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**Datasheet for the decision  
of 28 September 2021**

**Case Number:** T 2002/17 - 3.3.10

**Application Number:** 08748159.4

**Publication Number:** 2142225

**IPC:** A61L24/02, A61K6/06, A61L24/00,  
A61L27/00

**Language of the proceedings:** EN

**Title of invention:**

PREMIXED BIOLOGICAL HYDRAULIC CEMENT PASTE COMPOSITION AND  
USING THE SAME

**Patent Proprietor:**

Innovative Bioceramix, INC.

**Opponent:**

Ettmayr, Andreas

**Headword:**

**Relevant legal provisions:**

EPC Art. 54, 111(1)  
RPBA Art. 13  
RPBA 2020 Art. 11, 25(3)

**Keyword:**

Late-filed request - admitted (yes)

Novelty - (yes)

Remittal - (yes)

**Decisions cited:**

**Catchword:**



**Beschwerdekammern**

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Case Number: T 2002/17 - 3.3.10

**D E C I S I O N**  
**of Technical Board of Appeal 3.3.10**  
**of 28 September 2021**

**Appellant:** Innovative Bioceramix, INC.  
(Patent Proprietor) 1628 West 75th Avenue  
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British Columbia V6P 6G2 (CA)

**Representative:** Potter Clarkson  
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**Respondent:** Ettmayr, Andreas  
(Opponent) Emil-Riedel-Strasse 18  
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**Representative:** Icosa  
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**Decision under appeal:** **Decision of the Opposition Division of the  
European Patent Office posted on 19 July 2017  
revoking European patent No. 2142225 pursuant to  
Articles 101(2) and 101(3)(b) EPC.**

**Composition of the Board:**

**Chair** R. Pérez Carlón  
**Members:** M. Kollmannsberger  
W. Van der Eijk

## **Summary of Facts and Submissions**

- I. The patentee's appeal lies from the decision of the Opposition Division to revoke European patent EP 2 142 225 under Articles 101(2) and 101(3)(b) EPC.
  
- II. The patent had been opposed under Articles 100(a) and 54/56 EPC for lack of novelty and inventive step, and under Articles 100(b) and 83 EPC for insufficient disclosure.
  
- III. The following document is relevant for the present decision:  
  
D3: EP 1 945 194, corresponding to WO 2007/047994
  
- IV. In the impugned decision the Opposition Division concluded that the patent as granted was insufficiently disclosed under Article 83 EPC. Furthermore, the amended claim sets then pending as auxiliary requests 1-11 were sufficiently disclosed, fulfilled the requirements of Articles 123 EPC and, as far as applicable, 84 EPC, but the claimed invention lacked novelty under Articles 54(2) or 54(3) EPC over document D3.
  
- V. With the statement of grounds of appeal the appellant requested to set aside the decision of the Opposition Division and to reject the opposition.

As an auxiliary request, it requested the patent to be maintained in amended form on the basis of one of the claim sets submitted as auxiliary requests 1-10. Auxiliary requests 1-8 corresponded to requests already pending and decided on in opposition proceedings, albeit in different order. Auxiliary requests 9 and 10 were newly filed.

VI. In its reply to the appeal the respondent (opponent) requested the appeal to be dismissed.

VII. On 6 September 2019 the Board of Appeal issued summons for oral proceedings which were to take place on 17 September 2020. Later on, the date of the oral proceedings was postponed to 28 September 2021 in view of the COVID-19 pandemic.

VIII. With a communication of 12 September 2019, the Board informed the parties about the issues to be discussed at oral proceedings and gave a preliminary opinion on some of the disputed points. The Board's preliminary view was that:

the cement paste of claim 1 of the main request as well as those of auxiliary requests 1, 3, 5 and 7 was not novel over D3;

it would have to be discussed whether the feature *the calcium silicate hydrogel is the main structure component of the cement to contribute to mechanical strength* introduced into the claims of auxiliary requests 2, 4, 6, and 8 was clear (Article 84 EPC);

this feature additionally did not appear to provide novelty over D3;

novelty of auxiliary request 9 over D3 would have to be discussed, whereas the claims of auxiliary request 10 appeared to be novel;

inventive step might be dealt with in the appeal proceedings, but the case might also be remitted to the Opposition Division for further prosecution.

- IX. The parties filed further submissions addressing novelty, clarity and inventive step of the pending requests.
  
- X. With submission of 25 August 2021 the appellant filed a new main request and auxiliary requests 1-3. The main request corresponded to auxiliary request 2 and the auxiliary requests to auxiliary requests 8-10 as filed with the grounds of appeal. All other requests were withdrawn.
  
- XI. Oral proceedings took place on 28 September 2021. With the agreement of both parties, the proceedings were carried out as a video conference. During the oral proceedings, the appellant withdrew all pending claim sets and filed a new claim set as main request, based on the claims of auxiliary request 10 as submitted with the grounds of appeal, later renumbered as auxiliary request 3.

XII. Claim 1 of the appellant's main request as filed during oral proceedings reads:

*"A premixed cement paste for use in medical or dental applications, said cement paste comprising:*

*at least one calcium silicate compound;*

*at least one radio opaque material selected from the group consisting of zirconium oxide, tantalum oxide, and mixtures thereof; and*

*at least one water-free liquid carrier that undergoes exchange with an aqueous physiological solution, the at least one water-free liquid carrier comprising less than 20% water by weight of said water-free liquid carrier and being selected from the group consisting of:*

*ethylene glycol;  
polyethylene glycol;  
liquid glycerol;  
ethyl alcohol; and  
mixtures thereof;*

*the at least one water-free liquid carrier being mixed with said at least one calcium silicate compound;*

*said cement paste hydrating and hardening to produce calcium silicate hydrogel and calcium hydroxide when placed in a physiological environment."*

XIII. The final requests of the parties were the following:

The appellant requested to set aside the impugned decision and to remit the case to the Opposition Division for further prosecution based on the claims of the main request as filed during the oral proceedings before the Board.

