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**Datasheet for the decision
of 11 November 2010**

Case Number: T 0871/07 - 3.3.01

Application Number: 98400389.7

Publication Number: 0860484

IPC: C09D 17/00

Language of the proceedings: EN

Title of invention:

Lamellar pigment particle dispersion

Patentee:

SILBERLINE MANUFACTURING CO., INC.

Opponent:

ECKART GmbH
BASF Coatings GmbH
Akzo Nobel N.V.

Headword:

Pigment dispersion/SILBERLINE

Relevant legal provisions:

EPC Art. 100(c)

Relevant legal provisions (EPC 1973):

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Keyword:

"Party's announcement that it will not be represented at oral proceedings - Equivalent to withdrawal of request for oral proceedings"

"Amended claims of both requests - Extension of subject-matter beyond content of application as filed"

Decisions cited:

T 0003/90, G 0009/91

Catchword:

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Case Number: T 0871/07 - 3.3.01

D E C I S I O N
of the Technical Board of Appeal 3.3.01
of 11 November 2010

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Decision under appeal: Interlocutory decision of the Opposition
Division of the European Patent Office posted
20 April 2007 concerning maintenance of
European patent No. 0860484 in amended form.

Composition of the Board:

Chairman: P. Ranguis
Members: C. M. Radke
L. Bühler

Summary of Facts and Submissions

I. The appeal is directed against the interlocutory decision of the opposition division to maintain European Patent No. 0 860 484 in amended form, posted on 20 April 2007. An appeal was filed by all three Opponents being party to the proceedings before the first instance.

II. The patent as maintained in amended form comprised claims 1 to 23 filed with letter dated 25 May 2005. Claim 1 of this set of claims reads as follows:

"1. A lamellar pigment dispersion for forming lamellar pigment-containing coating compositions, comprising:
20-55% by weight of lamellar pigment particles, notably lamellar metal pigment particles; and
a dispersion carrier for the lamellar pigment particles, the dispersion carrier being liquid at room temperature and compatible with a vehicle for forming a coating composition;
said lamellar pigment particles being essentially completely dispersed and separated from one other within the dispersion carrier, thereby having improved shelf stability and being easily mixable with said vehicle for forming said coating composition, thereby further reducing the time and labor needed to formulate the coating composition;
said lamellar pigment dispersion has a viscosity of from 10 to 200 Pa.s (10,000 to 200,000 centipoises) when measured on a Brookfield RVT viscometer using a number 7 spindle at 5 rpm, and being notably obtained by the method as claimed in one of the method claims 19-22."

III. The three opponents requested revocation of the patent in its entirety. The oppositions were based on grounds pursuant to Article 100(a) EPC, and, as far as the opposition of opponent I is concerned, on grounds pursuant to Article 100(b) and (c) EPC. As to the ground pursuant to Article 100(c) EPC, opponent I had argued that the expression "said lamellar pigment particles being essentially completely dispersed and separated from one other within the dispersion carrier" in claim 1 had no basis in the application as originally filed.

IV. As far as Article 100(c) EPC is concerned, the opposition division held that the amendment in claim 1 was merely illustrative and thus could not introduce new subject-matter. Moreover it was based on paragraph [0016] of the patent (*sic*).

V. The present decision is based on the following claims:

- claims 1 to 23 filed with letter dated 25 May 2005 (Main Request); and
- claims 1 to 22 filed as Auxiliary Request I with letter dated 14 March 2008.

The claims of the Main Request are identical to those on which the decision under appeal was based. Claim 1 of this request is set out under point II above.

Claim 1 of the Auxiliary Request reads as follows:

"1. A lamellar pigment dispersion for forming lamellar pigment-containing coating compositions, comprising:

20-55% by weight of lamellar pigment particles, notably lamellar metal pigment particles; and

a dispersion carrier for the lamellar pigment particles, the dispersion carrier being liquid at room temperature and compatible with a vehicle for forming a coating composition; said dispersion carrier is at least one selected from the group consisting of a plasticizer; at least one solvent selected from the group consisting of a substituted and unsubstituted aliphatic and aromatic hydrocarbon, a ketone, an alcohol, a glycol ether, an ester and a nitroparaffin; a resin and an oil;

said lamellar pigment particles being essentially completely dispersed and separated from one other within the dispersion carrier, thereby having improved shelf stability and being easily mixable with said vehicle for forming said coating composition, thereby further reducing the time and labor needed to formulate the coating composition;

said lamellar pigment dispersion has a viscosity of from 10 to 200 Pa.s (10,000 to 200,000 centipoises) when measured on a Brookfield RVT viscometer using a number 7 spindle at 5 rpm, and being notably obtained by the method as claimed in one of the method claims 18 to 21."

- VI. The Board annexed a communication to the summons to oral proceedings containing *inter alia* its preliminary and non-binding opinion that the expression "thereby having improved shelf stability" in claim 1 as granted and in claim 1 of both requests indicated that the dispersion and separation of the particles caused the improved shelf stability. As the Board had not found

any basis in the application as filed for this causality it concluded that the ground pursuant to Article 100(c) EPC might prejudice the maintenance of the patent. If the Respondent deemed it advisable to amend claim 1, such an amended claim should not contravene the requirements of Article 123(3) EPC (see paragraphs 4.1, 4.1.3 and 4.1.4 of the communication).

- VII. The Appellants requested that the decision be set aside and that the patent be revoked.

