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**Datasheet for the decision
of 1 March 2023**

Case Number: T 0126/21 - 3.3.03

Application Number: 05709364.3

Publication Number: 1710280

IPC: C08L101/02

Language of the proceedings: EN

Title of invention:
HARDENABLE COMPOSITION

Patent Proprietor:
KANEKA CORPORATION

Opponents:
Wacker Chemie AG
Henkel AG & Co. KGaA

Relevant legal provisions:
EPC Art. 54, 56, 111(1)
RPBA 2020 Art. 12(4), 12(5), 12(6), 13(2)

Keyword:

Novelty - (yes)

Amendment after summons - exceptional circumstances (no)

Inventive step - (no: main request and first auxiliary request)

Appeal decision - remittal to the department of first instance (yes)

Decisions cited:

G 0001/03, G 0002/10, G 0001/16



Beschwerdekammern

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Case Number: T 0126/21 - 3.3.03

D E C I S I O N
of Technical Board of Appeal 3.3.03
of 1 March 2023

Appellant: Henkel AG & Co. KGaA
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Party as of right: Wacker Chemie AG
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Decision under appeal: **Interlocutory decision of the Opposition
Division of the European Patent Office posted on
19 January 2021 concerning maintenance of the
European Patent No. 1710280 in amended form.**

Composition of the Board:

Chairman D. Semino
Members: O. Dury
 A. Bacchin

Summary of Facts and Submissions

I. The appeal of opponent 2 lies from the interlocutory decision of the opposition division concerning maintenance of European Patent No. 1 710 280 in amended form according to the claims of the main request filed with letter of 8 July 2019 and a description adapted thereto.

II. The following document was, among others, cited in the decision under appeal:

D4: machine translation of JP 2001-055503

III. As far as relevant to the present decision, the following conclusions were reached in the decision under appeal:

- The subject-matter of claim 1 of the main request was novel over document D4;
- The subject-matter of claim 1 of the main request involved an inventive step when document D4 was taken as the closest prior art.

Further considering that none of the other objections put forward by the opponents succeeded, the patent amended on the basis of the main request was held to meet the requirements of the EPC.

IV. Opponent 2 (appellant) lodged an appeal against that decision.

- V. With their rejoinder to the statement of grounds of appeal the patent proprietor (respondent) filed a set of claims as second auxiliary request.
- VI. The parties were summoned to oral proceedings and a communication, in accordance with Article 15(1) RPBA 2020, indicating specific issues to be discussed at the oral proceedings was then sent to the parties.
- VII. With letter of 6 December 2022 opponent 1 (party to the proceedings as of right pursuant to Article 107, second sentence, EPC) indicated that they would not attend the oral proceedings.
- VIII. Oral proceedings were held on 1 March 2023 in the presence of the appellant and the respondent, as announced.
- IX. **The final requests of the parties were as follows:**
- (a) The appellant requested that the decision under appeal be set aside and that the European patent be revoked. The appellant further requested that the second auxiliary request, filed with the rejoinder to the statement of grounds of appeal, be not admitted in the appeal proceedings and the case be remitted to the opposition division in case of admittance of the second auxiliary request into the proceedings.
- (b) The respondent requested that the appeal be dismissed (main request) or, in the alternative, that the decision of the opposition division be set aside and the patent be maintained in amended form according to any of the first to fifth auxiliary requests indicated in their rejoinder to the

statement of grounds of appeal, whereby the first auxiliary request had been filed with letter of 8 July 2019, the second auxiliary request was filed with the rejoinder to the statement of grounds of appeal, the third and fourth auxiliary requests had been filed with letter of 8 July 2019, as second and third auxiliary requests and the fifth auxiliary request had been filed with letter of 8 July 2019 as fourth auxiliary request.

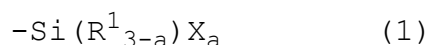
(c) The party as of right did not file any requests during the appeal proceedings.

