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D E C I S I O N
of 21 October 2003

Case Number: T 0973/02 - 3.2.7

Application Number: 97928539.2

Publication Number: 0925120

IPC: B05D 5/02

Language of the proceedings: EN

Title of invention:

Preparation and method for applying an anti-slip layer to a surface and product provided with an anti-slip layer

Patentee:

Boogaard Beheer B.V.

Opponent:

INSTALLERENDE PARTNERS BOUW B.V.

Headword:

-

Relevant legal provisions:

EPC Art. 56, 114(2)

Keyword:

"Late submission of public prior use (disregarded)"
"Inventive step (yes)"

Decisions cited:

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Catchword:

-



Case Number: T 0973/02 - 3.2.7

D E C I S I O N
of the Technical Board of Appeal 3.2.7
of 21 October 2003

Appellant: INSTALLERENDE PARTNERS BOUW B.V.
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Representative: Dokter, Hendrik Daniel
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Respondent: Boogaard Baheer B.V.
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Representative: Van kan, Johan Joseph Hubert, Ir.
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Decision under appeal: Decision of the Opposition Division of the
European Patent Office posted 17 July 2002
rejecting the opposition filed against European
patent No. 0925120 pursuant to Article 102(2)
EPC.

Composition of the Board:

Chairman: A. Burkhardt
Members: K. Poalas
C. Holtz

Summary of Facts and Submissions

I. The appellant (opponent) lodged an appeal against the decision of the Opposition Division to reject the opposition against the European patent No. 0 925 120.

Opposition was filed against the patent as a whole based on Article 100(a) EPC (lack of novelty and lack of inventive step) and Article 100(b) EPC (lack of enabling disclosure).

The Opposition Division held that the grounds for opposition mentioned in Articles 100(a) and (b) EPC did not prejudice the maintenance of the patent as granted.

II. Oral Proceedings before the Board of Appeal took place on 21 October 2003.

- (a) The appellant requested that the decision under appeal be set aside and the patent revoked, and that the appeal fee be reimbursed.
- (b) The respondent requested that the decision under appeal be set aside and the patent be maintained in amended form on the basis of claims 1 to 16 and description pages 2 to 7, all submitted in the oral proceedings on 21 October 2003.
- (c) Independent claims 1, 9, 14 and 15 as amended read as follows:

"1. Preparation for applying an anti-slip layer to a surface, wherein the preparation comprises a coating composition containing a resin and a

particulate synthetic material, wherein the coating composition further contains a curing agent and a polysiloxane and that said particulate synthetic material is an apolar synthetic material and has a Shore D hardness of 50 to 85."

"9. Method for applying an anti-slip layer to a surface, characterised in that:

- (i) the surface is pre-treated with a cleaning agent and then with an adhesion promoter and
- (ii) the preparation according to any one of Claims 1 to 8 is applied to the surface."

"14. Product which has been provided with an anti-slip layer which comprises a preparation according to any of Claims 1-8."

"15. Use of a preparation according to any of Claims 1-8 for applying an anti-slip layer to a surface."

- (d) During the oral proceedings the appellant and the respondent referred to the following documents:

D2: NL 9 300 665 A;

D7: Polymer Technology by D.C. Miles and J.H. Briston, Chemical Publishing Company, New-York, 1979, page 243;

D10: Application Bulletins Industrial Floor Coatings, from MICRO POWDERS, Inc.;

- D16: "Technische Information" from Dynamit Nobel Chemie, frontcover, pages 3-7, 13, backcover;
- D17: "Informatie" from Union Carbide, pages 1-7;
- D19: Letter by facsimile, dated 29 January 1993, from Spencer Chemie B.V. to NKC B.V., Deventer;
- D20: "Technical data" Nos. 52.001 and 52.003 from Hercules Europe S.A., distributed by CIBA-GEIGY TEN HORN B.V.;
- D21: Exhibit B: analytical data of a sample of propyltexpasta carried out in August 2000 by Centrilab B.V. at Soest, NL;
- D22: Exhibit C: correspondence of 3.10.2001 between Baderet and Mr James Strauss, president of Micro Powders Inc. including a technical data sheet of propyltexp;
- D23: Exhibit D: experiments carried out by TNO Industrial Technology published under TNO Project Number 007.80037/01.28.01 "Investigation into the adhesion of the anti-slip coating "BoRan" on ceramic tiles", dated 1 November 2001;
- D24: Exhibit E: a material safety data sheet of propyltexpasta (trade name) provided by Fortis;
- D26: Exhibit G: letter dated 6 July 2000 of W.J. Jansen, sales department of Fortis;

D32: Letter by facsimile, dated 11 November 2002, from Spencer Chemie B.V. to Octrooibureau Dokter disclosing a data sheet of coathylene PY 0787-F, dated "Juni 95".

