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**Datasheet for the decision
of 15 December 2017**

Case Number: T 0510/13 - 3.3.01

Application Number: 01943369.7

Publication Number: 1280863

IPC: C09D5/10, C09D183/02,
C09D183/04

Language of the proceedings: EN

Title of invention:
ANTICORROSION COATING COMPOSITION

Patent Proprietor:
Dow Corning Corporation

Opponent:
Ewald Dörken AG

Headword:
Anticorrosion coating/DOW CORNING

Relevant legal provisions:
RPBA Art. 12(4)

Keyword:

Decisions cited:

Catchword:



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Case Number: T 0510/13 - 3.3.01

D E C I S I O N
of Technical Board of Appeal 3.3.01
of 15 December 2017

Appellant:

(Opponent)

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Respondent:

(Patent Proprietor)

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Representative:

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Decision under appeal:

**Decision of the Opposition Division of the
European Patent Office posted on 11 December
2012 rejecting the opposition filed against
European patent No. 1280863 pursuant to Article
101(2) EPC.**

Composition of the Board:

Chairman

A. Lindner

Members:

J. Molina de Alba

L. Bühler

Summary of Facts and Submissions

- I. The present appeal lies from the decision of the opposition division to reject the opposition filed against European patent No. 1 280 863.

Claim 1 of the patent as granted reads as follows:

"1. A coating composition which comprises a binder, a lubricant and a corrosion inhibitor in a solvent, wherein the binder comprises a silicate and an organic titanate, and the corrosion inhibitor comprises aluminium particles and zinc particles."

- II. The following documents are referred to in the present decision:

(6) EP 0 161 129

(15) GB 1 386 546

(16) RÖMPP Chemie Lexikon 1995, pages 102-103,
2290-2291, and 4042

- III. In the decision under appeal, the opposition division considered *inter alia* that the coating composition according to granted claim 1 was inventive starting from document (6) as the closest prior art.
- IV. With its statement of grounds of appeal, the appellant (opponent) made reference to the arguments it presented in opposition proceedings and provided arguments of lack of inventive step starting from the new filed document (15). An additional new document (16) was

filed as evidence of the skilled person's knowledge regarding alkanes, hydrocarbons and lubricants.

- V. In its reply to the statement of grounds of appeal, the respondent (patent proprietor) raised the issue that the appeal constituted a fresh case because it rested solely on arguments and evidence submitted with the statement of grounds of appeal, which had not been considered in opposition proceedings.

With letter dated 12 October 2017, the respondent filed a set of claims as an auxiliary request, wherein claim 1 was based on the combination of granted claims 1 and 2.

- VI. In a communication annexed to the summons for oral proceedings dated 17 July 2017, the board informed the parties that it was minded to consider the appeal admissible and that the admission of documents (15) and (16) would be discussed at oral proceedings.

- VII. With letter dated 6 December 2017, the appellant withdrew its request for oral proceedings and announced that it would not attend the oral proceedings.

- VIII. Oral proceedings were held on 15 December 2017 in the absence of the appellant.

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

On the admission of document (15), the appellant provided arguments as to why it had been late filed and why its was *prima facie* relevant.

Regarding the first aspect, the appellant submitted that document (15) could not be found earlier despite an extensive search conducted in preparation for the opposition against the patent in suit. However, it had been filed immediately after the appellant had become aware of it during the search for another patent application.

On the issue of relevance, the appellant argued that document (15) was closer to the invention than any of the documents cited in opposition and examination proceedings. Document (15) disclosed a coating composition (see page 3, lines 34-36) comprising: i) a binder comprising a silicate and an organic titanate (constituents A and B); ii) a corrosion inhibitor comprising aluminium and zinc particles (filler); iii) a lubricant (constituent C); and iv) a solvent (constituent D). Although the term "lubricant" was not mentioned in document (15), constituent C contained substances that were lubricants such as fatty acids, castor oil, tallow, soya oil, linseed oil, tung oil, oiticica oil or paraffin hydrocarbons. Hence, the composition in document (15) was highly relevant because it differed from the one in granted claim 1 only by the fact that document (15) did not explicitly mention the combination of zinc and aluminium particles (see letter dated 24 January 2014, page 5, summary).

Document (16) was filed as evidence that paraffin hydrocarbons were known to be lubricants.

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

Concerning the late-filing of document (15), the respondent submitted that the document was a British patent. Therefore, it would have been easily accessible and there was no apparent reason as to why it could not have been found in a thorough search.

Turning to the issue of relevance, the respondent argued that document (15) was not more relevant than the closest prior art discussed in the appealed decision, i.e. document (6). The subjective problem as set out in the patent in paragraphs [0007] and [0024] and claim 12 was the provision of protective coatings for metal surfaces which provided a high level of corrosion protection, cathodic protection, and for-life lubrication for transportation industry related parts. Thus, the key issues in the patent were corrosion resistance and a low coefficient of friction. Document (6) addressed the problem of corrosion resistance and lubrication in the context of coating metallic substrates such as bolts (see page 3, paragraphs 2-4, and claim 1). Document (15) however focused on the provision of storage-stable binders (see the heading of document (15)) achieved by combining a titanate and a silicate. Hence, although document (15) mentioned corrosion resistance in its examples, this was not its main issue and it did not deal with the coefficient of friction at all. Further, in the discussion of the number of differences between the compositions of claim 1 and document (15), the respondent rejected the appellant's contention that document (15) disclosed a lubricant and identified two differences: the combination of zinc and aluminium particles, and the presence of a lubricant.

