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**Datasheet for the decision
of 27 September 2016**

Case Number: T 1444/13 - 3.3.07

Application Number: 99925867.6

Publication Number: 1005318

IPC: A61K6/083

Language of the proceedings: EN

Title of invention:

OPTIMUM PARTICLE SIZED HYBRID COMPOSITE

Patent Proprietor:

Kerr Corporation

Opponent:

3M Deutschland GmbH

Relevant legal provisions:

EPC Art. 123(2), 123(3), 111(1)

RPBA Art. 12(2)

Keyword:

Amendments - main request: added subject-matter (yes)
Amendments - auxiliary request: added subject-matter (no)
Amendments - auxiliary request: broadening of claims (no)
Appeal decision - remittal to the department of first instance
(yes)

Decisions cited:

T 0109/08



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Case Number: T 1444/13 - 3.3.07

D E C I S I O N
of Technical Board of Appeal 3.3.07
of 27 September 2016

Appellant: Kerr Corporation
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Decision under appeal: **Decision of the Opposition Division of the
European Patent Office posted on 24 April 2013
revoking European patent No. 1005318 pursuant to
Article 101(3) (b) EPC.**

Composition of the Board:

Chairman J. Riolo
Members: A. Usuelli
P. Schmitz

Summary of Facts and Submissions

- I. The present decision relates to the second appeal concerning European patent No. 1 005 318, which was filed as an international application published as WO 99/65453.
- II. The application as originally filed contained eighteen claims. Claims 1 and 7 read as follows:

"1 . A dental composite, comprising:
a resin base; and
between about 10% by volume and about 70% of a ground structural filler having a mean particle size between about 0.05 μm and about 0.50 μm , wherein the ground structural filler contains less than 50% by volume of particles above 0.5 μm in diameter, mean particle size."

"7. The dental composite of claim 1, further comprising between about 1.0 and about 10.0% by volume microfiller having a mean particle size of about 0.04 μm or less."

European patent No. 1 005 318 was granted on the basis of 12 claims. Claims 1 and 2 read as follows:

"1. A dental composite comprising a resin base and about 11% by volume to about 80% by volume filler comprising a ground structural filler and a microfiller, wherein the ground structural filler comprises between about 10% by volume and about 70% by volume of the composite and comprises ground particles of mean particle size between about 0.05 μm and about 0.5 μm and wherein the microfiller comprises between 1 and 10.0% by volume of the composite and comprises

particles of mean particle size of about 0.04 μm or less."

"2. The dental composite of claim 1 wherein the ground structural filler contains less than 50% by volume of particles above 0.5 μm in diameter."

- III. The patent was opposed under Article 100(a) EPC on the grounds that its subject-matter lacked novelty and inventive step. In the course of the opposition proceedings the opponent requested that a new ground of opposition for insufficiency of disclosure (Article 100(b) EPC) be introduced.

The following document was among those cited during the first-instance proceedings:

D5: EP 677 286

- IV. In the decision posted on 2 November 2007, the opposition division came to the conclusion that claim 1 of the patent as granted and claim 1 of the auxiliary requests admitted into the proceedings lacked novelty in view of document D5. The patent was therefore revoked. The ground of opposition under Article 100(b) EPC was not admitted into the proceedings because it was late-filed and not considered to be *prima facie* relevant.

The decision of the opposition division was appealed by the patent proprietor in case T 109/08. The competent Board considered that the arguments put forward by the opponent during the opposition proceedings raised reasonable doubts as to the sufficiency of disclosure of the subject-matter claimed in the patent. Accordingly, the Board considered that the

late-submitted ground pursuant to Article 100(b) EPC should have been admitted into the proceedings (point 4.9 of the reasons) and decided to set aside the decision of the opposition division and to remit the case to the department of first instance for further prosecution, and in particular for a substantive examination of the requirement of sufficiency of disclosure (point 6.3 of the reasons). The decision of the opposition division as to lack of novelty in view of D5 was not reviewed by the Board.

