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**Datasheet for the decision
of 26 January 2024**

Case Number: T 1198/21 - 3.3.06

Application Number: 17805204.9

Publication Number: 3387186

IPC: D21C5/00, D21C9/00, D21H11/18,
D21H17/67, D21H17/00

Language of the proceedings: EN

Title of invention:

BINDER COMPOSITION BASED ON PLANT FIBERS AND MINERAL FILLERS,
PREPARATION AND USE THEREOF

Patent Proprietors:

1. Centre Technique de l'Industrie des Papiers, Cartons et Celluloses
2. Kadant Lamort

Opponent:

FiberLean Technologies Limited

Headword:

BINDER COMPOSITION/CTIPC + Kadant Lamort

Relevant legal provisions:

RPBA 2020 Art. 12(4)
EPC Art. 54

Keyword:

Amendment to case - no reasons for filing new experimental evidence in appeal proceedings - reasons for submitting new claims (auxiliary requests 2 to 4) in appeal proceedings
Novelty (main request and auxiliary requests 1 to 2) - (no)
(auxiliary request 3) - (yes)

Decisions cited:

Catchword:



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Case Number: T 1198/21 - 3.3.06

D E C I S I O N
of Technical Board of Appeal 3.3.06
of 26 January 2024

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Decision under appeal: **Decision of the Opposition Division of the
European Patent Office posted on 7 June 2021
revoking European patent No. 3387186 pursuant to
Article 101(3) (b) EPC.**

Composition of the Board:

Chairman J.-M. Schwaller
Members: P. Ammendola
 O. Loizou

Summary of Facts and Submissions

I. The patent proprietors appealed the decision of the opposition division to revoke European patent No. 3 387 186 granted with the same claims 1 to 14 as the corresponding patent application. Independent claims 1 and 8 as granted read:

*"1. A binder composition containing water, plant fibers and mineral fillers,
- the plant fibers and the mineral fillers having a weight ratio between 99/1 and 2/98,
- the plant fibers and the mineral fillers having been refined simultaneously,
wherein the refined fibers have a mean size of between 10 and 700 µm, and wherein the refined fibers, at least partially, embed the refined mineral fillers."*

*"8. A method for preparing the composition according to one of claims 1 to 6, comprising the following steps:
- preparing a suspension of plant fibers and mineral fillers in water, the weight ratio between the plant fibers and the mineral fillers being comprised between 99/1 and 2/98, advantageously between 95/5 and 15/85,
- refining this suspension."*

II. In the notice of opposition the opponent (hereinafter **respondent**) raised objections of insufficient disclosure and of lack of novelty and inventive step over Sample 2 of Example 13/2 (hereinafter **Example 13/2**) of **D1** (WO 2010/131016 A2). Further, it referred *inter alia* to **D2** (experimental annex to the notice of opposition), **D3** (US 2015/0167243 A1), **D4** (US 2005/0194477 A1) and **D6** (WO 2012/054968 A1).

III. During the opposition proceedings, the appellants submitted with letter of 26 June 2020 two sets of amended claims as auxiliary requests 1 and 2, and a further set of amended claims as auxiliary request 3 was filed during the oral proceedings.

The opponent submitted with letter of 18 January 2021 (i.e. two months before the oral proceedings that concluded the opposition) the annex D8 with a rework of Example 13/2 of D1 and data on the fiber mean diameter, fiber mean length and fiber length distribution of this Example. With letter of 17 March 2021 it then filed **D10** containing a comparison in graphic form of the fiber length distributions of an invention example and a comparative example reported in the opposed patent and of that measured in D8 for said reworked Example 13/2.

IV. In auxiliary request 1, amended claim 1 read (amendments vis-à-vis granted claim 1 made visible):

*"1. A binder composition containing water, plant fibers and mineral fillers,
- the plant fibers and the mineral fillers having a weight ratio between 99/1 and 2/98,
- the plant fibers and the mineral fillers having been refined simultaneously,
wherein the refined fibers have a mean size of between 10 and 700 μm and a diameter of between 10 and 60 μm ,
~~and~~ wherein the refined fibers, at least partially, embed the refined mineral fillers, and wherein the
percentage of fibers having a mean size of 335 μm or more is 10 % or less of the overall amount of fibers
within the binder composition."*

In auxiliary request 2, claim 1 was as in auxiliary request 1, while claim 8 differed from that as granted

in the appended portion (added wording made apparent):
"- refining this suspension between refiner discs, and in the absence of grinding medium, wherein the method has an overall energy input of between 200 and 2000 kW.h per ton of plant fibers and mineral fillers."

