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**Datasheet for the decision
of 23 March 2023**

Case Number: T 0775/21 - 3.3.02

Application Number: 09778781.6

Publication Number: 2482648

IPC: A01N37/02, A01N37/06, A01N59/20

Language of the proceedings: EN

Title of invention:

OIL BORNE WOOD PRESERVING COMPOSITION FOR TREATMENT OF POLES,
POSTS, PILING, CROSS-TIES AND OTHER WOODED STRUCTURES
COMPRISING FATTY ACID AND BIVALENT COPPER

Patent Proprietor:

Koppers Performance Chemicals Inc.

Opponent:

Arxada AG

Headword:

Relevant legal provisions:

EPC Art. 100 (c), 123 (2)

Keyword:

Grounds for opposition - added subject-matter (yes)
Auxiliary requests - added subject-matter (yes)

Decisions cited:

T 0859/94, T 0615/95, T 0783/09, T 0407/10

Catchword:



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Case Number: T 0775/21 - 3.3.02

D E C I S I O N
of Technical Board of Appeal 3.3.02
of 23 March 2023

Appellant: Koppers Performance Chemicals Inc.
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Decision under appeal: **Decision of the Opposition Division of the
European Patent Office posted on 25 March 2021
revoking European patent No. 2482648 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 opposition division's decision to revoke European patent No. 2 482 648 ("the patent").

II. Claim 1 as granted reads as follows:

*"1. A wood preservative composition comprising:
bivalent copper selected from the group consisting of cupric oxide and copper hydroxide and a fatty acid derived from tall oil, and an oil; and
an organic co-biocide selected from the group consisting of a quaternary ammonium compound, a triazole compound, a borate compound, and a fluoride compound,
wherein the fatty acid compound is selected from the group consisting of palmitic fatty acid, arachidic fatty acid, linoleic fatty acid, oleic fatty acid, and stearic fatty acid, and
the oil is selected from the group consisting of lard, butter, hemp oil, canola oil, sunflower oil, olive oil, corn oil, palm oil, coconut oil, pine oil, cottonseed oil, wheat germ oil, soya oil, safflower oil, linseed oil, tung oil, castor oil, soybean oil, peanut oil, rapeseed oil, sesame seed oil, rice germ oil, fish oil, whale oil and tall oil, aliphatic petroleum distillates, aromatic kerosene extracts, and mineral oil."*

III. An 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 6. 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 to 6 infringed Article 123(2) EPC.

- IV. In its statement of grounds of appeal, the appellant contested the opposition division's reasoning and submitted that the claimed subject-matter was disclosed in the application as filed.
- V. In its reply to the appeal, the opponent ("respondent") rebutted the appellant's arguments and maintained that the claims of all the appellant's requests contained added subject-matter.
- VI. 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 subject-matter of the claims of all the appellant's requests was not directly and unambiguously disclosed in the application as filed.
- VII. By letter dated 24 January 2023, the appellant replied to the board's communication.
- VIII. Oral proceedings before the board were held on 23 March 2023 in the presence of both parties. During oral proceedings, the appellant submitted an allegation of fact that the interchangeability of the terms "*pine oil*" and "*tall oil*" was part of the common general

knowledge. In support of this, the appellant filed an excerpt from Wikipedia regarding "Tall oil".

IX. Final requests

The appellant requested that the decision under appeal be set aside and that the case be remitted to the opposition division for further prosecution on the basis of the patent as granted (main request) or one of auxiliary requests 1 to 6 underlying the decision under appeal, if the board finds one of these requests not to be prejudiced by the ground for opposition under Article 100(c) EPC or Article 123(2) EPC.

The respondent requested that the appeal be dismissed. It also requested that the case not be remitted to the opposition division for further prosecution. The respondent further requested that the appellant's allegation of fact regarding the interchangeability of the terms "*pine oil*" and "*tall oil*" and the excerpt from Wikipedia regarding "Tall oil", filed by the appellant at the oral proceedings, not be admitted into the proceedings.

