

Internal distribution code:

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

**Datasheet for the decision
of 26 February 2018**

Case Number: T 0417/13 - 3.3.01

Application Number: 03741936.3

Publication Number: 1511816

IPC: C09D127/06, C09D7/12

Language of the proceedings: EN

Title of invention:

COATING COMPOSITION HAVING POLYVINYL CHLORIDE EXTENDER
PARTICLES

Patent Proprietor:

Sherwin-Williams Luxembourg Investment
Management Company S.à r.l.

Opponent:

Akzo Nobel Coatings International B.V.

Headword:

PVC EXTENDER PARTICLES/SHERWIN

Relevant legal provisions:

EPC Art. 100(b), 83, 111(1), 113(1)

Keyword:

Grounds for opposition - insufficiency of disclosure (no)
Right to be heard - violation (no)
Appeal decision - remittal to the department of first instance
(yes)

Decisions cited:

T 0225/93, T 0805/93, T 0646/13, T 1811/13, R 0008/15



Beschwerdekammern

Boards of Appeal

Chambres de recours

Boards of Appeal of the
European Patent Office
Richard-Reitzner-Allee 8
85540 Haar
GERMANY
Tel. +49 (0)89 2399-0
Fax +49 (0)89 2399-4465

Case Number: T 0417/13 - 3.3.01

D E C I S I O N
of Technical Board of Appeal 3.3.01
of 26 February 2018

Appellant: Sherwin-Williams Luxembourg Investment
(Patent Proprietor) Management Company S.à r.l.
5, Rue du Kiem
1857 Luxembourg (LU)

Representative: Dannenberger, Oliver Andre
Abitz & Partner
Patentanwälte mbB
Postfach 86 01 09
81628 München (DE)

Respondent: Akzo Nobel Coatings International B.V.
(Opponent) Velperweg 76
6824 BM Arnhem (NL)

Representative: Akzo Nobel IP Department
Velperweg 76
6824 BM Arnhem (NL)

Decision under appeal: **Decision of the Opposition Division of the
European Patent Office posted on 12 December
2012 revoking European patent No. 1511816
pursuant to Article 101(3) (b) EPC**

Composition of the Board:

Chairman A. Lindner
Members: M. Pregetter
L. Bühler

Summary of Facts and Submissions

I. European patent No. 1 511 816 is based on European patent application No. 03 741 936.3, filed as an international application published as WO2003/106574.

II. The following documents, cited during the opposition and appeal proceedings, are referred to below:

(2) Rawle A., "The Basic Principles of Particle Size Analysis", pages 1-8

(2a) Rawle A., 2002, Advances in Colour Science and Technology, vol. 5(1), 1-12

(3) Goldschmidt A., Streitberger H.J., "BASF Handbook on Basics of Coating Technology", 2003, 300-315

(4) Cadle R.D., Particle Size Determination, 1955, 92-101

(5) Patrick S., "Practical Guide to Polyvinyl Chloride", 2005, 17-18

(7) ISO standard 1624, second edition, 15 December 2001, 11 pages

III. The appeal lies from the decision of the opposition division revoking the patent on the basis of a main request and auxiliary requests 1-3. The opposition division admitted documents (3)-(5) into the proceedings. The proprietor's request for postponement of the oral proceedings was rejected. The opposition division found that the main request fulfilled the requirements of Article 123(2) and (3) EPC. The subject-matter of the main request and of auxiliary

requests 1-3 was found to be insufficiently disclosed, since neither a method of measurement nor the type of average particle size had been described.

The main request contains 28 claims. Claims 1, 23 and 27 are independent claims. Claim 1 of the main request reads as follows:

"1. A paint composition comprising:
a liquid binder resin; and
about 5 to about 60 weight percent, based on the total weight of solids of the paint composition, of solid polyvinyl chloride extender particles having an average particle size in a range from 20 to 60 microns; and a color pigment; and
wherein the paint composition is free of plasticizers."

The other independent claims of the main request, claims 23 and 27, also define polyvinyl chloride extender particles having an average particle size in a range from 20 to 60 microns.

Claim 1 of auxiliary request 1 differs in that the average particle size has been limited to 30 to 60 microns.

Claim 1 of auxiliary request 2 differs from the main request in that the polyvinyl chloride extender particles are defined as being spherical.

Claim 1 of auxiliary request 3 combines the additional features of auxiliary requests 1 and 2.

IV. Oral proceedings were held on 26 February 2018 in the absence of the respondent, as announced in its letter

of 30 January 2018.

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

The appellant acknowledged that theoretically there might be differences in the values describing the average particle size due to different methods of measurement. However, the opponent-respondent had not provided any data showing that such differences also arose in the present specific case of polyvinyl chloride (PVC) particles. Decision T 225/93 cited by the respondent was no longer followed. The criteria developed by the later decisions T 1811/13 and T 646/13 should be applied instead. Furthermore, sieving, especially wet sieving, would be the most preferred method of measurement for the claimed PVC particles, as could be seen from document (4), Table II, and ISO standard 1624 (document (7)), which was referred to in document (5). The person skilled in the art could thus carry out the invention without undue burden.

