

Internal distribution code:

- (A) [] Publication in OJ
(B) [] To Chairmen and Members
(C) [X] To Chairmen
(D) [] No distribution

**Datasheet for the decision
of 9 January 2013**

Case Number: T 2526/11 - 3.3.01
Application Number: 03779813.9
Publication Number: 1556452
IPC: C09D 183/04, C09D 183/08,
C09D 4/00
Language of the proceedings: EN

Title of invention:
Process and composition for coating

Patentee:
Nanogate AG

Opponent:
Evonik Degussa GmbH

Headword:
Generation of a silane based coating/NANO GATE

Relevant legal provisions:
EPC Art. 113(1), 100, 84
EPC R. 80
RPBA Art. 11, 15(1), 13(1)

Keyword:
"Right to be heard (yes) - Discretion of the opposition
division not to postpone the oral proceedings - Right
principles applied"
"Admissibility of the amendment (no) - Reformulation of the
wording of claim 1 - not occasioned by a ground of opposition"
"Late-filed requests (not admitted) - Could have been filed
earlier - contravene the need for procedural economy"

Decisions cited:

T 1505/06, T 0699/06, T 1102/03

Catchword:

-



Case Number: T 2526/11 - 3.3.01

DECISION
of the Technical Board of Appeal 3.3.01
of 9 January 2013

Appellant: Nanogate AG
(Patent Proprietor) Zum Schacht 3
D-66287 Quierschied-Göttelborn (DE)

Representative: Jönsson, Hans-Peter
von Kreisler Selting Werner
Deichmannhaus am Dom
Bahnhofsvorplatz 1
D-50667 Köln (DE)

Respondent: Evonik Degussa GmbH
(Opponent) Paul-Baumann-Straße 1
D-45764 Marl (DE)

Representative: Fleischer, Holm Herbert
Fleischer, Godemeyer, Kierdorf & Partner,
Patentanwälte
polypatent
Braunsberger Feld 29
D-51429 Bergisch Gladbach (DE)

Decision under appeal: Decision of the Opposition Division of the
European Patent Office posted 18 October 2011
revoking European patent No. 1556452 pursuant
to Article 101(3) (b) EPC.

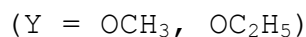
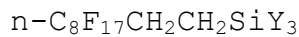
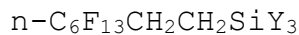
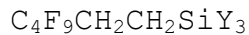
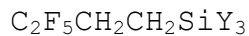
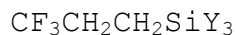
Composition of the Board:

Chairman: C. M. Radke
Members: J.-B. Ousset
C.-P. Brandt

Summary of Facts and Submissions

- I. The proprietor filed an appeal against the opposition division's decision revoking European patent No. 1 556 452.
- II. The patent was revoked on the grounds that the then pending main request contravened the requirements of Articles 123(3) and 84 EPC.
- III. With its statement setting out the grounds of appeal, the appellant submitted a new set of claims. Claim 1 of this request reads as follows:

"1. A process for the generation of a uniform oleophobic and/or hydrophobic coating on a substrate by spraying a coating material onto a substrate, characterized by coating siliceous glass and/or ceramic substrates with a coating material containing a catalyst being initiated after application of the coating material and at least one silane being a fluorinated silane selected from



in an amount of less than 10% by weight in a liquid carrier and that it exhibits a droplet size of up to 100 μm diameter in average when leaving the spray nozzle during spray-coating."

- IV. In its reply of 5 July 2012, the respondent and only opponent held that the set of claims filed by the appellant contravened Rule 80 EPC, since the reformulation of the wording of claim 1 did not aim at removing a ground of opposition.
- V. In its second letter of 6 December 2012, the appellant responded that the amendments in claim 1 were occasioned by the grounds of opposition under Article 100 (a) EPC.
- VI. The appellant argued as follows:
- By refusing to postpone the oral proceedings scheduled for 26 September 2011, the opposition division had deprived it of its right to be heard. It cited the decisions T 1102/03 and T 1505/06 in support of this argument. Although the conference in the USA was not firmly booked, the speech was scheduled for 24 September 2011 and it was not possible to fly back on Sunday to Europe in time for the oral proceedings. Moreover, three additional oral proceedings before the EPO had been scheduled for the same week.
 - The reformulation of the wording of claim 1 did not modify the scope of protection of the claims as granted. In view of Article 84 EPC it was necessary and sensible to make the wording of claim 1 clear and concise. Moreover, this article of the EPC took precedence over Rule 80 EPC. Furthermore, it held that the amendments were intended to overcome the grounds of opposition.

