:**

**Chairman** M. O. Müller  
**Members:** M. Maremonti  
L. Bühler

## Summary of Facts and Submissions

- I. The appeal lodged by the patentee ("appellant") lies from the decision of the opposition division to revoke European patent No. 1 840 145 ("the patent").
- II. The opposition was filed on the grounds of Article 100(a) to (c) EPC. During the opposition proceedings, the appellant filed sets of claims according to auxiliary requests 1 to 13. It maintained the patent as granted as its main request. The opposition division came, *inter alia*, to the following conclusions:
- The ground for opposition under Article 100(c) EPC prejudiced the maintenance of the patent as granted.
  - The subject-matter of claim 1 according to auxiliary requests 1 and 3 to 13 infringed Article 123(2) EPC.
  - Auxiliary request 2 was not admitted into the proceedings.
- III. In its statement of grounds of appeal, the appellant contested, *inter alia*, the reasoning of the opposition division that led to the non-admittance of what was then auxiliary request 2. It maintained that the subject-matter of this request, which has been re-filed in the appeal proceedings as the main request, complied with Article 123(2) EPC. The appellant also filed amended pages 2 to 27 of the specification, which has been adapted to the claims of this request.
- The main request (i.e. auxiliary request 2 underlying the appealed decision) contains 45 claims, with claim 1

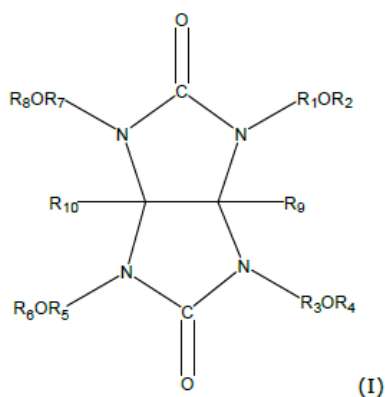
reading as follows (amendments over claim 1 as granted have been highlighted by the board):

"1. Microcapsules enclosing material with a solubility in water lower than 750 mg/L at 20°C or clomazone, characterized in that the wall of the microcapsules is formed by means of an interfacial polymerization reaction of the wall forming materials:

(a) aliphatic isocyanate(s), and

(b) aromatic isocyanate(s), and

(c) compound(s) of formula (I) - acetylene carbamide derivatives - ~~in monomeric and/or oligomeric and/or polymeric form~~ **said compounds of claim 1 (c) being a mixture of compounds (I) in the form of oligomers up to 10 mols per molecule, wherein the sum of the quantity of monomers, dimers, trimers and tetramers at least 75 weight-% of the total weight of compounds (I)**



wherein

R1, R3, R5, R7, are, independently one to each other, methylen, ethylen, n-propylen, isopropylen, n-butylen, isobutylen, sec-butylen, tert-butylen R2, R4, R6, R8, are, independently one to each other, hydrogen methyl, ethyl, n-propyl, isopropyl, n-butyl, isobutyl, sec-butyl, tert-butyl R9, R10 are hydrogen or hydroxymethyl;

*comprising compounds (I) all isomeric and stereochemical **stereoisomeric** configurations that may be present; depending on the radicals as cited, and been excluded from compounds (I) all the combinations of radicals that are not able to form polyurea-acetylene carbamide derivative polymers when such acetylene carbamide derivatives are reacted as described in the present invention with a mixture of isocyanates*

*and the ratio of wall forming materials is aliphatic isocyanate : aromatic isocyanate from 1 : 3 to 1 : 1; aromatic isocyanate : acetylene carbamide derivatives from 9 : 1 to 4 : 1; aliphatic isocyanates : acetylene carbamide derivatives from 2 : 1 to 5 : 1;*

*and the microcapsules have a mean diameter of 0.3 to 25  $\mu\text{m}$ , and 90% of the microcapsules have a diameter lower than 100  $\mu\text{m}$ , when measured with a conventional laser diffraction particle sizer analyzer, previous customary dilution upon water under agitation."*

Claims 2 to 44 define embodiments of the microcapsules of claim 1. Claim 45 is directed to the use of the microcapsules of claim 1 in agrochemical formulations.

