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**D E C I S I O N**  
**of 11 April 2006**

**Case Number:** T 0178/03 - 3.3.01

**Application Number:** 93920151.3

**Publication Number:** 0658181

**IPC:** C09D 5/14

**Language of the proceedings:** EN

**Title of invention:**

Gel-free paint containing copper pyrithione

**Patentee:**

Arch Chemicals, Inc.

**Opponent:**

Yoshitomi Fine Chemicals, Ltd.

**Headword:**

Copper pyrithione

**Relevant legal provisions:**

EPC Art. 54(3)(4), 123(2)

EPC R. 87

**Keyword:**

"Allowability of disclaimer (yes) - novelty destroying prior art pursuant to Article 54(3)(4) EPC"

"Novelty (yes) - no novelty destroying prior art"

"Inventive step (yes) - non obviousness finding not contested"

"Postponement of oral proceedings (no)"

**Decisions cited:**

G 0002/98, G 0001/99, G 0001/03, T 0123/85, T 0234/86,

T 0299/89, T 0156/90, T 0831/90, T 0506/91, J 0012/85

**Catchword:**

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Case Number: T 0178/03 - 3.3.01

**D E C I S I O N**  
of the Technical Board of Appeal 3.3.01  
of 11 April 2006

**Appellant:** Arch Chemicals, Inc.  
(Proprietor of the patent) 501 Merritt 7  
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**Representative:** Bannerman, David Gardner  
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**Respondent:** Yoshitomi Fine Chemicals, Ltd.  
(Opponent) 6-9 Hiranomachi 2-chome  
Chuo-ku, Osaka 541-0046 (JP)

**Representative:** Weber, Thomas  
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**Decision under appeal:** Interlocutory decision of the Opposition  
Division of the European Patent Office posted  
23 December 2002 concerning maintenance of  
European patent No. 0658181 in amended form.

**Composition of the Board:**

**Chairman:** A. Nuss  
**Members:** P. P. Bracke  
D. Rogers

## Summary of Facts and Submissions

I. The Proprietor of the patent in suit was the sole Appellant against the Opposition Division's decision to maintain European patent No. 0 658 181 on the basis of the then pending third auxiliary request submitted at the oral proceedings before the Opposition Division, which consisted of two sets of claims.

The set of ten claims for the contracting state ES corresponded with the set of claims as granted. The independent claims read:

"1. A paint or paint base composition characterized by enhanced biocidal efficacy and gellation resistance wherein the paint or paint base contains a biocide consisting essentially of cuprous oxide and copper pyrithione or pyrithione disulfide, or a combination thereof."

"6. A process for providing a gellation-inhibited paint or paint base containing a biocide consisting essentially of copper pyrithione or pyrithione disulfide and cuprous oxide characterized by the step of adding said copper pyrithione or pyrithione disulfide and also adding cuprous oxide to a paint or paint base to provide a paint or paint base characterized by enhanced biocidal efficacy and resistance to gellation, said copper pyrithione or pyrithione disulfide being present in an amount of between about 1% and about 25%, and said cuprous oxide being present in an amount of between about 20% and about 70%, the total amount of said copper pyrithione or pyrithione disulfide plus said cuprous oxide being

between about 20% and about 80% based upon the total weight of the paint or paint base."

The set of claims for the contracting states DE, DK, FR, GB, NL and SE consisted of eight claims. The wording of those claims is, however, not relevant for the present decision.

II. In particular, the Opposition Division was of the opinion that the sets of claims for the contracting states DE, DK, FR, GB, NL and SE in the then pending main request and first and second auxiliary requests were not novel over the disclosure of document

(1) EP-A-0 651 034,

which was considered to form part of the state of the art pursuant to Article 54(3) and (4) EPC for all contracting states designated in the patent in suit except ES.

III. At the oral proceedings before the Board of Appeal, which took place on 11 April 2006 and at which the Respondent (Opponent) was not represented, as announced in a fax of 3 April 2006, the Appellant filed two sets of claims as a sole Main Request.

The set of claims for ES was identical with the granted set of claims (see point I above).