- The board had not issued a communication indicating its preliminary opinion as to whether the amended claims met the requirements of Rule 80 EPC.
- Therefore, the appellant had been informed of the opinion of the board only during oral proceedings and did not have any hint as to whether the amendments were admissible. To give the appellant the chance to defend its case, auxiliary requests 2 and 3 should be admitted into the proceedings.

VII. The respondent's arguments can be summarised as follows:

- The intended restriction to certain silanes did not occasion the complete reformulation of the wording of claim 1 in the request filed with the appellant's letter of 24 February 2012. The amendments thus contravened Rule 80 EPC.
- The objection had already been raised in the letter of 5 July 2012. The appellant could therefore not be surprised. Editorial amendments were in contradiction with the requirements of Rule 80 EPC.
- It was not necessary that the board gave a preliminary opinion. It was the duty of the parties to formulate their requests.
- When an objection was raised, a new request could be submitted. The admissibility of new submissions

during oral proceedings was subject to the requirements of Article 13 RPBA. Moreover, an objection according to Rule 80 EPC had been raised and the appellant had not submitted any new request to overcome it in its answer of 6 December 2012.

- VIII. The appellant (patent proprietor) requested that the decision under appeal be set aside and that the case be remitted to the department of first instance for further prosecution (main request) or, alternatively, that the patent be maintained either on the basis of claims 1 to 5 of the first auxiliary request filed with letter of 24 February 2012 or, alternatively, on the basis of claims 1 to 5 of auxiliary request 2 or 3 both filed during oral proceedings on 9 January 2013.
- IX. The respondent (opponent) requested that the appeal be dismissed.
- X. The second and third auxiliary requests filed during the oral proceedings before the board each contain claim 1 as the only independent claim.

Claim 1 of the second auxiliary request reads as follows:

"1. A process for the generation of a uniform oleophobic and/or hydrophobic coating on a substrate by spraying a coating material onto a substrate, characterized by coating siliceous glass and/or ceramic substrates with a coating material containing a catalyst and at least one silane being a fluorinated silane selected from

$\text{CF}_3\text{CH}_2\text{CH}_2\text{SiY}_3$
 $\text{C}_2\text{F}_5\text{CH}_2\text{CH}_2\text{SiY}_3$
 $\text{C}_4\text{F}_9\text{CH}_2\text{CH}_2\text{SiY}_3$
 $n\text{-C}_6\text{F}_{13}\text{CH}_2\text{CH}_2\text{SiY}_3$
 $n\text{-C}_8\text{F}_{17}\text{CH}_2\text{CH}_2\text{SiY}_3$
 $n\text{-C}_{10}\text{F}_{21}\text{CH}_2\text{CH}_2\text{SiY}_3$
(Y = OCH_3 , OC_2H_5)

in an amount of less than 10% by weight in a liquid carrier and that it exhibits a droplet size of up to 100 μm diameter in average when leaving the spray nozzle during spray-coating, wherein said catalyst is initiated after application of the coating material."

Claim 1 of the third auxiliary request reads as follows:

"1. A process for the generation of a uniform oleophobic and/or hydrophobic coating on a substrate by spraying a coating material onto a substrate, characterized in that said coating material containing a catalyst and at least one silane in an amount of less than 10 % by weight in a liquid carrier and that it exhibits a droplet size of up to 100 μm diameter in average when leaving the spray nozzle during spray-coating and that siliceous glass and/or ceramic substrates are coated and that that said silane is an alkylsilane conforming to

$\text{CF}_3\text{CH}_2\text{CH}_2\text{SiY}_3$
 $\text{C}_2\text{F}_5\text{CH}_2\text{CH}_2\text{SiY}_3$
 $\text{C}_4\text{F}_9\text{CH}_2\text{CH}_2\text{SiY}_3$
 $n\text{-C}_6\text{F}_{13}\text{CH}_2\text{CH}_2\text{SiY}_3$
 $n\text{-C}_8\text{F}_{17}\text{CH}_2\text{CH}_2\text{SiY}_3$
 $n\text{-C}_{10}\text{F}_{21}\text{CH}_2\text{CH}_2\text{SiY}_3$
(Y = OCH_3 , OC_2H_5),

wherein said catalyst is initiated after application of the coating material."

