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**Datasheet for the decision
of 5 April 2012**

Case Number: T 1115/10 - 3.3.09

Application Number: 03768889.2

Publication Number: 1578879

IPC: C09J 133/02, D04H 1/64,
C03C 25/28, C03C 25/32,
B32B 17/10

Language of the proceedings: EN

Title of invention:

Extended polyacrylic acid based binder compositions

Patentee:

OWENS CORNING

Opponent:

Rohm and Haas Company

Headword:

-

Relevant legal provisions:

RPBA Art. 13(1)(3)
EPC Art. 100(c), 123(2)(3), 84
EPC R. 80

Keyword:

"Amendments - added subject-matter (yes: main and first
auxiliary requests; no: second auxiliary request)"
"Amendments - clarity (yes: second auxiliary request)"
"Amendments - occasioned by grounds of opposition (yes: second
auxiliary request)"

Decisions cited:

-

Catchword:

-



Case Number: T 1115/10 - 3.3.09

D E C I S I O N
of the Technical Board of Appeal 3.3.09
of 5 April 2012

Appellant: OWENS CORNING
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Decision under appeal: Decision of the Opposition Division of the
European Patent Office posted 19 March 2010
revoking European patent No. 1578879 pursuant
to Article 101(3)(b) EPC.

Composition of the Board:

Chairman: W. Sieber
Members: M. O. Müller
K. Garnett

Summary of Facts and Submissions

- I. This decision concerns the appeal by the proprietor of European patent No. 1 578 879 against the decision of the opposition division to revoke the patent.
- II. In the notice of opposition, the opponent (Rohm and Haas Company) had requested revocation of the patent in its entirety on the grounds that the claimed subject-matter was neither novel nor inventive (Article 100(a) EPC), that the patent did not disclose the invention in a manner sufficiently clear and complete for it to be carried out by a person skilled in the art (Article 100(b) EPC) and that the patent contained subject-matter which extended beyond the content of the application as filed (Article 100(c) EPC).
- III. The opposition division's decision, which was announced orally on 10 March 2010 and issued in writing on 19 March 2010, was based on a main request (sole request) filed during the oral proceedings before the opposition division. Claim 12 of this request read as follows:

"12. An aqueous binder composition according to claim 1, wherein the extender is selected from a group consisting of sodium lignonsulfonate, maltodextrin having a molecular weight of not more than 10,000, soybean protein, and combinations thereof."

According to the opposition division, the various amendments in the claims of the main request met the requirements of Article 84 EPC and Rule 80 EPC, but claim 12 as amended was not in line with Article 123(2)

- EPC. Although each of the extenders mentioned in this claim was supported by the application as filed, the combination of these extenders was nowhere disclosed.
- IV. On 19 May 2010, the appellant (proprietor) filed a notice of appeal against the decision and paid the prescribed fee on the same day. A statement setting out the grounds of appeal was filed on 21 July 2010 together with a main request and six auxiliary requests.
- V. On 2 November 2010, the respondent filed a response to the grounds of appeal.
- VI. By communication of 21 December 2011, the board's preliminary view was communicated to the parties. It was *inter alia* set out that the amendment of the molecular weight range in claim 7 appeared to be occasioned by the opponent's objection under Article 100(b) EPC and thus seemed to be in line with the requirements of Rule 80 EPC.
- VII. With its letter of 1 March 2012, the respondent submitted
- D13: D. A. Sorgentini et al, "Effects of Thermal Treatment of Soy Protein Isolate on the Characteristics and Structure-Function Relationship of Soluble and Insoluble Fractions", J. Agric. Food Chem. 1995, 43, page 2471.
- VIII. With its letter of 2 March 2012, the appellant submitted a new main request and new first to eleventh auxiliary requests.

IX. With its letter of 20 March 2012, the respondent requested that these new requests be not admitted into the proceedings. Furthermore, objections under Articles 84, 123(2) and 123(3) EPC were raised. Finally, the respondent requested an apportionment of costs.