The set of claims for the contracting states DE, DK, FR, GB, NL and SE consisted of seven claims with the independent claims reading:

"1. A paint or paint base composition characterised by enhanced biocidal efficacy and gelation resistance wherein the paint or paint base contains a biocide consisting essentially of cuprous oxide and copper pyrithione or pyrithione disulfide, said copper pyrithione or pyrithione disulfide being present in an amount of between 1% and 25% and said cuprous oxide being present in an amount of between 20% and 70%, based on the total weight of the paint or paint base, the total amount of said copper pyrithione or pyrithione disulfide plus said cuprous oxide being between 20% and 80% based on the total weight of the paint or paint base, provided that the composition does not consist of 10 wt% of chlorinated rubber resin, 25 wt% of cuprous oxide, 10 wt% of copper pyrithione, 15 wt% of rosin, 15 wt% of red iron oxide, 4 wt% of talc, 1 wt% of pulverised silica and 20 wt% of xylene."

"4. A process for providing a gellation-inhibited paint or paint base containing a biocide consisting essentially of cuprous oxide and copper pyrithione or pyrithione disulfide, characterised by the step of adding said copper pyrithione or pyrithione disulfide and also adding cuprous oxide to a paint or paint base to provide a paint or paint base characterised by enhanced biocidal efficacy and resistance to gellation, said copper pyrithione or pyrithione disulfide being present in an amount of between 1% and 25%, and said cuprous oxide being present in an amount between 20% and 70%, the total amount of said copper pyrithione or pyrithione disulfide plus said cuprous oxide being between 20% and 80% based upon the total weight of the paint or paint base, and provided that the composition does not consist of 10 wt% of chlorinated rubber resin,

25 wt% of cuprous oxide, 10 wt% of copper pyrithione, 15 wt% of rosin, 15 wt% of red iron oxide, 4 wt% of talc, 1 wt% of pulverised silica and 20 wt% of xylene."

IV. The Respondent had submitted, in writing, that the Appellant was deprived of the right to come back to sets of claims with subject matter broader than that of the broadest request under consideration before the Opposition Division.

Furthermore, the Respondent had objected, in writing, that the disclaimers in the sets of claims for the contracting states DE, DK, FR, GB, NL and SE submitted by the Appellant during the written stage of the appeal procedure remove more than is necessary to restore novelty over the disclosure of document (1).

Finally, the representative of the Respondent had requested postponement of the oral proceedings before the Board. The reason for this was that the oral proceedings were scheduled to take place in the school holidays in North Rhine-Westphalia, thus preventing the representative from spending the Easter holidays together with his family at a private place in Austria. The representative stated that the other colleagues in the firm were either away from the office for holidays as well or their technical background was not suitable for handling the present case, independent from the fact that the representative had exclusively been entrusted with the present case by the client with which a considerable level of trust had developed over the years.

- V. The Appellant requested that the decision under appeal be set aside and that the patent be maintained upon the basis of the Main Request filed at the Oral Proceedings on 11 April 2006 before the Board.

The Respondent requested in writing that the appeal be dismissed and that the following question be submitted to the Enlarged Board of Appeal:

"Taking account of the Notice of the Vice-President's Directorates-General 2 and 3 dated 1 September 2000 concerning Oral Proceedings before the EPO, item 2.2 and 2.3 can it be distinguished - in a judgment as to whether a request to fix a new date for Oral Proceedings represents serious substantive reasons - between holidays which are spent at a privately owned place to which it is traveled by car and holidays involving booked hotels and/or flights?"

### **Reasons for the Decision**

1. The appeal is admissible.
2. Formal matters
  - 2.1 Right to defend at the appeal stage broader claims than the broadest claim considered by the Opposition Division.

The independent claims of the main request for the contracting states DE, DK, FR, GB, NL and SE before the Opposition Division were restricted to compositions

containing besides cuprous oxide and copper pyrithione or pyrithione disulfide, a resin, whereas Claims 1 and 4 of the set of claims for the contracting states DE, DK, FR, GB, NL and SE in the present Main Request are not restricted to compositions containing such resin. Since the present claims are thus broader than the claims of the broadest request upon which the Opposition Division decided, the Respondent contested that the Appellant was entitled to defend such broader claims.