In auxiliary request 3, claim 8 only differed from that as granted in that it further specified the overall energy input (differences made apparent):

*"8. A method for preparing the composition according to one of claims 1 to 6, comprising the following steps:
- preparing a suspension of plant fibers and mineral fillers in water, the weight ratio between the plant fibers and the mineral fillers being comprised between 99/1 and 2/98, advantageously between 95/5 and 15/85,
- refining this suspension with an overall energy input of between 200 and 2000 kW.h per ton of plant fibers and mineral fillers."*

V. In the appealed decision the opposition division found that the patented invention was sufficiently disclosed, but the prior art disclosed in Example 13/2 of D1 anticipated the binder composition of claim 1 as granted; auxiliary requests 1 to 3 complied with Articles 123(2) EPC, but Example 13/2 of D1 anticipated the subject-matter of claim 1 of auxiliary requests 1 and 2, whereas other examples of D1 anticipated the subject-matter of claim 1 of auxiliary request 3.

VI. With the statement of grounds the appellants disputed the above findings, reported on pages 9 and 10 of the statement of grounds "Additional experimental evidence 1" and "Additional experimental evidence 2" (referred to as **AE1** and **AE2**) and filed four sets of amended claims as **auxiliary requests 1 to 4** (referred to as **AR1**

to AR4), wherein AR1 is identical to auxiliary request 1 considered in the decision under appeal; while AR2 to AR4 only contain claims directed to a method for preparing a binder composition.

Claim 1 of AR2 reads:

"1. A method for preparing a binder composition containing water, plant fibers and mineral fillers, comprising the following steps:
- preparing a suspension of plant fibers and mineral fillers in water, the weight ratio between the plant fibers and the mineral fillers being comprised between 99/1 and 2/98, advantageously between 95/5 and 15/85,
- refining this suspension, with an overall energy input of between 200 and 2000 kW.h per ton of plant fibers and mineral fillers,
wherein the refined fibers have a mean size of between 10 and 700 μ m, and wherein the refined fibers, at least partially, embed the refined mineral fillers."

Claim 1 of AR3 reads (differences vis-à-vis claim 8 as granted and as originally filed made apparent):

"~~8~~1. A method for preparing ~~the~~a binder composition according to ~~one of claims 1 to 6~~ containing water, plant fibers and mineral fillers, comprising the following steps:
- preparing a suspension of plant fibers and mineral fillers in water, the weight ratio between the plant fibers and the mineral fillers being comprised between 99/1 and 2/98, advantageously between 95/5 and 15/85,
- refining this suspension between refiner discs, and in the absence of grinding medium, with an overall energy input of between 200 and 2000 kW.h per ton of plant fibers and mineral fillers,

wherein the refined fibers have a mean size of between 10 and 700 μm , and wherein the refined fibers, at least partially, embed the refined mineral fillers."

VII. With its reply the **respondent** rebutted the appellants' submissions, disputed the admittance in the appeal proceedings of AR2 to AR4, and argued that claim 1 of AR2 was not novel in view of Example 13/2 of D1. It also disputed the compliance of AR3 with Articles 123(2), 83 and 54 EPC and reiterated the objection of lack of inventive step against the granted claims and auxiliary request 1 already raised in opposition, and submitted further inventive step objections against each version of claim 1 of auxiliary requests 2 to 4.

VIII. With letter of 27 November 2023 the appellants filed two further sets of amended claims as **auxiliary requests 5 and 6**.

IX. At the oral proceeding held on 26 January 2024, the final requests of the parties were as follows:

The appellants requested that the decision under appeal be set and the patent be maintained as granted (**main request**) or, in the alternative, that the patent be maintained in amended form on the basis of one of auxiliary requests 1 to 4 filed with the grounds of appeal, or of auxiliary requests 5 or 6 filed with letter of 27 November 2023.