X. The appellant'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.

- Claim 1 as filed defined the invention as a composition of four components.
- In claim 1 as granted, each of these components had merely been further restricted.
- This shrinkage did not lead to any singling-out of an undisclosed composition in line with decisions T 0615/95, T 0859/94, T 0407/10 and T 0783/09.

- As regards the feature that the fatty acids derived from tall oil, there was a clear pointer in both paragraph [0040] and the examples of the application as filed.
- It had to be concluded that the ground for opposition under Article 100(c) EPC did not prejudice the maintenance of the patent as granted.
- The same applied to the subject-matter of auxiliary requests 1 to 6, which complied with Article 123(2) EPC.

XI. The respondent's submissions, where relevant to the present decision, are summarised as follows.

- The subject-matter of claim 1 as granted derived from multiple selections within the application as filed without there being any pointer towards those selections.
- In particular, the five fatty acids required by claim 1 had been selected from a list of fourteen equally preferred fatty acids disclosed in paragraphs [008] and [0023] of the application as filed. Other commercially available fatty acids were disclosed in paragraph [0040] of the application as filed. The application as filed did not indicate any level of preference, so the selection was arbitrary.
- Even though the application as filed stated that the two selected bivalent copper compounds were the most preferred, it did not contain any pointer towards the combination of those compounds with the five fatty acids mentioned in claim 1.
- The four classes of organic co-biocides included in claim 1 had been selected from paragraph [0010] of the application as filed. However, the same

paragraph mentioned several other classes of organic co-biocides. Moreover, said paragraph stated specific compounds that were preferred, but these had not been included in claim 1. Other classes of organic co-biocides were disclosed in other paragraphs of the application as filed. In particular, exemplary compounds were indicated in paragraphs [0031] to [0035] of the application as filed.

- The application as filed did not contain any pointer towards the combination of the claimed four classes of organic co-biocides with the bivalent copper compounds and the fatty acids mentioned in claim 1.
- Furthermore, claim 1 as granted required the five mentioned fatty acids to be "*derived from tall oil*". This wording was only disclosed in paragraph [0023] of the application as filed. However, to arrive at the feature of claim 1, two selections from two lists within this paragraph were needed. There was no pointer towards this double selection in the application as filed.
- The fact that the five fatty acids defined in claim 1 might be derived from tall oil was irrelevant since the same fatty acids could also be derived from a number of other oils.
- Moreover, at no point did paragraph [0039] of the application as filed disclose fatty acids derived from tall oil.
- Paragraph [0040] of the application as filed disclosed two commercial tall oil fatty acids suitable for use in the composition. However, this disclosure did not imply that fatty acids derived from tall oil were preferred. Rather, the previous

paragraph [0039] indicated linseed oil as the oil from which fatty acids were derived. Additionally, there was no link in the application as filed between the commercial fatty acids of paragraph [0040] and the five fatty acids required by claim 1.

- Even if it were accepted that pine oil used in some of the examples was the same as tall oil, those examples disclosed fatty acids derived from pine oil in general. There was no link to the specific fatty acids required by claim 1 as granted. Hence, these examples did not represent a pointer towards the claimed feature of five specific fatty acids derived from tall oil either.
- The same objections applied to the subject-matter of claim 1 of the auxiliary requests. Moreover, claim 1 of all the auxiliary requests contained the further selection of tall oil as the oil included in the composition.
- It had to be concluded that claim 1 of all the claim requests defined subject-matter which extended beyond the content of the application as filed.