- IV. In its reply to the appeal, the opponent ("respondent") rebutted the arguments of the appellant and contested the admittance of all the appellant's requests. Moreover, it submitted that the claimed subject-matter infringed Article 123(2) and (3) EPC and lacked clarity under Article 84 EPC.
- V. The parties were summoned to oral proceedings as per their requests. In preparation for the oral proceedings, the board issued a communication under Article 15(1) RPBA 2020, in which it expressed, *inter alia*, the preliminary opinion that the main request should be admitted into the proceedings, that the claimed subject-matter fulfilled the requirements of

Article 123(2) and 84 EPC, and that the respondent's objection under Article 123(3) EPC should not be admitted into the proceedings.

VI. Oral proceedings before the board were held by videoconference on 7 February 2023 in the presence of both parties.

VII. Final requests

The appellant requested that the appealed decision be set aside and that the patent be maintained in amended form on the basis of the claims and description pages according to the main request as filed with the statement of grounds of appeal. Alternatively, it requested that the patent be maintained in amended form on the basis of the claims and description pages according to one of auxiliary requests 1 or 2 as filed with the statement of grounds of appeal. The appellant also requested that - should any of the above requests meet the requirements of Article 123(2) EPC - the case be remitted to the opposition division for further prosecution. Furthermore, the appellant requested that the respondent's objection under Article 123(3) EPC of an extension of the protection conferred in view of the feature "*stereoisomeric*" not be admitted into the appeal proceedings.

The respondent requested that the appeal be dismissed, meaning that the revocation of the patent be confirmed. It further requested that none of the appellant's requests be admitted into the proceedings.

VIII. The appellant's submissions, where relevant to the present decision, are summarised as follows:

Admittance of the main request

- As confirmed by the minutes of the oral proceedings before the opposition division, the appellant intended to file an amended description adapted to the claims of what was then auxiliary request 2 once these claims had been discussed in substance. Since that auxiliary request was not admitted, there was no need to file an adapted description. The statement of grounds of appeal represented the first opportunity for the appellant to file this amended description.
- The decision by the opposition division not to admit what was then auxiliary request 2 was part of the appealed decision. Therefore, since the main request in the appeal proceedings was identical to what had previously been auxiliary request 2, the filing thereof did not represent an amendment of the appellant's case under Article 12(4) RPBA 2020.
- The opposition division erred in concluding that claim 1 of what was then auxiliary request 2, i.e. of the present main request, contained added subject-matter. Furthermore, the opposition division did not follow the right principles when deciding not to admit this request and, moreover, it used the available criteria in the wrong way.
- Thus, the current main request should be admitted into the proceedings.

Compliance with Article 123(2) EPC

- The feature of claim 1 expressing the ratio of the wall-forming materials that was objected to by the



opposition division was disclosed in claim 3 as filed.

- Contrary to the reasoning of the opposition division, the feature expressed in claim 3 as filed by the sentence "*being the most preferred ratios and quality of isocyanates monomer aliphatic isocyanate : prepolymer aromatic isocyanate : monomer ACD of 3 : 6 : 1*" was an optional preferred feature. It expressed preferred ratios and types of the wall-forming materials. Being optional, this feature did not need to be included in claim 1 to comply with the requirements of Article 123(2) EPC.
- It therefore had to be concluded that the main request complied with Article 123(2) EPC.

Admittance of the respondent's objection under Article 123(3) EPC

- The respondent's objection under Article 123(3) EPC in view of the replacement of the term "*stereochemical*" by "*stereoisomeric*" in claim 1 of the main request had not been substantiated in the reply to the statement of grounds of appeal. It was merely stated that an assessment of compliance with Article 123(3) EPC could not be made.
- Therefore, this objection should not be admitted into the proceedings.

Clarity under Article 84 EPC

- The feature of claim 1 of the main request objected to by the respondent was contained in dependent claim 13 as granted. As such, this feature was not open to a clarity objection in view of decision G 3/14.

- Even assuming that an objection was allowable, the inclusion in claim 1 of the feature mentioned in dependent claim 13 as granted did not result in a lack of clarity. It was clear that this feature referred to the compounds of formula (I) recited under item (c) of claim 1.
- Hence, the main request was clear under Article 84 EPC.

IX. The respondent's submissions, where relevant to the present decision, are summarised as follows (for further details, reference is made to the reasons for the decision set out below):

Admittance of the main request

- The main request represented an amendment of the appellant's case. Solely for this reason, the main request should not be admitted.
- Moreover, the claims of the main request were not admitted by the opposition division. In view of decision G 7/93, this discretionary decision of the opposition division should not be overturned.
- Hence, the main request should not be admitted into the appeal proceedings.