However, as pointed out in the Case Law of the Boards of Appeal of the EPO, 4th edition 2001, VI.I.3.1.2(b), it is consistent jurisprudence that proprietors requesting in opposition proceedings maintenance of the patent in limited form do not, by virtue of such limitation, irrevocably abandon subject-matter covered by the patent as granted but not by the request as thus limited (T 123/85, OJ EPO 1989, 336).

In support of his argument that the Appellant was not now entitled to defend broader claims, the Respondent referred to decisions G 1/99 (point 6.3), J 12/85, T 299/89, T 156/90, T 234/86, T 831/90 and T 506/91.

However, these decisions all concern the entitlement to appeal under Article 107 EPC, stating in particular that only a party adversely affected by a decision may appeal. Since it is not contested in the present case that by refusing the main request and the first and second auxiliary request pending before the Opposition Division the Proprietor of the patent was adversely affected, the principles described in those decisions are not relevant in the present case.



Thus, the Board does not see any sound reason why the Appellant should not be entitled to defend the claims according to the present Main Request.

- 2.2 Respondent's request "to not allow any further sets of claims into the proceedings because, including the opposition procedure, almost 10 sets of claims for Main and Auxiliary Requests have been provided, by the Appellant" (see letter dated 16 March 2006) amounts to ask the Board to generally disallow any future request which does not seem to suggest a reasonable exercise of the Board's discretion when dealing with late filed amended claims. The claims for the contracting states DE, DK, FR, GB, NL and SE submitted during oral proceedings before the Board are the result of amendments which are straightforward in the sense that they result from first, the combination of the subject matter of compositions Claims 1 and 2 as granted with a disclaimer aiming at excluding now no more than the novelty destroying disclosure represented by example 3 of document (1), and second, the combination of the subject matter of process Claim 6 as granted with the same disclaimer as in Claim 1. In the judgement of the Board, neither new and complex subject matter is thereby introduced at a late stage of the appeal proceedings, nor is the need for procedural economy put at risk as the Board is not prevented from taking its final decision at the end of the oral proceedings.

The Board therefore exercised its discretion to consider the claims of Appellant's sole Main Request.

3. Novelty

3.1 Claims for the contracting state ES

It has never been contested that those claims meet the requirements of Article 123(2) EPC and of novelty within the meaning of Article 54 EPC. The Board does not have any reason to doubt this.

3.2 Claims for the contracting states DE, DK, FR, GB, NL and SE

3.2.1 Article 123(2) and (3) EPC

Claim 1 results from the combination of the product features of original Claims 1 and 2 with a disclaimer. This disclaimer specifically excludes the composition described in example 3 of document (1), which is state of the art under Article 54(3) and (4) EPC, and does thus not remove more than is necessary to restore novelty over that example 3. Therefore, this disclaimer complies with the criteria laid down in items 2.1 and 2.2 of the Order of decision G 1/03 (OJ EPO 2004, page 413).

The features in Claims 2 and 3 correspond with those in original Claims 4 and 5.

Claim 4 results from the combination of the process features of original Claim 6 with the same disclaimer as in Claim 1.

The features in Claims 5, 6 and 7 correspond with those original Claims 7, 9 and 10.

Moreover, in comparison with granted Claims 1 and 6 the scope of protection of Claims 1 and 4 has been restricted.

Thus, the requirements of Article 123(2) and (3) EPC are fulfilled.

### 3.3 Novelty

3.3.1 Novelty of the claimed subject-matter was only contested over the disclosure of document (1), which claims the priority of JP-206020/92, filed on 8 July 1992.

3.3.2 It has never been contested that the priority of US application No. 938962, filed on 1 September 1992, has been validly claimed in the patent in suit.

3.3.3 However, as correctly stated in the paragraph bridging pages 1 and 2 of Respondent's letter of 24 January 2000, it follows from a comparison of the disclosure of document (1) with the content of the priority document JP-206020/92 that the disclosure on page 3, lines 43 to 51, and page 6, line 36 to page 7, line 15 of document (1) is not included in JP-206020/92.