X. Claim 1 of the **main request** (main request filed with letter of 8 July 2019) reads as follows:

"1. A curable composition which comprises

an organic polymer (A) containing no urethane bond or urea bond within the molecule and containing reactive silyl groups represented by the general formula (1) given below wherein a is 3 and

an organic polymer (B) containing an average of 0.5 to 1.5 reactive silyl groups represented by the general formula (1) given below per molecule.



wherein R^1 represents an alkyl group containing 1 to 20 carbon atoms, an aryl group containing 6 to 20 carbon atoms, an aralkyl group containing 7 to 20 carbon atoms or a triorganosiloxy group represented by $(\text{R}')_3\text{SiO}-$, in which the three R' groups may be the same or different and each represents a monovalent hydrocarbon group containing 1 to 20 carbon atoms and, when there are two

or more R¹ groups, they may be the same or different, and X represents a hydroxyl group or a hydrolysable group and, when there are two or more X groups, they may be the same or different, and a represents 1, 2 or 3,

wherein the main chain of each of the organic polymers (A) and (B) is an oxyalkylene polymer."

XI. Claim 1 of **the first auxiliary request** differed from claim 1 of the main request in that the definition of the organic polymer (B) was amended as follows (additions in **bold**, deletions in ~~strikethrough~~):

"an organic polymer (B) containing an average of 0.5 to ~~1.5~~ **1.2** reactive silyl groups represented by the general formula (1) given below per molecule."

XII. Claim 1 of **the second auxiliary request** differed from claim 1 of the first auxiliary request in that it was further defined therein that:

"wherein the organic polymer (B) contains substantially one reactive silyl group represented by the general formula (1) per molecule".

XIII. Claim 1 of **the third auxiliary request** differed from claim 1 of the first auxiliary request in that the following feature was added at the end of the claim:

"and the molecular weight of the organic polymer (B) is lower than the molecular weight of the organic polymer (A) by not less than 1,000."

XIV. Claim 1 of **the fourth auxiliary request** differed from claim 1 of the first auxiliary request in that it

further contained the amendments indicated above for each of the second and third auxiliary requests.

XV. The appellant's arguments, in so far as they are pertinent for the present decision, may be derived from the reasons for the decision below. They are essentially as follows:

- (a) The subject-matter of claim 1 of the main request was not novel over the disclosure of document D4.
- (b) The subject-matter of claim 1 of each of the main request and first auxiliary request did not involve an inventive step when document D4 was taken as the closest prior art;
- (c) The second auxiliary request should be not admitted into the proceedings;
- (d) Should the second auxiliary request be admitted, the case should be remitted to the opposition division for further prosecution.

XVI. The respondent's arguments, in so far as they are pertinent for the present decision, may be derived from the reasons for the decision below. They are essentially as follows:

- (a) The subject-matter of claim 1 of the main request was novel over D4;
- (b) The subject-matter of claim 1 of each of the main request and first auxiliary request involved an inventive step when document D4 was taken as the closest prior art;

- (c) The second auxiliary request should be admitted into the proceedings;
- (d) Should the second auxiliary request be admitted, the respondent had no objection against a remittal of the case to the opposition division.

Reasons for the Decision

Main request

1. The operative main request is the main request dealt with in the decision under appeal and allowed by the opposition division. The appellant contested the decision of the opposition division in respect of said main request both regarding novelty over D4 and inventive step when document D4 was taken as the closest prior art.
2. Novelty over D4
 - 2.1 In the decision under appeal, the subject-matter of operative claim 1 was held to be novel over D4 (section 5.2.3 of the reasons) considering that
 - (a) A two-fold selection within the general disclosure of D4 was necessary in order to arrive at the combination of features according to operative claim 1 (section 5.2.3.1 of the reasons);
 - (b) None of examples 1 to 7 of D4 (table 1) constituted a direct and unambiguous disclosure of the subject-matter of operative claim 1 (section 5.2.3.2 of the reasons). That conclusion was reached considering

that:

- There was no information on file regarding the requirement that the compositions prepared in these examples effectively comprised an organic polymer (B) containing an average of 0.5 to 1.5 reactive silyl groups of formula (1) as defined in operative claim 1;
- The combination of these examples with paragraph 18 of the description of D4 considered by the opponents amounted to creating artificially a particular embodiment which was not disclosed in D4.

For these reasons, the subject-matter of operative claim 1 was held to be not directly and unambiguously derivable from D4.