- V. The present appeal lies from the second decision of the opposition division to revoke the patent. The decision announced during the oral proceedings held on 26 February 2013 was based on the patent as granted as main request and on two auxiliary requests filed with letter of 4 December 2012.

Claim 1 of auxiliary request 1 read as follows:

"1. A dental composite comprising a resin base and about 11% by volume to about 80% by volume filler comprising a ground structural filler and a microfiller, wherein the ground structural filler comprises between about 10% by volume and about 70% by volume of the composite and comprises ground particles of mean particle size between about 0.05 μm and about 0.5 μm and contains less than 50% by volume of particles above 0.5 μm in diameter, and wherein the microfiller comprises between 1 and 10.0% by volume of the composite and comprises particles of mean particle size of about 0.04 μm or less."

Claim 1 of auxiliary request 2 differed from claim 1 of auxiliary request 1 mainly in the addition of a feature requiring the ground structural filler to contain less

than 10% by volume of particles above 0.8 μm in diameter.

- VI. In a communication issued on 16 July 2012, the opposition division had raised on its own motion a new ground of opposition under Article 100(c) EPC in combination with Article 123(2) EPC.

The following document was filed by the appellant with letter dated 8 January 2013.

D14: Statement of Dr Ulf Drechsler

- VII. The second decision of the opposition division can be summarised as follows:

- (a) Compared to claim 1 of the original application, claim 1 as granted did not include the condition that the filler contained less than 50% by volume of particles above 0.5 μm . The deletion of this feature had no basis in the original application. Hence, the requirements of Article 123(2) EPC were not met.
- (b) The scope of protection defined by claim 1 of auxiliary requests 1 and 2 was broader than the scope defined by the granted patent. Hence, these requests did not comply with Article 123(3) EPC.

- VIII. The patent proprietor (hereinafter appellant) filed an appeal against that decision. With the statement setting out the grounds of appeal filed on 23 August 2013 it submitted five auxiliary requests and requested that the decision under appeal be set aside and that the case be remitted to the opposition division for further prosecution on the basis of the

claims of the patent as granted or on the basis of one of these auxiliary requests.

Auxiliary request 1 was the same as auxiliary request 1 forming the basis of the decision of the opposition division of 26 February 2013 (see point V above).

- IX. The opponent (hereinafter respondent) replied to the proprietor's appeal with letter of 13 December 2013.
- X. In a communication pursuant to Article 15(1) RPBA issued on 12 August 2016, the Board stated that it agreed with the opposition division that the subject-matter of claim 1 of the patent did not comply with the requirements of Article 123(2) EPC. Concerning auxiliary request 1, the Board expressed the view that the opposition division had been mistaken in considering that claim 1 did not comply with the requirements of Article 123(3) EPC. It furthermore informed the parties that it was in favour of allowing the appellant's request that the case be remitted to the opposition division for further prosecution.
- XI. In a letter dated 25 August 2016, the respondent requested the Board to avoid remittal by taking a final decision on all the patentability issues during the oral proceedings.
- XII. Oral proceedings were held on 27 September 2016.
- XIII. The appellant's arguments, as far as relevant to the present decision, can be summarised as follows:
- (a) Claim 1 of the patent as granted was essentially based on the combination of claims 1 and 7 as filed, but with the feature removed that the filler

contained less than 50% by volume of particles above 0.5 μm . It was clear from the first paragraph of the "Summary of the invention", in the description of the application, that the essential feature of the invention was that the structural filler particles had an average size below 0.5 μm and that they had to be ground particles. The feature that the ground structural filler contained less than 50% by volume of particles above 0.5 μm was not disclosed as an essential feature in this paragraph. This feature was also not present in the embodiment disclosed on page 9, lines 6 to 10, of the original description. Thus, the amendment complied with the requirements of Article 123(2) EPC since it was based on the removal of a non-essential feature.

