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**Datasheet for the decision
of 6 September 2013**

Case Number: T 0375/11 - 3.3.01

Application Number: 01974468.9

Publication Number: 1328591

IPC: C09D 5/02, C09D 167/00,
C09D 167/08

Language of the proceedings: EN

Title of invention:
Aqueous polyester coating compositions

Patent Proprietor:
DSM IP Assets B.V.

Opponent:
Akzo Nobel Coatings International N.V.

Headword:
Coating compositions/DSM

Relevant legal provisions:
-

Keyword:
"Main request; auxiliary requests 1, 2: added matter (yes)"
"Auxiliary requests 3, 4: admission (no)"

Decisions cited:
T 1033/10

Catchword:
-



Case Number: T 0375/11 - 3.3.01

D E C I S I O N
of the Technical Board of Appeal 3.3.01
of 6 September 2013

Appellant: DSM IP Assets B.V.
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Decision under appeal: Decision of the Opposition Division of the
European Patent Office posted 14 December 2010
revoking European patent No. 1328591 pursuant
to Article 101(2) EPC.

Composition of the Board:

Chairman: C. M. Radke
Members: L. Seymour
D. S. Rogers

Summary of Facts and Submissions

I. European patent No. 1 328 591, filed as application number 01 974 468.9, based on the international application published as WO 02/33008, was granted on the basis twenty-three claims. Claim 1 as granted reads as follows (emphasis added):

"1. An aqueous coating composition comprising:

an ambient temperature crosslinkable water-dispersible polyester oligomer(s) less than 80% by weight soluble in water throughout the pH range of from 2 to 10, with a measured weight average molecular weight in the range of from 1,000 to 100,000 Daltons; and
a dispersed polymer(s) which is not a polyester oligomer, **the dispersed polymer(s) having a lower limit of 10% by weight**, with a measured weight average molecular weight $\geq 120,000$ Daltons;

wherein said composition when drying to form a coating has the following properties:

- i) an open time of at least 20 minutes at $23 \pm 2^\circ\text{C}$;
- ii) a wet edge time of at least 10 minutes at $23 \pm 2^\circ\text{C}$;
- iii) a thumb hard time of ≤ 48 hours at $23 \pm 2^\circ\text{C}$;
- iv) a tack-free time of ≤ 20 hours at $23 \pm 2^\circ\text{C}$;
- v) 0 to 25% of co-solvent by weight of the composition; and
- vi) an equilibrium viscosity of $\leq 1,500$ Pa.s, at any solids content when drying in the range of from 20 to 55% by weight of the composition, using any shear rate in the range of from 9 ± 0.5 to 90 ± 5 s^{-1} and at $23 \pm 2^\circ\text{C}$."

Dependent claims 20 and 21 read as follows:

"20. An aqueous coating composition according to any one of the preceding claims comprising:

- i) 3 to 26% of a crosslinkable oligomer(s) by weight of the composition of which at least 52 wt% is said crosslinkable water-dispersible polyester oligomer(s);
- ii) 0 to 6.5% of a non-crosslinkable oligomer(s) by weight of the composition;
- iii) 10 to 56% of dispersed polymer(s) by weight of the composition;
- iv) 0 to 15% of co-solvent by weight of the composition;
- v) 5 to 65% of water by weight of the composition;

where i) + ii) + iii) + iv) + v) = 100%.

21. An aqueous coating composition according to any one of the preceding claims comprising:

- i) 14 to 40% of a crosslinkable oligomer(s) by weight of crosslinkable oligomer(s), non-crosslinkable oligomer(s) and dispersed polymer(s) of which at least 52 wt% is said crosslinkable polyester oligomer(s);
- ii) 0 to 10% of a non-crosslinkable oligomer(s) by weight of crosslinkable oligomer(s), non-crosslinkable oligomer(s) and dispersed polymer(s);
- iii) 50 to 85% of dispersed polymer(s) by weight of crosslinkable oligomer(s), non-crosslinkable oligomer(s) and dispersed polymer(s);

where i) + ii) + iii) = 100%."