2.2 The conclusion of the opposition division regarding the novelty objection related to the general disclosure of D4 (section 2.1.a above) was not contested in appeal. Also the Board has no reason to deviate from that view.

2.3 Regarding the conclusion based on examples 1 to 7 of D4 (section 2.1.b above), the appellant put forward that no information was provided in D4 regarding the average number of reactive silyl groups of polymer (A) used in these examples of D4, which corresponded to polymer (B) according to operative claim 1. In addition, since no information was provided in D4 regarding the amounts of reactants to be used when carrying out these examples, no conclusion could be drawn as to the average number of reactive silyl groups present in any of the polymers prepared in these examples, so the appellant (statement of grounds of appeal: page 2, fifth paragraph).

However, the appellant argued that the skilled person aiming at carrying out these examples would have been taught in paragraph 18 of D4 that the average number of reactive silyl groups in polymer (A) of D4 was preferably 1.2 or more. Therefore, the skilled person confronted with these examples of D4 would select the amounts of reactants in order to achieve such an amount of reactive silyl groups. Under these circumstances, the appellant considered that the skilled person making such a choice would perform a single selection within the ambit of D4 in order to arrive at the subject-matter of operative claim 1, namely to carry out the examples of D4, for instance example 7 thereof, so as to be according to the preferred embodiment disclosed in paragraph 18 of D4. Such a single selection amounted to a lack of novelty, so the appellant.

2.4 However, according to established case law, the concept of disclosure must be the same for the purpose of Article 54 as the one for Article 123(2) EPC (see G 2/10, OJ EPO 2012, 376: Reasons 4.6 and 4.3, G 1/03, OJ EPO 2004, 413: Reasons 2.2.2 and G 1/16, OJ EPO 2018, A70: Reasons 17.). Accordingly it has to be shown that the subject-matter being claimed is directly and unambiguously disclosed in the prior art (so-called gold standard, as referred to in G 2/10), so that no other test or list of criteria is necessary.

2.5 In the Board's view, the arguments put forward in appeal by the appellant provide no cause for the Board to deviate from the conclusion of the opposition division that the examples 1 to 7 of D4 do not directly and unambiguously disclose a polymer (B) as defined in operative claim 1 (polymer (A) of D4) and containing an average of 0.5 to 1.5 reactive silyl groups of

formula (1) according to operative claim 1.

- 2.5.1 In particular, the appellant explicitly acknowledged that the average number of reactive silyl groups of polymers (A) prepared in examples 1 to 7 of D4 (polymer (B) according to operative claim 1) was not explicitly disclosed. Also, as already indicated by the opposition division, no evidence in that respect was submitted by the appellant (section 5.2.3.2 of the reasons: third sentence). Therefore, already for that reason, it cannot be concluded that examples 1 to 7 of D4 constitute an implicit, but direct and unambiguous disclosure of the subject-matter of operative claim 1.
- 2.5.2 In addition, even if - to the appellant's benefit - the skilled person were to consider paragraph 18 of D4 as contemplated by the appellant, it is noted that amounts of reactive silyl groups above 1.5 are also indicated in said paragraph 18 (2 or more, 2 to 6, 2 to 8), even as more preferred embodiments. Therefore, there is no reason to consider that, in the absence of specific indications in the examples of D4 regarding the amounts of reactants, the skilled person would have mandatorily selected these amounts so as to obtain an average amount of reactive silyl groups of 1.2 or, at least, of 0.5 to 1.5 as defined in operative claim 1.
- 2.5.3 In the Board's opinion, although no exact information is provided in D4 regarding the preparation conditions effectively used in examples 1 to 7 thereof, the combination of a specific example of a prior art document - which constitutes an isolated and complete disclosure in itself of a specific combination of features - with a specific requirement indicated in the description as a suitable embodiment, among other possibilities, of the invention being claimed cannot be

equated to performing a single selection within a list of equivalent alternatives in a disclosure defined in generic terms, as was put forward by the appellant. Therefore, that argument is rejected.

- 2.6 In view of the above, the passages of D4 relied upon by the appellant do not amount to a direct and unambiguous disclosure of the subject-matter according to operative claim 1. Therefore, the appellant's arguments do not justify that the Board overturns the decision of the opposition division regarding novelty over D4.