- (b) The further amendment introduced in claim 1 as granted and in claim 1 of auxiliary request 1, namely the indication that the amount of filler was comprised between 11 and 80% by volume, was based on the addition of the volume amounts of ground structural filler and microfiller disclosed in original claims 1 and 7. As confirmed by Dr Drechsler in his statement, the volume percentages of the ground structural filler and of the microfiller could be added to provide the total volume percentage of filler particles. Hence, this amendment too complied with Article 123(2) EPC.
- (c) The scope of protection conferred by claim 1 of auxiliary request 1 was identical to the scope of protection conferred by claim 2 of the granted patent, irrespective of whether or not this claim was broader than claim 1 of the granted patent. Thus, claim 1 of auxiliary request 1 could not be

considered to extend the protection conferred by the patent.

XIV. The respondent's arguments, as far as relevant to the present decision, can be summarised as follows:

- (a) The dental composite material defined by the combination of original claims 1 and 7 had to fulfil the requirement of containing less than 50% by volume of particles above 0.5 μm . The omission of this feature in granted claim 1 constituted a generalisation of the original disclosure which infringed Article 123(2) EPC.
- (b) Claim 1 of the granted patent and claim 1 of auxiliary request 1 did not comply with Article 123(2) EPC also in view of the feature defining the volume percentage of the whole filler. This feature was obtained by adding the volume percentage of the ground structural filler disclosed in original claim 1 and the volume percentage of the microfiller disclosed in original claim 7. As explained in decision T 109/08 concerning the present case, when adding load volumes of two fillers of different particle sizes the filler component with smaller particle size fills the interstices between the bigger particles of the other filler component. Thus, the total volume of the filler material may be different from the arithmetical addition of the volumes of the different filler components.
- (c) Claim 1 of auxiliary request 1 had a broader scope than claim 1 as granted. Claim 2 as granted defined a particular embodiment of claim 1 and depended on this claim. Hence, granted claim 2 could not be

broader than granted claim 1. Accordingly, claim 1 of auxiliary request 1 was also broader than claim 2 as granted.

(d) The application of the patent in suit was filed in May 1999 and the opposition proceedings started in August 2005. In view of the length of the proceedings a further remittal was to be avoided. The parties had already presented in the previous proceedings their arguments in relation to all the substantive issues. Thus, the Board should come to a final decision during the oral proceedings.

XV. The appellant requested that the decision under appeal be set aside and that the case be remitted to the opposition division for further prosecution on the basis of the claims of the patent as granted or of one of the five auxiliary requests filed with the statement setting out the grounds of appeal dated 23 August 2013.

XVI. The respondent requested that the appeal be dismissed and that the case not be remitted to the opposition division but be finally decided by the Board.

Reasons for the Decision

Main request (patent as granted)

1. Article 100(c) EPC

1.1 The subject-matter of claim 1 defines a dental composite material containing *inter alia* a filler component which comprises a ground structural filler and a microfiller. In the appellant's view, this claim is essentially based upon original claim 7 which

incorporates the features of original claim 1 on which it depends.

- 1.2 As acknowledged by the appellant, the dental composite material defined in claim 1 of the original application is characterised *inter alia* by the requirement that "the ground structural filler contains less than 50% by volume of particles above 0.5 μm in diameter". This requirement is no longer included in claim 1 as granted.

The Board considers that there is no basis in the application as filed for a dental composite material having the features of original claims 1 and 7 with the exception of the feature quoted above.

As remarked by the appellant, the original description discloses on pages 6 (lines 18 to 22) and 9 (lines 6 to 10) preferred embodiments of the invention concerning dental composite material which are not characterised by the requirement that "the ground structural filler contains less than 50% by volume of particles above 0.5 μm in diameter". However, the dental composite materials defined in these passages are not characterised by the same features of the materials of claim 1. For instance, no information is given in these paragraphs as to the volume percentages of the ground structural filler and of the microfiller. Moreover, none of these passages of the description indicates that the microfiller has a mean particle size of 0.04 μm or less, as defined in claim 1 of the patent. Thus, the paragraphs of pages 6 and 9 referred to by the appellant relate to dental composite materials which are not characterised by the same features of the dental composite material of claim 1 as granted. Accordingly, these passages cannot be invoked to

justify the deletion of the feature requiring the ground structural filler to contain less than 50% by volume of particles above 0.5 μm in diameter.