The respondent requested that the appeal be dismissed.

Reasons for the Decision

1. *Admittance of experimental evidence AE1 and AE2*

- 1.1 According to the appellants, AE1 and AE2 were filed with the statement of grounds of appeal in reaction to the late filing of experimental data D8 (only two months before the oral proceedings). AE1 and AE2 had furthermore been provided as soon as possible, bearing in mind that the respondent had provided D8 very late, there were restrictions due to Covid-19 pandemic, and the number of grinders available worldwide was very limited.

- 1.2 The board notes the considerations of the opposition division in the passage at the top of page 8 of the appealed decision, reading: "*The OD is aware that document D8 was filed just two months before the oral proceedings (time limit set by R. 116(1) EPC). For the OD, two months could have been sufficient for the proprietor to reproduce the experiments carried out in D8. The OD further observes that the proprietor has not reacted in writing after the filing of this submission to inform that he would not have enough time to repeat the experiments of D8 before the date of the oral proceedings*".

- 1.3 The appellants argued that the opposition division's consideration that "*two months could have been sufficient for the proprietor to reproduce the experiments carried out in D8*" was unjustified and unrealistic.

- 1.4 In the board's view, even if this argument were correct, still from the reminder of the passage of the decision cited above, as well as from the minutes of the oral proceedings, it is apparent that the appellants chose to react to the filing of D8 (with letter of 18 January 2021) for the first time at the hearing of 18 March 2021, by stating that it was not

possible for them to verify the results presented in D8 or even to repeat these experiments (see the second sentence on page 6 of the appealed decision), and then to react to the adverse decision of the opposition division during the hearing to admit D8 into the proceedings, by filing a new claim request (the then auxiliary request 3) which was admitted in the opposition proceedings.

Hence, the appellants never announced that they intended to carry out experiments in order to verify D8, nor informed promptly the opposition division of the difficulties that they had encountered in attempting of have such experiments done, let alone did they request postponement or adjournment of the oral proceedings in order to be able to submit them.

The board thus cannot identify any reason that could justify for the first time at the appeal stage the admission of not previously announced experiments aiming at confuting D8.

1.5 Finally, the respondent's objections in points 14, 54-60 and 75-77 of the reply to appeal, render apparent that the admittance of the belated AE1 and AE2 into the appeal proceedings would introduce new issues to be debated (as to the relevance of their contents), contrary to the need of procedural economy.

1.6 Hence, the board exercising the discretion foreseen in the second sentence of Article 12(4) RPBA, decided not to admit AE1 and AE2 in view of the prescriptions in the last sentence of Article 12(4) RPBA and second sentence of Article 12(6) RPBA.

2. *Admittance of auxiliary requests 2 to 4 (AR2 to AR4)*

2.1 The respondent disputed the admittance of these sets of amended claims stressing that, as they only comprise method claims, the debate on novelty would necessarily be completely different from the one that already took place in opposition (i.e. exclusively for product claims). Moreover, AR2 to AR4 would not comply with the requirement of convergence, as they lacked of the features recited in the method claim of the higher ranking request (claim 8 of AR1). Additionally, both versions of claim 1 in AR3 and AR4 were characterised by a combination of features that was not present in any of the method claims already on file and thus, was completely new and caused new issues to be debated, contrary to the principle of procedural economy.

2.2 The board notes however several reasons for the filing of AR2 to AR4 with the grounds of appeal, namely that:

- the notice of opposition indisputably contested sufficiency of disclosure, novelty and presence of an inventive step also of the granted method claims;
- all three auxiliary requests filed by the appellants during the opposition proceedings also contained method claims (in addition to product claims);
- the opposition division's preliminary opinion was favorable to the then pending auxiliary request 1 (identical to present AR1);
- at the oral proceedings the parties debated and the opposition division decided on the sufficiency of disclosure also of the claimed method and on the compliance of the (whole) then pending auxiliary requests 1 to 3 (and thus also of the method claims in these requests) with the requirements of Articles 84 and 123 EPC;

- the subject matter of claim 1 of AR2 is substantially the same as the method claim 8 of auxiliary request 3 in opposition, and
- the amendments that distinguish the method according to claim 1 of AR3 and that of AR4 from the patented method claim 8 have all been present in claims 8 or of auxiliary request 2 filed on 26 June 2020 (i.e. almost nine months before the oral proceedings that concluded the opposition) and thus, the appellants' intention to also rely on amendments of the method claims based on these features was already apparent during the opposition proceedings.