Reasons for the Decision

Main request - the patent as granted - claim 1 - ground for opposition under Article 100(c) EPC - added subject-matter

1. Claim 1 as granted reads as follows, the amendments compared with claim 1 as filed having been highlighted by the board:

"1. A wood preservative composition comprising:

bivalent copper selected from the group consisting of cupric oxide and copper hydroxide and a fatty acid derived from tall oil, and an oil; and

an organic co-biocide selected from the group consisting of a quaternary ammonium compound, a triazole compound, a borate compound, and a fluoride compound,

wherein the fatty acid compound is selected from the group consisting of palmitic fatty acid, arachidic fatty acid, linoleic fatty acid, oleic fatty acid, and stearic fatty acid, and

the oil is selected from the group consisting of lard, butter, hemp oil, canola oil, sunflower oil, olive oil, corn oil, palm oil, coconut oil, pine oil, cottonseed oil, wheat germ oil, soya oil, safflower oil, linseed oil, tung oil, castor oil, soybean oil, peanut oil, rapeseed oil, sesame seed oil, rice germ oil, fish oil, whale oil and tall oil, aliphatic petroleum distillates, aromatic kerosene extracts, and mineral oil."

2. The appellant argued that claim 1 as granted was based on claim 1 as filed in combination with certain passages of the description as filed. More specifically, it took the view that claim 1 as filed was directed to a composition comprising four components, namely:

- a fatty acid
- bivalent copper
- an organic co-biocide
- an oil

2.1 In claim 1 as granted, each of these components had merely been further restricted using the lists

disclosed in the description as filed. Reference was made to paragraphs [008] and [0032] for the fatty acid, [009] and [0019] for the bivalent copper, [0010] and [0027] for the organic co-biocide and [0011] for the oil. For the copper compounds in particular, the two most preferred substances as disclosed in paragraph [0019] of the application as filed had been selected.

2.2 Even if some elements from these lists had been deleted, this shrinkage of the lists did not lead to any singling-out of an undisclosed composition. It had to be noted that the claimed composition did not derive from the combination of features taken from different embodiments. Rather, the application as filed disclosed a single invention and the skilled person would have understood that the definitions of each of the four components were always intended to be combined within the broader disclosure of this single invention. The appellant referred to decisions T 0615/95, T 0859/94, T 0407/10 and T 0783/09.

2.3 As regards the feature that the fatty acid derived from tall oil, the appellant referred to paragraph [0039] as filed, which disclosed two overall possibilities: the fatty acid was derived either from the same oil included in the composition or from a different oil. The skilled person was thus presented with a binary choice. Claim 1 as granted covered both possibilities since the fatty acid was stated as being derived from tall oil and the list of oils also included tall oil. Moreover, paragraph [0040] as filed disclosed non-limiting examples of fatty acids derived from tall oil. Two commercial products were mentioned, these being - the only commercial products identified in the whole application as filed. This clearly demonstrated that fatty acids derived from tall oil were the most preferred fatty acids. Even though claim 1 mentioned

five specific fatty acids, it was part of the common general knowledge that these fatty acids might be derived from tall oil.

At the oral proceedings, the appellant further argued that the majority of the examples of the application as filed disclosed compositions comprising fatty acids from pine oil. It was part of the common general knowledge that pine oil was a synonym for tall oil, so the two terms could be used interchangeably. This was confirmed by the excerpt from Wikipedia on "Tall oil" filed by the appellant at the oral proceedings before the board.

Therefore, in the appellant's view, the application as filed contained a clear pointer towards including fatty acids derived from tall oil in the compositions of the invention.

3. The board disagrees and concurs with the respondent that the subject-matter of claim 1 as granted derives from multiple selections within the application as filed, without there being any direct and unambiguous disclosure pointing to these selections, for the following reasons.

3.1 The five fatty acids mentioned in claim 1 as granted (point 1 above) have been selected from a list of fourteen equally preferred fatty acids disclosed in paragraphs [008] and [0023] of the application as filed. Other commercially available fatty acids are disclosed in paragraph [0040] of the application as filed. The application as filed does not contain any indication that the five selected fatty acids were preferred. In other words, there is no disclosure in the application as filed pointing to the five selected fatty acids.