Thus, the deletion of this feature is an amendment that infringes Article 123(2) EPC.

Hence, the main request is not allowable.

Auxiliary request 1

2. Article 123(2) EPC

2.1 Claim 1 of this request includes the feature disclosed in original claim 1 indicating that the ground structural filler contains less than 50% by volume of particles above 0.5 μm in diameter. Thus, the objection discussed in points 1.1 and 1.2 above no longer applies to this request.

2.2 Claim 1 also contains the indication that the total volume of the filler is comprised between about 11% and about 80% by volume. This feature is based, in the appellant's view, on the arithmetical sum of the volume percentage of the ground structural filler (10% to 70%) disclosed in original claim 1 with the volume percentage of the microfiller (1.0% to 10.0%) disclosed in original claim 7.

During the oral proceedings, the respondent objected to this amendment, arguing that when the microfiller was added to the ground structural filler, the small particles of the microfiller filled the interstices between the bigger particles of the ground structural filler. The addition of the microfiller could therefore occur without changes to the volume occupied by the

ground structural filler. As a consequence, the total volume of the filler materials could differ from the sum of the volumes of the two fillers.

- 2.3 The issue raised by the respondent was considered also in point 4.5 of decision T 109/08 in the context of the discussion concerning the admissibility of the ground of opposition under Article 100(b) EPC. The competent Board considered that it was common technical knowledge that when combining filler materials of different particles size the small particles filled the interstices between the bigger particle.

However, in the opinion of the present Board, when deciding whether the feature defining the volume percentage of the total filler has a support in the original application, this observation is beside the point.

Claim 1 of auxiliary request 1, as well as original claims 1 and 7, do not relate to a process involving the addition of the microfiller to the ground structural filler. They rather concern a product as such, i.e. the dental composite material. Thus original claim 7, in view of its dependency on claim 1, discloses a dental composite material comprising *inter alia* from about 10% to about 70% by volume of a ground structural filler and from about 1.0% to about 10.0% by volume of microfiller. This conclusion is not affected by observations concerning phenomena that may occur during the preparation of the dental composite. In other words, whether or not the particles of the microfiller fill the interstices between the particles of the other filler is immaterial since this does not affect the conclusion, expressed in claim 7, that the final dental composite contains from 10% to 70% of

ground structural filler and from 1.0% to 10.0% of microfiller.

The considerations put forward by the respondent and by the Board in charge of the case T 109/08 may possibly highlight problems which concern the correlation between the volumes of the different fillers before their combination and the total volume of the fillers after their combination. However, as explained above, original claim 7 discloses the volume percentages of the different fillers in the composite dental material, i.e. in the product obtained after the combination of the fillers. In the Board's view, there can be no doubt that if a composition comprises e.g. 10% volume of component A and 10% volume of component B, the volume of A+B is 20%.

This is in line with the conclusions of Dr. Drechsler who states in his declaration (document D14, point 4):

"The composite may include more than one type of filler particle, in which case the total filler particle loading is the simple arithmetic sum of the volume percentage taken up by each of the types of filler particles within the composite. Therefore, a composite made up of 10 volume percent structural filler, 1 volume percent microfiller, and resin, will have a total filler loading of 11 volume percent (10 plus 1) and a resin content of 89 volume percent".

Thus, in original claim 7 (which depends on claim 1) there is a basis, in the sense of Article 123(2) EPC, for the feature defining the total volume of the filler.

2.4 Thus, claim 1 of auxiliary request 1 meets the requirements of Article 123(2) EPC.

3. Article 123(3) EPC

3.1 The opposition division considered that the scope of protection conferred by claim 1 of auxiliary request 1 was broader than the scope of protection conferred by the patent and came to the conclusion that this request did not comply with the requirements of Article 123(3) EPC.