Compliance with Article 123(2) EPC

- In line with the appealed decision, the feature of claim 1 expressing the ratios of the wall-forming materials was not disclosed in the application as filed.
- Thus, it had to be concluded that the main request did not fulfil Article 123(2) EPC.

Admittance of the objection under Article 123(3) EPC

- The objection under Article 123(3) EPC as raised in the reply to the appeal in view of the replacement of the term "*stereochemical*" by "*stereoisomeric*" in claim 1 of the main request was complete.
- This objection should be admitted into the proceedings.

Clarity under Article 84 EPC

- Claim 1 of the main request included a reference to claim 1 itself. This led to a lack of clarity.
- Therefore, it should be concluded that the main request did not comply with Article 84 EPC.

## **Reasons for the Decision**

Main request - admittance into the proceedings

1. With its statement of grounds of appeal (section III above), the appellant filed amended pages 2 to 27 of the specification and a set of 45 claims identical to the claims of auxiliary request 2 underlying the appealed decision. These documents formed the appellant's main request.
  - 1.1 In particular, paragraph [0036] on page 7 of the description reads as follows (amendments over paragraph [0036] as granted are highlighted by the board and square brackets for unamended text have been inserted for brevity):

*"[0036] In particular, the polymer referred may be described [...] characterized in that:*

*i) such polymer is formed by the reaction of:*

*(a) a monomeric aliphatic isocyanate*

(b) a prepolymer aromatic isocyanate

(c) a N', N'', N''', N'''' alkoxy-alkyl and/or hydroxy-alkyl acetylene carbamide derivative ~~in monomeric and/or oligomeric and/or polymeric form~~ or mixtures of such compounds [...]

and

ii) the microcapsules have [...] upon water under agitation".

1.2 Claim 1 of the main request (section III above) was amended as compared with claim 1 as granted by, *inter alia*, replacing the feature "comprising compounds (I) all isomeric and **stereochemical** configurations that may be present" by the feature "comprising compounds (I) all isomeric and **stereoisomeric** configurations that may be present" (emphasis added by the board).

2. The respondent requested that the main request not be admitted into the proceedings.

2.1 As regards the amended description, the respondent argued that the above amendment to paragraph [0036] on page 7 was not present in the description pages filed before the opposition division. Therefore, the filing of amended page 7 represented an amendment of the appellant's case within the meaning of Article 12(4) RPBA 2020. No reason had been given as to why this amendment could not have been filed during the proceedings before the opposition division, especially in view of the fact that an objection to paragraph [0036] of the patent as granted had been raised in the notice of opposition (page 5, section D.1). For this reason alone, the main request should not be admitted into the proceedings.

2.2 The board finds this argument unconvincing.

- 2.2.1 According to Article 12(6) RPBA 2020, second sentence, the board has the discretion not to admit requests which should have been submitted in opposition proceedings.
- 2.2.2 However, it is common practice in proceedings before the opposition division that when amended claims are filed, corresponding amendments to the description are carried out only once (and if) the amended claims are admitted into the proceedings and found to be allowable. In the current case, claims according to auxiliary request 2, corresponding to the claims of the present main request, were filed by the appellant at the oral proceedings before the opposition division. As regards the description, the appellant explained that this was still "*to be amended*" (see the minutes of the oral proceedings, page 3, point 5). Since this claim request was not admitted by the opposition division (see below), in line with the above-mentioned current practice, there was no need for the appellant to file description pages in line with this claim request in the opposition proceedings. Hence, the appellant was not in a situation where it should have submitted an amended description in line with the claims of the current main request before the opposition division. The appellant promptly filed description pages in line with the claims of the present main request with its grounds of appeal.
- 2.2.3 It is acknowledged that the amendment to paragraph [0036] was not dealt with in the appealed decision and thus represents an amendment of the appellant's case within the meaning of Article 12(4) RPBA 2020, first paragraph. In addition to the above-mentioned criterion under Article 12(6) RPBA 2020, the further criteria under Article 12(4) RPBA 2020, third paragraph, also need to be considered for the board's discretionary

decision on the admittance of an amendment. According to Article 12(4) RPBA 2020, third paragraph, the board will exercise its discretion in view of, *inter alia*, the complexity of the amendment, the suitability of the amendment to address the issues which led to the decision under appeal, and the need for procedural economy.