The subject-matter of claim 1 of the main request is therefore novel over document D4.

3. Admittance of new submissions put forward at the oral proceedings in respect of inventive step
- 3.1 During the discussion regarding inventive step that took place at the oral proceedings before the Board, the respondent made for the first time new submissions regarding the relevance of the comparison of examples of the patent in suit (example 4 vs. example 7; example 3 vs. example 6) for proving the presence of a technical effect related to the amount of reactive silyl groups of organic polymer (B) defined in operative claim 1. However, the appellant requested that said submissions be not admitted into the proceedings.
- 3.2 In that respect, considering that these submissions were not provided in the rejoinder to the statement of grounds of appeal, which were limited to the comparison of example 7 and comparative example 8, and were submitted after the summons to oral proceedings was notified to the parties, they constitute an amendment

to the respondent's appeal case, the admittance of which is subject to the discretion of the Board under Article 13(2) RPBA 2020. According to this provision an amendment to a party's case shall in principle not be taken into account unless there are exceptional circumstances, which have been justified with cogent reasons by the party concerned.

- 3.3 In that respect, no arguments were put forward by the respondent why these submissions were made so late.
- 3.4 Further considering that these submissions were based on data of the patent in suit and that the opposition division already held in the decision under appeal that the patent in suit "lacked any pertinent Comparative Example showing any technical effect which can be associated with this distinguishing feature" (section 6.2 of the reasons: third paragraph) - which was further adhered to by the appellant in their statement of grounds of appeal (page 4, last paragraph) -, the Board cannot identify any exceptional circumstance which may justify the filing of these submissions at such a late stage of the proceedings.
- 3.5 Also, it is taken into account that by putting forward these submissions only at the oral proceedings, the appellant was left little time to react and prepare an appropriate defense, e.g. to evaluate the correctness of the comparisons being made and/or whether the results relied upon could be generalised. Under these circumstances, admitting the new submissions of the respondent would have run counter to the obligation of fairness toward the respondent and to the principle of procedural efficiency.

3.6 For these reasons, the Board decided not to take into account the submissions of the respondent made for the first time at the oral proceedings which were based on the comparison of example 4 vs. example 7 and example 3 vs. example 6 of the patent in suit. In other words, these submissions were not admitted into the proceedings.

4. Inventive step

4.1 Closest prior art and distinguishing feature(s)

4.1.1 Both parties agreed with the opposition division's finding that D4 was a suitable document to be taken as the closest prior art and that examples 1 to 7 thereof were particularly relevant and constituted suitable starting points for the assessment of the inventive step.

4.1.2 It was also common ground that the subject-matter of operative claim 1 differed from the compositions prepared in examples 1 to 7 of D4 only in that the organic polymer (B) as defined in operative claim 1 should contain an average of 0.5 to 1.5 reactive silyl groups per molecule (whereas no indication in that respect is indicated in D4, as explained in section 2 above).

4.1.3 The Board has no reason to deviate from these views.

4.2 Problem effectively solved over examples 1 to 7 of D4

4.2.1 Regarding the formulation of the problem to be solved, whereas the appellant agreed with the opposition division that it resided in the provision of an alternative composition (see e.g. statement of grounds

of appeal: page 4, last paragraph), the respondent put forward that said problem should be formulated as "to improve adjustability of mechanical properties" (rejoinder: section IV.2.1, page 5, second and fourth paragraphs). During the oral proceedings before the Board, the respondent also considered that the problem to be solved resided in the provision of sealings with improved sealing properties. In that respect, the respondent in particular considered that example 7 and comparative example 8 of the patent in suit showed that the improvement claimed was effectively achieved (see e.g. rejoinder: section IV.2.1, paragraph bridging pages 4 and 5).

4.2.2 In that respect, the opposition division indicated in their decision that comparative example 8 of the patent in suit did not allow a fair comparison to be made because it was directed to a curable composition comprising a polymer A5 containing a urethane bond, "thus not only differing in the distinguishing feature" (point 6.2 of the reasons: third paragraph).

