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**Datasheet for the decision  
of 23 February 2022**

**Case Number:** T 0509/21 - 3.3.03

**Application Number:** 10770298.7

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**Language of the proceedings:** EN

**Title of invention:**  
CURE ACCELERATORS FOR ANAEROBIC CURABLE COMPOSITIONS

**Applicant:**  
Henkel IP & Holding GmbH

**Relevant legal provisions:**  
EPC Art. 54  
RPBA 2020 Art. 12(4)

**Keyword:**  
Novelty - (no)  
Auxiliary request filed with the statement of grounds of  
appeal - admitted (no)



**Beschwerdekammern**  
**Boards of Appeal**  
**Chambres de recours**

Boards of Appeal of the  
European Patent Office  
Richard-Reitzner-Allee 8  
85540 Haar  
GERMANY  
Tel. +49 (0)89 2399-0  
Fax +49 (0)89 2399-4465

Case Number: T 0509/21 - 3.3.03

**D E C I S I O N**  
**of Technical Board of Appeal 3.3.03**  
**of 23 February 2022**

**Appellant:** Henkel IP & Holding GmbH  
(Applicant) Henkelstrasse 67  
40589 Düsseldorf (DE)

**Representative:** Henkel IP Department  
c/o Henkel AG & Co. KGaA  
Henkelstraße 67  
40589 Düsseldorf (DE)

**Decision under appeal:** **Decision of the Examining Division of the  
European Patent Office posted on 10 December  
2020 refusing European patent application No.  
10770298.7 pursuant to Article 97(2) EPC.**

**Composition of the Board:**

**Chairman** F. Rousseau  
**Members:** O. Dury  
W. Ungler

## Summary of Facts and Submissions

I. The appeal by the applicant (appellant) lies against the decision of the examining division posted on 10 December 2020 refusing European patent application No. 10 770 298.7.

II. That decision was based on a sole claim request filed on 9 October 2020. Claim 1 of said request read as follows:

"1. An anaerobic curable composition comprising

(i) a (meth) acrylate component;

(ii) an anaerobic cure system; and,

(iii) a compound prepared from reactants comprising:

a) tetrahydroquinoline (THQ), and

b) either

i) glycidol,

wherein the reaction product of (a) and (b) (i) comprises at least two pendant functional groups of -OH; or,

ii) an alkylating agent, wherein when employed said alkylating agent is selected from the group consisting of alkyl halides, and

iv) at least one accelerator, wherein the accelerator is selected from the group consisting of triazines, ethanolamine, diethanolamine, triethanolamine, N,N-dimethyl aniline, benzene sulphonimide, cyclohexyl amine, triethyl amine, butyl amine, saccharin, N, [sic] N-diethyl-p-toluidine, N,N-dimethyl-o-toluidine, acetyl phenylhydrazine, maleic acid, and mixtures thereof."

III. In the decision under appeal, the examining division held that the then sole operative request met the requirements of Article 123(2) EPC (section 12 of the reasons) and that its subject-matter was novel over various documents (section 14 of the reasons), including **D8** (CN 101328395 A). Regarding the latter, it was in particular indicated that:

- D8 described "THQ as an accelerator in anaerobic curable compositions, differing from the present compositions at least through the TQH [sic] component: the nitrogen atom of the THQ ring is unsubstituted vs. substituted", reference being made to embodiments 1-6;
- D8 also disclosed "a formula (1) on page 7 which overlaps with the present derivatives of THQ which are substituted at 1-position".

However, the application was refused because the subject-matter of claim 1 of the sole operative request was held to lack inventive step starting from D8 as the closest prior art document (section 15 of the reasons).

IV. In its statement of grounds of appeal the appellant requested that the decision under appeal be set aside and that a patent be granted on the basis of the claims

of either the main request or the first auxiliary request both filed therewith.

Claim 1 of the main request was identical to claim 1 of the operative request dealt with in the decision under appeal.

Claim 1 of the first auxiliary request differed from claim 1 of the main request in that feature b)ii) was amended as follows (additions in **bold**, deletions in ~~strikethrough~~):

"ii) an alkylating agent, wherein when employed said alkylating agent is ~~selected from the group consisting of alkyl halides~~ **1-bromobutane**,"

v. In a communication sent in preparation of the oral proceedings, the Board identified relevant issues to be addressed, whereby the following points were in particular identified:

- The main request filed with the statement of grounds of appeal was identical to the request filed on 9 October 2020 on which the decision under appeal was based (section 2.2 of the communication);
- Claim 1 of the main request neither appeared to meet the requirements of support in the description defined in Article 84 EPC, nor the ones of Article 123(2) EPC (sections 4.1.1 and 5.1 of the communication);
- Considering that document D8 appeared to be highly relevant for the proceedings, a translation of the complete document (**D8a**) made by the language

services of the EPO was provided in annex to the communication. In view of this, the subject-matter of - among others - claim 1 could be arrived at by the combination of claim 1 of D8a with 1-methyl-1,2,3,4-tetrahydroquinoline as described on the top of page 6 of D8a, i.e. after performing a single selection within the list of alternative components (g) described in claim 1 of D8a. For that reason, the subject-matter of claim 1 was not novel over D8/D8a (section 6 of the communication);

- Although a full analysis of inventive step was premature in view of the other issues outlined in the communication, some concerns in that respect were identified (sections 7 and 4.1.2 of the communication);
- In view of the circumstances of the case, the Board contemplated not to admit the first auxiliary request into the proceedings (section 8 of the communication);
- In view of the above, the appeal was likely to be dismissed (section 9.1 of the communication).

