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**Datasheet for the decision  
of 19 January 2024**

**Case Number:** T 1508/21 - 3.3.03

**Application Number:** 13813103.2

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C08J3/22

**Language of the proceedings:** EN

**Title of invention:**

BARIUM SULFATE COMPOSITE PARTICLES, RESIN COMPOSITION  
CONTAINING SAME, AND PROCESS FOR PRODUCING SAME

**Patent Proprietor:**

Sakai Chemical Industry Co., Ltd.

**Opponent:**

Venator Germany GmbH

**Relevant legal provisions:**

RPBA 2020 Art. 12(6) sentence 2, 13(2)  
EPC Art. 54

**Keyword:**

Late-filed evidence - should have been submitted in first-instance proceedings (yes)

Late-filed evidence - circumstances of appeal case justify admittance (no)

Novelty - (yes)

**Decisions cited:**

T 0724/08, T 2576/12, T 2352/19, T 0364/20



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Case Number: T 1508/21 - 3.3.03

**D E C I S I O N**  
**of Technical Board of Appeal 3.3.03**  
**of 19 January 2024**

**Appellant:** Venator Germany GmbH  
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**Respondent:** Sakai Chemical Industry Co., Ltd.  
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**Decision under appeal:** **Decision of the Opposition Division of the  
European Patent Office posted on 14 July 2021  
rejecting the opposition filed against European  
patent No. 2871209 pursuant to Article 101(2)  
EPC.**

**Composition of the Board:**

**Chairman** D. Semino  
**Members:** M. Barrère  
L. Basterreix

## Summary of Facts and Submissions

- I. The appeal of the opponent lies against the decision of the opposition division rejecting the opposition against European Patent No. 2 871 209.
- II. The following document was *inter alia* cited in the decision of the opposition division:  

D1: DE 4404953 A1
- III. In that decision the opposition division held, among others, that the subject-matter of granted claim 1 was novel over D1 and involved an inventive step over that document as the closest prior art.
- IV. The opponent (appellant) filed an appeal against said decision.
- V. With the rejoinder to the statement of grounds of appeal, the patent proprietor (respondent) filed three sets of claims as auxiliary requests 1 to 3.
- VI. Oral proceedings were held before the Board on 19 January 2024.
- VII. The following documents were filed by the appellant:
  - D11: Experimental report dated 21 September 2021 filed with the statement of grounds of appeal
  - D12: Experimental report dated 21 August 2023 filed with the letter dated 21 December 2023
  - Annexes to the letter dated 17 January 2024

- D13 to D36: Evidence of prior use filed during the oral proceedings before the Board

VIII. The appellant requested that the decision under appeal be set aside and the patent be revoked. The appellant also requested that documents D11 and D12, the annexes to the letter dated 17 January 2024 and documents D13 to D36 be admitted into the proceedings.

The respondent requested that the appeal be dismissed. In the alternative, the respondent requested that the patent be maintained in amended form on the basis of one of auxiliary requests 1 to 3 filed with the rejoinder to the statement of grounds of appeal. The respondent further requested that documents D11 and D12, the annexes to the appellant's letter dated 17 January 2024 and documents D13 to D36 not be admitted into the proceedings.

IX. Claim 1 as granted (main request of the respondent) read as follows:

"1. Barium sulfate composite particles having a zinc compound adhered to the particle surface and having an average particle diameter of 0.01 to 10  $\mu\text{m}$ , wherein a deposited amount of zinc compound is 0.05 to 1.0 weight% in terms of ZnO relative to the barium sulfate composite particle."

The remaining granted claims as well as the claims of auxiliary requests 1 to 3 are not relevant to this decision.

X. The appellant's submissions, in so far as they are pertinent to the present decision, may be derived from

the reasons for the decision below. They were essentially as follows:

(a) Admittance of late-filed evidence

Documents D11 and D12, the annexes to the letter dated 17 January 2024 and documents D13 to D36 should be admitted into the proceedings.

(b) Novelty over document D1

Documents D11 and D12 provided evidence that the subject-matter of granted claim 1 was anticipated by the example of document D1.