The opposition division had committed a substantial procedural violation, as the impugned decision failed to mention or take into consideration the important arguments with regard to document (5) and thus violated Article 113(1) and Rule 111(2) EPC. Furthermore, the opposition division had admitted documents (3) and (4), submitted by the opponent at a very late stage, without granting a postponement of the oral proceedings before the opposition division. Reimbursement of the appeal fee was thus appropriate.

The impugned decision was based solely on sufficiency of disclosure. Remittal back to the opposition division for consideration of novelty and inventive step was

therefore justified.

- VI. The respondent's arguments, presented in writing and insofar as they are relevant to the present decision, may be summarised as follows:

Documents (2) to (4) showed that it was common general knowledge that the results of particle size measurements depended on the method used. It was also clear, and furthermore supported by the teaching of document (5) (paragraph 2.4.1), that the type of average had to be specified. The sieving method itself involved serious problems. It was very difficult to carry out for dry powders under 38 microns and required rigid standardisation of measurement times and operating methods. The PVC particles used in the examples of the patent in suit and sold under the trademark "Geon 217" could not be taken into account, since it had not been established that the Geon 217 utilised in the examples of the patent in suit and the Geon 217 purchased at any one date were identical. Decision T 225/93 had been correctly followed by the opposition division. Another important decision in this respect was T 805/93, which stressed the importance of indicating the details of the method of measurement for a parameter which was "the only characterizing feature".

It was within the discretion of the opposition division to decide which arguments, facts and evidence to rely upon and thus within its rights to be silent about the merits of document (5).

The respondent provided no arguments concerning possible remittal to the opposition division.

VII. The appellant (patent proprietor) requested that the decision under appeal be set aside and that the case be remitted to the opposition division for consideration of novelty and inventive step, or alternatively that the patent be maintained on the basis of the claims of the main request or, alternatively, of one of auxiliary requests 1 to 3, all filed with the statement of grounds of appeal. The appellant further requested that the appeal fee be reimbursed.

The respondent (opponent) had requested in writing that the appeal be dismissed.

Reasons for the Decision

1. The appeal is admissible.
2. The oral proceedings before the board took place in the absence of the respondent, who had been duly summoned but chosen not to attend, as announced in its letter of 30 January 2018. According to Article 15(3) RPBA, the board is not obliged to delay any step in the proceedings, including its decision, by reason only of the absence at the oral proceedings of any party duly summoned who may then be treated as relying only on its written case. Hence, the board was in a position to announce a decision at the conclusion of the oral proceedings, as provided for by Article 15(6) RPBA.
3. *Particle size measurements*

In the board's judgment, the following physical and mathematical facts about particle size measurements are notorious, i.e. they were so well established in the art at the priority date that they cannot reasonably be

disputed. First, there are different methods of measurement that are based on different physical properties of the particles to be characterised. Second, to a large extent the type of average used (e.g. type of mathematical average or type of base (number average versus weight average)) influences the results obtained. Variations of the order of several magnitudes in the values obtained as results of the various methods are possible. Since this knowledge is notorious, there is no need to discuss documents (2) (including (2a)), (3) and (4), all filed in order to establish the above facts.

4. *Sufficiency of disclosure*

4.1 In order to establish insufficiency of disclosure, it must be shown that the patent (application) does not disclose the invention in a manner sufficiently clear and complete for it to be carried out by a person skilled in the art. If it is argued that insufficiency arises from a lack of clarity, it is generally not sufficient to establish a lack of clarity of the claims in order to establish insufficiency of disclosure. Rather, it is necessary to show that the patent as a whole does not enable the skilled person, relying on the description and on his common general knowledge, to carry out the invention (cf. T 1811/13, Reasons 5.1, and T 646/13, Reasons 3.1).

4.2 In the present case the size of the PVC particles is an important feature of the invention. The patent in suit, see paragraph [0046], states that various improved performance properties of the paint composition, such as burnish and mar resistance, scrub resistance and washability, are due to the size of the PVC extender particles. Thus a skilled person needs to be capable of

establishing which PVC particles have the appropriate size, as defined in the claims.

It has been discussed above, see point 3, that the results for the particle size may vary to a large extent depending on the method of measurement.

The description of the application provides only very limited information that could lead to the selection of a particular method of measurement. In paragraph [0028] it is merely disclosed that the PVC particles may be obtained by suspension polymerisation and are commercially available from a number of suppliers. One useful PVC extender particle is said to be Geon 217, obtainable from Poly One Corporation. The only further information can be found in the examples, which use either Geon 217, of an average particle size of about 35 microns, or CP 501, of an average particle size of about 45 microns.