X. With its letter of 3 April 2012, the appellant requested the opportunity to replace the requests filed with its letter of 2 March 2012 with corresponding "primed" sets of requests enclosed with this letter, in case the board were to agree with the respondent's objection under Article 123(3) EPC.

XI. On 5 April 2012 oral proceedings were held before the board. The appellant filed a new second auxiliary request as replacement of the previous second auxiliary request and withdrew the third to eleventh auxiliary requests. The appellant further clarified that the request to limit the proceedings before the board to consideration of "the sole ground of opposition upon which the opposition division's decision is based" meant that the board should deal with the requirements of Articles 123(2) EPC, 123(3) EPC and 84 EPC as well as Rule 80 EPC. The respondent requested that the new second auxiliary request be not admitted into the proceedings.

XII. Claims 1 and 12 of the main request read as follows:

"1. An aqueous binder composition for coating glass fibres comprising:

a polycarboxy polymer;

a poly alcohol having at least two hydroxyl

groups; and
a water-soluble extender selected from a group consisting of lignin, polysaccharides having a weight average molecular weight of not more than 10,000, proteins and sulfonated lignins, the extender being present in an amount sufficient to establish an extender-polycarboxy polymer weight ratio of at least 1:10."

"12. An aqueous binder composition according to claim 1, wherein the extender is selected from a group consisting of sodium lignonsulfonate, maltodextrin having a weight average molecular weight of not more than 10,000, and combinations thereof."

The claims of the first and second auxiliary requests are identical to those of the main request except that the wording "and combinations thereof" at the end of claim 12 (first auxiliary request) and claim 12 in its entirety (second auxiliary request) have been deleted.

XIII. The appellant's arguments can be summarized as follows:

- Admissibility of the appellant's requests

The main and first auxiliary requests should be admitted into the proceedings. The amendments effected in these requests represented a reaction to the board's preliminary opinion. Moreover, these amendments did not raise any complex new issues that the respondent could not be expected to deal with in preparation for the oral proceedings.

- Main request

The term "weight average molecular weight of not more than 10,000" in claim 1 was clear as there was no evidence that different measurement methods gave rise to different weight average molecular weights.

The group of extenders of claim 1 was based on the application as filed. In particular, lignin was based on claim 10 as filed, proteins were based on claim 11 as filed, polysaccharides having a weight average molecular weight of not more than 10,000 were described on page 8, line 28 to page 9, line 7 as filed and sulfonated lignins were disclosed on page 9, lines 8-10 as filed. It was also apparent from the application as filed that these extenders were of particular interest. These extenders therefore did not represent an individualised group in respect of the original disclosure. Also a mixture of these extenders, as covered by claim 1, was disclosed in the application as filed, namely on page 8, lines 23 and 25. Finally, the fact that the amount of non-water-soluble extenders was not limited in claim 1 did not extend its subject-matter over the content of the application as filed either. In particular, the extender-polycarboxy polymer weight ratio was already contained in claim 1 as filed and the fact that this ratio referred to the specific water-soluble extenders only was clearly and unambiguously derivable from the application as filed.

The feature "for coating glass fibers" in claim 1 was based on page 9, lines 24-27 as filed, on the basis of which it was clear that the binders of the invention had the function to coat glass fibers.

In the application as filed, the features of dependent claims 2-6, 13 and 14 applied clearly to any extender, including those contained in claim 1 of the main request. The subject-matter of these dependent claims therefore did not extend beyond the content of the application as filed.

Claim 9 was based on page 9, lines 3-7 of the application as filed from which it was clear that low molecular weight polysaccharides included those having a weight average molecular weight of not more than 10,000.

Claim 12 was based on claim 12 and examples 1 and 2 as filed. In the same way as for claim 1, the combination of the two extenders of claim 12 was based on page 8, lines 23 and 25 as filed. The addition of the wording "and combinations thereof" in claim 12 could at least theoretically be seen as a reaction against the respondent's objection under Article 123(2) EPC and thus was allowable under Rule 80 EPC.