2.3 Hence, the board, exercising the discretion foreseen in the second sentence of Article 12(4) RPBA, has decided to admit auxiliary requests 2 to 4 filed with the statement of grounds of appeal (i.e. AR2 to AR4).

3. *Main request (patent as granted) - Novelty*

3.1 According to the appellants, the patent in suit clearly explained (paragraphs [0022] to [0031] and [0057] to [0062]) that the binder compositions would comprise "*refined fibers*" - i.e. cut fibers and fibrillated fibers (whereby these latter are described in [0026] as "*fibers having fibrils emerging from a main core of the fibers*") - because these compositions resulted from "*refining*" the plant fibers, i.e. resulted from a mechanical treatment (preferably carried out by using a disc "*refiner*") during which the fibers were essentially cut, even though a limited separation of fibrils may occur. Instead, "*grinding*" and "*fibrillating*" processes would respectively favour e.g. crushing of the fibers and/or the liberation of the fibrils from the fibers, thereby resulting in

inevitably different structures of the resulting binder compositions. The existence of these differences between binder compositions containing ground fibers and those of the invention containing "*refined fibers*" was reflected in the different filler retention of the papers treated therewith, as demonstrated by the "*Ash retention, wt%*" value reported in Table 2 of the patent in suit. Since the suspension of filler and microfibrillated cellulose (hereinafter **MFC/filler suspension**) obtained in Example 13/2 of D1 resulted from fibrillating plant fibers ("Pulp Sample A") in the presence of a mineral filler ("ground marble") in a grinding vessel, this prior art was necessarily different from the patented composition.

Figure 2 of D10 would furthermore confirm that "ground" fibers were different and distinguishable from "refined" fibers. In fact, the particle size distribution reported in this figure for the invention example GPO obtained with a refiner, was different from that of the comparative sample CE (prepared by grinding) used in the patent examples, as well as from that of the respondent's own re-work in D8 of the MFC/filler suspension of Example 13/2 of D1, prepared by using a grinding vessel.

In addition, that MFC only contained microfibrils and no "*refined fibers*" was confirmed by the electron photomicrographic images of Figures 1 and 2 of D2, showing that only matters with dimensions of the order of few μm were present in two MFC/filler suspensions obtained from grinding processes, similar to that of Example 13/2 of D1.

Finally, the weight-weighted mean fiber length $L_c(w)$ of 257 μm measured in D8 for the replica of Example 13/2

of D1 would not be compatible with the d_{50} of 32.9 μm reported for the same sample in Table 7 of D1. Thus, the data in D8 would represent no reliable evidence of the particle dimensions observable in the MFC/filler suspension obtained in Example 13/2 of D1.

Hence, the opposition division erred in considering the meaning of "*refined fibers*" in granted claim 1 so broad to encompass the constituents of the MFC/filler suspension produced by grinding in Example 13/2 of D1.

3.2 The board notes that the patent itself does not contain any definition of the terms "*refined fibers*" or "*refining*", and only provides generic and qualitative descriptions thereof, mostly based on vague terms. Nor is there any evidence on file of the consistent use (in the technical field of the mechanical treatment of plant fibers) of the expression "*refined fibers*" only to designate matter exclusively resulting from the treatment of plant fibers in a ("*refining*") method, clearly different from those designated as "*grinding*" or "*fibrillating*" (or beating, milling, comminuting, etc.).

