

Internal distribution code:

- (A) [] Publication in OJ
(B) [] To Chairmen and Members
(C) [] To Chairmen
(D) [X] No distribution

**Datasheet for the decision
of 10 July 2012**

Case Number: T 2091/09 - 3.3.03

Application Number: 07748819.5

Publication Number: 2001941

IPC: C08K 3/00, C08K 9/00

Language of the proceedings: EN

Title of invention:
Forming of HTC dendritic fillers

Applicant:
Siemens Energy, Inc.

Opponent:
-

Headword:
-

Relevant legal provisions:
EPC Art. 123(2)

Keyword:
"Amendments - added subject-matter (yes; all requests)"

Decisions cited:
-

Catchword:
-



Case Number: T 2091/09 - 3.3.03

D E C I S I O N
of the Technical Board of Appeal 3.3.03
of 10 July 2012

Appellant: Siemens Energy, Inc.
(Applicant) 4400 Alafaya Trail
Orlando
FL 32826-2399 (US)

Representative: McGowan, Nigel George
Siemens Shared Services
Siemens AG
Postfach 22 16 34
D-80506 München (DE)

Decision under appeal: Decision of the Examining Division of the
European Patent Office posted 10 July 2009
refusing European patent application
No. 07748819.5 pursuant to Article 97(2) EPC.

Composition of the Board:

Chairman: B. ter Laan
Members: M. C. Gordon
C.-P. Brandt

Summary of Facts and Submissions

I. The appeal lies against the decision of the examining division dated 10 July 2009 refusing European patent application 07748819.5 (International application PCT/US2007/000087, published as WO 2007/114874 A1), entitled "Forming of HTC dendritic fillers".

II. The application as filed had 23 claims whereby claim 1 read as follows:

"1. A method of forming HTC dendritic fillers within a host resin matrix comprising:

adding HTC seeds to said host resin matrix, wherein said HTC seeds have been surface functionalized to not substantially react with one another;

accumulating HTC building blocks, wherein said HTC building blocks have been surface functionalized to not substantially react with one another;

assembling said HTC building blocks with said HTC seeds to produce HTC dendritic fillers within said host resin matrix."

Claims 2 to 23 were dependent claims.

III. The decision was based on a set of 23 claims filed with letter of 27 May 2009 and held that claim 1 thereof was directed to a completely new combination of features which was not derivable unambiguously from the application as originally filed and consequently did not meet the requirements of Art. 123(2) EPC.

Accordingly the application was refused.

- IV. A notice of appeal against that decision was filed on 16 September 2009, the prescribed fee being paid on the same day. The statement of grounds of appeal was filed concurrently, accompanied by an amended claim 1.
- V. On 21 March 2012 the Board issued a summons to attend oral proceedings, accompanied by a communication.
- VI. The appellant replied with a letter dated 6 June 2012. The appellant stated that it would not attend the oral proceedings.

The letter was accompanied by amended sets of claims forming a main request (Set A) and three auxiliary requests (Sets B, C and D).

The main request - Set A - consisted of 17 claims, claim 1 reading as follows (additions compared to the claims as originally filed indicated by **bold**):

"1. A method of forming **high thermal conductivity (HTC)** dendritic fillers within a host resin matrix comprising:
 adding HTC seeds to said host resin matrix,
wherein said HTC seeds have been surface functionalized to not substantially react with one another;
 accumulating HTC building blocks, wherein said HTC building blocks have been surface functionalized to not substantially react with one another; **and**
 assembling said HTC building blocks with said HTC seeds to produce HTC dendritic fillers **in the form of branched chains** within said host resin matrix;
 wherein said HTC seeds and said HTC building blocks have been surface functionalized by surface functional groups that are different in reactivity

between the seeds and the building blocks."

Claims 2-7, 10, 11, 13-15 and 17 were identical to the correspondingly numbered claims of the application as filed. Claims 8, 9, 12 and 16 had been amended. The details of those amendments are however not relevant for the present decision.

Claim 1 of the first auxiliary request (Set B) differed from claim 1 of the main request in specifying the compounds from which the HTC seeds and HTC building blocks were to be selected.

Claim 1 of the second auxiliary request (Set C) differed from the main request as indicated for the first auxiliary request and further in that the surface functional groups were specified.

Claim 1 of the third auxiliary request (Set D) differed from the second auxiliary request in that the list of permissible surface functional groups was restricted.

VII. The arguments of the appellant relevant for the present decision can be summarised as follows:

The basis for the feature of claim 1 "[HTC dendritic fillers] in the form of branched chains" (designated "feature (e)" in the decision under appeal and by the appellant in its statement setting out the grounds of the appeal) was to be found in the last two sentences of paragraph [0096] of the application as filed so that Article 123(2) EPC was complied with.

VIII. Oral proceedings were held on 10 July 2012.
As indicated, the appellant did not attend.

IX. The appellant/applicant requests that the decision under appeal be set aside and that the application be remitted to the first instance for further prosecution on the basis of claim set A. Auxiliarily it is requested that the decision under appeal be set aside and the application be remitted to the first instance for further prosecution on the basis of one of the sets of claims B, C or D.

Reasons for the Decision

1. The appeal is admissible.

Main request

2. Art. 123(2) EPC.

Regarding the feature "[HTC dendritic fillers] in the form of branched chains" the appellant in the statement of grounds of appeal (page 2, first two lines) directed attention to the final two sentences of paragraph [0096] of the application.

The first of these sentences reads:

"The dendritic filler is essentially an aggregate of particles that form branched structures rather than aggregate clumps".

This sentence does not refer to branched chains but to - not further specified or defined - "branched structures". Accordingly this sentence cannot provide a

basis for the indicated feature of claim 1.

The second sentence reads:

"Individually these structures can consist of hundreds and thousands of particles forming many long or extended branched chains, with many interconnections between other dendritic structures within the same resin."

In this sentence the wording "branched chains" is disclosed, however not in isolation but in combination with a number of other features, namely:

- hundreds or thousands of particles
- long or extended (branched chains)
- with many interconnections between other dendritic structures within the same resin.

The extraction and isolation of the term "branched chains" from the context in which it was disclosed in the application as filed results in a generalisation of the original disclosure and consequently constitutes the introduction of subject matter extending beyond the content of the application as originally filed. There is no other instance in the description that might provide support for this amendment which is thus contrary to the requirements of Art. 123(2) EPC.

The main request is therefore refused.

3. Auxiliary requests 1-3 (Claim sets B-D).

All of these claim sets retain the feature of "branched chains" as for claim 1 of the main request. Furthermore,

this feature is not to any extent modified by the amendments made in these sets of claims compared to the main request.

Accordingly the first, second and third auxiliary requests all suffer from the same defect as the main request and for the reason indicated do not meet the requirements of Art. 123(2) EPC.

The first auxiliary request, the second auxiliary request and the third auxiliary request are therefore also refused.

Order

For these reasons it is decided that:

The appeal is dismissed.

The Registrar

The Chairman

E. Görgmaier

B. ter Laan