- First auxiliary request

Claim 12 no longer covered combinations of extenders, due to the deletion of the wording "and combinations thereof". Hence, there could no

longer be a problem under Article 123(2) EPC or Rule 80 EPC.

- Request for apportionment of costs

The new requests basically were identical to those filed with the grounds of appeal except that the objections raised in the board's preliminary opinion had been dealt with. Hence, there could not have been any extra time and expenditure involved in reviewing the new requests.

Furthermore, oral proceedings would not have been avoided had these requests not been filed.

XIV. The respondent's arguments can be summarized as follows:

- Admissibility of the appellant's requests

The main and first auxiliary requests should not be admitted into the proceedings as these requests had been filed only after the provisional opinion of the board, did not fully address the issues raised in this opinion and changed the arguments presented previously by the proprietor.

The second auxiliary request should not be admitted into the proceedings either as there had already been 31 requests on file when submitting this request.

- Main request

The term "polysaccharides having a weight average molecular weight of not more than 10,000" in

claim 1 lacked clarity. There was no disclosure as to how to determine the weight average molecular weight of the polysaccharides and it was common general knowledge that weight average molecular weight values could vary depending upon the method by which they were measured.

There was no disclosure in the application as filed of the four specific water-soluble-extenders of claim 1, let alone for mixtures of these extenders as covered by claim 1. Moreover, contrary to claim 1 as filed, the extender-polycarboxy polymer weight ratio in claim 1 of the main request referred to the ratio between the weight of the four specific water-soluble extenders to the weight of the polycarboxy polymers and there was no disclosure for this in the application as filed. Finally, the specific extenders of claim 1 were not disclosed in the application as filed in combination with the further feature of claim 1 "for coating glass fibres" or with any of the specific features of claims 2-6, 13 and 14.

The restriction of the molecular weight range in claim 7 violated the requirements of Rule 80 EPC as claim 7 was a dependent claim.

The feature "starch having a weight average molecular weight of not more than 10,000" in claim 9 was not based on the application as filed.

Claim 12 covered mixtures ("combinations") of two specific extenders, namely sodium lignonsulfonate

and maltodextrin having a weight average molecular weight of not more than 10,000. These mixtures were not based on the application as filed.

On the basis of the board's interpretation of claim 1 that the extender-polycarboxy polymer weight ratio referred to the weight ratio of the specific water-soluble extenders to the polycarboxy polymer, the respondent withdrew its objection under Article 123(3) EPC. Moreover, the objections against claims 5 and 8 under Rule 80 EPC were equally withdrawn.

- First and second auxiliary requests

Claim 12 of the first auxiliary request still covered a mixture of the two specific extenders mentioned in this claim and such a mixture was not based on the application as filed.

As to the second auxiliary request, no new objections were raised.

- Request for apportionment of costs

The appellant's requests failed to address all the objections raised by the respondent in its observations of 2 November 2010 and, more particularly, all the objections raised by the board in its preliminary opinion. In the filing of these requests, the appellant had thus demonstrated lack of attention in the preparation of the requests which had resulted in the respondent having to spend a considerable amount

of time on each request. Accordingly, an apportionment of costs was requested.

XV. During the oral proceedings, the board made the following additional comments:

It could well be that at high molecular weights, such as 500,000, weight average molecular weight values indeed depended on the measurement method. This did however not necessarily apply also to low weight average molecular weights, such as required in claim 1.

The extender-polycarboxy polymer weight ratio in claim 1 of each request referred to the ratio between the specific water-soluble extenders mentioned in this claim and the polycarboxy polymer.

The addition of the wording "and combinations thereof" in claim 12 of the main request was not in line with Rule 80 EPC. Apart from that, claim 12 as filed could not provide a basis for claim 12 of the main request as maltodextrins with a molecular weight of not more than 10,000 were not disclosed in this original claim and as the original claim mentioned three extenders, out of which two had been singled out.

XVI. The appellant requested that the decision under appeal be set aside and the case be remitted to the opposition division for further examination on the basis of the main, alternatively the first auxiliary request both filed with the letter dated 2 March 2012, alternatively on the basis of the second auxiliary request filed during the oral proceedings.