- 2.2.4 The amendment to paragraph [0036] is not complex since it merely consists in the deletion of a sentence. Moreover, the amendment was made to overcome the objection raised in the appealed decision (see page 9, second paragraph) that the features expressed by the sentence that has now been deleted were not disclosed in the application as filed. Therefore, the amendment directly addresses an issue leading to the decision under appeal. Finally, no detriment to procedural economy associated with this amendment can be recognised.
- 2.2.5 Therefore, there are no reasons why description pages 2 to 27 according to the main request should not be admitted into the proceedings.
- 2.3 As regards the claims of the main request, the respondent argued that they did not correspond to a request on which the appealed decision was based. Therefore, these claims represented an amendment of the appellant's case within the meaning of Article 12(4) RPBA 2020. No reasons were apparent as to why this amendment could not have been filed in a timely manner during the proceedings before the opposition division. Moreover, the basis for the amended features had not been indicated. For this reason, the main request did not comply with Article 12(4) RPBA 2020 and should not be admitted.

2.4 This argument is not convincing either. The claims of the current main request are identical to the claims of auxiliary request 2 as filed at the oral proceedings before the opposition division. Said auxiliary request 2 was examined by the opposition division as regards its *prima facie* allowability. Thereafter, the division decided not to admit the request into the proceedings (appealed decision, page 11). This decision on the admittance of what was then auxiliary request 2 is part of the appealed decision and thus, contrary to the respondent's view, the filing of this request as the main request in appeal does not represent an amendment of the appellant's case within the meaning of Article 12(4) RPBA 2020. The provisions of Article 12(4) RPBA 2020, second and third paragraph, do not apply.

2.5 The respondent further argued that the opposition division correctly exercised its discretion in not admitting auxiliary request 2 (i.e. the current main request). The respondent submitted that the appellant had already filed 12 auxiliary requests prior to the oral proceedings before the opposition division. At the oral proceedings, two further auxiliary requests were filed, including auxiliary request 2, which corresponds to the present main request. No reasons were apparent as to why this auxiliary request could not have been filed earlier, especially since an objection made under Article 123(2) EPC to the term "*stereochemical*" in claim 1 as granted had already been raised in the notice of opposition. The appellant could and should have reacted to this objection by filing the current main request in a timely manner. When filing a request late, especially at the oral proceedings, only the *prima facie* allowability of the claims should be examined. The opposition division acted correctly in this regard, when it found that claim 1 did not comply

with Article 123(2) EPC. Therefore, the discretionary decision of the opposition division met the requirements of both procedural fairness and procedural efficiency. As regards the review of this decision by the board, the respondent referred to decision G 7/93 (Official Journal EPO 1994, 775), especially to section 2.6 of the reasons thereof. The Enlarged Board clearly stated that when examining a discretionary decision on admittance made by the first-instance department, the conclusion that the board would have exercised its discretion in a different way was not sufficient to overturn the decision. The opposition division should have a certain degree of freedom when exercising its discretion, without interference from the board. According to the Enlarged Board, the board should overrule a discretionary decision only if the opposition division either failed to exercise its discretion in accordance with the right principles or if it exercised its discretion in an unreasonable way. Thus, the threshold placed by the Enlarged Board was very high. In the respondent's view, even though the opposition division had admitted auxiliary request 1, which was also filed at the oral proceedings, it applied the right criterion in not admitting auxiliary request 2, which corresponds to the present main request. If an error was made by the opposition division, this was admitting auxiliary request 1 and not refusing to admit what was then auxiliary request 2. Hence, to overturn the admittance decision of the opposition division with regard to the current main request would run against decision G 7/93.

2.6 The board disagrees.

2.6.1 According to the established case law of the boards of appeal developed in view of decision G 7/93, a board should only overrule the way in which a department of



first instance has exercised its discretion on the admittance of, *inter alia*, claim requests if the board concludes that the department has done so according to the wrong principles, or without taking into account the right principles, or in an unreasonable way (see also T 879/18 and T 222/16). This case law has been codified in Article 12(6) RPBA 2020, first sentence, according to which the board "*shall not admit **requests, facts, objections or evidence which were not admitted in the proceedings leading to the decision under appeal, unless the decision not to admit them suffered from an error in the use of discretion or unless the circumstances of the appeal case justify their admittance***" (emphasis added by the board).

