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File No.: T 0408/91 - 3.3.2  
Application No.: 83 304 429.0  
Publication No.: 0 102 199  
Classification: A61K 6/08  
Title of invention: Dental restorative compositions having improved  
mechanical properties and hydrolytic stability.

**D E C I S I O N**  
of 23 November 1993

Applicant: -  
Proprietor of the patent: Dentsply Research & Development Corp.  
Opponent: Espe Stiftung & Co. Produktions- und Vertriebs  
KG

Headword: Late filed claims/DENTSPLY

EPC: Art. 104(1), 114(2) and 111(1)

Keyword: "Late filed claims admitted - appellant's reasons accepted" -  
"Remittal to Opposition Division - patentability of new claims  
not previously considered" - "Apportionment of costs considered  
but not awarded".

**Headnote**  
**Catchwords**



Case Number: T 0408/91 - 3.3.2

**D E C I S I O N**  
of the Technical Board of Appeal 3.3.2  
of 23 November 1993

**Appellant:**  
(Proprietor of the patent) Dentsply Research & Development Corp.  
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**Representative:**  
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**Respondent:**  
(Opponent) Espe Stiftung & Co.  
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**Representative:**  
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**Decision under appeal:** Decision of the Opposition Division of the  
European Patent Office dated 5 February 1991 and  
posted on 2 March 1991 revoking European patent  
No. 0 102 199 pursuant to Article 102(1) EPC.

**Composition of the Board:**

**Chairman:** P.A.M. Lançon  
**Members:** I.A. Holliday  
E.M.C. Holtz  
A. Nuss  
F. Benussi

### Summary of Facts and Submissions

I. European patent No. 0 102 199 concerning dental restorative compositions was granted on the basis of ten claims contained in European patent application No. 83 304 429.0.

II. Opposition was filed against the granted patent by the Respondent citing, *inter alia*, the following documents:

- (1) US-A-3 923 740
- (2) Douglas *et al*, J. Dent. Res., 58, 1982-86 (1979)
- (3) DE-A-2 705 220

In addition, lack of novelty was alleged based on the prior use of the Respondent's dental composition sold under the trade name "UVIO-FIL".

III. The Opposition Division revoked the patent on the grounds that Claim 1 of the main request lacked novelty in the light of the prior use of the commercial product "UVIO-FIL" which contained a binder resin and a quartz filler having a specified particle size distribution, both of which fell within the definition of Claim 1 of the patent in suit.

The Opposition Division also took the view that since documents (1) and (2) were each concerned with the use in dental compositions of resins having low water absorption and document (3) related to dental compositions containing small particles of filler, especially quartz, analogous to those of the patent in suit, a combination of their teachings would have led in an obvious manner to the subject-matter of the patent in suit as claimed in Claim 1 and the remaining dependent claims.

- IV. The Appellant lodged an appeal against the decision of the Opposition Division. The original Proprietor of the patent submitted arguments against both the alleged prior use and in favour of inventive step.
- V. A change of ownership of the patent was recorded on 1 April 1993.
- VI. At the opening of the oral proceedings held on 23 November 1993, the representative of the new Proprietor initially submitted two requests. In the original main request the filler according to Claim 1 was restricted to acid-washed and heat treated barium or strontium glass or a mixture thereof with quartz. The main claim of the auxiliary request made no mention of quartz.

The Appellant apologised for the late filing of the amended claims arguing that the patent in suit was one of portfolio of patents only recently acquired by the present Proprietor; instructions relating to the present appeal had been received only a few days before the date appointed for oral proceedings.

The Respondent indicated that if the claim were to be restricted to the auxiliary request, a withdrawal of the opposition might be considered. On the other hand, if the reference to quartz were maintained, the claim would be contested.

After a short adjournment, the Board indicated that it was prepared to admit the new requests, but for reasons of equity (Article 104(1) EPC), these circumstances might warrant an apportionment of costs for the oral proceedings to be borne by the Appellant.

The Board also expressed the opinion that since the revocation was based on the use of quartz as a filler, both according to the prior use of "UVIO-FIL" and document (3), the case ought to be remitted to the Opposition Division to consider the patentability of the new requests.

The Respondent indicated that a request for costs would only be made if the Appellant insisted on the main request.

The Appellant then withdrew the original main request.