During the oral proceedings reference was also made to the following documents filed by the appellant for the first time on 19 September 2003 as evidence for two alleged prior uses in March and May 1996:

Annex 23: Report by TNO, dated 18 September 2003;

Annex 24: Invoice from Baderet to Th. De Groot B.V., dated 28 June 1996, Fakt. Nr.: 680126;

Annex 25: Overeenkomst (Agreement), dated 2 February 1996;

Annex 26: Invoice from Baderet International B.V. to Baderet, dated 11 March 1996, Fakt. Nr.:9610029;

Annex 27: Invoice from Baderet International B.V. to Baderet, dated 30 June 1996, Fakt. Nr.:96001035.

III. The appellant argued in written and oral submissions essentially as follows:

(a) Late filed evidence

The appellant had been selling the anti-slip coatings according to the alleged prior uses without being aware of their chemical composition. The presented evidence

(Annexes 23 to 27) concerning two alleged prior uses were only recently available to the appellant. Therefore, the appellant analysed samples of said anti-slip coatings and filed the present evidence only one month before the oral proceedings.

(b) Documents D16 and D17

The two brochures from Dynamit Nobel Chemie and Union Carbide both referring to the use of polysiloxane were available to the public before the priority date of the patent in suit.

(c) Claim 1 - Inventive step

The preparation of claim 1 differs from the preparation known from document D2 in that the coating composition further contains a polysiloxane, the particulate material is a synthetic apolar material, and said particulate material has a Shore D hardness of 50 to 85.

The problem underlying the invention is to replace the propyltex pasta of the anti-slip layer of document D2 by an equivalent, softer particulate material and to improve the durability of the coating.

A skilled person trying to solve this problem will gain the information from suppliers of commercially available alternatives for the particulate materials mentioned in document D2 that an apolar synthetic material in the form of polypropylene powder is suitable for non-skid applications, see documents D10, D19 or D20. Such a polypropylene powder has a Shore D

hardness of 75, see document D32, which lies within the claimed Shore D range of 50 to 85. Also the use of polysiloxane as adhesive promoter is well known to the skilled person.

Therefore, the combination of the teachings of the documents D2 and either D10, D19 or D20 taking into account the general knowledge of the person skilled in the art renders obvious the subject-matter of claim 1.

(d) Reimbursement of the appeal fees

By allowing the request of the respondent/patentee during the oral proceedings before the opposition division to consider claims 1-18 as granted as main request and claims 1-16 as received on 29 November 2001 as an auxiliary request, although said latter claims were specified in the letter received on 29 November 2001 as main request, the opposition division contravened the procedure set out in the Guidelines for Examination and acted contrary to existing case law, thereby adversely affecting the appellant's rights without any justification.

IV. The respondent argued in written and oral submissions essentially as follows:

(a) Late-filed alleged prior use evidence

The issue of prior use should not be admitted as no good reason was presented by the appellant why it had not been raised earlier in the proceedings.

(b) Documents D16 and D17

There existed no evidence that documents D16 and D17 were available to the public before the priority date of the patent and therefore they should be disregarded.

(c) Inventive step - Claim 1

Although the use of polypropylene powder as anti-slip material was well known (see documents D10, D19 or D20) the person skilled in the art starting from document D2 would be discouraged from the teaching of said document from using polypropylene powder, since document D2 mentioned only an inorganic alu-silicate material, namely "propyltex pasta", see documents D24 and D26. The specific Shore D hardness-range mentioned in claim 1 of the patent in suit is not suggested by any prior art document. Furthermore, there is nothing in the prior art documents to suggest incorporating of a polysiloxane into the coating composition prior to the application of the anti-slip layer.