(a) However, although it is correct that comparative example 8 of the patent in suit differs from a composition according to operative claim 1 in at least two features (absence of urethane/urea bonds in polymer (A); amount of reactive silyl groups in polymer (B)), it is agreed with the respondent that it only differs from example 7 of the patent in suit in the above identified distinguishing feature (amount of reactive silyl groups in polymer (B)).

(b) Therefore, example 7 and comparative example 8 of the patent in suit may be fairly compared with one another and said comparison effectively illustrates a possible effect related to the distinguishing

feature identified in section 4.1.2, above. In that respect, it was indicated in the decision under appeal that the patent proprietor acknowledged during the opposition proceedings that a typographical error occurred in respect of comparative example 8 in tables 1 to 4 of the patent in suit (see section 4.2.1 of the reasons: third and fourth paragraphs). Therefore, that example will be read accordingly hereinafter, i.e. comparative example 8 is read as being directed to a composition comprising organic polymers A5 and B6 - and not A5 and B5 as indicated in the B1 publication.

- (c) From the properties reported for example 7 and comparative example 8 in tables 3 and 4 of the patent in suit, it can further be accepted that the above identified distinguishing feature leads to cured compositions with increased elongation at break and reduced modulus by otherwise comparable viscosity and recovery.

- (d) However, it was not disputed by the respondent that, as put forward by the opposition division, the compositions according to example 7 and comparative example 8 of the patent in suit contain a polymer (A) which comprises urethane bonds, which is excluded by the definition of polymer (A) according to operative claim 1 (rejoinder: page 4, last line and page 5, lines 1 to 5). Therefore it has to be assessed if there are reasons to consider that the effect shown by example 7 and comparative example 8 of the patent in suit - none of which is according to claim 1 - is also achieved for similar compositions which differ therefrom in that they comprise a polymer (A) without urethane bonds as

defined in operative claim 1.

In that respect, the respondent put forward that this was the case because it was indicated in the patent in suit that the urethane bonds affected heat resistance but not elongation at break and recovery rate (rejoinder: page 5, lines 1-5; although the respondent made reference to paragraph 16 of the patent in suit, it seems that paragraph 21 was meant). However, the Board considers that it is merely indicated in paragraph 21 of the patent in suit that urethane bonds may decrease thermal stability but nothing is said therein regarding the effect of these bonds on properties such as elongation at break and modulus. In the absence of any additional evidence or arguments in support of that statement of the respondent and further considering that it cannot be excluded that the presence or not of urethane bonds - which modify the chemical structure of the polymer - may have an impact on the interactions between the different components of the curable compositions prepared in the examples of the patent in suit and, therefore, on the properties of the whole cured composition, the Board considers that the improvement relied upon by the respondent cannot be taken up in the formulation of the problem effectively solved over the closest prior art.

4.2.3 In view of the above, the problem solved over the closest prior art resides in the provision of further curable compositions in alternative to the ones according to examples 1 to 7 of D4.

4.3 Obviousness

- 4.3.1 The question remains to be answered if the skilled person desiring to solve the problem identified as indicated in section 4.2.3 above, would, in view of the teaching of D4 (which was the sole document referred to by the appellant), have modified the disclosure of the closest prior art in such a way as to arrive at the claimed subject matter.
- 4.3.2 In that respect, it is not contested that D4 teaches that polymers (B) according to operative claim 1 and containing an amount of silyl groups as defined in operative claim 1 may be used as polymer (A) according to D4 (see paragraph 18 of D4, in which an amount of reactive silyl groups as low as 1.2 is explicitly disclosed). In addition, since the ranges disclosed in paragraph 18 of D4 are all referred to as being preferred embodiments and in the absence of any counter-indications in D4 in that regard, it is considered that D4 contains no limitation in respect of that feature (as also derivable from the fact that claim 1 of D4 is also not limited in that respect). Therefore, considering that the problem to be solved resides in the provision of a mere alternative, it would be obvious to use in the compositions according to examples 1 to 7 of D4 a polymer (A) - corresponding to the definition of polymer (B) according to operative claim 1 - containing an average of reactive silyl groups in the range of 0.5 to 1.5 as defined in operative claim 1. In that regard, it is noted that the appellant's argument that the skilled person would have no difficulty to prepare such polymers (see e.g. statement of grounds of appeal: page 2, sixth paragraph, in respect of novelty), was not contested by the respondent, in particular not at the oral proceedings before the Board. Also, it is derivable from paragraph 5 of D4 that the problem addressed in D4

was to provide curable compositions whose mechanical and curing properties are adjustable over a wide range. Therefore, the Board is of the opinion that the skilled person would have had good reasons to consider any teaching comprised within the ambit of D4, as put forward by the appellant (statement of grounds of appeal: page 4, fifth paragraph).