- 2.6.2 In order to decide whether the opposition division's discretionary decision not to admit into the proceedings what was then auxiliary request 2 (i.e. the current main request) suffered from an error, i.e. was based on a wrong principle, or was taken by applying the right principle in an unreasonable way, the file history of the present case needs to be considered.
- 2.6.3 At the oral proceedings, the opposition division came to the conclusion (appealed decision, sections 1.1.3 and 1.1.4) that Article 100(c) EPC prejudiced the maintenance of the patent as granted. As regards claim 1 as granted, the opposition division found that the terms "*stereochemical*" and "*polymeric*" in the definition of the compounds of formula (I) in claim 1 (item (c)) did not have a basis in the application as filed (see also the minutes of the oral proceedings, page 2, sixth paragraph). In coming to this conclusion, the opposition division deviated from its preliminary opinion, according to which the term "*stereochemical*" was based on the application as filed (annex to the summons to oral proceedings issued on 27 March 2019,

page 6, item (ii)). Moreover, the subject-matter of granted claim 15 was found not to have any basis in the application as filed.

- 2.6.4 Thereafter, the appellant filed auxiliary request 1. In claim 1 of this request, the objected term "*polymeric*" was deleted from the definition of the compounds of formula (I) (item (c) in claim 1) and the objected term "*stereochemical*" was replaced by "*stereoisomeric*". Granted claim 15 was deleted. The opposition division admitted this request into the proceedings (appealed decision, page 10, section 2.2.1) "*because the claims are substantially identical to those of auxiliary request 5 [filed on 29 August 2019] already on file and therefore they do not represent an unexpected change of the subject of the proceedings*" (text in square brackets has been inserted by the board). Indeed, the only amendment to claim 1 of this request as compared to claim 1 of auxiliary request 5 filed on 29 August 2019 was the replacement of "*stereochemical*" by "*stereoisomeric*". Moreover, the opposition division found that there were no *prima facie* clarity issues (appealed decision, section 2.2.1, last line). However, the *prima facie* allowability under Article 123(2) EPC was not examined when the opposition division decided on the admittance of auxiliary request 1.
- 2.6.5 When examining claim 1 of auxiliary request 1 in substance, the division found that claim 1 infringed Article 123(2) EPC. Although the term "*polymeric*" had been deleted from the definition of the compounds of formula (I) (item (c) in claim 1), the remaining feature "*in monomeric and/or oligomeric form*" was found not to be disclosed in the application as filed (appealed decision, page 10, section 2.2.2).

- 2.6.6 Thereafter, the appellant filed auxiliary request 2, which corresponds to the current main request. As in the case of auxiliary request 1, this request was also based on a previous request filed on 29 August 2019, specifically auxiliary request 9, in which the feature "*in monomeric and/or oligomeric form*" was deleted from the definition of the compounds of formula (I) in claim 1. This was recognised by the opposition division (appealed decision, page 11, section 2.3). As in the case of auxiliary request 1, the sole amendment contained in claim 1 of auxiliary request 2 as compared with previous auxiliary request 9 was the replacement of "*stereochemical*" by "*stereoisomeric*". Even though this replacement could have been made earlier in the proceedings in view of the corresponding objection of the respondent in the notice of opposition (see above), this amendment was motivated by the opposition division changing its mind (see section 2.6.3 above). Moreover, this amendment was straightforward, promptly addressed the objection raised and did not change the subject of the proceedings, as had been recognised by the opposition division with respect to the admitted auxiliary request 1.
- 2.6.7 However, instead of applying the same criterion as for auxiliary request 1 - substantially identical to a previous request and thus no unexpected change of the subject of the proceedings and no *prima facie* clarity issues - when deciding on the admittance of auxiliary request 2, the opposition division applied the criterion of *prima facie* allowability under Article 123(2) EPC (appealed decision, page 11, section 2.3.1).
- 2.6.8 In applying this different criterion of *prima facie* allowability under Article 123(2) EPC, the opposition division reasoned that the feature of claim 1

expressing the ratio of the wall-forming materials to be "*aliphatic isocyanate : aromatic isocyanate from 1 : 3 to 1 : 1; aromatic isocyanate : acetylene carbamide derivatives from 9 : 1 to 4 : 1; aliphatic isocyanates : acetylene carbamide derivatives from 2 : 1 to 5 : 1*" (section III above) was not *prima facie* allowable under Article 123(2) EPC.

