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**Datasheet for the decision
of 5 October 2022**

Case Number: T 0825/21 - 3.3.05

Application Number: 12382072.2

Publication Number: 2634147

IPC: C01G19/08, C03C17/00,
C03C17/245

Language of the proceedings: EN

Title of invention:

Stabilized non smoking tin tetrachloride

Patent Proprietor:

Segura Ruiz, Pedro
Segura Ruiz, Jorge
Moya Zayas, Juan

Opponent:

ARKEMA France

Headword:

Tin tetrachloride/Segura Ruiz

Relevant legal provisions:

RPBA 2020 Art. 13(2)

Keyword:

Amendment after summons - taken into account (no)

Decisions cited:

Catchword:



Beschwerdekammern

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Case Number: T 0825/21 - 3.3.05

D E C I S I O N
of Technical Board of Appeal 3.3.05
of 5 October 2022

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Appellant: Segura Ruiz, Jorge
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Decision under appeal: **Decision of the Opposition Division of the
European Patent Office posted on 14 April 2021
revoking European patent No. 2634147 pursuant to
Article 101(3) (b) EPC.**

Composition of the Board:

Chairman	P. Guntz
Members:	G. Glod
	S. Besselmann

Summary of Facts and Submissions

- I. The joint patent proprietors' (appellant's) appeal concerns the opposition division's decision revoking European patent No. 2 634 147 B1.
- II. With the statement of grounds of appeal, the appellant filed a main request and ten auxiliary requests.
- III. In the communication pursuant to Article 15(1) RPBA, the board was of the preliminary opinion that the requests filed with the statement of grounds of appeal should not be admitted under Article 12(4) and (6) RPBA 2020.
- IV. In its reply, the appellant filed on 2 September 2022 a new main request and an auxiliary request replacing all requests on file.

Claim 1 of the main request reads as follows:

"1. A composition based on anhydrous tin tetrachloride in watery solution, obtained from a mixture consisting of:

- At least 5 % in weight of tin tetrachloride, provided in anhydrous tin tetrachloride form; and*
- A HCl aqueous solution with a concentration between 3-15 % in weight of hydrochloric acid,*

by a procedure which includes the following steps:

- a) Mixing in agitation distilled water with HCl up to obtaining a solution with a final concentration between 3-15 % of HCl; and*
- b) Adding at least 5% in weight of anhydrous tin tetrachloride to the mixture obtained in the step a)."*

Claim 1 of the auxiliary request reads as follows:

"1. A composition based on anhydrous tin tetrachloride in watery solution, obtained by a procedure which includes the following steps:

a) Mixing in agitation distilled water with HCl up to obtaining a solution with a final concentration between 3-15 % of HCl; and

b) Adding at least 5 % in weight of anhydrous tin tetrachloride to the mixture obtained in the step a)."

V. Oral proceedings took place on 5 October 2022.

VI. The appellant's arguments relevant to the present decision can be summarised as follows.

The requests should be admitted into the proceedings for three reasons. Firstly, the general timeline of the appeal proceedings, in particular the bringing forward of the oral proceedings, made it difficult to prepare the case. Secondly, point 11 of the impugned decision was to be contested strongly, and the opposition division had given the wrong weight to the experiments submitted by the opponent. Thirdly, point 6.3 of the communication pursuant to Article 15(1) RPBA contained new information. Therefore, the appellant should be permitted to react.

VII. The respondent's (opponent's) arguments are reflected in the reasoning below.

VIII. The appellant requests that the impugned decision be set aside and that the patent be maintained in amended form on the basis of the main request or, alternatively, on the basis of the auxiliary request, all requests filed on 2 September 2022.

The respondent requests that the appeal be dismissed.