The respondent requested that the appeal be dismissed and that the appellant pay the respondent's costs, including the costs of its professional representative, incurred for reviewing the twelve new requests filed on 2 March 2012 and for attending the oral proceedings.

Reasons for the Decision

1. The appeal is admissible.

Main request

2. *Admissibility*

The claims of the main request, which were submitted with the appellant's letter of 2 March 2012, correspond to the claims of the main request filed with the grounds of appeal, amended by (i) the insertion of the term "weight average" before the wording "molecular weight of not more than 10,000", (ii) deletion of the term "low molecular weight" in connection with proteins and (iii) deletion of the word "soy bean" (claim 11) and "soybean protein" (claim 12).

These amendments represent a reaction to the clarity objections (amendments (i) and (ii)) and the objections under Article 123(2) EPC (amendment (iii)) raised by the board in its communication dated 21 December 2011. They do not raise any complex new issues that the respondent or the board could not be expected to deal with in preparation to the oral proceedings. The board therefore admitted the main request into the proceedings (Article 13(1) and (3) RPBA).

3. *Interpretation of claim 1*

3.1 Claim 1 reads as follows:

"1. An aqueous binder composition for coating glass fibres comprising:

a polycarboxy polymer;

a poly alcohol having at least two hydroxyl groups; and

a water-soluble extender selected from a group consisting of lignin, polysaccharides having a weight average molecular weight of not more than 10,000, proteins and sulfonated lignins, the extender being present in an amount sufficient to establish an extender-polycarboxy polymer weight ratio of at least 1:10."

3.2 As to the interpretation of claim 1, both parties were of the opinion that claim 1, by virtue of the wording "a water-soluble extender selected from a group consisting of", covers compositions with one or more (ie mixtures) of the four extenders mentioned in the claim. The board does not see any reason to deviate from this claim interpretation, in particular because the application as filed supports it. In this context, the passage on page 8, lines 22-25 of the application as filed states (see also point 4.2 below):

"The binder composition of the present invention also incorporates a functional quantity of one or more extenders to reduce the overall cost of the binder composition while maintaining acceptable thermoset

binder performance. Depending on the extender or extenders selected, ..." (emphasis added by the board).

- 3.3 Furthermore, as accepted by the respondent and as not disputed by the appellant, the term "an extender-polycarboxy polymer weight ratio" in claim 1 refers to the weight ratio of the specific water-soluble extenders mentioned in this claim and the polycarboxy polymer.
- 3.4 Finally, the extenders mentioned in claim 1 of the main request in fact constitute four groups of extenders, each group covering a number of chemical compounds (e.g. water soluble proteins cover a variety of different proteins).

4. *Amendments of claim 1 - Article 123(2) EPC*

- 4.1 The respondent argued that there was no disclosure in the application as filed of the four specific groups of water-soluble-extendere of claim 1.

It is true that claim 1 as filed simply refers to "an extender". However, the application as filed discloses five groups of extenders, namely water-soluble lignin (claim 10), water-soluble polysaccharides, preferably having a weight average molecular weight of not more than 10,000 (page 9, lines 6 to 7), water-soluble proteins (claim 11), water-soluble sulfonated lignins (page 9, line 8) and soybean protein (claim 12). The four groups of extenders in claim 1 thus represent a selection of four groups out of the five groups of extenders disclosed in general terms in the application as filed. This selection does not represent a singling

out of specific extenders. In fact, essentially the same level of generality is kept in claim 1 of the main request as compared with the content of the application as filed. Furthermore, the selected groups of extenders are highlighted in the application as filed by being part of dependent claims (water-soluble lignin and water-soluble protein), by being described as "preferred" (polysaccharides having a weight average molecular weight of not more than 10,000, page 9, lines 3-7) and by being exemplified in example 1 (water soluble sulfonated lignins). In view of this, the four groups of extenders of claim 1 represent a non-individualized sub-set of groups of extenders that do not add any new matter to the general disclosure of the five groups of extenders in the application as filed. The requirements of Article 123(2) EPC are thus met.

