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**Datasheet for the decision
of 25 June 2019**

Case Number: T 1665/16 - 3.3.03

Application Number: 09007437.8

Publication Number: 2261305

IPC: C09K21/14, C08K5/02, C08L11/00,
C08L9/00, C08L9/02, C08L23/08,
C08L27/06, C08L83/00, C08K3/22

Language of the proceedings: EN

Title of invention:
Fire retardant elastic foam material

Patent Proprietor:
Armacell Enterprise GmbH & Co. KG

Opponent:
L'ISOLANTE K-FLEX GmbH

Relevant legal provisions:
EPC Art. 56, 105, 111(1)

Keyword:
Inventive step - (yes)
Intervention of the assumed infringer - status of the submitted documents
Appeal decision - remittal to the department of first instance (yes)

Decisions cited:

G 0003/04



Beschwerdekammern

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Case Number: T 1665/16 - 3.3.03

D E C I S I O N
of Technical Board of Appeal 3.3.03
of 25 June 2019

Appellant: L'ISOLANTE K-FLEX GmbH
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Respondent: Armacell Enterprise GmbH & Co. KG
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Decision under appeal: **Decision of the Opposition Division of the
European Patent Office posted on 19 May 2016
rejecting the opposition filed against European
patent No. 2261305 pursuant to Article 101(2)
EPC.**

Composition of the Board:

Chairman D. Semino
Members: D. Marquis
C. Brandt

Summary of Facts and Submissions

I. The appeal of the opponent lies against the decision of the opposition division posted on 19 May 2016 to reject the opposition against the European patent No. 2 261 305.

II. The patent was granted with a set of 9 claims, whereby claim 1 read as follows:

"1. An elastomeric material containing 50 to 100 percent by weight of polychloroprene based on the total polymer content and more than 25 percent by weight of chloroparaffin based on the total polymer content, wherein the material is vulcanized and expanded and contains fillers and additives."

III. The patent was opposed on the grounds that its subject matter lacked novelty and inventive step in view of D1 (Rubber Technology, Compounding and Testing for Performance; Edited by John S. Dick; Carl Hanser Verlag, Munich 2001, pages 46-47, 129-130, 132-135, 207-211, 325-343, 476-503 and 517). The decision of the opposition division, as far as it is relevant to the present proceedings, can be summarized as follows:

(a) D1 disclosed in Table 22.4 on page 495, a "skim compound" comprising polychloroprene (100 parts by weight) and butadiene rubber (10 parts by weight) meaning that the weight percent of the polychloroprene was 90,9 weight percent; the chlorinated paraffin represented 27,3 weight percent, based on the total polymer content. Fillers and additives were also present in that composition. The table disclosed vulcanizate properties of that composition but did not disclose

that the "skim compound" was expanded. D1 was a general document that also contemplated expansion of rubber compositions in other chapters as that containing Table 22.4. There was however no pointer in D1 that would specifically link the composition of Table 22.4 and the parts of D1 that referred to expansion. The claims as granted were novel over D1.

- (b) D1 was the closest prior art. Claim 1 of the main request differed from the "skim compound" of Table 22.4 of D1 in that the elastomeric material was expanded. The patent did not show that expansion of the claimed composition led to a surprising effect over D1. The problem was thus the provision of an alternative elastomeric material. In order to arrive at the claimed subject matter, the skilled person starting from the composition of Table 22.4 would have had to use the composition for a mining belt, to add a foaming agent to the composition, to carry out the foaming step and to vulcanize the material after foaming. There was no indication in the prior art that the specific material of Table 22.4 was at all suitable for foaming and vulcanization. In particular, the skilled person would not have modified a mining belt to arrive at an alternative foamed composition. There was no indication in the prior art that a mining belt compound should be foamed in order to arrive at a fire retardant elastomeric foam material. There was thus no pointer in D1 towards expansion of the elastomeric material of Table 22.4. The claims as granted were thus inventive over D1.

IV. The opponent (appellant) lodged an appeal against that decision and submitted documents D2 (Excerpt of

Wikipedia concerning "Zellenkautschuk"), D3 (Excerpt of Wikipedia concerning "Chlorparaffine"), D4 (JP H10-298328 A) and its English translation D4a with the statement setting out the grounds of appeal. An additional translation of D4 in German (D4b) was provided with letter of 13 October 2017.