Reasons for the Decision

Main request

1. Article 13(2) RPBA 2020
 - 1.1 Under Article 13(2), any amendment to a party's appeal case made after notification of a summons to oral proceedings shall, in principle, not be taken into account unless there are exceptional circumstances, which have been justified with cogent reasons by the party concerned.
 - 1.2 In the current case, the main request was submitted on 2 September 2022, clearly after notification of the summons to oral proceedings issued on 11 April 2022 and also after the notification bringing forward the oral proceedings issued on 4 August 2022. Therefore, it needs to be evaluated whether there were exceptional reasons that could justify taking into account the request.
 - 1.3 The overall procedure may have been unusual because of the oral proceedings being brought forward, but this does not provide the appellant an opportunity to submit yet another request in reaction to objections that have been known for a long time. The events to which the appellant referred were changes to the date and the format of the oral proceedings after the initial summons, i.e. after the cut-off point under Article 13(2) RPBA 2020. Any amendments that should have been filed prior to the summons or even earlier cannot be

justified by merely organisational changes occurring after this cut-off point.

1.4 If the appellant was of the opinion that the opposition division's decision was erroneous, in particular in point 11, there was no reason to submit amended claims in reaction to the decision. Rather, it would have been logical to contest the opposition division's finding and rely on the requests underlying the impugned decision. It is certainly not a reason for submitting yet another request only after having been summoned to oral proceedings.

1.5 The communication pursuant to Article 15(1) RPBA 2020 did not bring up any new issues but only relied on the respondent's submissions and the decision under appeal. The board pointed out in point 6.3 that the omission of the features "stable" and "non-smoking" was apparently not in line with the requirements of Article 123(2), and thus it accepted the respondent's position laid out in point II.3 of the reply to the appeal. The board thus explained why the other features of the claim cannot be considered to inherently lead to a stable and non-smoking composition, this being completely in line with the respondent's observation in point II.3 of the reply to the appeal. Furthermore, the clarity problem addressed for the auxiliary request in point 6.3 of the communication was already part of the impugned decision (point 10) and repeated by the respondent in the reply to the appeal (point III.1.1.). Therefore, the board cannot concede that it brought up any new issues which triggered the need for the submission of new requests. To the contrary and as acknowledged by the appellant, the only information in the board's communication that could possibly be considered new was the fact that the board preliminarily shared the respondent's concerns.

This, however, is a normal development typical of proceedings before a board and cannot be seen as exceptional circumstances justifying the submission of new requests.

- 1.6 When exercising its discretion under Article 13(2) RPBA 2020, the board may also rely on criteria applicable under Article 13(1) RPBA 2020 (Case Law of the Boards of Appeal of the EPO, 10th edition, 2022, V.A.4.5.9). When considering the criterion of suitability of the amendment to resolve the issues raised, it is evident that the claim still does not include the features "stable" and "non-smoking". However, as indicated by the respondent in the reply to the appeal (point II.3) and relied on by the board in its communication pursuant to Article 15(1) RPBA 2020 (point 6.3), the omission of these features is contrary to the requirements of Article 123(2) EPC. These features imply certain properties which are key for solving the problems the patent intends to solve (see paragraph [0044]). These features cannot be considered the inevitable result of the other features of the claim since they depend on specific conditions such as time, temperature, pressure and pH. This is also confirmed by the information provided in the patent (paragraph [0043]), indicating that temperature control was very important. However, the product by process definition in claim 1 is not limited to steps a) and b) (the procedure *includes* these steps) and in any case does not include details about temperature, time and pressure. Consequently, the board is not convinced that the amendments made are suitable for overcoming the objection under Article 123(2) EPC.

The mere fact that the total number of requests on file has been substantially reduced does not compensate for this.

- 1.7 To summarise, there are no exceptional reasons justifying the submission of the request after the summons to oral proceedings, and the amendments made are not suitable for overcoming objections raised during opposition proceedings.

Therefore, the main request is not taken into consideration.

Auxiliary request

2. The difference with claim 1 of the main request does not have an impact on the reasoning provided for the main request. The features "stable" and "non-smoking" are still missing and not compensated for by the other features of the claim.

Therefore, the same conclusion as for the main request applies, and the auxiliary request is not taken into consideration either.

Order

For these reasons it is decided that:

The appeal is dismissed.

The Registrar:

The Chairman:



A. Pinna

P. Guntz

Decision electronically authenticated