The person skilled in the art has thus to rely on his common general knowledge for the selection of an appropriate method of measurement.

- 4.3 It thus has to be determined whether this common general knowledge would point the skilled person to a specific method of measurement for the determination of the particle size of PVC particles.

The appellant has submitted ISO standard 1624 (document (7)) relating to sieving as a method of measurement for determining the size of PVC particles. ISO, the International Organization for Standardization, is a worldwide federation of national standard-setting bodies that publishes international standards for certain procedures. A person skilled in the art would

be aware of the existence of these standards and would consult them when looking for usual methods of measurement.

The common general knowledge, as represented by document (7), thus points towards sieving as the method of choice for determining the particle size of PVC particles.

- 4.4 The respondent has alleged that, even with sieving, different values of average particle size would result, depending on the measurement conditions, but it has provided no experimental proof. It is thus not known to what extent the parameters selected for performing sieving will influence the particle size values obtained by that method. There is no evidence on file to show that the possible variations in results will be such that particles having an average particle size in a range from 20 to 60 microns according to any allowable variation of the standard method of measurement would not allow the skilled person to carry out the invention.

The respondent has further argued that dry sieving is difficult to carry out for particle sizes below 38 microns. However, a person skilled in the art, being aware of document (7), would consider using wet sieving if difficulties arose with dry sieving.

Concerning the type of average and variations in results depending on the selection of a certain type of average, the respondent has made no submissions which relate to sieving. The passage cited in document (5), paragraph 2.4.1, discusses molecular weight determination and not particle size measurements.

In the case underlying decision T 225/93 the prior art contained no indication of which method of measurement was suitable in particular for the calcium carbonate particles under consideration (Reasons 2.2). Unlike the situation in T 225/93, in the present case it has been determined that one particular method of measurement would have been chosen by the skilled person.

Decision T 805/93 discusses methods and conditions of measurement for determination of viscosities, mainly within the context of Article 84 EPC. The argumentation turns on the need to select the reactive compounds in order to obtain a reaction product having the claimed but unclear viscosity, and finds a lack of sufficiency of disclosure. There is no discussion in T 805/93 of the common general knowledge of the skilled person concerning viscosity measurements. The situation is thus not directly comparable with the present case.

- 4.5 Summing up, it can be concluded that in the present case of PVC particles the skilled person would not have considered using any method of measurement, but would have chosen a method relying on sieving, such as a method according to ISO standard 1624. There is no evidence on file that different measurement conditions in such a method would have led to the selection of PVC particles that would have prevented the skilled person from carrying out the invention as defined in the claims.
- 4.6 The subject-matter of the main request and of auxiliary requests 1-3 is sufficiently disclosed.

5. *Remittal to the opposition division*

The decision under appeal concerned only the allowability of amendments and sufficiency of disclosure. The grounds of appeal under Article 100(a) EPC were not addressed. In these circumstances, and in accordance with the appellant's request, the board finds it appropriate to exercise its power under Article 111(1) EPC and remit the case to the department of first instance for further prosecution.

6. *Reimbursement of the appeal fee*

6.1 In support of its request for reimbursement of the appeal fee the appellant considered that the late admission of documents (3) and (4) without postponement of the oral proceedings and the lack of consideration given to document (5) constituted a substantial procedural violation.

Documents (3) and (4) were filed in addition to document (2), the publication date of which had been questioned by the appellant, in order to establish basic facts concerning particle size measurement (see point 3 above). Since the facts that these documents were intended to establish are to be regarded as notorious knowledge, the admission, or non-admission, of these documents had no bearing on the impugned decision and could not have taken the appellant by surprise.

Moreover, by stating that there may theoretically be differences in the values describing the average particle size due to different methods of measurement, the appellant has indirectly acknowledged the relevant

facts for which documents (2)-(4) were adduced as evidence. Therefore the admission of documents (3) and (4) and the refusal to postpone the oral proceedings as a consequence of their admission cannot be seen as a substantial procedural violation.

6.2 Document (5) is a post-published document and, as such, cannot by itself establish the knowledge of the skilled person at the effective filing date. Consequently, the absence of any discussion of the contents of document (5) did not result in a decision which could be considered non-reasoned for purposes of the right to be heard (see R 8/15), although it would certainly have been appropriate for the opposition division to state that document (5) was not relevant. In this context the board notes that the present decision does not rely on document (5), but on document (7), which was not filed before the opposition division.

6.3 No substantial procedural violation having occurred, reimbursement of the appeal fee cannot be granted.

Order

For these reasons it is decided that:

1. The decision under appeal is set aside.
2. The case is remitted to the opposition division for further prosecution.
3. The request for reimbursement of the appeal fee is refused.

The Registrar:

The Chairman:



M. Schalow

A. Lindner

Decision electronically authenticated