- 3.2 The two bivalent copper compounds mentioned in claim 1 as granted (point 1 above) have been selected from a list of fifteen compounds disclosed in paragraphs [009] and [0019] of the application as filed. Although the two selected compounds are stated as being the most preferred, there is no pointer in the application as filed towards the combination of these two specific copper compounds with the five fatty acids mentioned in claim 1.
- 3.3 The four classes of organic co-biocides included in claim 1 as granted have been selected from paragraph [0010] of the application as filed. However, the same paragraph mentions several other classes of organic co-biocides, including fungicides, insecticides, algaecides, moldicides, miticides and bactericides. Moreover, said paragraph states that specific compounds are preferred but these have not been included as such in claim 1. Additionally, paragraph [0027] of the application as filed discloses other classes of organic co-biocides to be used in the compositions of the invention. Other specific examples of compounds are mentioned in paragraphs [0031] to [0035] of the application as filed. Hence, the claimed selection of the co-biocide also has to be regarded as lacking a pointer in the application as filed. Moreover, the application as filed does not contain any pointer towards the combination of the claimed four classes of organic co-biocides with the bivalent copper compounds and the fatty acids mentioned in claim 1.
- 3.4 As regards decisions T 0615/95, T 0859/94, T 0407/10 and T 0783/09 referred to by the appellant, the following is noted.
- 3.4.1 In decision T 0615/95 (point 6 of the reasons), the claim was directed to a single compound defined by a chemical formula with various residues to be selected

from respective lists. The amendment accepted by the competent board involved a restriction of the lists of three residues. The board held that the formula after this amendment maintained its level of generality without singling out particular combinations of specific meanings of the residues. Moreover, all the examples as filed fell within the scope of the amended formula. Therefore, the case underlying T 0615/95 is totally different from the one in hand, which concerns a composition including specific components rather than a generic chemical formula of a compound. The rationale developed in T 0615/95 is not applicable to the case at issue.

3.4.2 The case underlying decision T 0859/94 was very similar to that dealt with in T 0615/95, with the difference that the competent board concluded that the restrictions of the lists of residues did lead to an inadmissible singling-out of specific meanings of the residues (points 2.4.3 and 2.5 of the reasons). This decision therefore cannot help the appellant's case either.

3.4.3 In decision T 0407/10 (point 7 of the reasons), claim 1 of the claim request found allowable by the competent board contained, as the sole amendment to claim 1 as filed, the restriction of components (2) and (5) to single compounds. The application as filed had indicated that the two compounds were the preferred ingredients (2) and (5). The situation in T 0407/10 was thus totally different from the one in hand, and therefore the rationale of that decision is not applicable to the case at issue.

3.4.4 In decision T 0783/09 (point 5 of the reasons), the claim found allowable by the competent board was directed to the combination of only two components, the first being specific and the second being selected from

a list. The specific component was indicated in the application as filed as being very preferred. Moreover, it was disclosed that in a very preferred embodiment of the invention, said very preferred component was combined with a second one selected from a list. In the allowable claim, this list had been restricted to three compounds. According to the competent board, there was a pointer towards the claimed combination in the application as filed. However, for the reasons set out above, the situation is not the same in the current case, in which four components or classes of components are combined in claim 1 without there being any pointer towards that combination.

3.5 For these reasons alone, the subject-matter of claim 1 as granted does not result from the mere shrinkage of lists but derives from multiple selections of compounds or classes of compounds from different lists disclosed in the application as filed, with no pointer towards those selections.

3.6 Claim 1 as granted further requires that the five mentioned fatty acids are "*derived from tall oil*". Contrary to the appellant's view, this feature is not directly and unambiguously disclosed in the application as filed.