3.2.1 Hence, the board sees no reason to consider erroneous the conclusion in the first paragraph on page 7 of the decision under appeal, reading: "*Refining and grinding treatments are similar process, which can even be performed in the same apparatus, e.g. a double disc refiner. In the field of pulp making, several terms are often used to describe the same or similar operations: beating, milling, grinding, refining. Therefore the process feature of granted claim 1 "refined fibers" cannot be considered as defining a clear limitation of the scope of the granted claim 1.*"

3.2.2 Moreover, a broad construction of the terms "refining" and "refined fibers" by the skilled reader of the opposed patent (i.e. as relating in general to processes in which the plant fibers have been mechanically treated, including those carried out e.g. in refiners, grinders, mills, beaters, etc. and to the resulting products, so as for instance, to also possibly describe ground or fibrillated products such as MFCs) appears consistent with:

- the patent's own description in paragraphs [0022], [0059], [0061] and [0100], acknowledging that "*fibrillation*" may occur during the "refining" of the plant fibers, and that the absence of fibrillation is only a preferred option;
- the description in paragraph [0064] of the patent, which suggests the possible additional presence of "*grinding*" medium during "refining";
- the initial description of Example 13 of D1, in which fibers are "refined" by using a "beater";
- paragraph [0050] of D3 reciting: "*...fibers are mechanically comminuted in any type of mill or device that grinds the fibers apart. Such mills are well known in the industry and include, without limitation, Valley beaters, single disk refiners, double disk refiners, conical refiners, including both wide angle and narrow angle, cylindrical refiners, homogenizers, micro fluidizers, and other similar milling or grinding apparatus...[t]he nature of the grinding apparatus is not critical, although the results produced by each may not all be identical....[t]he process of mechanical breakdown, regardless of instrument type, is sometimes referred to in the literature as as "refining"...*");
- the description from page 8, line 16 to page 9, line 15 of D6, of "refining" processes (by

"grinding" fibers in a "refiner" using different amounts of energy) that produce "fibers" with "a high degree of fibrillation";

- claims 1 and 4 of D1, that describe the possibility to use a "refiner" for producing MFC;
- the use also in D4 (see e.g. abstract) of "refiners" to produce MFC.

3.2.3 Hence, the generic use in the relevant technical field of the terms "*refined fibers*" and "*refining*" excludes the possibility for the skilled person to conclude that "*refining*" clearly designates a process different from "grinding" or "fibrillating", and (thus also) to attribute to "*refined fibers*" in granted claim 1 the restricted vague meaning described in the patent in suit (namely the combination of "*cut fibers*" and "*fibrillated fibers*" allegedly only resulting from "*refining*", and not from grinding or fibrillating).

3.2.4 Finally, the board notes that Table 7 of D1 explicitly confirms that the term "fibers" can also be used to describe the components of the MFC/filler suspension produced by grinding in Example 13/2, and that the "d₅₀" value of "32.9 μm" of these "fibers" is not incompatible with the further requirement in granted claim 1 of the fibers' "*mean size between 10 and 700 μm*". In addition, since (as acknowledged by the appellants) the term "*mean size*" in the patent in suit refers to the fiber largest dimension, the requirement in granted claim 1 of a mean size that can be as low as about "10 μm" also allows all the "*refined fibers*" in the patented composition to have the largest size e.g. around or even well below 32.9 μm, and so to be comparable in size or even substantially smaller than the constituents of the MFC/filler suspension of Example 13/2 of D1, i.e. even smaller than the matter

that this document denotes as "fibers". This fact further confirms that also the term "*fiber*" in the patent in suit may denote the constituents of the relevant prior art.

- 3.2.5 Moreover, D8 shows that a replica of the MFC/filler suspension of Example 13/2 of D1, has e.g. a number-weighted mean fibre length of 87 μm , a length-weighted mean fibre length of 110 μm and a weight-weighted mean fiber length $L_c(w)$ of 257 μm . Hence, this prior art appears to necessarily comply with any possibly reasonable meaning of the feature in granted claim 1 of a fiber "*mean size between 10 and 700 μm* " (feature that is also intrinsically vague since it lacks of any reference to the kind of "mean" and its measurement).
- 3.2.6 The fact, as stressed by the appellants, that one (out of three) "mean" fiber length value measured in D8 (namely, the weight-weighted mean fiber length $L_c(w)$ of 257 μm) appears incompatible with the " d_{50} " value of "32.9 μm " reported in Table 7 of D1 for the same sample, is however insufficient to justify the appellant's allegation that D8 would not describe a replica of Example 13/2 of D1. Indeed, a single discrepancy between numerical values reported in D8 and D1 is insufficient at casting severe doubts on the further abundant and detailed information offered in D8 as to the materials, apparatuses and processing conditions used, all consistent with a perfect re-working of Example 13/2 of D1.
- 3.2.7 The board finally finds that the limited portions of two compositions (prepared by grinding fibers in the presence of mineral fillers) visible from Figures 1 and 2 of D2, do not justify any sound conclusion as to the

alleged absence therein of substantial amounts of any matters with a "*mean size between 10 and 700 μm* ".