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. Article 113 - Right to be heard
 - 2.1 According to Article 11 RPBA the board remits the case to the department of the first instance if fundamental deficiencies are apparent in first-instance proceedings. During the oral proceedings before the board on 9 January 2013, and hence at a very late stage of the appeal proceedings, the representative of the appellant contended for the first time that its right to be heard had been violated by refusing its request to postpone the oral proceedings of 26 September 2011 (Monday) before the opposition division. The reason given for the postponement was a lecture to be given at a conference on 23/24 September 2011 in Carolina (US). As announced by fax dated 26 August 2011, the representative did not attend the oral proceedings before the opposition division.
 - 2.2 When exercising its discretion in deciding whether or not to postpone oral proceedings, the opposition division has to take into account the particular circumstances of the case. Given this discretion of the opposition division the principal task of the board of

appeal is to consider whether the opposition division exercised its discretion in a reasonable way.

- 2.3 In order to safeguard a party's right to be heard pursuant to Article 113(1) EPC not only must the party be granted the procedural possibility of presenting comments but also the EPO has to take into due account the arguments and submissions of the party. These requirements were met by the procedure applied by the opposition division when dealing with the said request for postponement.
- 2.4 With communication dated 27 May 2011 the opposition division replied to the request for postponement filed with the applicant's fax of 4 May 2011, explaining that the request could not be granted because the fact that the representative was to speak at a conference did not fall under the exceptional reasons for which the change of date of oral proceedings was allowed according to the case law of the boards of appeal. The opposition division quoted the pertinent pages of the 5th edition of the Case Law of the Boards of Appeal. It repeated its refusal of the request for postponement with communication of 8 September 2011, now referring to the current (6th) edition of the case law book, the appellant having complained that it had cited an old edition.
- 2.5 In the decision under appeal the opposition division reiterated the objection made in its previous communications and summarised the issue of postponement, explaining why the reasoning of the appellant could not be followed. It held that the fact that the representative had to travel over the weekend in order

to attend oral proceedings scheduled for a Monday was not a sufficient reason to change the date of the oral proceedings. Furthermore, it explained why decisions T 1102/03 and T 1505/06, cited by appellant, did not support the appellant's request for postponement. In this context the opposition division pointed out that the journey to the US had not been firmly booked, as confirmed by the representative in the oral proceedings before the present board on 9 January 2013, and that the conference took place three days before the oral proceedings scheduled before the opposition division.

2.6 Hence, the opposition division did indeed take into account the arguments of the appellant when it exercised its discretion and decided on the request for postponement. It follows from the foregoing that it did not refuse the request for postponement merely by citing as outdated edition of the Case Law book, as the appellant has alleged.

2.7 Admittedly, the reasoning given by the opposition division for refusing the request is relatively brief and could indeed in some respects have been more detailed and comprehensive. However, the absence of possibly more detailed reasoning is certainly not a *fundamental* (emphasis by the board) deficiency requiring a remittal pursuant to Article 11 RPBA. Lastly, the reasons provided by the opposition division in its communications of 27 May 2011 and 8 September 2011 and in the decision under appeal are sufficiently clear and comprehensible to show that the arguments put forward by the appellant in support of its request had been taken into due account by the opposition division when exercising its discretion.

2.8 The board points out that the reason given for postponement, namely a speech to be held by the representative at a conference, is actually clearly and unambiguously not a serious substantive reason for a postponement, as is clear from the case law of the boards of appeal. That case law is also reflected in the Guidelines for Examination (Part E-III. 7, 2010) and in the Notice from the EPO dated 18 December 2008 concerning oral proceedings before the EPO (OJ EPO 2009, 68). The Guidelines are issued by the President of the European Patent Office in accordance with Article 10(2)(a) EPC. Although the Guidelines are not legally binding, the examining staff may depart from them only in exceptional cases and, as a general rule, parties can expect the EPO to act in accordance with the Guidelines.

2.9 It is correct that the list of serious reasons justifying a change of the date of oral proceedings in the Guidelines is not exhaustive. However, these reasons clearly all involve special circumstances (e.g. pre-existing oral proceedings, serious illness, or death within the family) or unavoidable commitments such as military service or other obligatory performance of civic duty. Business trips and holidays must have already been firmly booked in order to qualify as serious reasons for a postponement of oral proceedings. It has been explicitly confirmed by the appellant's representative that his trip to the US had not been firmly booked prior to the notification of the summons to oral proceedings on 26 September 2011. Furthermore it is obvious that a speech at a conference is not one of the serious reasons listed in the notice

of the EPO referred to in the Guidelines. Rather, in T 699/06 of 29 June 2010 (point 6 of the reasons) the board stated that such a commitment - to speak at a conference - was additional to the normal professional responsibilities of a representative. A representative who undertook such a commitment did so in the knowledge that this would make him unavailable to his clients, and unavailable to appear at any oral proceedings, on the dates in question. Therefore, as a reason for changing the date of oral proceedings, it was a reason which by definition resulted from excessive work pressure - excessive if only because it was a commitment which the representative was not obliged to undertake but which, having undertaken it, made him unavailable. Excessive work pressure was specifically mentioned in the notice from the EPO of 18 December 2008 as a non-acceptable reason (see paragraph 2.4 of the notice). With this legal situation in mind it is in principle irrelevant whether the representative had sufficient time to prepare and attend the oral proceedings once the conference in the US was over.