II. An opposition was filed and revocation of the patent in its entirety requested pursuant to Articles 100(c) and 100(a) EPC (lack of inventive step).

III. The appeal lies from the decision of the opposition division revoking the patent under Article 101(2) EPC. The opposition division considered that the subject-matter of claims 1 and 4 as granted extended beyond the content of the application as originally filed.

IV. The appellant (patentee) lodged an appeal against this decision, and filed two auxiliary requests with the statement of grounds of appeal.

Claim 1 of auxiliary request 1 differed from claim 1 of the main request *inter alia* with respect to the introduction of "an upper limit of 90% by weight" in the definition of the amount of the dispersed polymer(s) present (cf. point I above, feature highlighted in bold in claim 1).

In claim 1 of auxiliary request 2, said upper limit was limited to "80% by weight"; in addition the "crosslinkable water-dispersible polyester oligomer(s)" was defined as being "in an amount from 20 to 90% by weight".

V. In its reply of 20 July 2011, the respondent (opponent) maintained its objection under Article 100(c) EPC regarding the main request, and raised objections under Article 123(2) EPC with respect to the appellant's auxiliary requests.

VI. A communication by the board, dated 18 June 2013, was sent as annex to the summons for oral proceedings. In connection with objections raised under Articles 100(c) and 123(2) EPC, the following was stated in point 6.1:

"With respect to the feature "the dispersed polymer(s) having a lower limit of 10% by weight" specified in the respective claims 1 and 4, it is noted that the point of reference for the percentage is not specifically defined. However, from the syntax of the claims, the figure of "10% by weight" can be understood to relate to the subject of the claim, namely, the "aqueous coating composition". In contrast, the passage referred to by the appellant on page 22, lines 1 to 5, of the application as originally filed relates to the relative proportions of specific components in the composition, namely, of "crosslinkable polyester oligomer (s) (and other crosslinkable or non-crosslinkable oligomers if used)" with respect to "the dispersed polymer(s)". It would therefore appear to be doubtful that the latter can be regarded as providing a direct and unambiguous basis for the former."

VII. During the course of oral proceedings, held before the board on 6 September 2013, the appellant presented two additional auxiliary requests, labelled "Request 3" and "Request 4".

In claims 1 of both these requests, the feature "the dispersed polymer(s) having a lower limit of 10% by weight", present in claim 1 as granted, was deleted; in addition, the claimed compositions were defined as comprising two alternative groups of features as listed

in dependent claims 20 and 21 as granted (cf. above point I).

VIII. The appellant's arguments, insofar as they are relevant to the present decision, may be summarised as follows:

In the written appeal proceedings, the appellant initially based its arguments on the premise that the feature "a lower limit of 10% by weight" appearing in claim 1 as granted (main request) defined the minimum amount of dispersed polymer in the composition (see statement of grounds of appeal, page 4, section A, in particular, paragraph 4). However, at oral proceedings before the board, the appellant rejected this claim construction. Instead, it was argued that the claimed compositions comprised two components, namely, "an ambient temperature crosslinkable water-dispersible polyester oligomer(s)" (PEO) and "a dispersed polymer(s)" (DP). In the light of the patent specification as a whole, the skilled person would understand the figure of "10% by weight" to define the amount of DP with respect to the sum of the two components PEO and DP.

The basis in the application as originally filed for said lower limit of 10% could be found in the first paragraph on page 22 (lines 1 to 5). Here, preferred weight ratios in the solid material of PEO and DP were defined. The feature "other crosslinkable or non-crosslinkable oligomers" in said paragraph was merely to be seen as optional. When there were no other solid ingredients present apart from PEO and DP, the ratios disclosed could also be used to calculate absolute weight percentages of these two components.

Consequently, the appellant submitted that the minimum percentage of 10% for DP could be derived from the ratio of PEO to DP of 90:10 disclosed in line 4 on page 22.