3.6.1 Paragraph [0039] of the application as filed, invoked by the appellant as the basis for this feature, merely discloses that in one embodiment the fatty acid of the composition is derived from an oil of the same identity as the oil selected for the composition. The very same paragraph discloses, however, that in another embodiment the fatty acid chosen for the composition is not derived from an oil used in the composition. At no point does paragraph [0039] disclose a fatty acid derived from tall oil; only linseed oil is mentioned as an example of oil. Even though tall oil is mentioned as

an oil possibly present in the composition (e.g. in paragraphs [0011], [0023] and [0037] of the application as filed), the above general statement in paragraph [0039] does not represent the basis for the feature of claim 1 as granted specifically requiring that the palmitic, arachidic, linoleic, oleic or stearic fatty acid, as included in the composition, is derived from tall oil. In fact, these five fatty acids can be derived from a number of different oils, as confirmed by paragraph [0023] of the application as filed. The fact that these five fatty acids could also be present in tall oil does not change this conclusion.

3.6.2 The appellant also pointed to paragraph [0023] of the application as filed as the basis for the feature of claim 1 that the five mentioned fatty acids are "*derived from tall oil*". However, this feature can only be arrived at by carrying out two selections from two lists within paragraph [0023]: firstly, the list of fourteen fatty acids from which the five acids mentioned in claim 1 have been selected, and secondly, the list of twenty-five oils from which tall oil has been selected. However, there is no pointer towards this double selection in the application as filed.

3.6.3 Paragraph [0040] of the application as filed, indicated by the appellant as the pointer towards the above feature, merely discloses that certain commercial tall oil fatty acids, namely "*SYLFAT®2*" and "*for2*", have properties that render them suitable for use in the composition of the invention. However, merely mentioning these two commercial products does not imply that fatty acids derived from tall oil are preferred. In fact, as pointed out by the respondent, the preceding paragraph [0039] of the application as filed indicates linseed oil as the oil from which fatty acids may be derived. Moreover, there is no link in the

application as filed between the commercial fatty acids of paragraph [0040] and the five fatty acids required by claim 1.

- 3.6.4 As stated above, on the basis of the excerpt from Wikipedia on "Tall oil" filed at the oral proceedings before the board, the appellant asserted that the terms "*pine oil*" and "*tall oil*" were interchangeable and argued that the skilled person would thus have recognised a pointer towards the selection of fatty acids derived from tall oil in the examples of the application as filed.

The board decided not to admit this allegation of fact into the proceedings. However, even if it were accepted, for the sake of argument, that "*pine oil*" was a synonym of "*tall oil*" as asserted by the appellant, the examples would not be regarded as a suitable pointer towards the feature at issue. In fact, the compositions of examples 3 and 5 to 9 of the application as filed (pages 16 to 19) are stated as comprising "*pine oil fatty acid*" but there is no disclosure of any details about the specific nature of the fatty acid included.

- 3.6.5 Therefore, the feature of claim 1 whereby specifically the palmitic, arachidic, linoleic, oleic or stearic fatty acid included in the claimed composition is "*derived from tall oil*" is not directly and unambiguously disclosed in the application as filed.

- 3.6.6 Since the board, in arriving at this conclusion, also took account of the appellant's allegation of fact that the terms "*pine oil*" and "*tall oil*" were interchangeable, there is no need for the board to give reasons as to why this allegation of fact was not admitted into the proceedings.

4. For the reasons set out above, claim 1 as granted defines subject-matter that extends beyond the content of the application as filed. Therefore, the ground for opposition under Article 100(c) EPC prejudices the maintenance of the patent as granted. Hence, the main request is not allowable.

