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**Datasheet for the decision
of 15 May 2025**

Case Number: T 1558/23 - 3.3.02

Application Number: 15728244.3

Publication Number: 3149094

IPC: C09D183/04, C09D183/14,
C08L83/04

Language of the proceedings: EN

Title of invention:
RELEASE MODIFIER COMPOSITION

Patent Proprietor:
Momentive Performance Materials Inc.

Opponent:
ELKEM SILICONES France SAS

Headword:

Relevant legal provisions:

EPC Art. 123(2)
RPBA 2020 Art. 13(2), 12(3), 12(2)

Keyword:

Amendments - added subject-matter

Amendment after notification of Art. 15(1) RPBA communication

- deletion of alternative(s) in claim

Decisions cited:

J 0014/19, T 0449/23

Catchword:



Beschwerdekammern

Boards of Appeal

Chambres de recours

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Case Number: T 1558/23 - 3.3.02

D E C I S I O N
of Technical Board of Appeal 3.3.02
of 15 May 2025

Appellant:

(Opponent)

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Respondent:

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Decision under appeal:

**Interlocutory decision of the Opposition
Division of the European Patent Office posted on
27 June 2023 concerning maintenance of the
European Patent No. 3149094 in amended form.**

Composition of the Board:

Chairman

M. O. Müller

Members:

S. Bertrand

R. Romandini

Summary of Facts and Submissions

- I. The appeal by the opponent ("appellant") lies from the opposition division's interlocutory decision finding that European patent No. 3 149 094 ("the patent") as amended in accordance with the set of claims of the main request filed on 13 April 2023 and the invention to which it relates met the requirements of the EPC.
- II. The patent is concerned with providing a release modifier comprising a vinyl terminated polyorganosiloxane and an organo functional siloxane, and a release composition comprising said release modifier for laminate release application.
- III. In the impugned decision, the opposition division's conclusions included that claim 1 of the main request fulfilled the requirements of Article 123(2) EPC.
- IV. In the statement of grounds of appeal, the appellant contested the opposition division's decision and raised objections of, *inter alia*, added subject-matter.
- V. In the reply to the grounds of appeal, the patent proprietor ("respondent") contested the appellant's submissions. It submitted a copy of auxiliary requests 1 to 8 filed before the opposition division.
- VI. The board summoned the parties to oral proceedings as per their requests and issued a communication under Article 15(1) RPBA.
- VII. In a subsequent letter, the respondent replied to the board's communication and submitted sets of claims according to auxiliary requests 9 to 17.

VIII. Oral proceedings before the board were held by videoconference on 15 May 2025 in the presence of the appellant and the respondent.

IX. The parties' requests, where relevant to this decision, were as follows.

The appellant requested that the decision under appeal be set aside and the patent be revoked in its entirety.

The respondent requested:

- that the appeal be dismissed, implying that the opposition division's decision to maintain the patent in amended form in accordance with the main request be upheld, or alternatively
- that the patent be maintained in amended form on the basis of
 - the set of claims of one of auxiliary requests 1 to 8 filed on 13 April 2023 and re-filed with the reply to the grounds of appeal or
 - the set of claims of one of auxiliary requests 9 to 17 filed with the letter dated 15 April 2025

X. The parties' submissions that are relevant to the decision are referred to in the reasons for the decision below.

Reasons for the Decision

Main request

1. Added subject-matter - claim 1 - Article 123(2) EPC

1.1 Claim 1 of the main request reads as follows:

"1. A release modifier comprising:

i) ~~an alkenyl silsesquioxane~~ **a vinyl terminated polyorganosiloxane having a structure chosen from $M_x M^{Vi}_y Q$ or $M_x D^{Vi}_z Q$ where x and y of the alkenyl silicone resin range from 0.6 to 1.2, and z is 0.05 to 0.25; M represents $R^6_3 SiO_{1/2}$, M^{Vi} represents $R^3_p R^1_p SiO_{1/2}$, D^{Vi} represents $R^6 Vi SiO_{2/2}$, Q represents $SiO_{4/2}$, R is selected from the group consisting of one to forty carbon monovalent hydrocarbon radicals, R^1 is selected from the group consisting of two to forty carbon atom olefinic monovalent hydrocarbon radicals, p ranges from 1 to 3, and R^6 is an alkyl of 1 to 40 carbon atoms, and Vi is vinyl; and**