- 4.2 The respondent additionally argued that claim 1 covered compositions containing a mixture of more than one of the four groups of extenders and such mixtures were not disclosed in the application as filed.

However, the possibility of more than one extender being present is disclosed in a general way, ie not referring to any specific extenders, on page 8, line 23 ("one or more extenders") and line 25 ("Depending on the extender or extenders selected") as filed. By combining this general disclosure with the non-individualised subset of the four groups of extenders of claim 1, the level of generality is not changed and therefore no new matter is added. The requirements of Article 123(2) EPC are thus not violated.

4.3 The respondent further argued that in claim 1 as filed, the extender-polycarboxy polymer weight ratio referred to the ratio of the weight of any extender, including non-water-soluble extenders, to the weight of polycarboxy polymers, whereas in claim 1 of the main request this ratio referred to the weight of the four specific water-soluble extenders to the weight of polycarboxy polymers only. There was, however, no disclosure in the application as filed that the extender-polycarboxy polymer weight ratio should relate to water-soluble extenders only.

The board cannot accept the respondent's argument. As set out in point 4.1 above, the four groups of water-soluble extenders are clearly and unambiguously derivable from the application as filed. Therefore, contrary to the respondent's argument, the skilled person would read the extender-polycarboxy polymer weight ratio in claim 1 as filed to apply to these four groups of water soluble extenders.

4.4 The respondent also argued that the specific water-soluble extenders of claim 1 were not disclosed in the application as filed in combination with the feature of this claim "for coating glass fibers".

In the board's view, this argument is not convincing as this feature is based on page 9, lines 24-25 as filed, where the following is stated:

"During a typical manufacturing operation, the binder composition will be applied to glass fibers as they are being formed into a mat. The majority of the water will be evaporated from the binder

composition to produce a mat coated with a binder."

As this passage follows a paragraph in which the "binder of the present invention" is described and belongs to the section "DETAILED DESCRIPTION OF THE INVENTION", it is clear that this passage, including the feature "for coating glass fibers", constitutes a general disclosure of the binder composition of the invention. Therefore, by combining this feature with the four non-individualised groups of extenders present in claim 1, the level of generality is not changed and consequently no new matter is added.

- 4.5 The respondent finally argued that the specific water-soluble extenders of claim 1 were not disclosed in the application as filed in combination with the features present in claim 2 (cure catalyst), claim 3 (pH adjuster), claim 4 (corrosion inhibitor), claims 5 and 6 (specific polycarboxy polymers) or claims 13 and 14 (restricted extender-polycarboxy polymer weight ratio) of the main request.

The board cannot accept this argument. With the extender of claim 1 as filed being selected from the four groups of water-soluble extenders disclosed in the application as filed (see point 4.1 above), the features of claims 2-6, 13 and 14 as filed (which are identical to those of claim 2-6, 13 and 14 of the main request) are at least implicitly linked for the skilled person to these extenders by way of being dependent on claim 1 as filed. In other words, contrary to the respondent's allegation, the combination of the four groups of water-soluble extenders with these features

of the dependent claims is clearly and unambiguously derivable from the application as filed and hence in line with the requirements of Article 123(2) EPC.

4.6 The amendments in claim 1 of the main request thus meet the requirements of Article 123(2) EPC.

5. *Amendments of claim 12 - Article 123(2) EPC*

5.1 Claim 12 reads as follows:

"12. An aqueous binder composition according to claim 1, wherein the extender is selected from a group consisting of sodium lignonsulfonate, maltodextrin having a weight average molecular weight of not more than 10,000, and combinations thereof."

Since the group of extenders of claim 12 has been limited to only two members, the "combinations" referred to in this claim in fact represent only one specific combination, namely the combination of sodium lignonsulfonate and maltodextrin having a weight average molecular weight of not more than 10,000.

This is different from claim 12 as filed in two respects. First, claim 12 as filed contains three different extenders (sodium lignonsulfonate, low molecular weight maltodextrin and soybean protein) and thus covers four different combinations of extenders. Second, claim 12 as filed does not disclose any maltodextrin having a weight average molecular weight of not more than 10,000.