4.3.3 In addition, the Board shares the appellant's view that, when the problem to be solved resides in the provision of a mere alternative, the fact that D4 may suggest other possible amounts of silyl groups, in particular amounts higher than 1.5, which would lead to subject-matter which is not according to operative claim 1, cannot affect the above conclusion (see statement of grounds of appeal: page 5, third paragraph; see also rejoinder: section IV.2.2, third paragraph). Indeed, since the problem to be solved resides in the provision of a mere alternative to the closest prior art, no suggestion or pointer in the prior art is needed in order to render the subject-matter claimed obvious: it is sufficient to show that said missing feature constitutes an arbitrary selection within a host of available alternatives, which is the case here as outlined above.

4.3.4 The Board further agrees with the appellant that the "functional group number" discussed in paragraph 15 of D4 does not correspond to the average of reactive silyl groups per polymer molecule defined for organic polymer (B) according to operative claim 1 but to the number of functional groups present in the polymer raw material used in the synthesis of that polymer (statement of grounds of appeal: page 4, second paragraph). Therefore, paragraph 15 of D4 cannot teach away from using an amount of reactive silyl groups as defined in

operative claim 1. This is particularly true considering that an amount as low as 1.2 silyl group per molecular of the final polymer is explicitly disclosed in paragraph 18 of D4. For that reason, the respondent's argument (rejoinder: page 5, section IV.2.2, second paragraph) did not convince. For the same reason, the same conclusion is equally valid for the respondent's argument that it would be common practice to introduce as many cross-linking functional groups as possible (rejoinder: page 5, section IV.2.2, second and third paragraphs).

- 4.3.5 In view of the above, the subject-matter of operative claim 1 does not involve an inventive step in view of document D4 as the closest prior art and the main request is not allowable.

Auxiliary requests

5. First auxiliary request - Inventive step
- 5.1 Claim 1 of the **first auxiliary request** differs from claim 1 of the main request in that the amount of reactive silyl groups of polymer (B) in the first auxiliary request was limited to the range of "an average of 0.5 to 1.2" (instead of "an average of 0.5 to 1.5" in the main request).
- 5.2 However, the amendment made does not introduce an additional distinguishing feature over the disclosure of D4 (as compared to the main request, the distinguishing feature remaining the average number of reactive silyl groups per molecule in polymer (B)) and, since an amount of reactive silyl groups of e.g. 1.2 is explicitly disclosed in paragraph 18 of D4, it does not change any part of the reasoning of inventive step

outlined for the main request. Therefore, said amendment cannot overcome the objection of lack of inventive step in view of D4 as the closest prior art that was successful against the main request.

- 5.3 At the oral proceedings before the Board, the respondent argued - for the first time - that it would be difficult for the skilled person to prepare an organic polymer (B) having an amount of reactive silyl groups as low as 1.2, which was the lowest value disclosed in D4 and was the upper limit of the domain defined in operative claim 1.

However, said argument is not backed up by any evidence, and this, although a contradictory statement was made by the appellant in their statement of grounds of appeal (page 2, sixth paragraph, in respect of novelty), as was indicated in the Board's communication (section 8.4.2, in respect of inventive step) and was never contested before. For that reason, the respondent's argument is not persuasive.

- 5.4 In view of the above, the first auxiliary request is not allowable for the same reasons as outlined for the main request.

6. Second auxiliary request - Admittance

- 6.1 Claim 1 of the **second auxiliary request** differs from claim 1 of the first auxiliary request in that the amount of reactive silyl groups of organic polymer (B) was limited to be "substantially one".

- 6.2 During the oral proceedings before the Board, the appellant requested that the second auxiliary request be not admitted into the proceedings because it was

late-filed and should have been filed already during the opposition proceedings.