VI. With letter of 26 January 2022, the appellant withdrew its request for oral proceedings.

VII. The appellant's arguments, as far as relevant for the present decision, may be summarized as follows:

**Main request - Novelty over D8**

- (a) As acknowledged by the opposition division, the subject-matter of claim 1 differed from D8 in that different tetrahydroquinoline derivatives were

used. Therefore, claim 1 of the main request was novel over D8.

#### **First auxiliary request - Admittance**

(b) No arguments in support of the admittance of the first auxiliary request were put forward (in particular neither in the statement of grounds of appeal, nor in the appellant's submission of 26 January 2022).

VIII. The appellant requested that the decision under appeal be set aside and that a patent be granted on the basis of the claims of either the main request or the first auxiliary request, both filed with the statement of grounds of appeal.

### **Reasons for the Decision**

#### **Main request - Article 54 EPC**

1. Novelty over D8
  - 1.1 Considering that document D8, in Chinese language, appeared to be highly relevant for the current proceedings, an English translation of the complete document (**D8a**) made by the language services of the EPO was provided to the appellant in annex to the Board's communication. The appellant neither contested the content of that translation, nor the Board's preliminary view that D8a confirmed the analysis provided in the sixth paragraph on page 3 of the statement of grounds of appeal (section 6.1 of the communication). Therefore, the passages of D8 indicated

in the following refer to the corresponding passages of D8a.

1.2 It is undisputed that claim 1 of D8 is directed to an anaerobic adhesive composition, comprising among others the following components:

- 70-98 wt.% of a monomer and/or an oligomer containing vinyl (a), whereby all more specifically defined components (a) disclosed in D8 (claims 2, 3; bottom of page 4 to top of page 5) are (meth)acrylate components according to feature (i) of operative claim 1;
- a cure system (c) according to feature (ii) of operative claim 1;
- saccharin (e), which is an accelerator according to feature (iv) of operative claim 1;
- 1,2,3,4-tetrahydroquinoline or a derivative thereof (g).

1.3 Among the various embodiments of component (g) indicated at the top of page 6 of D8 (second and third line after the formula), compound 1-methyl- 1,2,3,4-tetrahydroquinoline (which corresponds to N-methyl-tetrahydroquinoline) is explicitly disclosed, as also noted by the appellant (statement of grounds of appeal: page 3, sixth paragraph, lines 4-5). However, contrary to what is argued by the appellant in the seventh paragraph on page 3 of the statement of grounds of appeal, this compound is a component (iii) according to operative claim 1, as confirmed by the present application (paragraph 86 and paragraph 97, sample 4). Therefore, the subject-matter of operative claim 1 is



disclosed by the mere mention of 1-methyl-1,2,3,4-tetrahydroquinoline at the top of page 6 of D8 which passage has to be read in the light of the general definition of the invention of D8 given in claim 1 of that document, i.e. the subject-matter of operative claim 1 is disclosed by claim 1 of D8 after performing a single selection within the list of alternative components (g) disclosed in D8.

- 1.4 Although said conclusion was already reached in the Board's communication, no argument was put forward by the appellant to refute it. Therefore, there is no reason for the Board to deviate from its preliminary consideration.
- 1.5 In view of the above, the subject-matter of operative claim 1 is not novel within the meaning of Article 54(2) EPC over D8 and the main request is not allowable.

**First auxiliary request**

2. Admittance
  - 2.1 According to Article 12(2) RPBA 2020, a party's appeal case shall be directed to the requests on which the decision under appeal is based.
  - 2.2 Considering that in the present case the decision under appeal was based on a single operative request, the question of the admittance of the first auxiliary request, which was filed for the first time with the statement of grounds of appeal, was raised by the Board in its communication.

- 2.3 As already indicated in said communication (section 8, second paragraph), the Board considers that by actively withdrawing its request for oral proceedings during the examination proceedings (letter of 9 October 2020: section I) the appellant decided to defend at that stage only the then pending request and had effectively prevented the examining division from taking a decision on any additional auxiliary request(s), in particular on the present first auxiliary request.
- 2.4 In addition, the appellant has neither provided any argument justifying the filing of the first auxiliary request for the first time with the statement of grounds of appeal, nor explained why the amendments made would overcome the objection of lack of inventive step retained by the examining division, both of which is contrary to the stipulations of Article 12(4) RPBA 2020. In particular, no arguments were put forward in reaction to the Board's communication in which the admittance of the first auxiliary request was explicitly questioned.
- 2.5 Under these circumstances, the Board finds it appropriate to make use of its discretion pursuant to Article 12(4) RPBA 2020 by deciding not to admit into the proceedings the first auxiliary request filed with the statement of grounds of appeal.
3. Since the main request is not allowable and the first auxiliary request is not admitted into the proceedings, the appeal is to be dismissed.

**Order**

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

The appeal is dismissed.

The Registrar:

The Chairman:



B. ter Heijden

F. Rousseau

Decision electronically authenticated