The respondent requested to dismiss the appeal.

### **Reasons for the Decision**

1. The appeal is admissible.
2. Admissibility of the main request
  - 2.1 The main request was filed during the oral proceedings before the Board.

Summons to oral proceedings had been issued in 2019. Thus, according to the transitional provision in Article 25(3) RPBA 2020 the admissibility of the main request is governed by Article 13 RPBA 2007.

According to Article 13(1) RPBA 2007, amendments to a party's case submitted after it has filed its ground of appeal or reply may be admitted at the Board's discretion. Criteria for the exercise of the discretion are i. a. the complexity of the new subject-matter submitted, the current state of proceedings and the need for procedural economy.

Additionally, Article 13(3) RPBA 2007 stipulates that, after oral proceedings have been arranged, amendments may not be admitted if they raise issues which the Board and the parties cannot be expected to deal with without adjourning the oral proceedings.



2.2 The appellant argued that, although the request was filed very late in the proceedings, it was a reaction to the objections under Article 84 EPC discussed during the oral proceedings. The appellant could not have expected that this objection extended also to the claims of auxiliary request 10 as filed with the grounds of appeal, which was still pending as auxiliary request 3 at the onset of the oral proceedings. This request was considered novel over the cited documents in the preliminary opinion of the Board and, the newly filed request having the feature objected to for lack of clarity removed, it would be unfair towards the appellant not to admit a reaction to this new development during the oral proceedings.

2.3 The respondent argued that the request was filed very late in the proceedings, just before possibly a final decision was to be announced. The clarity objection was part of the preliminary opinion of the Board, so a request omitting this feature could have been submitted well before the oral proceedings. Thus, it should not be admitted into the proceedings at such a late stage anymore.

2.4 It is correct that the main request request has been filed extremely late, at a point where a decision on the then pending requests was imminent.

However, in the present case the Board nevertheless makes use of its discretion under Article 13 RPBA 2007 to admit the main request into the proceedings.

The main request is based on auxiliary request 10 filed with the grounds of appeal. This request, as outlined also in the preliminary opinion of the Board, is novel over D3 and overcomes thus the ground for which the

patent had been revoked. The new main request additionally removes the feature objected to for lack of clarity. It is true that this objection had been mentioned in the Board's preliminary opinion, but not in connection with auxiliary request 10. Its importance in the context of auxiliary request 10 may thus have emerged only during the course of the oral proceedings.

The amended main request does not raise any issue beyond those already on file, and solves those which led to the patent being revoked. Article 13(3) RPBA 2007 thus does not preclude the admittance of the new main request into the proceedings.

2.5 Thus, the appellant's main request is admitted into the proceedings.

3. Novelty (Article 54 EPC)

Claim 1 of the appellant's main request is novel over D3 at least because D3 does not disclose a premixed cement paste comprising "*at least one radio opaque material selected from the group consisting of zirconium oxide, tantalum oxide, and mixtures thereof*".

This was uncontested; the respondent did not raise any novelty objection against this claim.

4. Remittal (Article 111(1) EPC, Article 11 RPBA 2020)

4.1 Under Article 111(1) EPC, a Board may either exercise any power within the competence of the department which was responsible for the decision appealed or remit the

case for further prosecution to the Opposition Division.

According to Article 11 RPBA 2020, a remittal should be the exception, requiring special reasons for it to be ordered. The appellant requested the case to be remitted, the respondent requested that the Board would deal itself with the question of inventive step.

- 4.2 In the present case the decision of the Opposition Division was limited to the issues of unallowable amendments (Article 123(2) EPC), clarity of the amended claims (Article 84 EPC) and novelty over D3 (Article 54 EPC). Inventive step (article 56 EPC) was not decided upon since all the requests then pending were considered either not sufficiently disclosed or not novel.
- 4.3 According to Article 12(2) RPBA 2020 the primary object of the appeal proceedings is a judicial review of the appealed decision. However, with respect to inventive step there is no decision to review. The fact that inventive step has not been decided upon constitutes in the Board's view a special reason in the sense of Article 11 RPBA, justifying a remittal to the Opposition Division.
- 4.4 The respondent has argued that the case had already been delayed due to the COVID pandemic and a remittal would thus be detrimental to the procedural economy. Furthermore the case was simple and could easily be decided by the Board.

However, the Board notes that in this case the document which was cited against novelty (D3) is a citation published between the priority date and the filing of

the patent application. It is thus state of the art for assessing novelty, but not necessarily for examining inventive step, in case the priority is validly claimed. Depending on the assessment of the priority claim the question of inventive step may not build upon the discussion on novelty, but start from different prior art giving rise to entirely different questions. Such questions have not been addressed by the Opposition Division and would have to be decided upon by the Board for the first time, which decision would also be final.

The Board is of the view that it shouldn't take such a decision but should rather, by remitting the case, open the possibility of a consideration of the issue by two instances. Furthermore, even upon remittal a decision on this issue can be expected well before the expiry of the patent term.

4.5 Thus, the Board comes to the conclusion that the case should be remitted to the Opposition Division for further prosecution.

## **Order**

### **For these reasons it is decided that:**

The decision under appeal is set aside.

The case is remitted to the Opposition Division for further prosecution.

The Registrar:

The Chair:



C. Rodríguez Rodríguez

R. Pérez Carlón

Decision electronically authenticated