- 2.6.9 However, this feature was already present in claim 1 as granted (section III above) and in claim 1 of auxiliary request 1 as filed during the oral proceedings and admitted by the opposition division. More importantly, this feature had never been objected to before under Article 123(2) EPC, either by the respondent or by the opposition division. The respondent confirmed at the oral proceedings before the board that it had not objected to this feature prior to the oral proceedings before the opposition division, and then only when auxiliary request 2 (the current main request) was being considered (minutes of the oral proceedings before the opposition division, page 3, point 5).
- 2.6.10 In view of the specific case history set out above, the opposition division should have used the same criteria when deciding on the admittance of auxiliary requests 1 and 2. Not doing so, and thus basing the decision as regards the two claim requests on different criteria, resulted in an inconsistent approach.
- 2.6.11 Moreover, the board acknowledges that *prima facie* allowability under Article 123(2) EPC of a late-filed amended claim request may be a valid criterion to be used by the opposition division when deciding on the admittance of this claim request (case law of the boards of appeal, IV.C.5.1.4, point (d), tenth edition, 2022). However, using this criterion, to object for the first time at oral proceedings to a feature of the late-filed claim request that was already present in

higher-ranking claim requests and had never been objected to before, not even when deciding on the allowability or admittance of those higher-ranking claim requests, goes against the principles of fairness and good faith.

2.6.12 Therefore, the board has concluded that the opposition division, when deciding not to admit the current main request, used the available criteria in an unreasonable way. The opposition division's decision thus suffered from an error in the use of its discretion.

2.7 For these reasons, the board has decided to overturn the opposition division's decision on the non-admittance of what was then auxiliary request 2, and to admit the present main request into the appeal proceedings pursuant to Article 12(6) RPBA 2020.

Main request - claim 1 - added subject-matter under Article 123(2) EPC

3. The sole objection under Article 123(2) EPC raised by the respondent against the main request concerned the feature of claim 1 expressed by the sentence: "*and the ratio of wall forming materials is aliphatic isocyanate : aromatic isocyanate from 1 : 3 to 1 : 1; aromatic isocyanate : acetylene carbamide derivatives from 9 : 1 to 4 : 1; aliphatic isocyanates : acetylene carbamide derivatives from 2 : 1 to 5 : 1*".

3.1 The respondent argued that this feature did not have a basis in the application as filed. It referred to claim 3 as filed, wherein the aforementioned feature was immediately followed by the sentence: "*, being the most preferred ratios and quality of isocyanates monomer aliphatic isocyanate : prepolymer aromatic isocyanate : monomer ACD of 3 : 6 : 1*". According to the respondent, even if the intention of the appellant was to recite in this sentence a preferred feature, the

wording did not reflect this. The appellant had, after all, decided to deviate from the well-established, conventional way of drafting preferred features in claims. Thus, the actual disclosure of claim 3 as filed had to be considered.

3.2 In line with the appealed decision (page 11, section 2.3.1, last paragraph), the respondent argued that the sentence "*being the most preferred ratios*" included in claim 3 as filed, referred back to the set of ratios recited previously in the claim and not, as argued by the appellant, to the ratio 3 : 6 : 1 mentioned thereafter. This was clear in light of the fact that the plural form "*ratios*" was used. This plural form could not refer to the single ratio recited at the end of claim 3 as filed.

3.3 Thus, according to the respondent, the ratios mentioned in claim 1 of the main request were disclosed in claim 3 as filed only in combination with the feature stating "*a quality of isocyanates monomer aliphatic isocyanate : prepolymer aromatic isocyanate : monomer ACD of 3 : 6 : 1*". The latter had not been included in claim 1 of the main request, thus leading to an unallowable extension of the subject-matter beyond the content of the application as filed. It therefore had to be concluded that the subject-matter of claim 1 infringed Article 123(2) EPC.

4. The board disagrees.

4.1 Claim 3 as filed reads as follows:

*"A microcapsule characterized in that the wall forming materials are according to claim 1 and 2 and the ratio of wall forming materials is aliphatic isocyanate : aromatic isocyanate from 1 : 3 to 1 : 1; aromatic isocyanate : ACD [acetylene carbamide derivatives] from 9 : 1 to 4 : 1; aliphatic isocyanates : ACD from 2 : 1*

*to 5 : 1, being the most preferred ratios and quality of isocyanates monomer aliphatic isocyanate : prepolymer aromatic isocyanate : monomer ACD of 3 : 6 : 1*" (the text in square brackets has been added by the board).

