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File No.: T 1045/92 - 3.3.3
Application No.: 89 121 876.0
Publication No.: 0 370 531
Classification: C08L 71/02
Title of invention: Two pack type curable composition comprising epoxy resin and silicon-containing elastomeric polymer

D E C I S I O N
of 21 October 1993

Applicant: Kanegafuchi Chemical Industry Co., Ltd.
Proprietor of the patent: -
Opponent: -

Headword:

EPC: Art. 84, 113, 123 (2)
Rule 67

Keyword:

Catchwords

Clarity of term "two-pack composition" affirmed; Rejection based on Art. 123(2) objection not previously communicated - procedural violation justifying reimbursement of appeal fee.



Case Number: T 1045/92 - 3.3.3

DECISION
of the Technical Board of Appeal 3.3.3
of 21 October 1993

Appellant: Kanegafuchi Chemical Industry Co., Ltd
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Decision under appeal: Decision of the Examining Division of the European Patent Office dated 30 July 1992 refusing European patent application No. 89 121 876.0 pursuant to Article 97(1) EPC.

Composition of the Board:

Chairman: F. Antony
Members: R.A. Lunzer
M.K.S. Aúz Castro

Summary of Facts and Submissions

- I. European patent application No. 89 121 876.0, Publication No. 370 531, was filed on 27 November 1989, having a priority date of 25 November 1988 derived from Japanese Applications No. 299 088/88 and 299 089/88, both filed on the same date.
- II. The European search report was issued on 23 July 1991, and in response thereto the Applicant (present Appellant) amended the claims with its letter of 16 September 1991. The Examining Division's first communication, which was issued on 20 February 1992, objected on the grounds of Article 84 EPC to an alleged lack of clarity in Claim 1 having regard to the use of the term, "two pack composition", which was said to have no generally accepted meaning in European patent practice. Claims 1 and 11 were in the following form:
- "1. A two-pack type curable composition comprising:
- A. a first composition containing (A-1) an organic elastomeric polymer having at least one silicon-containing group to the silicon atom of which a hydroxyl group and/or a hydrolyzable group are bonded and which is cross linkable through formation of a siloxane linkage in a molecule and (A-2) a curing agent for an epoxy resin, and
- B. a second composition containing (B-1) an epoxy resin, (B-2) a curing catalyst for the organic elastomeric polymer having at least one silicon-containing reactive group and (B-3) at least one member selected from the group consisting of acidic fillers and carboxylic acids.

11. A process for preparing a two-pack type curable composition characterized in that there are provided:
 - A. a first composition containing (A-1) an organic elastomeric polymer having at least one silicon-containing group to the silicon atom of which a hydroxyl group and/or a hydrolyzable group are bonded and which is cross linkable through formation of a siloxane linkage in a molecule and (A-2) a curing agent for an epoxy resin, and
 - B. a second composition containing (B-1) an epoxy resin, (B-2) a curing catalyst for the organic elastomeric polymer having at least one silicon-containing reactive group and (B-3) at least one member selected from the group consisting of acidic fillers and carboxylic acids.

III. By a letter dated 17 March 1992, the Appellant responded with the suggestion that the objection might be overcome by the adoption of the wording:

"Curable composition in the form of a kit comprising..."

IV. Without issuing any further communication, the Examining Division issued a written decision on 30 July 1992 refusing the application. It held that the above wording, which it treated as being a proposed amendment of Claim 1, was unacceptable because the application as filed did not contain any reference to a "kit", and the introduction of such wording into the claim would constitute added subject-matter, contrary to Article 123(2) EPC. Furthermore, it was held that the set of Claims 1 to 11 filed with the letter of 16 September 1991 lacked clarity, as previously stated

in the communication of 20 February 1992, and therefore failed to meet the requirements of Article 84 EPC. Having regard to those objections, the Examining Division did not look at the issues of novelty or inventiveness.

V. Apart from its objection to the proposal for amendment by the introduction of a reference to a kit, the decision of the Examining Division, insofar as it can be understood by the Board, took two distinct objections to Claim 1 in the form in which it is set out above:

- (i) The term, "a two pack composition", had no well defined meaning in European patent practice. It indicated that the two components were in separate packages, but no more, giving no idea of the degree of proximity required, or whether the two needed to be in the same box, or even in the same warehouse.
- (ii) If the designations "first" and "second" meant no more than that the two could be interchangeable, they were apparently meaningless.

In addition to the above grounds, which were the basis of the refusal of the application, the Examining Division also drew attention to other matters, which were explicitly excluded from the basis of the decision, since they had not been communicated to the applicant. They were the following:

- (iii) A "composition" could not be defined as comprising two separate and distinct compositions.
- (iv) Claim 11 failed to place any limitation on, for instance, whether the provision of the two compositions must occur within a particular time

interval, whether compositions which were provided in the reverse order to that stated, or simultaneously, would also fall under the claim, and it was not clear whether a process whereby one composition was provided in England, and the other in Australia, would fall under the Claim.