2.10 The decisions of the boards of appeal cited by the appellant during the opposition proceedings related to circumstances explicitly acknowledged as serious reasons for postponement of oral proceedings, namely serious illness (T 1505/06) and pre-booked holidays (T 1102/03). These decisions therefore cannot support the present request for postponement.

2.11 The appellant has failed to show - either in its written submissions or orally at the oral proceedings before the board on 9 January 2013 - why its request for postponement might nevertheless qualify as a

serious reason exceptionally allowing the requested change of date. It follows from the foregoing that its contention in the statement of grounds of appeal of 24 February 2012 that the decision regarding postponement had no basis in the EPC has to be considered as a mere allegation which lacks the necessary substantiation.

2.12 In the statement of grounds of appeal the appellant further contends that the reasoning given in the decision under appeal, namely that having to travel at weekends could not be regarded as sufficient reason not to attend oral proceedings, was not the reasoning of the appellant, since representatives could of course be expected to travel at weekends in order to attend oral proceedings. Rather, the correct reasoning was that it was physically impossible to get from the conference in the US in time for the oral proceedings in Munich given the time difference. Apart from that what has already been said above (point 2.9), this submission, however, was put forwarded for the first time in the statement of grounds of appeal, whereas the letters of the appellant filed during the opposition proceedings are silent about it. So too are the minutes of the oral proceedings before opposition division, due to the fact that the appellant did not attend them. Hence, this submission could not have been taken into account by the opposition division when taking its discretionary decision on the request for postponement and thus cannot be a basis for a contending that the division infringed the appellant's right to be heard.

2.13 In consequence, the decision of the opposition division not to postpone the oral proceedings scheduled for

26 September 2011 is fully justified and based on a reasonable exercise of its discretion. In this context it has also be taken into account that the request of the appellant's representative for postponement filed on 4 May 2011 was already its third request to change the date fixed for oral proceedings, following two previous requests which had already been granted, the second of which was due to a lecture to be held by the appellant's representative at a conference.

- 2.14 The request for postponement having been properly refused and the appellant duly summoned by communication dated 18 April 2011 for oral proceedings on 26 September 2011, the appellant had ample time to prepare for these oral proceedings. As long as a request for postponement of oral proceedings has not been granted, the requesting party cannot simply assume that it will be. The party has to consider the possibility of a refusal of the request and has to prepare the case accordingly to minimise the risk of time pressure (T 1102/03 of 28 May 2008, point 3.2 of the reasons). The right to be heard had thus been granted by the opposition division. By choosing not to attend oral proceedings, as announced with letter dated 26 August 2011, the appellant deliberately did not avail himself of his right to be heard and must therefore bear any adverse consequences.

Hence, the request to remit the case to the first instance is to be refused.

3. Auxiliary request 1 - Rule 80 EPC

3.1 According to Rule 80 EPC, any amendment in opposition proceedings except those under Rule 138 EPC must be occasioned by a ground of opposition under Article 100 EPC.

3.2 Compared to its granted version, present claim 1 was amended not only by

(1) restricting the type of silanes to be used, but also by

(2) completely reformulating the rest of the characterising part of the claim, i.e. by replacing the following wording in granted claim 1 "**...characterized in that** said coating material containing a catalyst and at least one silane in an amount of less than 10% by weight in a liquid carrier and that it exhibits a droplet size of up to 100 µm diameter in average when leaving the spray nozzle during spray-coating and that siliceous glass and/or ceramic substrates are coated and that said silane is an alkylsilane conforming to the general formula (I)... wherein said catalyst is initiated after application of the coating material" by "**...characterized by coating siliceous glass and/or ceramic substrates with a coating material containing a catalyst being initiated after application on the coating material and at least one silane being a fluorinated silane selected from ...** in an amount of less than 10% by weight in a liquid carrier and that it exhibits a droplet size of up to 100 µm diameter in average when leaving the spray nozzle during spray-coating".

3.3 Whereas amendment (1) might be occasioned by a ground of opposition, the appellant has not given any reason why this is also the case as far as reformulation (2) is concerned.