- 4.2 As was common ground between the two parties, the ratios recited in the first part of claim 3 as filed, prior to the wording starting with "*being the most preferred ratios and quality of...*", are identical to the ratios defined in claim 1 of the main request.
- 4.3 The decisive question is whether these ratios recited in the first part of claim 3 as filed are further qualified by what follows in the second part of this claim or whether what follows represents merely a preferred and thus non-limiting embodiment of what is disclosed in the first part.
- 4.4 The board concurs with the appellant that the latter is true, i.e. that the second part of claim 3 as filed, starting with "*being the most preferred ratios*", expresses optional, most preferred types and ratios of the wall-forming materials. This becomes evident from the fact that in this second part of claim 3 as filed the type ("*quality*" in claim 3 as filed) of the materials is further specified as monomer aliphatic isocyanate, prepolymer aromatic isocyanate and monomer ACD. In the same way, the ratios of 3 : 6 : 1 in this second part lie within the ranges of the ratios among the wall-forming materials mentioned previously in the first part of the claim. Hence, the second part of claim 3 as filed defines specific embodiments falling, in terms of the type (quality) of compounds and the ratios thereof, within what is disclosed in the first part of the claim. The wording "*being the most preferred ratios and quality of ...*" thus clearly

refers to these specific embodiments since they are explicitly defined as most preferred.

- 4.5 As pointed out by the appellant, this interpretation of claim 3 as filed is also supported by paragraphs [0074] and [0075] of the application as filed (see the A1 publication). More specifically, in these paragraphs, two of the three compounds disclosed in claim 3 as filed after the wording "*being the most preferred ratios and quality of ...*" (monomeric aliphatic isocyanate and prepolymer aromatic isocyanate) are disclosed as more or most preferred. This corroborates the above interpretation that the wording "*being the most preferred ratios and quality of ...*" refers to what comes next rather than what is stated before.
- 4.6 Moreover, contrary to the respondent's view, the feature "*3 : 6 : 1*" in the second part of the claim expresses three ratios, i.e. the ratios among the wall-forming materials, and not only one ratio. Therefore, the plural form "*ratios*" is in line with the above-mentioned reading of claim 3 as filed.
- 4.7 Furthermore, if the respondent's reading of the sentence "*being the most preferred ratios*" as belonging to the first part of the claim were to be accepted, the following sentence, i.e. "*and quality of isocyanates monomer aliphatic isocyanate : prepolymer aromatic isocyanate : monomer ACD of 3 : 6 : 1*", would make no sense, not only from a technical point of view but also from a semantic point of view.
- 4.8 As a consequence, the second part of claim 3 as filed, starting with "*being the most preferred ratios and quality of*", may contain unconventional wording but it clearly expresses optional preferred features and not a further specification of the feature mentioned in the first part of the claim. Contrary to the respondent's



argument, its inclusion in claim 1 of the main request is thus not needed to comply with the requirements of Article 123(2) EPC.

- 4.9 For these reasons, the board has concluded that the respondent's sole objection under Article 123(2) EPC is not convincing. Therefore, the main request fulfils the requirements of Article 123(2) EPC.

Main request - claim 1 - respondent's objection under Article 123(3) EPC - admittance into the proceedings

5. In its reply to the statement of grounds of appeal (page 10, second paragraph), the respondent stated that *"to the extent that 'sterioisomeric' [sic] has a broader meaning than 'stereochemical', claim 1 of the Main Request contravenes both Article 123(2) and (3) EPC"*.

The appellant requested that this objection under Article 123(3) EPC not be admitted into the proceedings.

- 5.1 Under Article 12(3) RPBA 2020, the reply to the grounds of appeal shall contain the respondent's complete case. It shall set out clearly and concisely the reasons why it is requested that the decision under appeal be reversed, amended or upheld, and should specify expressly all the facts, objections, arguments and evidence relied on.
- 5.2 The respondent argued that its objection in the reply to the appeal was complete insofar as possible given the circumstances. It submitted that no definition of the terms "stereochemical" and "stereoisomeric" had been provided by the appellant. Thus, no complete assessment of compliance with Article 123(3) EPC could be made. The replacement of "stereochemical" by "stereoisomeric" in claim 1 of the main request had

been made by the appellant. Since this amendment raised a new issue under Article 123(3) EPC, it was up to the appellant to show that Article 123(3) EPC was met.