- 6.3 In that respect, it was acknowledged by the respondent that the second auxiliary request was filed for the first time in appeal (rejoinder: page 1, penultimate paragraph). Therefore, the filing of that auxiliary request constitutes an amendment to the respondent's case, the admission of which is subject to the Board's discretion pursuant, to Article 12(4) to 12(6) RPBA 2020.
- 6.4 It was not argued by the appellant that the second auxiliary request should be not admitted in virtue of Article 12(5) RPBA 2020. Also the Board has no reason to deviate from that view.
- 6.5 Although it makes no doubt that the second auxiliary request could have been filed earlier, e.g. with any of the other operative auxiliary requests or at the oral proceedings before the opposition division, said auxiliary requests was filed at the start of the appeal proceedings, namely with the rejoinder to the statement of grounds of appeal. Also, since the opposition division decided that the main request then pending was allowable, it cannot be concluded that there were objective reasons why the respondent could have been expected to present that request in the first instance proceedings, i.e. that said request should have been already filed during the opposition proceedings. For that reason, the Board decided that it was not justified that the second auxiliary request be not admitted pursuant to Article 12(6) RPBA 2020.
- 6.6 In addition, the amendment made is not complex and is directed to a further limitation of the feature which

was critical during both the opposition and the appeal proceedings. Also, the amendment made is based on a feature found in claim 5 as granted and is a further limitation of a feature defined in a broader manner in claim 1 of each of the main request and first auxiliary request. Therefore, the Board is satisfied that the amendment made should not have taken the appellant by surprise. With that amendment, the respondent further addressed at the first opportunity in appeal (see point 6.5 above) the objection of lack of inventive step which did not succeed in front of the opposition division but was pursued by the appellant in their statement of grounds of appeal, whereby the respondent followed in appeal the same line of argumentation as during the opposition proceedings in support of the inventive step of the higher ranked requests (namely that the specific range of reactive silyl groups of organic polymer (B) defined in operative claim 1 was not obvious). Under these circumstances, the Board cannot identify a deliberate abuse of the procedure on the side of the respondent which would be detrimental to the procedural economy. Rather, the Board considers that the filing of the second auxiliary request at the outset of the appeal proceedings is the result of normal developments in the opposition appeal proceedings.

6.7 The appellant argued that the second auxiliary request should be not admitted because it was not convergent with the operative third and fourth auxiliary requests.

However, as explained in section 6.6 above, the Board is satisfied that the second auxiliary request is convergent with the higher-ranked requests. Therefore, considering the specific circumstances of the present case (and the conclusion reached in section 6.6 that

the filing of the second auxiliary request resulted from normal developments of the case), the argument did not convince.

6.8 In view of the above, the Board found it appropriate to make use of its discretion to decide to admit the second auxiliary request into the proceedings pursuant to Article 12(4) RPBA 2020.

7. Remittal

7.1 During the oral proceedings before the Board, the appellant requested that, should the second auxiliary request be admitted into the proceedings, the case be remitted to the opposition division for further prosecution, which was not objected to by the respondent (see minutes of the oral proceedings: page 4, penultimate paragraph).

7.2 In that respect, the Board considers that in view of the amendment made in claim 1 of the second auxiliary request (amount of reactive silyl groups of polymer (B) limited to "substantially one"), the question may arise if the disclosure of paragraph 18 of D4 (amount of silyl groups of polymer (B): "... 1.2 or more are preferable, two or more are more preferable, 2-8 are still more preferable, and 2-especially 6 are preferable"), which was central for the decision reached regarding inventive step for the main request and the first auxiliary request, is still relevant when assessing inventive step for the second auxiliary request over D4 as the closest prior art. On that specific issue, very limited exchange took place between both parties during the appeal proceedings, so that a fresh case has to be decided upon. Considering that these circumstances amount to special reasons in

the sense of Article 11 RPBA 2020 and in view of the primary object of the appeal proceedings to review the decision under appeal in a judicial manner (as indicated in Article 12(2) RPBA 2020), the Board finds it appropriate to remit the case to the department of first instance for further prosecution (Article 111(1) EPC).

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 prosecution.

The Registrar:

The Chairman:



D. Hampe

D. Semino

Decision electronically authenticated