V. With letter of 10 February 2017, the patent proprietor (respondent) submitted a first auxiliary request.

VI. Two interventions in the opposition proceedings according to Article 105(1) EPC were filed by Kaimman GmbH (intervener), the first on 11 September 2017 and the second on 17 October 2017. Both notices of opposition filed with these interventions raised objections of lack of novelty and lack of inventive step in view of documents E1 to E20:

E1: GB 521764

E2: US 3565748

E3: US 4632865

E4: DE 3410889 A1

E5: Hornsby et al., Polymer Degradation and Stability, 1991, Vol. 32, pages 299-312

E6: US 2894926

E7: RU 2 034 884 C1

E7a: RU 2 034 884 C1 English translation

E8: RU 2 131 448 1

E8a: RU 2 131 448 C1 English translation

E9: EP 1 970 403 A1

E10: EP 1 469 059 A2

E11: US 5 719 199

E12: Rubber Technology, John S. Dick, Carl Hanser Verlag, Munich, 2001, pages 46-47, 129-130, 132-135, 207-211, 325-343, 476-503, 517, 553, Preface und Contents viii-xx

E13: JP H10-298328 A
E13a: JP H10-298328 A computer generated translation
into English
E13b: JP H10-298328 A, English abstract
E14: EP 0 341 876 A2
E15: DE 27 29 838 A1
E16: Neoprene-Technical Information, DuPont Performance
Elastomers
E17: Flame retarding in polychloroprene, Plastics,
Paint and Rubber: December 1976, pages 13-17
E18: EP 2 011 818 A1
E19: Excerpt of Wikipedia concerning "Chlorparaffine"
E20: Excerpt of Wikipedia concerning
"Polytetrafluorethylene"

- VII. With letter of 12 March 2018, the respondent submitted a second auxiliary request.
- VIII. With letter of 16 August 2018, the intervener submitted documents E21 (D.H. Abang Ismawi Hassim, "The use of flame-retardant additives in natural and chloroprene rubbers" (Master's Thesis), Loughborough University, 2004, List of Abbreviations and pages 1-41) and E22 (GB 2 029 419).
- IX. With letter of 9 April 2019, the intervener withdrew their interventions and their oppositions against the European patent.
- X. In a communication sent in preparation of oral proceedings, the Board summarised the points to be dealt with and provided a preliminary view on the disputed issues.
- XI. Oral proceedings were held on 25 June 2019.

XII. The arguments of the appellant, insofar as relevant to the present decision, can be summarised as follows:

Inventive step in view of D1

(a) D1 and more particularly the "skim compound" disclosed in Table 22.4 represented the closest prior art. The elastomeric material according to claim 1 of the main request differed from the "skim compound" disclosed in Table 22.4 only in that it was expanded. The problem solved starting from D1 was thus to provide a material suitable for thermal insulation. The skilled person knew that the "skim compound" disclosed in Table 22.4 of D1 was an effective flame retardant material (as a result of the presence of chloroparaffin and alumina trihydrate). The skilled person knew from D1 itself that flame retardant elastomeric compounds could find an application in foam insulation (Table 22.2). He also knew from D2 that polychloroprene could be expanded. The expansion of the material of D1 in order to provide thermal insulation was thus not inventive.

Status of documents E1-E20

(b) Documents E1-E20 were all validly introduced into the appeal proceedings with the opposition of the intervener. The procedural situation with respect to these documents did not change as a consequence of the withdrawal of the opposition. These documents were thus further in the proceedings.

Remittal

(c) The patent had already been granted five years ago so that there was a legitimate interest to come to a decision on the present case. Taking into account the needs for legal certainty and procedural economy the case should not be remitted to the department of first instance.

XIII. The arguments of the respondent, insofar as relevant to the present decision, can be summarised as follows:

Inventive step in view of D1

(a) The compositions disclosed in Table 22.4 of D1 and in particular the "skim compound" chosen by the appellant as the composition representing the closest prior art were non expanded elastomeric materials that were only disclosed in the context of mining belt applications. The object of the patent in suit differed radically from that of that specific disclosure of D1 in that it concerned expanded elastomeric compositions for applications as thermal insulation materials. The purpose of using elastomeric flame retardant materials in mining belts in D1 was so remote to the purpose of using expanded materials for thermal insulation as disclosed in the patent in suit that the specific disclosure of D1 could not be considered as the closest prior art. The objection of lack of inventive step starting from D1 was thus based on an ex-post facto analysis of the claimed subject matter from which it could not be concluded that the claimed subject matter lacked an inventive step.

Status of documents E1-E20

- (b) The withdrawal of the intervention and opposition by the intervener changed the procedural situation regarding documents E1-E20 which had to be considered as having been filed late into the appeal proceedings. These documents should therefore not be admitted into the proceedings.

Remittal

- (c) Documents E3, E5, E13, E14 and E15, on which objections of lack of novelty and inventive step were based, were new to the appeal proceedings and created a fresh case. The respondent was not in the position to react adequately to these objections on the day of the oral proceedings as the appellant had not provided arguments based on these documents in writing. In that situation and as a matter of fairness, the respondent should be given the benefit of a review by two instances. The case should be remitted to the department of first instance.