5.3 The board finds this argument unconvincing.

5.3.1 Whether or not the replacement of the term "*stereochemical*" by "*stereoisomeric*" in claim 1 of the main request complied with Article 123(3) EPC was not discussed before the opposition division. However, in the appealed decision (page 7, section 1.1.3), the opposition division concluded that stereoisomers were a particular case of a stereochemical configuration and, thus, that the term "*stereochemical*" was broader than the term "*stereoisomeric*". In other words, the amendment of "*stereochemical*" to "*stereoisomeric*" restricted the claimed subject-matter.

5.3.2 Therefore, by raising in its reply to the appeal an objection under Article 123(3) EPC in view of the amendment of the term "*stereochemical*" to "*stereoisomeric*" in claim 1 of the main request, the respondent should have explained why the above conclusion of the opposition division was not correct. This explanation would have been necessary to comply with the above requirement of Article 12(3) RPBA 2020, according to which the complete case should be presented with the reply to the appeal.

5.3.3 However, the respondent did not provide this explanation, and therefore the respondent's objection under Article 123(3) EPC was not substantiated in the reply to the appeal. As a consequence, neither the board nor the appellant were in a position to understand why the amendment of the term "*stereochemical*" to "*stereoisomeric*" would have led to an extension of the protection conferred. For these reasons, the board has concluded that the respondent's

case regarding Article 123(3) EPC was not complete in the reply to the appeal.

5.4 Under Article 12(5) RPBA 2020, the board has the discretion not to admit any part of a submission by a party which does not meet the requirement under Article 12(3) RPBA 2020 of presenting its complete case at the onset of the appeal proceedings.

5.5 Hence, in exercising its discretion under Article 12(5) RPBA 2020, the board has decided not to admit the respondent's objection under Article 123(3) EPC into the proceedings.

6. *Main request - claim 1 - clarity under Article 84 EPC*

6.1 The feature of claim 1 of the main request which reads "*(c) compound(s) of formula (I) - acetylene carbamide derivatives - said compounds of claim 1 (c) being a mixture of compounds (I) in the form of...*" contains a reference to claim 1 itself. The respondent considered this feature to lack clarity. It argued that this feature had been taken from dependent claim 13 as granted. By incorporating this feature into claim 1 of the main request, the appellant decided to deviate from the conventional way of including a feature from a dependent claim in an independent claim. The appellant could have just introduced the subject-matter of dependent claim 13 into claim 1. Instead, it decided not to do so but to also incorporate the reference to claim 1 itself. This reference therefore had to play a role in the definition of the invention in claim 1. Yet this role was unclear, thus contravening Article 84 EPC.

6.2 The board disagrees.

While the inclusion in claim 1 of the expression "*said compound of claim 1 (c)*" may be regarded as

unconventional, it does not affect the clarity of the claimed subject-matter. In fact, it is clear that this expression refers to the compounds of formula (I) as mentioned under item (c) of claim 1 and required in the wall-forming materials.

Moreover, when asked by the board at the oral proceedings about other possible meanings of the inserted expression, the respondent could not explain what else could be intended other than the reference to the compounds of formula (I) as mentioned under item (c) of claim 1.

- 6.3 For this reason, the board has concluded that the respondent's sole objection under Article 84 EPC against the main request is not convincing. Therefore, the main request meets the requirements of Article 84 EPC.

Remittal to the opposition division

7. The appellant requested that the case be remitted to the opposition division for further prosecution if a claim request was found to comply with Article 123(2) EPC. The respondent did not raise any objection against this request of the appellant in the written or oral proceedings.
- 7.1 Under Article 12(2) RPBA 2020, the primary object of the appeal proceedings is to review the decision under appeal in a judicial manner to give the losing party an opportunity to challenge the decision on its merits.
- 7.2 The appealed decision deals only with the issue of added subject-matter under Article 123(2) EPC. However, the opposition also invoked a lack of sufficiency of disclosure and a lack of inventive step (Article 100(a) and (b) EPC).

- 7.3 Therefore, essential questions concerning the patentability of the claimed subject-matter have not yet been examined or decided upon by the opposition division.
- 7.4 Hence, the board finds it appropriate to make use of its discretion under Article 111(1) EPC and to remit the case to the opposition division for further prosecution, in accordance with the appellant's request.

## 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:



N. Maslin

M. O. Müller

Decision electronically authenticated