5.2 The combination of sodium lignonsulfonate and maltodextrin having a weight average molecular weight of not more than 10,000 is furthermore not disclosed in the remaining part of the application as filed either. In fact, in order to arrive at the mixture of extenders of claim 12 on the basis of the application as filed, one would have to:

- single out two specific extenders from the five groups of extenders disclosed in general terms in the application as filed, namely sodium lignonsulfonate out of the group of water soluble sulfonated lignins and maltodextrin having a weight average molecular weight of not more than 10,000 out of the group of polysaccharides; and
- apply the general disclosure in the application as filed of mixtures of extenders on page 8, lines 23 and 25 (see point 4.2 above) to these two specific extenders.

This would however be in contradiction to examples 1 and 2 of the application as filed where, instead of the mixture of the two extenders, either the sodium lignonsulfonate (example 1) or the maltodextrin having a weight average molecular weight of not more than 10,000 (example 2) is applied.

More importantly even, by applying the general teaching on page 8, lines 23 and 25 to the two specific extenders singled out from the application as filed, the level of generality would be significantly changed and thus new matter would be added, in contravention to Article 123(2) EPC. This is different from the situation present with regard to claim 1, where the

amendment leaves the level of generality essentially unchanged and where consequently, the requirements of Article 123(2) are met.

- 5.3 As claim 12 of the main request does not meet the requirements of Article 123(2) EPC, the main request is not allowable.

First auxiliary request

6. *Admissibility*

The claims of the first auxiliary request differ from the claims of the main request only by the deletion of the wording "and combinations thereof" in claim 12. For the same reasons as given above with regard to the main request, the board decided to admit the first auxiliary request into the proceedings (Article 13(1) and (3) RPBA).

7. *Amendments - Allowability*

Claim 12 of the first auxiliary request contains the requirement that the extender is "selected from a group consisting of sodium lignonsulfonate and maltodextrin having a weight average molecular weight of not more than 10,000". As has been set out above in point 3.2, this wording covers the selection of one or more (ie a mixture of) extenders. Therefore, even though the wording "and combinations thereof" has been deleted in claim 12 of the first auxiliary request, this claim still covers a mixture of the two specific extenders mentioned in this claim, namely sodium lignonsulfonate and maltodextrin having a weight average molecular

weight of not more than 10,000. As has been set out above for claim 12 of the main request (points 5.1 and 5.2), such a mixture of specific extenders is not disclosed in the application as filed. Therefore for the same reasons as given above with regard to claim 12 of the main request, claim 12 of the first auxiliary request does not meet the requirements of Article 123(2) EPC.

Second auxiliary request

8. *Admissibility*

The second auxiliary request, which was submitted during the oral proceedings before the board, was filed in reaction to the respondent's objection that claim 12 of the first auxiliary request had to be interpreted such that it covered combinations of sodium lignonsulfonate and maltodextrin having a weight average molecular weight of not more than 10,000 and that this combination was not disclosed in the application as filed. This objection was raised only during the oral proceedings, at least in this explicit form. Moreover, the only amendment effected by this request compared to the previous requests was the deletion of claim 12 and the re-numbering of claims 13 and 14. The deletion of a dependent claim does not raise any new issues and hence the respondent and the board could be expected to deal with this new request without adjournment of the oral proceedings. The board therefore admitted the second auxiliary request into the proceedings (Article 13(1) and (3) RPBA).

9. *Amendments - Allowability*

9.1 Due to the deletion of claim 12, the objections raised above against this claim no longer apply.

9.2 As with the main request, the respondent objected that the specific water soluble extenders of claim 1 were not disclosed in the application as filed. However, for the same reasons as given above with regard to the main request (points 4.1-4.5), these arguments are not convincing.

9.3 The respondent additionally argued that the term "polysaccharides having a weight average molecular weight of not more than 10,000" in claim 1, which was not present in the granted claims, lacked clarity. In particular the respondent held the view that there was no disclosure on how to determine the weight average molecular weight of the polysaccharides and that it was common general knowledge that weight average molecular weight values could vary depending upon the method by which they were measured.