ii) an organo functional siloxane of the formula $MD_x M$, wherein M represents $R^5_3 SiO_{1/2}$, D represents $R^5_2 SiO_{2/2}$, wherein R^5 is alkyl or alkenyl of 1 to 40 carbon atoms or hydrogen, wherein the organo functional siloxane has a viscosity of from ~~about~~ 5 centipoises to ~~about~~ 80 centipoises and x of the organo functional siloxane is from ~~about~~ 5 to ~~about~~ 80; **and**

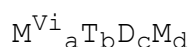
iii) a reactive diluent selected from the group consisting of: α -olefins and vinyl ethers." (Emphasis added by the board, with strike-through and bold text representing deletions and additions, respectively, compared with claim 14 as filed.)

The structure of the vinyl terminated polyorganosiloxane compound i) specified in claim 1 of the main request by way of amendment (see bold text above) is thus defined by two alternatives, one being $M_x M_y^{Vi} Q$, with the group " M^{Vi} " representing $R_{3-p} R_p^1 SiO_{1/2}$, R being selected from the group consisting of one to forty carbon monovalent hydrocarbon radicals and R^1 being selected from the group consisting of two to forty carbon atom olefinic monovalent hydrocarbon radicals, where p ranges from 1 to 3.

- 1.2 The appellant submitted that the specification of the vinyl terminated polyorganosiloxane compound i) as $M_x M_y^{Vi} Q$ and in particular the definition of its " M^{Vi} " group was not based on the application as filed.
- 1.3 The respondent submitted that this formula and the " M^{Vi} " group of the vinyl polyorganosiloxane compound i) in claim 1 of the main request was based on paragraph [0036] in conjunction with paragraph [0023] of the application as filed.
- 1.4 Paragraph [0036] of the application as filed discloses a vinyl terminated polyorganosiloxane defined by *inter alia* formula $M_x M_y^{Vi} Q$. The board acknowledges that this paragraph of the application as filed discloses formula $M_x M_y^{Vi} Q$ of claim 1 of the main request. However, this paragraph does not give any definition for the M^{Vi}

group in this formula, let alone the definition as present in claim 1 of the main request.

The board also acknowledges that a definition of an M^{Vi} group as present in claim 1 of the main request is given in paragraph [0023] of the application as filed (version as published). More specifically, this paragraph discloses a base polymer used for coating having the following formula:



In said paragraph [0023], the " M^{Vi} " group is defined as $R_{3-p}R^1_pSiO_{1/2}$. In the same paragraph, R is selected from the group consisting of one to forty carbon atom monovalent hydrocarbon radicals and R^1 is selected from the group consisting of two to forty carbon atom olefinic monovalent hydrocarbon radicals, where p ranges from 1 to 3.

Thus the " M^{Vi} " group in paragraph [0023] of the application as filed has the same definition as that in claim 1 of the main request.

However, paragraph [0023] of the application as filed refers to a base polymer used for a coating composition. By contrast, compound i) of claim 1 of the main request is a vinyl terminated polyorganosiloxane compound of a release modifier composition. Paragraph [0023] of the application as filed thus refers to a different compound from compound i) in claim 1 of the main request.

- 1.5 The respondent submitted, with reference to claims 5 and 17 as filed, that the person skilled in the art would consult the whole application as filed and clearly identify that there was only one definition for the " M^{Vi} " group used for the base polymer used in the

coating composition, for the polyorganosilane polymer used in the release composition and for the vinyl terminated polyorganosiloxane of the release modifier disclosed in the application as filed.

The board disagrees.

It is established case law that any amendment to the parts of a European patent is subject to the mandatory prohibition on extension laid down in Article 123(2) EPC and can therefore, irrespective of the context of the amendment made, only be made within the limits of what a skilled person would derive directly and unambiguously, using common general knowledge, and seen objectively and relative to the date of filing, from the application as filed.