The passage on page 3, lines 43 to 51, is the only disclosure in document (1) where particular amounts and ratios of heavy metal compounds, such as cuprous oxide, and copper pyrithione are disclosed.

3.3.4 In view of the jurisprudence of the Boards of Appeal, as presented in point 6.2 of opinion G 2/98 OJ EPO 2001, page 413, namely that the right of priority covers only those elements of the European patent application which are included in the application whose priority is claimed, compositions containing cuprous oxide and copper salt of 2-pyridinethiol-1-oxide **in the amounts specified on page 3, lines 43 to 51, of document (1)** are not covered by the priority right of document (1).

3.3.5 As the priority date of the patent in suit is before the filing date of document (1) the compositions disclosed in document (1) with the stated amounts and ratios for the different compounds are not embraced within the state of the art.

3.3.6 In order to be novelty destroying, all features in the claimed combination must be directly and unambiguously derivable from the teaching of one single document. Since such combination of features is not disclosed in the general teaching of document (1), a novelty destroying disclosure could only be found in the experimental part entitled to the claimed priority, namely examples 1 to 3 of document (1).

However, since the compositions disclosed in examples 1 and 2 contain 10 respectively 20 wt% of cuprous oxide and the claims are restricted to compositions containing **between** 20 and 70 wt% of cuprous oxide, those compositions cannot be considered to destroy the novelty of Claim 1. Moreover, as the specific composition described in example 3 is excluded by disclaimer, Claim 1 is novel over that part of document (1) entitled to the claimed priority.

4. Inventive step

Document (1), which represents state of the art according to Article 54(3) and (4) EPC is not to be considered in assessing inventive step.

The Opposition Division found that the claimed compositions and processes in both sets of claims were not obviously derivable from the cited state of the art under Article 54(2) EPC. This was not contested by the Respondent in the appeal procedure and the Board has no reason to doubt this finding.

5. The description

The description is not yet adapted to the two sets of claims found allowable by the Board. In such a case, the Board deems it appropriate to make use of its power under Article 111(1) EPC and to remit the case for the purpose of this adaptation to the Opposition Division.

In view of the findings on novelty set out above, document (1) should be duly acknowledged in the introductory part of the description. Moreover, it should be taken into consideration whether the presence of two sets of claims justifies the presence of two different descriptions (see Rule 87 EPC).

6. Request by the Respondent to postpone oral proceedings and proposed referral to the Enlarged Board of Appeal (see point IV, third paragraph above).

6.1 The Notice of the Vice-Presidents of Directorates-General 2 and 3 dated 1 September 2000 concerning oral proceedings before the EPO (OJ EPO 2000, 456) lists holidays in point 2.3 as a potential serious substantive reason justifying the fixing of a new date. However, point 2.5 of that Notice sets the further requirement that every request for fixing another date for oral proceedings should contain a statement why another representative within the meaning of Articles 133(3) or 134 EPC cannot substitute the representative prevented from attending the oral proceedings. In the present case, the Respondent's representative stated that the other available colleagues in the firm did not have a suitable technical background for handling the present case or were on holidays.

Such mere assertion, however, cannot be considered a sufficiently substantiated written statement indicating the serious reasons which justify the fixing of a new date, as required in point 2.2 of that Notice. Moreover, the present case does not appear to imply special technical difficulties which might prevent the substitution of one representative for another representative of similar background.

Therefore, the Board refused postponement of the oral proceedings scheduled on 11 April 2006.

6.2 As the request to postpone oral proceedings is to be refused already since the reasons put forward by the Respondent do not justify the fixing of a new date, as required in the above mentioned Notice, the question proposed by the Respondent to be submitted to the

Enlarged Board of Appeal is not relevant in the present case. Consequently the request for referral is refused.

## 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 with Claims 1 to 7 for DE, DK, FR, GB, NL and SE and with Claims 1 to 10 for ES as filed at the Oral Proceedings before the Board on 11 April 2006; and a description yet to be adapted.
3. The request by the Respondent for referral to the Enlarged Board of Appeal is refused.

The Registrar:

The Chairman

N. Maslin

A. Nuss