- VI. An appeal against that decision was lodged on 30 September 1992, the appeal fee was paid on the same day, and the Grounds of Appeal were filed on 28 October 1992. In the Statement of Grounds of Appeal the Appellant argued that the wording of the Claims took a form which was common in the industry, and was not open to any valid objection.
- VII. The Appellant requested that the decision under appeal be set aside, and the application referred back to the Examining Division for further examination based on Claims 1 to 11 filed with its letter of 16 September 1991, which formed the basis of, and were attached to, the decision of the Examining Division, and for reimbursement of its appeal fee under Rule 67.

Reasons for the decision

1. The appeal is admissible.
2. As the Examining Division has not ruled on the admissibility of the new Claim 11, the Board prefers not to make any decision in relation to that Claim.

3. *Article 113*

3.1 As shown in the statement of facts set out above, the Examining Division issued a decision based inter alia on an alleged breach of Article 123(2) EPC, by the introduction of new subject matter, without at any time having drawn the attention of the Appellant to that possible ground of objection or inviting its comments. The sole ground of objection to the application which had been drawn to the Appellant's attention, and on which it had had any opportunity to comment within the provisions of Article 113 EPC, was the alleged lack of clarity of the Claims.

3.2 It is a fundamental requirement of the EPC that decisions of the EPO may only be based on grounds on which the party concerned has had an opportunity to comment. As the Appellant had not been afforded any such opportunity in relation to the objection under Article 123(2), it follows that there has been a non-compliance with an essential procedural requirement of the EPC. On that ground alone, the decision under appeal must be set aside, and the matter referred back to the Examining Division.

3.3 Non-compliance with the procedural requirements of Article 113 EPC is clearly a substantial procedural irregularity within the meaning of Rule 67 EPC. As the Board considers that reimbursement of the appeal fee is equitable in the present circumstances, it is ordered accordingly.

4. *Clarity of Claims, Article 84*

4.1 The Board finds some difficulty in understanding the nature of the objections raised under this heading, because Claim 1 seems to be in a form which has

consistently been regarded as clear by the EPO from the outset. In the Board's view, "a two pack curable composition", is an item of commerce as familiar to readers skilled in the polymer art, as everyday articles are to the public at large.

4.2 Merely by way of illustration, reference is made to the granted European patents:

0 029 668, granted 25 January 1984, in which Claim 3 opens with the words:

"A two-pack container or two part syringe characterised etc...", and

0 119 336, granted 12 August 1987, in which Claim 1 opens with the words:

"A two pack cleaning preparation which comprises, etc..."

A number of published pending European applications having claims in a similar form were also found. These examples were found on the basis of a search directed to claims which actually included the words "two pack". The Board infers that there must be many other comparable claims directed to inventions involving two components which need to be kept apart, but mixed at the time of use, and which are expressed in other words.

4.3 The Board finds comparable difficulty in understanding the objection identified in paragraph II. (ii) above; i.e. to the designation of the two compositions as "first" and "second". It has long been commonplace, when drafting claims which embrace more than one of a single class of item, such as two or more cog wheels, dynamos, or switches, to identify them as a **first**, having certain

characteristics, and a **second**, having another set of characteristics. In claims when so drafted, the words "first" and "second" are not intended to distinguish supremacy from inferiority, or the earlier from the later, but merely to distinguish the characteristics of one cog wheel, dynamo, or switch, from the other.

4.4 In the present Claim 1 it is clear that there are two distinct compositions which are intended to react with each other, and the definition is as clear as it could be having regard to the nature of the subject-matter here involved. It makes no difference whether the component parts are labelled "A" and "B", or "first" and "second", or even, as in the present case, where there is a "first composition A", and a "second composition B".

4.5 The Board is no less surprised by the objection to a definition of a "composition comprising .. a first composition A .. and a second composition B.." The purposes of literary elegance might better be served by expressing the invention as a "composition comprising components A and B", rather than "compositions A and B", but elegance of language has little bearing on the clarity of a Claim for the purposes of Article 84 EPC. Thus there can be no valid objection under this head either.

4.6 Claim 1 is as clear as the nature of the alleged invention permits, with the consequence that the Board rejects the finding of the Examining Division that there is any lack of clarity within the requirements of Article 84 EPC.

Order

For these reasons, it is decided that:

1. The decision under appeal is set aside.
2. The case is remitted to the Examining Division with the order that substantive examination be continued on the basis Claims 1 to 10 referred to in paragraph II above, the Board making no ruling on Claim 11.
3. Reimbursement of the appeal fee is ordered.

The Registrar:

The Chairman:

E. Goergmaier

F. Antony