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**Datasheet for the decision
of 29 November 2010**

Case Number: T 1848/07 - 3.3.01

Application Number: 96917571.0

Publication Number: 0904323

IPC: C09D 5/14

Language of the proceedings: EN

Title of invention:
Inhibition of bacterial growth

Patentee:
Biocote Limited

Opponent:
DuPont Performance Coatings GmbH

Headword:
Powder coating manufacture/BIOCOTE

Relevant legal provisions:
EPC Art. 123(2)

Relevant legal provisions (EPC 1973):
-

Keyword:
"All requests: amendments (not allowable) - not unambiguously derivable from application as filed"

Decisions cited:
-

Catchword:
-



Case Number: T 1848/07 - 3.3.01

D E C I S I O N
of the Technical Board of Appeal 3.3.01
of 29 November 2010

Appellant:
(Patent Proprietor)

Biocote Limited
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Representative:

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Respondent:
(Opponent)

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Representative:

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Decision under appeal:

**Decision of the Opposition Division of the
European Patent Office posted 14 September 2007
revoking European patent No. 0904323 pursuant
to Article 102(1) EPC 1973.**

Composition of the Board:

Chairman: P. Ranguis
Members: G. Seufert
D. S. Rogers

Summary of Facts and Submissions

- I. The Appellant (Patent Proprietor) lodged an appeal on 6 November 2007 against the decision of the Opposition Division dated 14 September 2007 revoking the European patent No. 0 904 323.
- II. Opposition was filed by the Respondent (Opponent) requesting revocation of the patent in suit in its entirety on the grounds of Article 100(a), (b) and (c) EPC.
- III. The Opposition Division held that the subject-matter of at least claims 11, 15 and 18 of the patent in suit offended Article 100(c) EPC.
- IV. With the statement setting out the grounds of appeal the Appellant filed an amended main request as well as an auxiliary request.
- V. In a communication accompanying the summons to oral proceedings, the Board expressed its preliminary opinion that the main request and the auxiliary request did not comply with the requirements of Articles 100(c) and 123(2) EPC.
- VI. In response to the Board's communication the Appellant filed an amended main request, an amended auxiliary request (subsequently named first auxiliary request) and a new second auxiliary request with letter dated 29 October 2010. By the same letter the Appellant informed the Board that it would not be attending the oral proceedings scheduled for the 29 November 2010.

The main request consists of 13 claims with independent claims 1 and 11-13 reading as follows:

- "1. A method of distributing biocide substantially uniformly in a powder coating composition, the method comprising:
- mixing precursors of a powder together with the biocide and heating the mixture, wherein the precursors to form a matrix of the coating composition are selected from epoxy, polyester, epoxy-polyester, nylon, acrylic, polyethylene, polypropylene and eva;
 - extruding the hot mixture into sheet form;
 - granulating the sheet;
 - grinding the granules to powder."
- "11. A substantially dry powder coating composition comprising particles of epoxy, polyester or epoxy-polyester each containing biocide, the biocide making up 0.1 to 20% by weight of the composition and being substantially uniformly distributed throughout the composition, when made by a method according to any of Claims 1 to 10."
- "12. A substantially dry powder coating composition comprising particles of epoxy, polyester or epoxy-polyester, each containing biocide, the biocide making up 0.1 to 20% by weight of the composition, the biocide being a trichlorohydroxydiphenylether, a methylurea, or an imidazolcarbamate, when made by a method according to any of Claims 1 to 10."
- "13. A method of providing biocidal activity to a coating applied to a substrate, the method

comprising applying a substantially dry powder coating composition according to any of Claims 11 to 12 to the substrate by electrostatic spraying followed by stoving."

The first auxiliary request is distinguished from the main request in that the expression "stoving" in claim 13 is replaced by the expression "stoving within the temperature range 140°C - 210°C.

The second auxiliary request consist of two claims which are identical to independent claim 1 and dependent claim 2 of the main request.

- VII. With letter dated 8 November 2010 the Respondent withdrew its request for oral proceedings.
- VIII. The arguments submitted by the Appellant in the written procedure to the extent that they are relevant for the present decision can be summarized as follows.

Claim 1 of the main request has been amended by introducing the feature "that the precursors to form a matrix of the coating composition are selected from epoxy, polyester, epoxy-polyester, nylon, acrylic, polyethylene, polypropylene and eva" and by deleting the word "polymer". Basis for the amendment in claim 1 of the main request can be found on page 4, paragraph 3 where a list of suitable materials to form the matrix of the coating is disclosed.

- IX. The Respondent did not comment on the main, first and second auxiliary requests filed with letter dated 29 October 2010.

X. The Appellant requested

- that the decision under appeal be set aside
- that the case be remitted to the Opposition Division for further prosecution concerning the grounds under Article 100(a) and (b) EPC on the basis of the main request or, alternatively, on the basis of the first or the second auxiliary request, all filed with letter dated 29 October 2010.

