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**Datasheet for the decision
of 2 December 2024**

Case Number: T 2604/22 - 3.3.09

Application Number: 12843796.9

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D21B1/12, D21D1/20, C08L1/02,
C09D101/02, D21C9/00,
D21H11/18, D21H15/02

Language of the proceedings: EN

Title of invention:
PROCESS FOR PRODUCING A DISPERSION COMPRISING NANOPARTICLES
AND A DISPERSION PRODUCED ACCORDING TO THE PROCESS

Patent Proprietor:
Stora Enso Oyj

Opponent:
FiberLean Technologies Limited

Headword:
Dispersion comprising nanoparticles/STORA ENSO

Relevant legal provisions:
EPC Art. 54(1), 111(1), 113(1)
EPC R. 103(1) (a)
RPBA 2020 Art. 11

Keyword:

Appeal decision - withdrawal of opposition during appeal proceedings

Novelty - main request (no)

Remittal - fundamental deficiency in first-instance proceedings (yes)

Decisions cited:

T 0564/02, T 2249/08, T 1340/10, T 0049/13, T 0032/17,
T 1286/19



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Case Number: T 2604/22 - 3.3.09

D E C I S I O N
of Technical Board of Appeal 3.3.09
of 2 December 2024

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Decision under appeal: **Decision of the Opposition Division of the
European Patent Office posted on 12 October 2022
revoking European patent No. 2771387 pursuant to
Article 101(3) (b) EPC.**

Composition of the Board:

Chairman A. Haderlein
Members: C. Meiners
A. Jimenez

Summary of Facts and Submissions

- I. This decision concerns the appeal filed by the patent proprietor (appellant) against the opposition division's decision to revoke the patent. This is the second appeal filed in these proceedings.
- II. In its notice of opposition, the opponent had requested revocation of the patent on the basis of, among other things, a lack of novelty and inventive step under Article 100(a) EPC and a lack of sufficiency of disclosure under Article 100(b) EPC.
- III. In the case underlying the first appeal, the opposition division revoking the patent held, among other things, that the subject-matter of claim 1 as granted was indeed insufficiently disclosed (Article 100 (b) EPC). However, in decision T 1286/19, this board, in a different composition, held, among other things, that the subject-matter of the claimed invention was sufficiently disclosed, and remitted the case to the opposition division for further prosecution.
- IV. In its second decision, the opposition division decided, among other things, that the subject-matter of claim 1 as granted lacked novelty in view of document D1. Since claim 1 of auxiliary request 1 was identical to that of the main request, auxiliary request 1 also lacked novelty. Moreover, the opposition division admitted documents D23 and D24 into the proceedings, and held that each of them anticipated the subject-matter of claim 9 as granted. In addition, it held that claim 9 of auxiliary request 2 then on file (in which the mechanical pre-treatment of the cellulose fibres had been deleted) did not meet the requirement

of novelty either since the dispersions obtained according to the process of claim 1 were structurally indistinguishable from those that had been prepared in documents D23 and D24, for example. Furthermore, the opposition division held that the claimed subject-matter of auxiliary request 3 then on file (the present auxiliary request 4) did not involve an inventive step in view of document D1 as the closest prior art.

V. The following documents are relevant to this decision:

D1 WO 2010/115785 A1
D23 JP2010-202987
D24 CN101869989
D24a Machine translation of D24 generated by EPO
Patent Translate

VI. The opponent did not file a reply to the statement of grounds of appeal and withdrew its opposition against the patent. Consequently, it ceased to be a party to the present appeal proceedings. In such cases, the board must carry out a substantive examination of the opposition division's decision, and can only set aside this decision if the grounds for opposition do not prejudice the maintenance of the patent. The board's examination can include the examination of evidence submitted by the respondent prior to the withdrawal of the opposition and can also consider any arguments the respondent submitted before the withdrawal (see Case Law of the Boards of Appeal, 10th edition, 2022, III.Q. 3.3, third paragraph).

VII. Wording of the relevant claims

Independent claim 1 as granted reads as follows:

"A process for producing a dispersion comprising microfibrillated cellulose and nanoparticles wherein the process comprises the steps:

- providing a slurry comprising pre-treated cellulosic fibers wherein the cellulosic fibers have been pre-treated by mechanical treatment, enzymatic treatment, carboxy methylation, TEMPO oxidation, CMC grafting, chemical swelling or acid hydrolysis,
- adding nanoparticles to the slurry and
- treating the slurry by mechanical disintegration so that a dispersion comprising microfibrillated cellulose is formed in which the nanoparticles are being absorbed to the surface of the microfibrillated cellulose and/or being absorbed into the microfibrillated cellulose."