Auxiliary requests - claim 1 - added subject-matter under Article 123(2) EPC

5. Auxiliary request 1

- 5.1 Claim 1 of auxiliary request 1 reads as follows, the amendments compared with claim 1 as granted having been highlighted by the board:

"1. A wood preservative composition comprising:

bivalent copper selected from the group consisting of cupric oxide and copper hydroxide and a fatty acid derived from tall oil, and ~~an-tall~~ oil; and

an organic co-biocide selected from the group consisting of a quaternary ammonium compound, a triazole compound, a borate compound, and a fluoride compound,

wherein the fatty acid compound is selected from the group consisting of palmitic fatty acid, arachidic fatty acid, linoleic fatty acid, oleic fatty acid, and stearic fatty acid, ~~and~~

~~the oil is selected from the group consisting of lard, butter, hemp oil, canola oil, sunflower oil, olive oil, corn oil, palm oil, coconut oil, pine oil, cottonseed oil, wheat germ oil, soya oil, safflower oil, linseed oil, tung oil, castor oil, soybean oil, peanut oil, rapeseed oil, sesame seed oil, rice germ oil, fish oil, whale oil and tall oil, aliphatic petroleum~~

~~distillates, aromatic kerosene extracts, and mineral oil."~~

- 5.2 Therefore, claim 1 of auxiliary request 1 contains the same selections as claim 1 as granted as regards the fatty acid, covalent copper and organic co-biocide. Moreover, as in claim 1 as granted, the fatty acid has to be derived from tall oil. Therefore, the same objections apply as raised above against claim 1 as granted.
- 5.3 Additionally, the oil included in the composition has been restricted to tall oil. Therefore, a further selection of a single oil has been made from among the twenty-eight compounds listed in paragraphs [0011] and [0037] or the twenty-five oils listed in paragraph [0023] of the application as filed. There is no pointer in the application as filed towards the combination of the selected oil with the four classes of organic co-biocides, the two bivalent copper compounds and the five fatty acids mentioned in claim 1.
- 5.4 Therefore, claim 1 of auxiliary request 1 defines subject-matter that extends beyond the content of the application as filed, contrary to the requirements of Article 123(2) EPC. Auxiliary request 1 is not allowable.
6. Auxiliary request 2
- 6.1 Claim 1 of auxiliary request 2 is identical to claim 1 of auxiliary request 1 with the sole difference that the five fatty acids have been replaced with "*a tall oil fatty acid (TOFA) selected from the group consisting of SYLFAT®2 (Arizona Chemical) or for2 (Rauma Finland)*".

6.2 The appellant indicated paragraph [0040] of the application as filed as disclosing the fatty acids mentioned in claim 1 of this request.

However, there is no pointer in the application as filed towards the combination of these commercial fatty acids with tall oil, the four classes of organic co-biocides and the bivalent copper compounds required by claim 1. Hence, as for claim 1 of auxiliary request 1, multiple selections within the application as filed are needed to arrive at the subject-matter of claim 1 of auxiliary request 2, without there being any pointer towards those selections in the application as filed.

6.3 Therefore, claim 1 of auxiliary request 2 defines subject-matter that extends beyond the content of the application as filed, contrary to the requirements of Article 123(2) EPC. As a consequence, auxiliary request 2 is not allowable.

7. Auxiliary requests 3 to 6

7.1 Auxiliary requests 3 to 6 all contain the same claim 1, which is identical to claim 1 of auxiliary request 1 with the sole difference that the list of fatty acids has been restricted to linoleic fatty acid and oleic fatty acid. Hence, an even more limited selection is needed to arrive at the fatty acids of claim 1, without there being any pointer in the application as filed.

7.2 It follows that the same objections against claim 1 of auxiliary request 1 apply *mutatis mutandis* against claim 1 of auxiliary requests 3 to 6. Claim 1 of these requests defines subject-matter that extends beyond the content of the application as filed, contrary to the requirements of Article 123(2) EPC. Therefore, auxiliary requests 3 to 6 are not allowable.

Conclusion

8. None of the appellant's claim requests is allowable.

Order

For these reasons it is decided that:

The appeal is dismissed.

The Registrar:

The Chairman:



N. Maslin

M. O. Müller

Decision electronically authenticated