The opposition division considered in essence that claim 1 of auxiliary request 1 provided a narrower definition of the ground structural filler than claim 1 as granted because in claim 1 as granted the ground structural filler was characterised by a single feature (mean particle size between about 0.05 μm and about 0.5 μm - hereinafter "Condition A") while in auxiliary request 1 it was characterised by the same feature and additionally by the requirement of containing less than 50% by volume of particles above 0.5 μm in diameter (hereinafter: "Condition B"). As a consequence, in claim 1 of auxiliary request 1 the upper limit of 70% by volume applied only to this more narrowly defined group of ground particles. However, the filler not covered by the definition of auxiliary request 1 (i.e. fulfilling condition A but not condition B) could still be present in the dental composite material defined in this claim, in view of the term "comprising" at the beginning of the claim. Moreover, it could be present in any amount, thereby leading to an extension of the scope of protection as compared to claim 1 as granted.

3.2 The Board agrees with the respondent's remark that the reasoning of the opposition division implies that in

the dental composite material of claim 1 of auxiliary request 1 it would be possible to distinguish a filler fulfilling both conditions A and B and a filler fulfilling only condition A. However, this subdivision of the filler into two groups appears artificial and not technically sound, since both groups of fillers are made of particles of the same particle size (see condition A). A skilled person would not construe the claims in this manner.

In the Board's view, the upper limit of 70% by volume applies to the whole structural filler present in the composite. In the context of the present invention the structural filler is a filler characterised by an average particle size comprised between 0.05 μm and 0.5 μm (see for instance page 6, lines 18 to 22). Thus, this upper limit also applies to the total amount of particles in the dental composite material of auxiliary request 1 that have an average particle size comprised between 0.05 μm and 0.5 μm .

3.3 Independently of the above, it is noted that the feature introduced in claim 1 of auxiliary request 1 was included in claim 2 of the granted patent which depended on claim 1. Claim 1 of auxiliary request 1 is actually the combination of granted claims 1 and 2. It could also be described as the claim resulting from deleting granted claim 1 and then writing out granted claim 2 in full. In other words, claim 1 of auxiliary request 1 is not different from granted claim 2.

It follows that claim 1 of auxiliary request 1 does not extend the scope of protection conferred by the patent since it has the same scope as claim 2 of the patent.

3.4 This conclusion is not affected by the consideration that claim 2 as granted depends on claim 1. The respondent, in line with the decision of the opposition division, considered that claim 2 as granted could not be broader than claim 1 as granted, because it depended on it. Hence, since claim 1 of auxiliary request 1 was broader than claim 1 as granted, it was also broader than claim 2 as granted.

The Board does not share this position. Assuming for the sake of argument that claim 1 of auxiliary request 1 is broader than claim 1 as granted, since claim 1 of auxiliary request 1 and claim 2 as granted define the same subject-matter it would have to be concluded that claim 2 as granted is also broader than claim 1 as granted. It would also follow that claim 2 as granted, although formally drafted as a dependent claim, would *de facto* be an independent claim. This may possibly highlight a clarity issue in claim 2 as granted. In other words, this Board takes the view that if it is established that a claim formally drafted as a dependent claim has a scope which is actually broader than the scope of the claim on which it depends, it must normally be concluded that the construction of the claim's dependency was wrong rather than that the claim formally drafted as dependent is "by law" narrower in scope than the independent claim.

In view of the above, the Board concludes that auxiliary request 1 does not extend the protection conferred by the patent.

Remittal

4. The primary function of an appeal is to consider whether the decision issued by the first-instance

department was correct. Hence, a case is normally remitted if essential questions regarding the patentability of the claimed subject-matter have not yet been examined and decided by the department of first instance.