Its argument that this reformulation did not change the scope of protection does not take into account that such amendments have to meet both the requirements of Article 123(3) EPC (i.e. they must not extend the scope of protection) and of Rule 80 EPC (i.e. they must be occasioned by a ground of opposition under Article 100 EPC).

Nor is the board convinced by the appellant's argument that the reformulation was necessary in order to render the wording of the claim clear and concise, and, as Article 84 EPC takes precedence over Rule 80 EPC, was to be allowed.

On the one hand, Rule 80 EPC limits the allowable amendments (except those under Rule 138 EPC) to those occasioned by a ground of opposition under Article 100 EPC. As a lack of clarity and conciseness cannot be subsumed under such a ground of opposition, Rule 80 EPC clearly rules out amendments which only render the granted claims clearer and more concise, and so excludes any precedence of Article 84 over Rule 80 EPC.

Nor has the appellant explained why the reformulation was necessary in order to render the claim as amended clear and concise.

3.4 Hence, amended claim 1 of the first auxiliary request contravenes the requirements of Rule 80 EPC.

4. Auxiliary requests 2 and 3 - Article 13(1) RPBA

4.1 The admissibility of any amendments filed after the statement of the grounds of appeal or the reply is left to the discretion of the board. This discretion is to be exercised in view inter alia of the current state of the proceedings and the need for procedural economy (Article 13(1) RPBA).

4.2 These requests were filed during the oral proceedings before the board, i.e. at a very late stage of the proceedings. The appellant argued that these requests were a reaction to the objection under Rule 80 EPC against the claims of auxiliary request 1 first raised by the board during oral proceedings. This was surprising as the board had not issued a communication summarising its preliminary view on this point. Moreover, the appellant had offered to amend the claim (see page 3, third paragraph of the letter dated 6 December 2012).

4.2.1 In its reply to the appellant's statement setting out the grounds of appeal, the respondent explained why it considered claim 1 of the single set of claims filed by the appellant not to comply with Rule 80 EPC. The appellant replied to this letter by submitting an argument but without providing any further sets of claims. Realising that the board agreed with the respondent in that respect, the appellant filed these requests, which however, could have been filed earlier in the proceedings and more particularly with the appellant's letter of 6 December 2012, since an objection based on Rule 80 EPC had been raised by the

opposing party and any party should reckon with the board deciding against it. Filing these requests at a very late stage of the proceedings, namely almost at the end of oral proceedings, contravenes the requirement of procedural economy, since these requests, if accepted, would have to be examined as to their formal and substantive validity.

- 4.2.2 As to appellant's proposal to amend its claims if necessary, the board would point out the following.

Proposing to amend a request is not a valid reason to admit late-filed requests which could have been submitted during the written proceedings. Waiting for an opinion of the board as to a specific objection before performing an amendment in order to overcome said objection slows down the proceedings and is thus contrary to the requirement of procedural economy (Article 13(1) RPBA).

- 4.2.3 The appellant also submitted that the board did not provide any guidance in a previous communication to clarify its opinion as to the objection based on Rule 80 EPC, and that consequently the appellant learnt of the board's opinion only during the oral proceedings. The board has the possibility but not the obligation to send a communication to the parties setting out its preliminary and non-binding opinion (see Article 15(1) RPBA, supplement to OJ EPO 1/2011, page 45). The board might send a communication to notify the parties that a specific point not yet tackled by the parties in their submissions is of relevance and will have to be discussed during oral proceedings. However, in the present case, the objection based on Rule 80 EPC was

unambiguously formulated by the respondent in its letter of 5 July 2012 (see point 3.1) and the appellant commented on this objection (see its letter of 6 December 2012, page 2, paragraphs 3 and 4).

Hence, there was no reason for the appellant to expect a communication from the board if it regarded the claims of auxiliary request 1 as not allowable. Nor could an absence of such a communication be understood as an indication that the board considered these claims to be allowable. In the present case, such a communication would probably have given an advantage to one party, so that the other party might have considered the board to be partial.

Lastly, the board would emphasise that each party is responsible for making its own case and for presenting in due time counter-arguments and/or amended requests needed to overcome an objection raised by an opposing party.

4.3 Hence, contrary to the appellant's assertion, the board's objection based on Rule 80 EPC should not have surprised it, and it could and should have filed auxiliary requests 2 and 3 at an earlier stage for reasons of procedural economy.

4.4 For these reasons, the board declined to admit these auxiliary requests into the proceedings.

Order

For these reasons it is decided that:

The appeal is dismissed.

The Registrar

The Chairman

M. Schalow

C. M. Radke