Independent claim 9 as granted reads:

"A dispersion being produced according to the process according to claims 1-8 wherein the dispersion has a dry content of above 50% by weight fibers."

Auxiliary request 1 is identical to the main request, save for the deletion of claims 9 to 11.

VIII. The appellant's relevant arguments are set out below in the reasons for the decision.

IX. Requests

The appellant requests that the opposition division's decision be set aside and that the patent be maintained as granted. As an auxiliary measure, it requests that the patent be maintained on the basis of one of auxiliary requests 1 to 5 as filed with the statement of grounds of appeal.

Reasons for the Decision

1. *Right to be heard (Article 113(1) EPC)*

1.1 The appellant argued that the decision under appeal did not take into consideration its argument that Sample 9 of D1 did not disclose the addition of nanoparticles to a slurry of cellulose fibres. The opposition division's decision did not "in any way mention or comment on the Proprietor's arguments concerning Sample 9 of D1 or why the Main request would or would not fulfil the requirement of novelty over Sample 9 of D1 in view of the Proprietor's arguments."

1.2 The proprietor (now appellant) filed a corresponding request for a correction of the minutes of the oral proceedings before the opposition division. The opposition division refused this request since it considered this argument "not [...] essential for taking the decision" under appeal (see the opposition division's communication dated 25 November 2022).

The board notes that the opposition division did not contest that the aforementioned argument was presented by the patent proprietor during the oral proceedings. Hence, the board has no reason to doubt that this

argument was effectively part of the patent proprietor's case before the opposition division.

- 1.3 It is true that the decision under appeal does not set out the reasons why the aforementioned argument, which was presented in relation to the main request, was not considered convincing. The board opines that this argument is indeed relevant for the assessment of novelty of claim 1 of the main request. It is thus concluded that the appellant's right to be heard has been infringed.

An infringement of the right to be heard by a department of first instance has to be acknowledged if a central argument has been heard by the deciding body but has not been considered and addressed in substance - either explicitly or implicitly - in its decision (see Case Law of the Boards of Appeal, 10th edition, 2022, III.B.2.4.2). To meet the requirement of the right to be heard, a decision that is open to appeal has to contain at least some reasoning on the crucial points of dispute in order to give the party concerned a fair idea of why its submissions were not considered convincing. In relation to the assessment of novelty of claim 1 of the main request, however, such a reasoning was not provided either explicitly or implicitly in the decision under appeal.

- 1.4 In order to be able to assert that there has been a substantial or fundamental procedural violation, however, a causal link between the procedural violation and the outcome of the case needs to be established. As held in decision T 49/13, an error that would not have led to a different outcome of the proceedings cannot be regarded as a substantial procedural violation (see

Reasons 9; cf. also decision T 2249/08, Reasons 6.7, and decision T 1340/10, Reasons 1.6).

- 1.5 In the case at hand, the main request would also have fallen in view of the finding of a lack of novelty in respect of claim 9 over both documents D23 and D24.
- 1.6 In auxiliary request 1, however, claim 9 has been deleted. Auxiliary request 1 was not held allowable by the opposition division only because claim 1 thereof was identical to that of the main request which, in turn, had been held to lack novelty over D1. The procedural violation and the resulting assessment of novelty of claim 1 as granted in view of D1 are thus decisive for the decision taken by the opposition division to refuse auxiliary request 1. Moreover, not taking into account the aforementioned argument could also have had a bearing on the assessment of inventive step. In this regard, the appellant stated that "the Opposition Division also made an incorrect assessment of inventive step since the analysis of the distinguishing technical features was not correct."
- 1.7 Consequently, the board concludes that the opposition division committed a substantial procedural violation causal to the appeal, and therefore the appealed decision must be set aside and the appeal fee reimbursed (Rule 103(1)(a) EPC), see Case Law of the Boards of Appeal, 10th edition, 2022, V.A.11.7.1.
- 1.8 As the procedural violation does not affect claim 9 of the main request, the board will assess the novelty of the subject-matter of this claim in the following.