XI. The respondent's submissions, in so far as they are pertinent to the present decision, may be derived from the reasons for the decision below. They were essentially as follows:

(a) Admittance of late-filed evidence

Documents D11 and D12, the annexes to the letter dated 17 January 2024 and documents D13 to D36 should not be admitted into the proceedings.

(b) Novelty over document D1

Documents D11 and D12 were not suitable to show that the subject-matter of granted claim 1 was anticipated by the example of document D1.

## **Reasons for the Decision**

1. Admittance of late-filed documents
  - 1.1 Document D11
    - 1.1.1 Document D11 is an experimental report filed by the appellant with the statement of grounds of appeal. Its purpose is to provide evidence that the subject-matter of granted claim 1 is not novel in view of the experimental section of document D1. In particular, according to the appellant, D11 reports a reworking of sample 3 of the example of D1 including the measurement of the ZnO content showing that said content was within the range defined in granted claim 1.
    - 1.1.2 The respondent requested that D11 and the corresponding written submissions of the appellant not be admitted into the proceedings.
    - 1.1.3 According to the appellant, D11 should be admitted into the proceedings for the following reasons:
      - (a) D11 was not a new submission because it only confirmed/corroborated what the appellant had already repeatedly argued during the opposition proceedings. In that respect, reference was made to decision T 364/20 where the corresponding Board took into account a late-filed document (document A012) confirming the public availability of a prior art document.
      - (b) Due to the general emergency caused by the COVID pandemic as well as severe economic and personal

issues, the appellant was not able to complete report D11 at an earlier stage.

- (c) The EPO's primary task was to grant patents only if they were new, inventive and industrially applicable. This meant that the Boards of Appeal of the EPO had the duty of maintaining the quality of European patents. This task would not be fulfilled if the Board upheld the decision of the opposition division despite knowledge that sample 3 of the example of D1 was novelty-destroying for granted claim 1. In this respect, the appellant submitted that the fact that D11 provided evidence that D1 was novelty-destroying constituted exceptional circumstances justifying the admittance of D11. In that context, reference was made to decision T 2352/19 in which the corresponding Board noted that "exceptional circumstances can justify the admittance of a new request if a causal link exists between the new aspect raised by the Board and the Board's final conclusion, because the right to be heard requires the possibility of providing a defense against it" (point 2.5.2 of the reasons).

- 1.1.4 Article 12(6) RPBA, second sentence provides that evidence which should have been submitted in the proceedings leading to the decision under appeal should not be admitted, unless the circumstances of the appeal case justify its admittance.

The admittance of late-filed submissions is usually carried out in two steps. The question to be answered in the first step is whether the submission objected to is an amendment to the appellant's appeal case (as argued by the respondent). If that question is answered in the negative, then the Board has no discretion not



to take the submission into account. If, however, that question is answered in the affirmative, then the Board needs to decide whether said submission can be admitted (second step).

- 1.1.5 The first question to be answered by the Board is therefore whether document D11 constitutes an amendment of the appellant's case.

An amendment to a party's appeal case under Article 12(4) RPBA (with reference to Article 12(2) RPBA ) is a submission which is not directed to the requests, facts, objections, arguments and evidence on which the decision was based. In other words: it goes beyond the framework established therein (Case Law of the Boards of Appeal, 10th edition 2022, in the following "Case Law", V.A.4.2.1 a)).

As noted above (point 1.1.3 (a)), the appellant held that D11 did not provide new information thereby implying that this experimental report cannot be seen as an amendment of their case. The Board cannot agree with this argument because D11 discloses new experimental data such as the alleged ZnO content of sample 3 of the example of D1 (0,49 wt.-% ZnO). These data are clearly new facts that were not present in the submissions of the appellant during the opposition proceedings and are therefore an amendment of the appellant's case within the meaning of Article 12(4) RBPA 2020. The Board has therefore the discretion to admit D11 into the appeal proceedings, to be exercised in accordance with the Rules of Procedure.

- 1.1.6 The second question to be answered is whether D11 should have been submitted during the opposition proceedings.