Therefore, starting from document D2, a person skilled in the art finds no hint from the prior art either for an apolar synthetic material with a Shore D hardness from 50 to 85 or for the incorporation of polysiloxane into the coating composition prior to the application of the anti-slip layer.

Reasons for the Decision

1. *Admissibility of the late-filed evidence*

According to Article 114(2) EPC facts or evidence which are not submitted in due time may be disregarded. In the extensive jurisprudence relating to this issue the Boards of Appeal have developed the principle that in cases where the late-filed material relates to an alleged prior use by the party relying on it, this material should only be admitted into the proceedings in exceptional circumstances, and only if there were pressing reasons for the delay.

In the present case the alleged prior uses were based on the appellant's own activities. As a reason for the late filing of evidence for the alleged prior uses, the appellant declared that this evidence "could only recently be obtained". However, it is apparent that the fact that the evidence could only recently be obtained is a consequence of the fact that the appellant only recently decided to analyse samples of the anti-slip coatings which the appellant had been selling before the priority date of the patent in suit. This cannot be regarded as a valid justification for the delay in producing the evidence in question, since, objectively, the appellant was without any doubt in a position to analyse these anti-slip coatings before the expiration of the time period for opposition.

The Board finds that the filing of the evidence concerning the opponent's (appellant's) own prior uses in a very late stage of the procedure (more than two and a half years after the end of the time limit for

opposition and only one month before the date of the oral proceedings) without any valid justification for such a delay represents in the view of the Board an abuse of proceedings.

Therefore the late-filed evidence concerning alleged prior uses is disregarded pursuant to Article 114(2) EPC, irrespective of any potential relevance.

2. *Documents D16 and D17*

Documents D16 and D17 are two brochures from Dynamit Nobel Chemie and Union Carbide, both referring to the use of polysiloxanes. It is unclear from the data on the last page of document D16 "7.86" and from the expression "februari 1987" on the last page of document D17, whether said documents were only produced at that time, whether they were available only to the employees of said firms or whether they were also publicly available on those dates.

Since the appellant was not able to present any conclusive evidence that documents D16 and D17 were publicly available before the priority date of the patent in suit, said documents are disregarded.

3. *Claim 1*

3.1 Inventive step

3.1.1 Closest prior art

The closest prior art is undisputedly represented by document D2 disclosing a preparation for applying an

anti-slip layer to a surface, wherein the preparation comprises a coating composition containing: a resin in the form of polyurethane (page 2, lines 19 to 22 and page 3, line 11), a particulate material named "propyltex pasta" (page 2, lines 26 to 28 and page 3, line 13) and a curing agent in the form of isocyanate (page 2, line 23 and page 3, line 12).

Document D26 (Exhibit G) is a letter dated 6 July 2000 signed by Mr W.J.Jansen of the sales department of Fortis, which company is the supplier of the "propyltex pasta" mentioned in document D2, stating that "propyltexpasta" is an alu-silicate. Document D24 (Exhibit E) being a non-dated material safety data sheet of Fortis for a material with the trade name "propyltexpasta" supports the statement of document D26. Although document D24 is a non-dated sheet the Board acting on the principle of free evaluation of evidence is convinced that documents D24 and D26 considered together and in combination with document D22 (Exhibit C) allow the Board to conclude with a sufficient degree of certainty that the "propyltex pasta" mentioned in document D2 is an alu-silicate.

The alu-silicate particulate material in the propyltex pasta of document D2 is similar to sand and therefore its particles are sharp and cause an unpleasant feeling. Furthermore, the durability of the anti-slip layer known from document D2 is not sufficient.

3.1.2 Problem underlying the invention

The problem underlying the invention of the patent in suit is to improve the preparation for applying an

anti-slip layer known from document D2 so that the particulate material disclosed in said layer is not sharp and feels pleasant, and that the anti-slip layer has a sufficient durability, i.e. that the coating has a satisfactory adhesion to the surface to be treated.

3.1.3 Solution

In accordance with claim 1 of the patent in suit the above-mentioned problem is solved in that the preparation of document D2 is modified by using a coating composition containing polysiloxane and by choosing as particulate material an apolar synthetic material having a Shore D hardness of 50 to 85.