3.3 The board comes therefore to the conclusion that for the skilled reader of granted claim 1 the term "*refined fibers*" has a broad and vague meaning, and thus that the opposition division was correct in finding that the patented subject-matter encompasses the MFC/filler suspension obtained in Example 13/2 of D1 by co-grinding Pulp Sample A and a mineral filler and having the fiber dimensions reported in Table 7 of D1 and in D8.

3.4 Hence, the appellants' submissions do not succeed in proving erroneous the opposition division's conclusion that the subject-matter of granted claim 1 is objectionable under the grounds of Articles 100(a) and 54 EPC. Therefore, the main request must be refused.

4. *Auxiliary request 1 (AR1) - Novelty*

4.1 This claim differs from granted claim 1 in that the former additionally specifies the two features that:

- the "*refined fibers*" must have "*a diameter of between 10 and 60 μm* " and
- the binder composition must comprise "*10% or less*" of "*fibers having a mean size of 335 μm or more*".

4.2 The opposition division found that the additional data submitted by the respondent with D8 (i.e. the mean diameter of the refined fibers of 22.03 μm and the 5.8% of the fibers having a length of 200 μm or more) would demonstrate that these two features were also present in Example 13/2 of D1 that had been found to anticipate the subject-matter of granted claim 1.

4.3 The appellants contested this finding because D8 would represent no reliable evidence of the particle dimensions observable in Example 13/2 of D1, due to the contradiction with the fiber d_{50} value for the same sample in Table 7 of D1, already stressed in the discussion of the granted claim 1 above. Furthermore, the electron photomicrographic images of Figures 1 and 2 of D2, showed that only matters with dimensions of the order of few μm were present in two MFC/filler suspensions obtained from grinding processes similar to that of Example 13/2 of D1, thereby rendering plausible that also in this prior art there would be no "fibers" with the required diameter.

4.4 For the board, none of these arguments is found convincing for essentially the same reasons given above.

4.5 Hence, the appellants' submissions also do not succeed in proving erroneous the opposition division's conclusion that the subject-matter of claim 1 of AR1 does not comply with Article 54 EPC. Therefore, also the auxiliary request 1 (AR1) must be refused.

5. *Auxiliary request 2 (AR2) - Novelty*

5.1 This claim defines a method for preparing a binder composition by preparing a suspension of plant fibers and mineral fillers in water and refining this suspension "*with an overall energy input of between 200 and 2000 kW.h per ton of plant fibers and mineral fillers*", wherein the refined fibers have a mean size of between 10 and 700 μm and at least partially embed the refined mineral fillers.

5.2 The appellants contended that claim 1 was novel over D1, Example 13/2 because "*refining*" was different from "*grinding*", and because the energy amount of 237 kWh/t "*per ton of plant fibers and mineral fillers*" used in this example as calculated by the respondent would be the energy of grinding (and not of refining).

5.3 As already indicated above, the board finds instead that the skilled reader would consider the term "*refining*" so broad to encompass grinding method steps and, in particular to also encompass the co-grinding described in Example 13/2 of D1. Hence, the appellants' submissions are found unconvincing.

5.4 Therefore, the board concludes that the subject-matter of claim 1 of AR2 encompasses the prior art method used for the preparation of the MFC/filler suspension described in Example 13/2 of D1 (by co-grinding Pulp Sample A and a mineral filler with the energy amount described in Table 7) having the fiber dimensions reported in Table 7 of D1 and in D8. Thus, this claim does not comply with Article 54 EPC and also auxiliary request 2 must be refused.