(a) As noted above (point 1.1.3 (b)), the appellant stated that the COVID pandemic and serious business and personal problems made it impossible to carry out the necessary tests and to submit D11 during the opposition proceedings. While the Board acknowledges that the pandemic (among other difficult circumstances) has disrupted and delayed many processes in the industry, it is also noted that the patentee raised for the first time on 4 November 2019 the issue that D1 did not disclose a zinc content according to granted claim 1 (reply to the notice of opposition, page 4, penultimate paragraph). Furthermore, on two occasions, the opposition division followed the patentee's assessment of D1 (communication dated 13 December 2019, page 1, point 3.1 and communication dated 9 October 2020, page 1, point 2.1). In view of the fact that the contested decision was taken during the oral proceedings of 17 June 2021 (i.e. 19 months after the reply to the notice of opposition), the Board considers that the appellant had sufficient time to rebut the patentee's submissions by filing report D11 during the opposition proceedings.

Moreover, it is pointed out that the appellant could at least have informed the opposition division that they needed more time to carry out additional experiments and could have requested a postponement of the oral proceedings in order to file D11. However, no request in this sense was submitted during opposition proceedings.

(b) Finally, the Board cannot recognise any circumstance of the appeal case which would justify

the admittance of D11, since the main issue in dispute between the parties in the appeal proceedings (whether D1 disclosed composite particles with a ZnO content as defined in claim 1) was already contested from the beginning of the opposition proceedings.

(c) Under these circumstances the Board takes the view that D11 should have been filed during the opposition proceedings and the circumstances of the appeal case do not justify its admittance.

1.1.7 The appellant referred to decision T 364/20 allegedly justifying the admittance of a document (document A012) merely confirming an information submitted during the opposition proceedings (letter of 17 January 2024, page 3, second paragraph). However the Board cannot recognise in T 364/20 any decision on the admittance of document A012. Therefore decision T 364/20 cannot be seen as relevant to the present case. The same applies to decision T 2352/19 which concerns a situation where a new aspect was raised by the Board during the appeal proceedings (see the cited statement in point 2.5.2 of the reasons reported in point 1.1.3 (c) above). In the present case, contrary to that decision, the disputed issue in D1 (the ZnO content) was discussed from the outset of the opposition proceedings.

1.1.8 The last argument put forward by the appellant relates to the *prima facie* relevance of D11 (point 1.1.3 (c)). According to the case law, the relevance of a new piece of evidence is not as such a sufficient criterion to justify its admittance into the appeal proceedings (see e.g. T 0724/08, point 3.4 of the reasons; T 2576/12, point 1.2.6 of the reasons). Otherwise an opponent could always wait until the onset of the appeal

proceedings to file highly relevant documents. Moreover, this would in effect undermine the nine-month opposition period. It follows that the Board is not obliged to consider the criterion of *prima facie* relevance when deciding on the admissibility of a late-filed document.

- 1.1.9 Under these circumstances, the Board finds it appropriate to exercise its discretion under Article 12(6) RPBA by not admitting document D11 into the proceedings.
  
- 1.2 Document D12
  - 1.2.1 Document D12 was filed by the appellant with letter of 21 December 2023 as a revised version of D11. Its purpose is identical to D11's purpose: i.e. to provide evidence that the subject-matter of granted claim 1 is not novel in view of sample 3 of the example of document D1. D12 was submitted in reaction to a criticism of the respondent that the experiment of D11 was not a true reworking of sample 3.
  - 1.2.2 The respondent requested that D12 not be admitted into the proceedings.
  - 1.2.3 The admission of D12 to the proceedings is subject to the discretionary power of the Board under Article 13(2) RPBA, however Article 12(6) RPBA continues to apply (Case Law, V.A.4.1.2). As mentioned above, D11 was not admitted to the proceedings because the Board considered that it should have been filed during the opposition proceedings but not because of any deficiency related to its experimental design. Since D12 is merely a revised version of D11, its admission can only suffer the same fate as the one of D11.

In other words, the respondent's submissions raising additional concerns about D11, concerns which were irrelevant to the non-admittance of D11, cannot justify the admittance of a corrected version of D11 at a later stage of the proceedings.