XIV. The appellant requested that the decision under appeal be set aside and that the European patent No. 2 261 305 be revoked. It was also requested that D2, D3, D4/D4a and E1 to E22 be admitted into the proceedings, or alternatively that E14, E15 and E16 be admitted into the proceedings. It was also requested that the case not be remitted to the first instance for further prosecution.

XV. The respondent requested that the appeal be dismissed, i.e., that the patent be maintained as granted, or, in the alternative, that the patent be maintained in amended form on the basis of either the first auxiliary request filed with letter dated 10 February 2017, or

the second auxiliary request filed with letter dated 12 March 2018. It was also requested that D4/D4a and E1 to E22 not be admitted into the proceedings. It was further requested that, if E1 to E22 were admitted into the proceedings, the case be remitted to the first instance for further prosecution.

Reasons for the Decision

Main request (claims as granted)

1. Inventive step in view of D1
 - 1.1 The objection of lack of novelty against claim 1 of the main request in view of D1 (disclosure of the "skim compound" in Table 22.4 of page 495) raised by the appellant in the statement setting out the grounds of appeal was withdrawn at the oral proceedings before the Board. It was indeed acknowledged that the "skim compound" disclosed in Table 22.4 of D1 was not an expanded material and that expansion was the feature distinguishing the elastomeric material according to claim 1 of the main request from the "skim compound" of D1. In that regard, the Board agrees with this conclusion and sees no reason to reverse the decision of the opposition division on novelty over document D1.
 - 1.2 In their argumentation of inventive step, the appellant considered that D1 and in particular the disclosure of the "skim compound" in Table 22.4 of D1 (page 495) represented the closest prior art.
 - 1.3 According to established case law, in selecting the closest prior art, a central consideration is that it must be directed to the same purpose or effect as the invention, otherwise it cannot lead the skilled person

in an obvious way to the claimed invention (Case Law of the Boards of Appeal, 8th Edition, July 2016, I.D.3.2).

- 1.4 The patent in suit relates to an expandable and crosslinkable elastomeric material with improved fire retardant properties and low smoke generation (paragraph 1). It is also clearly apparent from the discussion of the prior art in paragraph 2, as well as from the discussion of the object in paragraph 5 that the patent in suit is concerned with imparting flame retardant properties, in particular low flame spread and low smoke density levels, to expandable elastomeric materials.

- 1.5 Document D1 is a collection of excerpts from a textbook on rubber technology and covers a wide range of topics organized in seven chapters, among which flame retardants (pages 489-503 of chapter 22). In particular, section 22.4.1 of chapter 22 discloses that polychloroprene is the polymer of choice for applications demanding high levels of flame retardancy such as in conveyor belts. In the specific case of mining belt applications reference is made to Table 22.4 detailing the composition "Skim compound" based on polychloroprene which is considered as the starting point for the assessment of inventive step of the main request by the appellant.

- 1.6 It is however apparent that the reference to the compositions of Table 22.4 in section 22.4.1 of D1 does not concern expanded elastomeric compositions, but rather addresses the effect of zinc borate as a halogen source on the inhibition of afterglow combustion of polychloroprene compositions for mining belt applications. The purpose of section 22.4.1 of D1 is thus to address specific flame retardant properties of

polychloroprene compositions for applications that do not involve an expansion of the composition. That is also apparent from Table 22.2 on page 490 of D1 listing polychloroprene as a typical flame retardant elastomeric compound for use in conveyor belts but not for foamed insulation. The Board thus finds that the purpose disclosed in section 22.4.1 of D1 differs significantly from that of the patent in suit.

1.7 In view of the above, the "Skim compound" composition in Table 22.4 cannot be considered as a suitable closest prior art for the assessment of inventive step of the main request. Under these circumstances, it is clear that section 22.4.1 and the "Skim compound" composition of Table 22.4, with and without the reference to D2 and D3 which concern the use of chloroprene and chloroparaffin as flame retardants, cannot lead the skilled person in an obvious way to the subject matter of claim 1 of the main request.

1.8 The objection of lack of inventive step starting from the specific composition of Table 22.4 of D1 cannot therefore be successful, so that the decision of the opposition division relating to it hold good.