In particular, remittal is considered by the boards in cases where a first-instance department takes a decision against a party having regard to only some issues decisive for the case, and leaves other essential issues outstanding. If, following appeal proceedings, the appeal on the particular issues addressed is allowed, the case is normally remitted to the first-instance department for consideration of the undecided issues (Article 111(1) EPC).

4.1 The observations above apply in full to the present case.

In the first appeal proceedings concerning the present case, the competent Board came to the conclusion that the arguments put forward by the respondent during the first opposition proceedings raised reasonable doubts as to whether the requirement of sufficiency of disclosure was met. Accordingly, it considered that the late-filed ground for opposition under Article 100(b) EPC should have been admitted into the proceedings (point 4.9 of the reasons). The case was therefore remitted to the opposition division for further prosecution with the explicit indication to carry out a substantive examination of the requirement of sufficiency of disclosure (point 6.3 of the reasons).

Instead of deciding on sufficiency of disclosure the opposition division introduced a new opposition ground under Article 100(c) EPC and revoked the patent for

non-compliance with Article 123(2) EPC. It furthermore considered that the auxiliary requests did not comply with Article 123(3) EPC. Thus, neither in the first nor in the second decision of the opposition division has the ground of sufficiency of disclosure (Article 100(b) EPC) been dealt with.

4.2 A first-instance department should conduct an examination as complete as possible, in order to reduce the likelihood of remittal in any subsequent appeal. In the present case, it appears that the requirement of sufficiency of disclosure could have been examined despite the problems regarding the allowability of the amendments. Furthermore, the Board competent for the first appeal remitted the case with the explicit indication that a substantive examination of the ground under Article 100(b) EPC should be carried out. It furthermore emphasised that there was little point in assessing the other opposition grounds until the issue of sufficiency had been resolved (point 6.1 of the reasons). Thus, having regard to the clear indications provided in T 109/08 and also considering that a decision revoking a patent based solely on Article 100(c) EPC may in many cases be set aside in appeal proceedings because a new set of claims is filed, the opposition division should have examined the requirement of sufficiency of disclosure.

4.3 While the appellant requested already in the statement setting out the grounds of appeal the appealed decision to be set aside and the case remitted to the opposition division, the respondent opposed remittal for the first time in its letter of 25 August 2016, essentially arguing that the proceedings had already been very long. However, both in this letter and in its previous written submissions (i.e. in the reply to the statement

setting out the grounds of appeal) the respondent did not develop any arguments on substantive issues. It generically indicated that it was maintaining the objections presented in the earlier written submissions and in the oral proceedings.

- 4.4 Article 12(2) RPBA states that a party should specify expressly all the facts, arguments and evidence on which it wants to rely. The wording "specify expressly" suggests that a mere reference to previous submissions may well not be sufficient. In the Board's view this applies even more when said reference also covers facts, arguments and evidence presented in the course of earlier proceedings.

In this context, the Board would point out that the scope of the present appeal is to review the second decision of the opposition division. Thus, if a party wishes the Board to consider the possibility of also examining other issues not addressed in the appealed decision but raised by the parties during previous proceedings, it is a prerequisite that the party concerned present a complete case within the meaning of Article 12(2) RPBA in respect of those issues too.

- 4.5 In the present case, in the absence of any written submissions in relation to the substantive issues, these would have had to be dealt with, as far as the present appeal proceedings are concerned, for the first time during the oral proceedings. In the Board's view, this was not possible given the complexity and number of issues to be dealt with, which included sufficiency of disclosure, novelty and inventive step. In the Board's opinion, it would also be unfair to the appellant to open a discussion in which the respondent could potentially cherry-pick the evidence and

arguments it wants to use from those submitted throughout the entire proceedings concerning this case.

4.6 Thus, in the light of the circumstances of the present case the Board decides to remit the case to the opposition division for the examination of all the outstanding issues.

Order

For these reasons it is decided that:

1. Decision under appeal is set aside.
2. The case is remitted to the opposition division for further prosecution.

The Registrar:

The Chairman:



S. Fabiani

J. Riolo

Decision electronically authenticated