VII. Claim 1 of the sole request on which this decision is based reads:

- \*1. A dental restorative composition comprising:
  - (a) a polymerizable composition containing at least one compound having at least two olefinically unsaturated groups, wherein, when said polymerizable composition is polymerized in the unfilled state, the resulting cured material has a water absorption as determined by ADA Specification No. 27 at 37°C for one week, of less than 1 milligram per square centimetre;
  - (b) a polymerization initiator for said polymerizable composition; and
  - (c) a hydrophobic inorganic filler having a volume average particle size below 15µm, at least 30 per cent of the particles of said filler having a size of less than 5µm, said filler being present in an amount within the range of from 35 to 78 volume per cent, based on volume of said polymerizable composition plus said filler, and said filler being selected from acid-washed and heat treated barium or strontium glass, wherein the heat treatment is carried out at a temperature below the sintering

temperature of the glass, and at a temperature and for a period of time sufficient to effect at least a 50% reduction in the specific surface area of the glass".

VIII. The Appellant requested that the decision under appeal be set aside and that the patent be maintained on the basis of Claims 1 to 9 as finally submitted during the oral proceedings.

The Respondent requested that the case be remitted to the Opposition Division for further prosecution.

#### Reasons for the decision

1. The appeal is admissible.
2. With regard to the amendments filed during the oral proceedings decisions T 95/83 (OJ EPO 1985, 75; Reasons point 8) and T 153/85 (OJ EPO 1988, 1; Reasons point 2.1) concluded that such amendments may be refused if they are not clearly allowable or if the patent Proprietor cannot justify the late filing. In the present case, however, having regard to the recent change in ownership of the patent which occurred long after the date on which the grounds of appeal were filed and to the fact that the claims according to the new request do appear to be a genuine attempt to meet the grounds on which the patent was revoked by the Opposition Division the late filing seems justified.
- 2.2 Finally, the Board noted that the Respondent made no objection to the amendments and even tentatively offered to withdraw the opposition. Provided that the new claims meet the requirements of the EPC, there seems to remain

no reason why the amended patent should not be maintained.

- 2.3 In the present exceptional circumstances the Board decided not to invoke article 114(2) EPC. Thus, although the Board deplores the late filing of the claims, it was decided to admit them into the proceedings.
  
3. The amended Claim 1 is substantially the same as that granted except that the reference to quartz in the tenth line of the claim has been deleted. This claim finds support on page 3, lines 39 to 40 of the printed description (page 6, lines 22 to 24 according to the originally filed documents). The amendment restricts the subject-matter claimed. The requirements of Article 123(2) and 123(3) EPC are accordingly satisfied.
  
4. The reasons for revoking the patent related firstly to a prior use of a dental composition containing a binder resin falling within the definition of Claim 1 of the patent in suit together with a filler consisting predominately of quartz having a specified particle size distribution. Document (3) which played an important part in the inventive step arguments of the Opposition Division also relates to a dental composition in which the filler is preferably quartz (page 11, lines 14 to 15; page 12, lines 24 to 26; page 13, lines 14 to 22 according to the typewritten pagination). Quartz is used as filler in both compositions described in the worked examples.
  - 4.1 Since quartz is now excluded from the scope of the claims, the reasons for revoking the patent no longer exist. However, the patentability of compositions containing barium or strontium glass as filler has not been considered during the present opposition proceedings. It does not seem appropriate at the present

state of the proceedings for the Board to carry out such an investigation since the parties would be deprived of an instance of jurisdiction.

4.2 Accordingly, the Board has decided to invoke its powers under Article 111(1) EPC and to remit the case to the Opposition Division with an order to resume examination of the opposition on the basis of the newly filed claims.

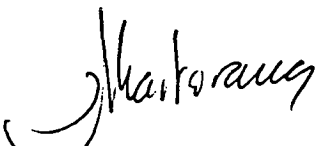
5. As indicated under VI above, the Board considered that an apportionment of costs would have been equitable. However, the Respondent stated at the oral proceedings before the Board that no such request would be made and that no decision on the apportionment of costs, even if awarded by the Board on its own motion, would be enforced by the Respondent. In view of the circumstances, there is no basis for applying Article 104(1) EPC in the present case.

**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 on the basis of Claims 1 to 9 as filed in the oral proceedings.

The Registrar:

  
P. Martorana

The Chairman:

  
P.A.M. Lançon