The board acknowledges that the base polymer used in the coating composition disclosed in paragraph [0023] of the application as filed and the polyorganosilane polymer used in the release composition of claim 5 or 17 as filed have structures that both refer to an "M^{Vi}" group. For both compounds, said "M^{Vi}" group is defined as $R_{3-p}R^1_pSiO_{1/2}$, i.e. the definition found for the vinyl terminated polyorganosiloxane compound i) of claim 1 of the main request; R, R¹ and p have the same definition as in claim 1 of the main request.

However, as submitted by the respondent, the application as filed does not disclose that any group defined by the same denotation should have the same definition for any compound described throughout the application as filed. For instance, the definition of the M group is different depending on the compound containing it. More specifically, M is used in a formula representing the structure of the polyorganosiloxane of the release composition of

paragraph [0011] and is defined as $M=R_3SiO_{1/2}$, with **R** being a **monovalent hydrocarbon radical** comprising one to forty carbon atoms.

M is also used in a formula representing the structure that represents a polyorganosiloxane included in the release modifier disclosed in paragraph [0036] of the application as filed. R is defined as $M=R^6_3SiO_{1/2}$, with **R⁶** being an **alkyl** comprising one to forty carbon atoms.

Lastly, M is also used in a formula representing the structure of an organo functional siloxane included in the release modifier disclosed in paragraph [0037] of the application as filed. R is defined there as $M=R^5_3SiO_{1/2}$, with **R⁵** being **alkyl, alkenyl**, of one to forty carbon atoms, or **hydrogen**.

Therefore, as uncontested by the respondent during the oral proceedings, one and the same symbol - M in the above examples - in the application as filed does not necessarily mean one and the same thing. The application as filed therefore does not clearly and unambiguously disclose that a group using a specific denotation in a formula should have the same definition as any group using the same denotation in any other formula throughout the application as filed, let alone that all M^{Vi} groups throughout the application as filed should have the same definition for any compound containing this group. Thus, contrary to the respondent's submission, the application as filed does not clearly and unambiguously disclose that the M^{Vi} group of the vinyl polyorganosiloxane of the release modifier (compound i) in claim 1 of the main request) has the same definition as that for the base polymer used in the coating composition as disclosed in paragraph [0023] of the application as filed. Therefore, the definition of said M^{Vi} group in formula

$M_x M_y^{Vi} Q$ of compound i) of claim 1 of the main request is not based on the application as filed.

2. Consequently, the board concludes that claim 1 of the main request does not meet the requirements of Article 123(2) EPC, meaning that the main request is not allowable.

Auxiliary requests 1 to 8

3. During the oral proceedings, after having announced that the main request was not allowable, the chairman stated that the same conclusion regarding added subject-matter as that given for the main request seemed to apply to claim 1 of each of auxiliary requests 1 to 8.
4. The respondent did not make any submissions contesting this preliminary opinion of the board. In the absence of any submission in reply to this preliminary opinion, the board concludes that the grounds of added subject-matter in claim 1 of the main request apply *mutatis mutandis* to claim 1 of each of auxiliary requests 1 to 8 (Article 123(2) EPC).
5. Auxiliary requests 1 to 8 are therefore not allowable.

Auxiliary requests 9 to 17

6. Admittance - Article 13(2) RPBA
- 6.1 The respondent submitted the sets of claims of auxiliary requests 9 to 17 after notification of the communication under Article 15(1) RPBA and prior to oral proceedings before the board.

Claim 1 of these auxiliary requests differs from claim 1 of the main request and auxiliary requests 1 to 8, respectively, in that the alternative of the vinyl terminated polyorganosiloxane defined by formula $M_xM^{Vi}_yQ$ that led to the above conclusion of added matter has been deleted.

- 6.2 Since auxiliary requests 9 to 17 were submitted after the issuance of the board's communication pursuant to Article 15(1) RPBA, their admittance is governed by the provisions of Article 13(2) RPBA.