In the board's view, it may well be that according to common general knowledge, weight average molecular weight values depend on the measurement method applied in as far as high molecular weights (eg 500,000 or higher) are concerned. This does however not necessarily extend to low weight average molecular weights such as required by claim 1 (not more than 10,000) and no proof has been provided that the alleged dependence exists also for these low weight average molecular weights. In the absence of any such proof, it can be assumed in the appellant's favour that the

weight average molecular weight of not more than 10,000 in claim 1 does not depend on the measurement method. The inclusion of this weight average molecular weight in claim 1 therefore does not infringe the requirements of Article 84 EPC.

- 9.4 The respondent further argued in writing that the restriction of the molecular weight range in granted claim 7 from "about 100 to about 200,000" to "about 1000 to about 10,000" in claim 7 of the main request violated the requirements of Rule 80 EPC. (This argument was not reiterated during the oral proceedings).

The restriction of the lower limit of 100 is however clearly a reaction to the opponent's objection under Article 100(b) EPC (second paragraph on page 5 of the notice of opposition) that oligomers or polymers do not exist that have two or more carboxy groups and at the same time are characterised by a molecular weight of only 100. The simultaneous amendment of the upper limit results from the incorporation of the range of 1000-10000 as originally disclosed and thus meets a potential objection under Article 123(2) EPC.

Hence, the amendment of claim 7 meets the requirement of Rule 80 EPC.

- 9.5 The respondent finally raised an objection in writing under Article 123(2) EPC against the feature "starch having a weight average molecular weight of not more than 10,000" in claim 9. (Again, this objection was not reiterated during the oral proceedings). This feature is however based on claim 9 as filed ("low molecular

weight starch") in conjunction with page 9, lines 5-7 as filed, which defines the molecular weight of the starch (a polysaccharide) to be a weight average molecular weight of not more than 10,000. The feature objected to thus meets the requirements of Article 123(2) EPC.

9.6 On the basis of the board's interpretation of claim 1 (the extender-polycarboxy polymer weight ratio refers to the weight ratio of the specific water-soluble extenders to the polycarboxy polymer, see point 3.3 above), the respondent withdrew its objection under Article 123(3) EPC and the board is satisfied that the requirements of this Article are met.

9.7 The respondent has not raised or maintained any further objections under Articles 123(2)/100(c) EPC, 123(3) EPC and 84 EPC or Rule 80 EPC and the board is satisfied that the requirements of these provisions are met by the amendments effected in the second auxiliary request.

Remittal

10. The remaining grounds of opposition under Articles 100(a) and (b) EPC have not been dealt with yet by the opposition division. To allow a full examination of these grounds at two levels, the board has decided to exercise its discretion under Article 111(1) EPC to remit the case to the opposition division for further prosecution, in line with the appellant's request.

Request for apportionment of costs

11. The respondent requested the payment of its costs, including the cost of its professional representative incurred for reviewing the twelve new requests filed by the appellant with its letter of 2 March 2012 (of which the main and first auxiliary requests have been discussed above) and for attending the oral proceedings.

As has been set out above in point 2, the appellant's requests constituted a reaction to the board's preliminary opinion issued as the annex to the summons to oral proceedings. Such a reaction constitutes the normal way of proceedings and in no way justifies the apportionment of costs for reviewing any claim sets filed as such a reaction.

With regard to the costs for attending oral proceedings, this request is equally unjustified, not least because no reasons were given or are apparent to the board why it was only the filing of the new claim sets that made the respondent's attendance at the oral proceedings necessary.

The request for apportionment of costs is therefore refused.

Order

For these reasons it is decided that:

1. The decision under appeal is set aside.
2. The case is remitted to the opposition division for further examination on the basis of claims 1 to 13 according to the second auxiliary request filed during the oral proceedings.
3. The respondent's request for costs is refused.

The Registrar:

The Chairman:

G. Röhn

W. Sieber