In its statement of grounds of appeal (see page 4, section A, paragraph 2), the appellant further pointed to the embodiment described on page 24, lines 1 to 9 of the application as originally filed as using weight percentages rather than weight ratios to define the amount of the PEO and DP ingredients.

With respect to the subject-matter of claim 1 of auxiliary request 1, the appellant submitted that this complied with Article 123(2) EPC. The introduced upper limit of 90% by weight of DP was based on the weight ratio of PEO to DP of 10:90, as disclosed on page 22, line 3 of the application as originally filed. Analogous arguments applied as for claim 1 of the main request.

In auxiliary request 2, PEO was defined as being in an amount from 20 to 90% by weight and DP in an amount from 10 to 80% by weight. The basis in the application as originally filed was to be found on page 22, lines 3 and 4, which disclosed the preferred weight ratio of PEO to DP "in the range of from 90:10 to 20:80".

Turning to the issue of admissibility of auxiliary requests 3 and 4 (respectively "Request 3" and "Request 4" submitted during oral proceedings before the board, cf. above point VII), the appellant argued that it had not thought it to be appropriate to file these prior to oral proceedings since it had not wanted

to unnecessarily burden the board and the respondent with numerous requests containing various permutations of amendments relating to different disputed features. The appellant had therefore decided to wait and to see how the discussion would go at oral proceedings, so that it could file new requests in a more focused manner. Moreover, the amendments introduced did not disadvantage the respondent, since they mainly consisted in simple combinations of independent claims with dependent claims as granted.

- IX. The respondent's arguments, insofar as they are relevant to the present decision, may be summarised as follows:

The respondent disputed that the feature relating to the amount of DP in the composition had a basis in the application as originally filed. In particular, the passage on page 22, lines 1 to 5, clearly defined weight ratios of specific components rather than percentages by weight of composition.

Moreover, the respondent submitted that auxiliary requests 3 and 4 should not be admitted into the proceedings, since the deficiencies with respect to added matter had been an issue throughout the opposition and appeal proceedings. Such a late filing of attempts at overcoming objections that had long been known was not in keeping with the purpose of appeal proceedings.

- X. The appellant (patent proprietor) requested that the decision under appeal be set aside and that, as a main request, the patent be maintained as granted, or

alternatively, that the case be remitted to the department of first instance for further prosecution upon the basis of auxiliary requests 1 or 2 filed with the statement of grounds of appeal, or alternatively upon the basis of the claims of Request 3 or Request 4 filed at the oral proceedings on 6 September 2013.

The respondent (opponent) requested that the appeal be dismissed and that Request 3 and Request 4 of the appellant not be admitted into the proceedings.

XI. At the end of the oral proceedings, the decision of the board was announced.

Reasons for the Decision

1. The appeal is admissible.
2. *Main request, claim 1 as granted - Article 100(c) EPC*
 - 2.1 Since the feature "the dispersed polymer(s) having a lower limit of 10% by weight" in claim 1 as granted does not appear verbatim in the application as originally filed, the question arises whether the subject-matter of this claim is directly and unambiguously derivable from the application as originally filed.

For the sake of conciseness, in the discussion below, the board will employ the acronyms assigned by the appellant to "an ambient temperature crosslinkable water-dispersible polyester oligomer(s)" and "a

dispersed polymer(s)", namely, PEO and DP, respectively (cf. above point VIII).

- 2.2 The first issue that has to be decided in this context is how the feature "the dispersed polymer(s) having a lower limit of 10% by weight" is to be construed.

The first line of claim 1 as granted reads, "An aqueous coating composition comprising:". This is followed by a list of components and properties of the composition (cf. above point I). From this syntax, the only logical point of reference for the "lower limit of 10% by weight" is the subject of the claim, that is, the composition being defined. In the absence of any explicit indication in the claim to the contrary, there exists no reason that would justify any other interpretation. Indeed, as outlined above in point VIII, this was the way in which the appellant initially read claim 1, as being consistent with the embodiment on page 24, lines 1 to 9 of the application as originally filed (paragraph [0116] of the patent in suit).