Under Article 13(2) RPBA, any amendment to a party's appeal case made after notification of a communication under Article 15(1) RPBA is, in principle, not to be taken into account unless there are exceptional circumstances justified with cogent reasons by the party concerned.

- 6.3 As a first step, it must therefore be determined whether auxiliary requests 9 to 17 constitute such an amendment within the meaning of Article 13(2) RPBA.

The respondent submitted that, by deleting formula $M_xM^{Vi}_yQ$ representing one alternative of the vinyl terminated polyorganosiloxane i), the objection raised under Article 123(2) EPC had been fully overcome, and no new and further objections had become relevant. Furthermore, this deletion did not introduce any new subject-matter into claim 1 of auxiliary requests 9 to 17. The remaining subject-matter of auxiliary requests 9 to 17 was completely identical to that of the main request and auxiliary requests 1 to 8, which had already been part of the appeal proceedings so far. Therefore, there was no need for either a new assessment by the board or any new arguments from the

appellant. Auxiliary requests 9 to 17 did not constitute an amendment to the respondent's appeal case.

The board does not agree.

Under Article 12(3) RPBA, the statement of grounds of appeal and the reply must contain all of a party's appeal submissions. Under Article 12(2) RPBA, the grounds of appeal or reply must be directed *inter alia* to the requests on which the contested decision is based. As stated in J 14/19 (Reasons 1.4 and 1.5), parties' submissions that are not directed to the requests contained in the statement of grounds of appeal or reply have the effect of amending the appeal submission. Hence, any new and amended claim request is to be considered an amendment to the party's appeal case (see T 449/23, Reasons 3.6.6 and 3.6.7).

It thus follows that, in the case in hand, deleting formula $M_xM^{Vi}_yQ$ representing one alternative of the vinyl terminated polyorganosiloxane i) in claim 1 of any of auxiliary requests 9 to 17 represents an amendment to the respondent's appeal case under Article 13(2) RPBA.

- 6.4 As a second step, it must therefore be assessed whether exceptional circumstances exist that justify the admittance of auxiliary requests 9 to 17 under Article 13(2) RPBA.

The respondent submitted that auxiliary requests 9 to 17 had been filed as a direct response to the board's communication pursuant to Article 15(1) RPBA, by which the board had objected to claim 1 of the main request and auxiliary requests 1 to 8 under Article 123(2) EPC.

This objection had come as a surprise to the respondent since the opposition division, in its decision, had not considered this objection convincing. The board's objection therefore represented an exceptional circumstance justifying the admittance of auxiliary requests 9 to 17 into the proceedings.

The board disagrees. In its communication, the board had simply reiterated what the appellant had submitted in its statement of grounds of appeal. This was not disputed by the respondent. It cannot be surprising - and it is in fact unavoidable - that a board giving a preliminary opinion on a certain issue in its communication under Article 15(1) RPBA agrees with either the proprietor (respondent) or opponent (appellant).

Consequently, there are no exceptional circumstances justified with cogent reasons for admitting auxiliary requests 9 to 17 into the proceedings.

As regards the respondent's argument that the amendment in claim 1 clearly overcame the board's objection without raising any new issues, the board notes that this, if anything, may satisfy the requirements of Article 13(1) RPBA. However, the requirements of Article 13(2) RPBA are not the same as those of Article 13(1) RPBA. On the contrary, as set out in the Explanatory Remarks to the Rules of Procedure, the Rules of Procedure implement a "convergent approach" represented by Articles 12(4), 13(1) and 13(2) RPBA, with Article 13(2) introducing an additional and independent requirement for admittance. Therefore, compliance with Article 13(1) or Article 12(4) does not imply compliance with Article 13(2) RPBA.

- 6.5 Therefore, the board decided not to admit auxiliary requests 9 to 17 into the proceedings.
7. None of the respondent's requests is both admissible and allowable.

Order

For these reasons it is decided that:

1. The decision under appeal is set aside.
2. The patent is revoked.

The Registrar:

The Chairman:



U. Bultmann

M. O. Müller

Decision electronically authenticated