2. *Novelty (Article 100(a) EPC in conjunction with Article 54 EPC) - main request*
- 2.1 Claim 9
- 2.1.1 The appellant argues that the process of claim 1 was distinguished from that disclosed in D23 and D24 by the presence of nanoparticles during the mechanical disintegration step.
- 2.1.2 However, this argument is not sufficient to establish the novelty of product-by-process claim 9 of the patent. In fact, the aqueous slurries comprising microfibrillated cellulose (MFC) described in both D23 and D24 also comprise, like the patent, very fine cellulosic fibres having a large open surface, i.e. microfibrillated cellulose within the meaning of claim 1, onto which nanoparticles can be adsorbed. Moreover, these documents describe such nanoparticles and disclose, at least implicitly, that these nanoparticles are indeed adsorbed onto such cellulosic fibres.
- 2.1.3 In this regard, D23 expressly mentions that a filler material is efficiently taken into the inside of a loose MFC aggregate in aqueous MFC dispersions under appropriate dispersion (see paragraph [0036]).
- 2.1.4 Example 6 of D23 discloses the mixing of fumed silica "Aerosil 90G" having a minor axis diameter of 20 nm and a ratio of major axis diameter to minor axis diameter of 1:1, i.e. nanoparticles within the meaning of claim 1 of the patent.
- 2.1.5 Likewise, paragraph [0075] of D23 sets out that it is preferred that the filler used is non-aggregated.

Paragraph [0076] of D23 discloses that the MFC and the filler material should be evenly distributed. To this end, a high-speed disperser or high pressure homogeniser can be used.

2.1.6 Moreover, claim 1 does not call for a specific quantity of nanoparticles absorbed to the MFC fibres.

2.1.7 In view of these findings, the board concludes that it cannot be established whether or not a dispersion as featured in Example 6 of D23 has been prepared by a process as called for in claim 1 or in accordance with the procedure described in Example 6. In the absence of a demonstrated structural difference that could be associated with the process feature in question, the dispersion prepared in Example 6 is considered to anticipate the dispersions claimed in claim 9 as granted.

2.1.8 Similar considerations apply in respect of the disclosure of Examples 1 to 5 of D24. First of all, nanocellulose is an MFC within the meaning of the patent, see paragraph [0028]. It is unlikely that the dispersions of nanocellulose that are contacted with nanoparticles formed therein would contain significant amounts of aggregated nanoparticles. D24 also sets out that no sedimentation of the formed dispersions was observed. The dispersions of D24 are thus stable dispersions, as described in the example of the patent in suit. D24 also divulges that nanocellulose can be used as a dispersant and stabiliser agent (see paragraph [0004] of D24/D24a). This requires, however, the adsorption of the dispersant to the dispersed compound (filler particles). Thus, the products obtained in Examples 1 to 5 of D24 cannot be discerned

from corresponding dispersions obtained using the process of claim 1 as granted.

2.1.9 As regards the burden of proof in relation to the novelty of products characterised by process features, the appellant presented essentially two arguments. First, it was inequitable to allow the opponent to produce comparative data less than two months prior to the oral proceedings before the opposition division. In this regard, the board observes that the comparative data provided by the opponent have not been taken into account in the decision under appeal. Second, the appellant referred to T 564/02. However, this decision does not support the appellant's case because it held that the subject-matter of the product-by-process claim under examination could not be distinguished from a product obtained by the process of the prior art (see Reasons 3.5 and 3.7) and in fact confirms established jurisprudence as to the assessment of novelty of "product-by-process claims" (see Reasons 3.4). In this regard, the burden of proof to demonstrate novelty is incumbent upon the proprietor, which has failed to do so (see also T 32/17, Reasons 15).

2.1.10 Therefore, and in line with the findings in the decision under appeal, the subject-matter of claim 9 as granted is not considered novel in view of documents D23 and D24.

3. *Remittal*

As set out above, the opposition division's assessment of auxiliary request 1 is tainted with a substantial procedural violation. In these circumstances, the board considers it appropriate to remit the case to the opposition division for further prosecution

(Article 111(1) EPC; Article 11, second sentence, RPBA) .

Order

For these reasons it is decided that:

1. The decision under appeal is set aside.
2. The appeal fee is reimbursed.
3. The case is remitted to the opposition division for further prosecution.

The Registrar:

The Chairman:



K. Götz-Wein

A. Haderlein

Decision electronically authenticated