The use of such particulate material gives an anti-slip layer with a pleasant feeling and the incorporation of polysiloxane into the coating composition results in a satisfactory adhesion of the coating on a substrate, especially on ceramic tiles, under dry as well as under wet conditions. The latter effect is documented in Table 1 of document D23 (Exhibit D), where it is shown that the adhesion of an anti-slip coating on a tile with a polysiloxane application prior to the application of the coating (tile 1) and on a tile with a coating in which the polysiloxane was incorporated (tile 3) into the coating exhibit a similar adhesion, said adhesion being much better than the one of a tile with the similar coating but without the use of polysiloxane (tile 2).

3.1.4 The above mentioned solution is not rendered obvious by the documents under consideration for the following reasons:

None of the presented documents discloses a hint for the incorporation of polysiloxane into the coating composition prior to the application of said coating to a surface to be treated.

Even accepting the argumentation of the appellant that the person skilled in the art would be led by the teaching of document D19 to replace the "propyltex pasta" of document D2 by the polypropylene powder PY-0787 F mentioned in said document, said polypropylene powder having according to document D32 a Shore D hardness within the claimed range of 50 to 85, namely 75, and furthermore assuming that polysiloxane was known to the person skilled in the art before the priority date of the patent in suit as an adhesion promoter, the skilled person would not arrive at the subject-matter of claim 1 of the patent in suit, since he would find no hint in the prior art for the incorporation of polysiloxane as an ingredient into the coating composition of a modified preparation for an anti-slip layer known from document D2 in order to solve the problem mentioned above.

3.1.5 For the above-mentioned reasons, the subject-matter of claim 1 of the patent in suit involves an inventive step within the meaning of Article 56 EPC.

4. *Claims 2 to 16*

Dependent claims 2 to 8 concern particular embodiments of the preparation claimed in claim 1 and likewise involve an inventive step.

Since the application according to claims 1 to 8 is inventive vis-à-vis the prior art, the same necessarily applies to the subject-matter of independent claim 9 referring to a method for applying such a preparation, to the subject-matter of independent claim 14 referring to a product comprising such a preparation and also to the subject-matter of independent claim 15 referring to a use of such a preparation.

The method according to claim 10, the product according to claim 14 and the use according to claim 15 therefore also involve an inventive step.

Dependent claims 10 to 13 concern particular embodiments of the method claimed in claim 9 and dependent claim 16 concerns a particular embodiment of the use claimed in claim 15, which all likewise involve an inventive step.

5. *Reimbursement of the appeal fee*

The appellant alleges a procedural violation by the opposition division by allowing the patentee to fall back during the oral proceedings to the claims as granted, although the patentee had before the oral proceedings submitted an amended set of claims replacing the claims as granted.

The Board however, is of the opinion that there is no legal basis for not allowing the patentee during a pending opposition procedure to fall back to the claims as granted. In requesting that his patent be maintained in a limited form the patentee merely tried to delimit his patent to meet the objections expressed by the

opponent. However, by virtue of such a limitation the patentee did not irrevocably surrender the subject-matter covered by the patent as granted, in particular since the amendment was made before the opposition division had commented on the patentability of the patent as granted, see also T 64/85, point 2.4 and T 168/99, point 1.3.

The minutes of the oral proceedings before the opposition division indicate that the patentee had filed two auxiliary requests, but that his main request was that the patent be maintained as granted.

The opponent filed an opposition against the patent as granted and during the oral proceedings before the opposition division he was given the opportunity to present arguments against the patent as granted. His right to be heard was therefore met.

The request for reimbursement of the appeal fee is therefore unfounded and must be rejected.

Order

For these reasons it is decided that:

1. The decision under appeal is set aside.
2. The case is remitted to the first instance with the order to maintain the patent in amended form with the following documents:

claims: 1 to 16, filed in the oral proceedings on 21 October 2003,

description: pages 2 to 7, filed in the oral proceedings on 21 October 2003.
3. The appellant's request for reimbursement of the appeal fee is refused.

The Registrar:

The Chairman:

D. Spigarelli

A. Burkhardt