The Respondent requested that the appeals be dismissed or that the patent be maintained on the basis of claims 1 to 22 filed as Auxiliary Request I with the letter dated 14 March 2008.

Appellant I additionally filed an unconditional request for oral proceedings. Appellants II and III requested oral proceedings in the event that the patent was not to be revoked in the written proceedings. The Respondent initially filed an auxiliary request for oral proceedings.

- VIII. By letter dated 18 October 2010 the Respondent indicated that it would not be represented at the oral proceedings and that it solicited "a Decision by the Board of Appeal on the basis of the pending file".

The Appellants asked the Board to reconsider the need for oral proceedings and, if the patent could be revoked in the written proceedings, to cancel the oral proceedings (see Appellant I's letter dated 28 October 2010, Appellant II's letter dated 29 October 2010, and Appellant III's letter dated 4 November 2010).

IX. The Board informed the parties by fax that the oral proceedings were cancelled.

Reasons for the Decision

1. The appeals are admissible.

2. The Respondent stated that it would not be represented at the oral proceedings (see point VIII above). According to the established jurisprudence of the boards of appeal this statement is to be treated as an equivalent to a withdrawal of the request for oral proceedings (see T 3/90, OJ EPO 1992, 737, point 1 of the Reasons).

This interpretation is also in line with the Respondent's request for a decision to be made "on the pending file".

The remaining requests for oral proceedings were only to take effect if the patent was not to be revoked in the written proceedings.

Therefore, the Board is not obliged to have held oral proceedings if it revokes the patent in the written proceedings.

3. This decision is based on the facts and arguments mentioned in the communication annexed to the summons to oral proceedings posted on 9 July 2010 and received by the parties, as evidenced by the respective advices of delivery. The parties thus had an opportunity to

present their comments and arguments on these facts and hence were duly accorded the right to be heard (see Article 113(1) EPC).

4. Article 100(c) EPC

4.1 The power of a board of appeal to decide on the maintenance of a patent depends on the extent to which the patent is opposed in the notice of opposition (see G 09/91, OJ EPO 7/1993, 408, point 6 of the Reasons and the Order of the Decision).

Opponent I (now Appellant I) opposed the patent in the notice of opposition based on the ground pursuant to Article 100(c) EPC that the subject-matter of claim 1 as granted was deemed to extend beyond the content of the application as filed (see under point III above). This objection was maintained during the appeal proceedings (see point II.1 of Appellant I's letter dated 30 August 2007).

Hence the Board has had to examine whether or not Article 100(c) EPC prejudices the maintenance of the patent as a result of the amendments in claim 1 as granted.

Within this legal and factual framework, the Board may examine the facts of its own motion (see Article 114(1) EPC). Therefore, it is not confined in its examination of the ground pursuant to Article 100(c) EPC to the expression "said lamellar pigment particles being essentially completely dispersed and separated from one other within the dispersion carrier" objected to by Appellant I.

4.2 Claim 1 of both requests contains the wording "said lamellar pigment particles being essentially completely dispersed and separated from one other within the dispersion carrier, thereby having improved shelf stability ...".

4.3 The Board informed the parties that

- it held that this wording indicated that the dispersion and separation of the particles caused the improved shelf stability; and that
- it had not found any basis in the application as filed for this causality

(see paragraph VI above).

The Respondent and Patentee did not provide any counterarguments thereto.

4.4 The stability of the pigment dispersions is addressed in the following parts of the application as filed:

Page 1, lines 10-13;
the sentence bridging pages 1 and 2;
page 2, lines 9-15;
page 3, lines 28-34; and
examples 1 and 2.

4.4.1 Page 1, lines 10-13 only states that due to stability problems, the lamellar pigment particles of the prior art were shipped as highly concentrated pastes. The sentence bridging pages 1 and 2 merely states that the particles are capable of remaining in a dispersed state without separation indefinitely. Page 3, lines 28-34 only states that the dispersions of the invention

showed stability and defines what stability means in that context. The last sentence in examples 1 and 2 reads: "The metal pigment particles are completely separated and the dispersion is stable."

Hence, these four passages of the application as filed do not give any indication of what might be the cause of the stability observed.

4.4.2 Page 2, lines 9-14 of the application as filed reads as follows:

"In addition, the dispersion of the present invention can improve shelf stability as opposed to a paste form, especially for non-leafing grades that are coated with unsaturated fatty acids. Shelf stability is largely dependent on the exposure of the pigment particles to air. This exposure will cause solvent evaporation and oxidation of the lubricant, resulting in flake agglomeration. Dispersions will further help to exclude air, thus maintaining the integrity of the pigment."

This part of the application as filed thus attributes a lack of stability to the exposure of the pigment particles to air and to the resulting evaporation of the solvent.

4.4.3 Therefore, the application as filed does not link the improved stability of the pigment dispersion with complete dispersion and separation of the pigment particles from one another.

4.5 In view of the fact that the application as filed indicates that "Shelf stability is largely dependent on

the exposure of the pigment particles to air" there is no reason to believe that the person skilled in the art reading the application would conclude that shelf stability was due to another cause, namely to the complete dispersion and separation of the pigment particles from one another.

4.6 Consequently, the subject-matter of claim 1 of both requests extends beyond the content of the application as filed. Hence, the ground pursuant to Article 100(c) EPC prejudices the maintenance of the patent in suit based on both requests.

Order

For these reasons it is decided that:

1. The decision under appeal is set aside.
2. The patent is revoked.

The Registrar:

The Chairman:

M. Schalow

P. Ranguis