2. Status of documents E1-E22

2.1 The intervention filed on 17 October 2017 (second intervention) has been timely filed within the three months time period after institution of the infringement proceedings, Rule 89(1) EPC. It also fulfils the requirements of Article 105 EPC and Rule 76 EPC. Documents E1 to E20 were annexed to the intervention of 17 October 2017. Since the intervention, apart from the requirements according to Article 105 and Rule 89(1) EPC, is not subject to any

time limit, documents E1 to E20 have been filed as early as possible. Documents E1 to E20 were thus as a matter of fact part of the appeal proceedings even without there being a need for the exercise of discretion or a decision of the Board on the admittance of these documents into the proceeding. The Board in its communication of 29 January 2019 regarded the intervention filed on 17 October 2017 (second intervention) as admissible. The respondent/patent proprietor neither objected to the Board's opinion nor contested the admissibility of that intervention. The intervention is therefore admissible.

2.2 In G 3/04 (OJ EPO 2006, 118), the Enlarged Board concluded, *inter alia*, that the valid intervener acquired the status of an opponent, irrespective of whether the intervention occurred during the proceedings before the opposition division or at the appeal stage (Case Law of the Boards of Appeal, 8th Edition, July 2016, IV.C.3.2.1). Furthermore, the Enlarged Board ruled that if the intervention was filed during the appeal proceedings, as it is the case in the present appeal, the intervener, because he could only acquire the status of an opponent, had the same rights and obligations - apart from the right to raise new grounds of opposition - as any opponent who had not filed an appeal.

2.3 With the valid filing of the notice of opposition with the intervention, the factual and legal framework of the present opposition in appeal was defined by the sum of the facts and statements of the extent to which the patent was opposed and by the grounds for opposition submitted and substantiated in the notices of opposition provided by each opponent. In that regard, the documents E1-E20 filed by the opponent/intervener

were added to the proceedings alongside document D1 filed by the original opponent.

2.4 The withdrawal of the intervention with letter of 9 April 2019 did not change the legal and factual status of documents E1 to E20. The withdrawal of the intervention only terminated the status of the intervener as opponent and party to the proceedings, but has no direct procedural consequences for the appeal proceedings as the original opponent, who had filed a valid appeal, remained party to the proceedings. The withdrawal of the intervention does not affect the legal validity of procedural acts like the filing of documents or other evidence carried out before the withdrawal of the intervention. In particular, the withdrawal of the intervention does not render the intervention retroactively inadmissible, since such a withdrawal has only the legal effect *ex nunc*. Consequently, contrary to the proprietor's/respondent's opinion, there is no legal basis for regarding documents E1 to E20, which have been filed in the context of an admissible intervention, as retroactively late filed after the withdrawal of the intervention. Since there is no legal basis in the EPC that foresees the exclusion of documents from continuing opposition proceedings when one of the oppositions is withdrawn, the documents E1-E20 submitted by the opponent/intervener with the notice of opposition remain in the proceedings and have to be taken into account in the Board's decision.

2.5 As the Board has no discretion not to admit documents E1 to E20 in the proceedings, the request not to admit these documents must be refused.

2.6 The request not to admit D4 does not need to be answered by the Board as the document is already in the proceedings as E13.

2.7 As to documents D2 and D3, no objection to their admittance was raised by the respondent. The Board sees no reason not to admit these documents which are also therefore in the proceedings.

2.8 E21 and E22 were submitted by the intervener in order to address a limitation regarding the fillers and their amounts in claim 1 of the second auxiliary request. The present decision however concerns the set of claims of the main request in which the fillers are not defined. E21 and E22 are thus not relevant to the main request and were indeed not mentioned by the parties in the discussion of that request in appeal. There is therefore no need for the Board to decide on the admittance of these documents that may only be found to be relevant to the second auxiliary request which was not dealt with in the present appeal.

3. Remittal

3.1 Having reviewed the decision under appeal, the Board has not taken a decision on the objections of lack of novelty and lack of inventive step involving documents E1-E20 introduced into the proceedings with the opposition of the intervener.

3.2 As it is apparent from that opposition as well as from the communication of the Board dated 19 January 2019, these objections were not part of the proceedings before the opposition division. They also involve aspects of claim 1 of the main request that have never been discussed between the parties prior to the

intervention in appeal. It is also the view of the Board that the complexity of these objections alter the factual framework of the case to such an extent that they constitute a fresh case in appeal. Moreover, any reason of urgency addressed by the intervener is no longer of relevance in view of the withdrawal of the intervention.

- 3.3 In conclusion, the Board, in agreement with the request of the patent proprietor, considers it appropriate, weighing the fresh case arising in appeal against the interest of procedural economy, to exercise the power conferred to it by Article 111(1) EPC to remit the case to the opposition division for further prosecution in order to enable the department of first instance to decide on the outstanding issues.

Order

For these reasons it is decided that:

1. The decision under appeal is set aside.
2. The case is remitted to the first instance for further prosecution.

The Registrar:

The Chairman:



G. Nachtigall

D. Semino

Decision electronically authenticated