1.2.4 Accordingly, the Board finds it appropriate to exercise its discretion under Article 12(6) RPBA by not admitting document D12 into the proceedings.

1.3 Annexes to the letter dated 17 January 2024

1.3.1 The appellant filed several annexes which were allegedly first sent to the respondent by e-mail on 16 November 2023 (letter of 17 January 2024, page 4, last paragraph). The purpose of these annexes is to show that the respondent had been informed of D12 before its submission to the Board on 21 December 2023. The submission of D12 was therefore in no way surprising or unfair.

1.3.2 The respondent requested that these annexes not be admitted into the proceedings.

1.3.3 The admission of the annexes to the proceedings is subject to the discretionary power of the Board under Article 13(2) RPBA which provides that amendments to a party's case made after notification of a communication under Article 15, paragraph 1 RPBA shall not be taken into account unless exceptional circumstances, justified by cogent reasons, exist.

1.3.4 The Board notes that the content of the annexes was not explained by the appellant. It is therefore not apparent why these annexes have any bearing on the

admittance of document D12 (as argued by the appellant), let alone on the outcome of the appeal case. On that basis and in the absence of further submissions, the Board cannot identify any exceptional circumstances in the sense of Article 13(2) RPBA.

1.3.5 Consequently, the annexes to the letter of 17 January 2024 are not taken into account (Article 13(2) RPBA).

1.4 Documents D13 to D36

1.4.1 The appellant filed documents D13 to D36 during the oral proceedings before the Board.

1.4.2 The admission of these documents to the proceedings, which is contested by the respondent, is also subject to the discretionary power of the Board under Article 13(2) RPBA.

1.4.3 According to the appellant, documents D13 to D36 were filed as a fallback position in case D11 and D12 were not admitted. Their purpose was to provide evidence of a prior use which anticipated the subject-matter of granted claim 1. The appellant further stated that it took months to collect these documents.

1.4.4 The respondent requested that D13 to D36 not be admitted into the proceedings.

1.4.5 The Board notes that the appellant asserted in their statement of ground of appeal that they had evidence of a prior use which was prejudicial to novelty. It concerned a production batch that was manufactured and sold to a third party before the priority date of the opposed patent. However, they deliberately refrained

from submitting this additional evidence at the onset of the appeal proceedings (statement of grounds of appeal, page 5, third paragraph). In principle, an attempt by a party to submit at a late stage of the proceedings evidence that has been deliberately withheld is considered to be an abuse of procedure (Case Law, V.A.5.13.4 a) and b)). In any event, the Board fails to recognise any exceptional circumstances which would justify the filing and admittance of D13 to D36 during the oral proceedings, all the more so as it has been acknowledged that at least some of the evidence was already available at the beginning of the appeal proceedings.

- 1.4.6 Consequently, documents D13 to D36 and the corresponding allegation of prior use are not taken into account (Article 13(2) RPBA).

**Main request (patent as granted)**

2. Novelty and inventive step in view of document D1
- 2.1 The appellant's case for lack of novelty of granted claim 1 was based entirely on the experimental evidence in D11 and D12 (statement of grounds of appeal, page 3, penultimate paragraph; letter dated 21 December 2023, page 2). Given that these documents were not admitted to the proceedings, there is no further argument for the Board to consider. This was also confirmed by the appellant during the oral proceedings (minutes of oral proceedings, page 2, fourth paragraph).
- 2.2 For the sake of completeness, it is noted that the findings on inventive step of granted claim 1 as set out in the contested decision were not addressed by the appellant (statement of grounds of appeal, page 7,

point B.2.). In particular, it was not explained why the choice of a specific content of deposited zinc compound (as distinguishing feature) was obvious to a person skilled in the art. The appellant confirmed this as well during the oral proceedings (minutes of oral proceedings, page 2, fourth paragraph).

2.3 Accordingly, the Board has no reason to overturn the decision of the opposition division on novelty and inventive step.

3. Since none of the appellant's objections is successful, the appeal is to be dismissed.

## Order

### For these reasons it is decided that:

The appeal is dismissed.

The Registrar:

The Chairman:



D. Hampe

D. Semino

Decision electronically authenticated