6. *Auxiliary request 3 (AR3)*

6.1 Claim 1 of this request defines a method for preparing a binder composition by preparing a suspension of plant fibers and mineral fillers that differs from that of AR2 only in that it further specifies that the refining of suspension must occur "*between refiner discs, and in the absence of grinding medium*". The remaining claims 2 to 7 of AR2 define preferred embodiments of the method of claim 1.

- 6.2 Alleged added subject-matter (Article 123(2) and (3) EPC)
- 6.2.1 The appellants submitted that claim 1 of AR3 resulted from restrictive amendments of claim 8 as granted, identical to claim 8 as originally filed, based on the original description on page 16, lines 1 to 7, and page 10, lines 32 to 34.
- 6.2.2 The respondent pointed to the fact that original and granted claim 8 referred to *"the composition according to claims 1 to 6"*, and thus implicitly also require that the *"weight ratio between 99/1 and 2/98"* must occur between the final amounts of fibers and fillers in the final composition, as recited in original claim 1, also identically granted. Instead, claim 1 under consideration would only require the occurrence of such weight ratio between the starting amounts of fibers and fillers used for preparing the suspension. Hence, claim 1 of AR3 would contravene Article 123(2) and (3) EPC.
- 6.2.3 In the board's view, as convincingly submitted by the appellants, any realistically conceivable plant fiber processing step that a person skilled in the field of plant fiber mechanical treatments may designate as *"refining"*, is a step in which no fibers or fillers are removed. Hence, the allegedly missing feature is necessarily implied in claim 1 at issue, because this claim imposes to refine *"this"* suspension, i.e. imposes to refine a suspension in which fibers and fillers must be present at a *"weight ratio between 99/1 and 2/98"* and therefore ensures that the same weight ratio initially present in the suspension that is subject to *"refining"* must inevitably also be present in the refined composition.

6.2.4 Thus, the board finds that the claim 1 of AR3 complies with the requirements of Article 123(2) and (3) EPC, and is also satisfied that same applies to the remaining claims of this auxiliary request.

6.3 Sufficient disclosure (Article 83 EPC)

6.3.1 The sole objection of insufficient disclosure was directed to the feature of claim 1 requiring in the composition resulting from the claimed method that the refined fibers "*at least partially, embed the refined mineral fillers*". In the respondent's opinion, the patent did not explain how the skilled person can determine whether the filler is embedded in the fibers or not, and that the patent contained no example as to how to achieve this feature. Hence, the patent failed to disclose how to carry out the subject-matter of claim 1 of AR3.

6.3.2 The board notes however that, as convincingly argued by the opposition division (last paragraph on page 2 of the appealed decision), it is apparent from the last sentence in paragraph [0091], reading: "*[t]he simultaneous refining of the fibers and fillers also serves to coat, or embed, the fillers at least partially by the fibers over the course of the process for producing the binder composition*", that some embedding of the filler in the fibers derives inherently from the simultaneous processing of the fibers and filler. Thus, in the absence of evidence to the contrary, the board has no reason to arrive at a different conclusion, and board finds that the subject-matter claimed in AR3 complies with the requirements of Article 83 EPC.

6.4 Novelty (Article 54 EPC)

- 6.4.1 The respondent pointed to claim 4 of D1 which described that the processes of this prior art can be performed in a refiner. In addition it was described in D1 (page 10, line 19) that the grinding can be performed without a grinding medium. Hence, a refiner would typically have refiner discs and be used without grinding medium. Therefore claim 1 of AR3 lacked novelty over D1.
- 6.4.2 The board finds this argument manifestly unconvincing because it is based on the allegation that "*a refiner would typically have refiner discs*". This allegation implies the acknowledgement that refiners may also not have "*refiner discs*", and thus, it cannot be equated to the direct and unambiguous disclosure of the use of "*refiner discs*" in the method of D1.
- 6.5 Thus, the board finds that the subject-matter of claim 1 of AR3 (and by the same token that of claims 2 to 7, which depend thereon) complies with the requirements of Article 54 EPC.
7. As none of the inventive step objections was debated at the oral proceedings in opposition, and since both parties requested the remittal of the case to the opposition division for the assessment of inventive step, the board finds it appropriate to remit the case pursuant to 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:



A. Pinna

J.-M. Schwaller

Decision electronically authenticated