Contrary to the submissions of the appellant, the description cannot be relied on to give clear terms anything other than their ordinary meaning within the wording of the claim. As explained above, the meaning of the feature in question is clear within the context of claim 1 as granted, and there is no discrepancy between the claims and the description. The skilled person would therefore have no cause to turn to the description in order to seek alternative interpretations.

The board therefore concludes that the feature "the dispersed polymer(s) having a lower limit of 10% by weight" in claim 1 as granted designates a percentage relative to the total weight of composition.

- 2.3 The only disclosure of a lower limit of 10% of DP by weight of the composition in the application as originally filed (see page 24, lines 1 to 9; claim 23) is in the limited context of a specific composition comprising components i) to v), which are defined as detailed above in point I for claim 20 as granted, whereby component iii) is "**10** to 56% of dispersed polymer(s) by weight of the composition" (emphasis added). In view of the very specific nature of this disclosure, it cannot provide the basis for the feature now appearing in the general context of claim 1 as granted.

The paragraph referred to by the appellant on page 22, lines 1 to 5 of the application as originally filed, which is discussed in more detail in the next section (point 2.4), relates to the relative proportions of specific components of the composition, and not to the amount of any specific component in the composition as a whole. This paragraph cannot therefore provide a basis for the disputed feature.

- 2.4 Moreover, even if, for the sake of argument, the board were to accept the appellant's reading of claim 1 as granted according to which the "lower limit of 10% by weight" defined the amount of DP with respect to the sum of PEO and DP, rather than the composition as a whole, this would not change the conclusion that no

basis can be found in the application as originally filed for the disputed feature.

The appellant relied in this respect on the paragraph on page 22, lines 1 to 5 of the application as originally filed, which reads as follows (emphasis added):

"Preferably the ratios by weight of solid material of crosslinkable polyester oligomer(s) **(and other crosslinkable or non-crosslinkable oligomers if used)** to the dispersed polymer(s) in the range of from 100:0 to 10:90, more preferably in the range of from 90:10 to 20:80, still more preferably in the range of from 80:20 to 25:75 and especially in the range of 60:40 to 30:70."

The appellant submitted that the presence of the components highlighted above in bold was optional, and therefore that percentages of DP by weight of DP and PEO could be derived from the ratios disclosed. However, this reading does not accurately reflect that which is actually stated in the above paragraph, namely, that, when other oligomers are present, which is not excluded in claim 1 as granted, they must be taken into account when calculating the ratios defined. In other words, the values that are in fact derivable from the ratios disclosed in this paragraph are percentages by weight of DP relative to the sum of DP and all oligomers present, and not just PEO alone, as argued by the appellant (cf. component iii in claim 24 as originally filed, which corresponds to claim 21 as granted, see above point I).

2.5 Consequently, the main request fails because it includes subject-matter which extends beyond the content of the application as originally filed (Article 100(c) EPC).

3. *Auxiliary request 1, claim 1 - Article 123(2) EPC*

In claim 1 of auxiliary request 1, DP is defined as being present in "a lower limit of 10% and an upper limit of 90% by weight".

The introduction of an upper limit does not alter the arguments presented for the main request. Indeed, the appellant did not make any additional submissions in favour of auxiliary request 1 in this respect.

Hence, the subject-matter of claim 1 according to auxiliary request 1 does not meet the requirements of Article 123(2) EPC.

4. *Auxiliary request 2, claim 1 - Article 123(2) EPC*

In claim 1 of auxiliary request 2, PEO is defined as being present "in an amount from 20 to 90% by weight" and DP as "having a lower limit of 10% and an upper limit of 80% by weight".

It is noted that the point of reference for the percentages introduced is still not specifically defined in claim 1. In the absence of any such indication, the board sees no reason to deviate from the claim construction as outlined under point 2.2, according to which these features designate percentages relative to the total weight of composition. If the

appellant had wished to argue for a different interpretation, this should have been explicitly reflected in the amendments introduced.