XI. The Respondent requested

- that the appeal be dismissed
- that the case be remitted to the Opposition Division for further prosecution concerning the grounds under Article 100(a) and (b) EPC, if the decision under appeal is set aside

XII. At the end of the oral proceedings which took place on 29 November 2010 in the absence of both parties, the decision of the Board was announced.

Reasons for the Decision

1. The appeal is admissible.

2. *Non-appearance at oral proceedings before the Board*

2.1 According to Article 15(3) of the Rules of Procedure of the Boards of Appeal (RPBA) the Board is not obliged to delay any step in the proceedings, including its

decision, by reason only of the absence at oral proceedings of any party duly summoned who may then be treated as relying only on its written case. By deciding not attend the oral proceedings, the Appellant chose not to avail itself of the opportunity to present its case orally but instead to rely solely on its written arguments.

- 2.2 The Appellant was informed with a communication annexed to the summons to oral proceedings of the Board's objections under Articles 100(c) and 123(2) EPC. In response it filed amended and new requests (see point VI above). In view of the Board's objections and in view of the new wording of at least claim 1 in all these requests, the Appellant must have expected that the question of their allowability under Article 123(2) EPC would be addressed by the Board at the oral proceedings. The Appellant was also aware of all the facts on which it would be judged, since deciding on the question of compliance with Article 100(c) and 123(2) EPC solely requires a comparison between the disclosure of the application as filed and the Appellant's requests.

Hence the Board concludes that the Appellant had reason and opportunity to present comments on the grounds and evidence on which the Board's decision, arrived at during oral proceedings, is based. Consequently, the requirement of Article 113(1) EPC is satisfied.

- 2.3 The Board was therefore in a position to take a final decision at the oral proceedings on the case before it, notwithstanding the absence of the duly summoned Appellant.

3. *Late filed requests*

The main request as well as the first and second auxiliary requests were filed by the Appellant with letter of 29 October 2010 in response to the objections raised by the Board in its communication annexed to the summons. Since part of the objections were raised for the first time, the Board in exercising its discretion under Article 13(1) RPBA decides to admit these requests into the proceedings.

Main request, first and second auxiliary request

4. *Amendments (Article 123(2) EPC)*

4.1 Claim 1 of the main request as well as the first and second auxiliary request differs from claim 1 as granted in that the feature "*wherein the precursors to form a matrix of the coating composition are selected from epoxy, polyester, epoxy- polyester, nylon, acrylic, polyethylene, polypropylene and eva*" has been introduced into the first step of the claimed method, namely the mixing and heating step of the precursors and the biocide. Additionally, in the same step the term "polymer" has been deleted from the expression "mixing precursors of a polymer powder".

4.2 According to the Appellant this amendment is supported by paragraph 3 on page 4 of the application as filed.

4.3 The Board does not share the Appellant's opinion.

4.3.1 The general method of claim 1 of the patent in suit finds support solely on page 2, paragraph 4 of the

application as filed. This paragraph refers to the incorporation of the biocide into the powder to form the matrix of the coating during the manufacture of the powder by adding the biocide at the initial mixing stage of the constituents which are to be converted into the desired powder. It furthermore refers to a typical powder manufacturing process, where the **precursors** of the desired powder, **e.g. the resin base and its hardener, together with any other additives** are mixed, heated and extruded to sheet form, the sheet form is granulated and then ground to the desired **powder** size. The resin base, hardeners or other additives are not further defined.

4.3.2 On page 4, paragraph 3 of the application as filed reference is made to "**suitable materials** to form the matrix of the coating composition". These materials "include epoxy, polyesters and epoxy-polyester and **are available in powder form, pre-pigmented and to provide a variety of desired surface finishes - gloss, matt and textured**". Additionally, the use of "*other polymeric powders materials, e.g. thermoset materials, e.g. nylon, acrylics, polyethylene, polypropylene and eva*" is suggested.

4.3.3 From the wording it is apparent that this statement refers to already manufactured powders to form the matrix of the coating containing pigments and the necessary additives to obtain the desired coating properties. Such powders were used in the examples of the application as filed, where the manufactured matrix powder and the biocide are simply mixed (see example 1, page 5, last two lines: "*the matrix powder was a proprietary polyester*"; example 2, page 7, lines 7-8:

"the matrix powder was a polyester supplied under the identification OMEGA PC P6/035"). The statement on page 4 of the application as filed does not mention precursors or constituents to be converted into the desired matrix powder as described on page 2, paragraph 4, but to suitable powder materials. This statement therefore does not provide a clear and unambiguous basis for the amendment "*wherein the **precursors** to form a matrix of the coating composition are selected from epoxy, polyester, epoxy- polyester, nylon, acrylic, polyethylene, polypropylene and eva*" in the mixing a heating step of the method according to claim 1 of the main request. Neither is the Board aware of any other part of the application as filed which could support this amendment.

Hence, claim 1 of the main request as well as the first and second auxiliary requests do not fulfil the requirements of Article 123(2) EPC, with the consequence that these requests must be refused.

Order

For these reasons it is decided that:

The appeal is dismissed.

The Registrar:

The Chairman:

M. Schalow

P. Ranguis