Therefore, in view of the fact that the feature relating to the "lower limit of 10% ... by weight" is still present in claim 1, the considerations presented above in point 2.3 apply *mutatis mutandis*.

Moreover, even were the appellant's reading to be accepted, according to which the ranges in claim 1 defined percentages with respect to the weight of PEO and DP, the analysis outlined above in point 2.4 would also apply *mutatis mutandis*. In particular, as explained above, "the range of from 90:10 to 20:80" as disclosed on page 22 of the application as originally filed (lines 3, 4) does not refer to ratios of PEO to DP, but to ratios of all oligomers present to DP.

Therefore, the additional amendments introduced cannot lead to a different conclusion with respect to added matter to that reached for the main request and auxiliary request 1 (Article 123(2) EPC).

Consequently, the subject-matter of claim 1 according to auxiliary request 2 does not meet the requirements of Article 123(2) EPC.

5. *Auxiliary requests 3 and 4 - Admissibility*

5.1 Auxiliary requests 3 and 4 were submitted during the oral proceedings before the board (cf. above point VII).

Article 13(1) of the Rules of Procedure of the Boards of Appeal (see Supplement to OJ EPO 1/2013, 38 to 49) provides that any amendment to a party's case after it has filed its grounds of appeal or reply may be admitted and considered at the board's discretion, which shall be exercised in view of *inter alia* the complexity of the new subject-matter submitted, the current state of the proceedings and the need for procedural economy. These last two criteria imply a requirement on a party to present appropriate requests as soon as possible if such requests are to be admitted and considered (see e.g. T 1033/10, point 5.5 of the Reasons).

In the present case, the ground for revocation of the patent in suit was based on Article 100(c) EPC. In its letter of 20 July 2011 in reply to the statement of grounds of appeal, the respondent maintained its objection under Article 100(c) EPC regarding the main request, and raised objections under Article 123(2) EPC with respect to the appellant's auxiliary requests 1 and 2, *inter alia* in view of the feature "having a lower limit of 10% by weight" (see points 2.1, 3.1 and 4.1 of letter). This issue was also addressed by the board in its communication annexed to the summons to oral proceedings (see above point VI).

Therefore, the appellant had ample opportunities to file additional requests aimed at overcoming these objections at a much earlier stage in the procedure, and should have done so, if it had considered this to be necessary.

In this context, it is emphasised that no new facts or arguments were raised for the first time in the discussions during oral proceedings, and the appellant did not argue that this was the case.

The board therefore concludes that the timing of these submissions cannot be regarded as being an appropriate response to the course of proceedings.

- 5.2 The board is not convinced by the justification provided by the appellant for waiting until oral proceedings to file auxiliary requests 3 and 4 (cf. above point VIII, last paragraph).

Contrary to the appellant's assertions, the amendments to its requests filed during oral proceedings cannot be regarded as being simple in nature, since independent claims 1 and 4 were substantially amended, with the introduction of numerous features (cf. above point VII). In addition, the feature "the dispersed polymer(s) having a lower limit of 10% by weight" was deleted from these independent claims, a feature that is also absent in the group of features incorporated from claim 21 as granted.

Moreover, the appellant did not make a convincing case as to why it would not have been possible to file a limited number of requests in a timely manner, in order to clarify in advance of oral proceedings the approaches that it intended to follow in attempting to overcome the objections raised. Contrary to the appellant's stated intention, it is the avoidable late filing of extensive amendments that places a burden on the board and the respondent, by curtailing the

possibility for them to acquaint themselves thoroughly with the appellant's case. As a result, the respondent is also put at a disadvantage in exercising its right to present its case.

5.3 Consequently, the board decided not to admit auxiliary requests 3 and 4 into the appeal proceedings.

Order

For these reasons it is decided that:

The appeal is dismissed.

The Registrar:

The Chairman:

M. Schalow

C. M. Radke