XI. The parties' requests were the following:

The appellant requested in writing that the decision under appeal be set aside and European patent No. 1 280 863 be revoked. It also requested that documents (15) and (16) be admitted into the appeal proceedings.

The respondent requested that the appeal be dismissed and the patent be maintained as granted. It further requested that documents (15) and (16) not be admitted into the appeal proceedings. In the event that documents (15) and (16) were to be admitted, the respondent requested that the case be remitted to the department of first instance. Alternatively, the respondent requested that the patent be maintained on the basis of the claims of the first auxiliary request filed with letter dated 12 October 2017.

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

Reasons for the Decision

1. The appeal is admissible. This was not contested by the respondent.
2. The appellant did not attend the oral proceedings before the board, as announced by way of letter dated 6 December 2017. The board nevertheless maintained the oral proceedings in accordance with Rule 115(2) EPC and Article 15(3) RPBA and treated the appellant as relying only on its written case.

Considering that the facts and evidence upon which the present decision is based were known to the appellant from the written proceedings and that it had sufficient opportunity to present its comments, the board was in a position to announce a decision at the conclusion of the oral proceedings (Article 15(6) RPBA).

3. *Admission of documents (15) and (16) - Article 114(2) EPC and 12(4) RPBA*

Documents (15) and (16) were filed for the first time with the statement of grounds of appeal. The respondent objected to their admission on the ground that they were late filed.

In order to decide whether or not the board should exercise its discretion under Article 114(2) EPC and Article 12(4) RPBA to disregard these documents, it was firstly analysed whether the appellant could reasonably have been expected to present the documents in opposition proceedings and, secondly, the relevance of the documents.

The admission of document (16) depends entirely on that of document (15) since document (16) was filed to prove that the paraffin hydrocarbons disclosed in document (15) were lubricants. For this reason, the admission of document (15) will be discussed first.

3.1 *Reasons for late filing document (15)*

According to the appellant, document (15) could not be found earlier despite an extensive search conducted in preparation of the opposition against the patent in suit. In order to prove this, the appellant disclosed its search strategy and submitted that even carrying

out the search retroactively with the knowledge of document (15), it was very difficult to find the document (see letter dated 24 January 2014, page 2). As an additional hint at the difficulty in finding document (15), the appellant noted that the document had not been cited in the international search report.

The board observes that the search strategy carried out by the appellant, as outlined in its letter dated 24 January 2014, was based exclusively on the combination of keywords that were introduced for search in the fields of: title, abstract and claims in the databases DEPATISnet and Espacenet. Such a strategy however, suffers from several deficiencies. Firstly, it relies on keywords in databases that do not provide any control of keywords. Secondly, the keywords were not searched in the full documents but only in their title, abstract and claims. Thirdly, the use of synonyms and truncations was apparently not contemplated. And lastly, the appellant did not perform any alternative search strategy independent from keywords, e.g. using patent classification symbols, in order to compensate the limitations of a strategy based exclusively on keywords. For this reason, the board is not convinced that the appellant carried out a comprehensive search and that document (15) could not have been found. In addition, the appellant's remark that document (15) was not cited in the international search report does not prove that the document could not be found. This could simply mean that the International Searching Authority did not consider document (15) to be relevant.

It cannot therefore be concluded that document (15) could not have been filed in opposition.

3.2 *Relevance of document (15)*

The appellant filed document (15) as the closest prior art because, in its opinion, this document was closer to the composition of granted claim 1 than any of the documents cited in the first instance proceedings (see letter dated 24 January 2014, point 2).

As explained by the respondent in its letter dated 28 August 2013 (see point 3.2) and at oral proceedings, the patent is directed (see paragraphs [0007] and [0024] and claim 12) to the provision of protective coatings for metal surfaces of transportation industry related parts, e.g. bolts, which confer high level of corrosion protection and for-life lubrication. This was essentially the problem addressed in document (6) (see page 3, paragraph 3, and claim 1), aimed primarily at the provision of coating compositions that lend corrosion resistance and lubrication to metallic substrates, e.g. bolts. By contrast, document (15) focused on the provision of storage-stable binders which *inter alia* could be used for corrosion resistant coatings (see page 1, lines 9-12; page 3, lines 34-36 and lines 76-87; and examples I and VI). Thus, even if the problem dealt with in document (15) was related to that of the patent to the extent that it concerned coating compositions with corrosion resistance, this aspect was not primary, and the document did not address the aspect of lubrication at all. Hence, having regard to their purposes, document (6) was closer to the patent than document (15).

Another aspect to be considered for determining the closest prior art is the number of distinguishing features with regard to the claimed compositions. In this context, the appealed decision established (see point 13.3) that the compositions in claim 1 differed

from those in document (6) in two features, the binder and the combination of zinc and aluminium particles. This was not disputed by the parties. Regarding document (15), the parties agreed that it also did not disclose the combination of aluminium and zinc particles. It was however disputed whether or not the compositions in document (15) contained a lubricant. The appellant maintained that they did because the component C in the compositions of document (15) was a film forming organic resin which contained substances known to be lubricants, such as paraffin hydrocarbon solvents, fatty acids, castor oil, tallow, soya oil, linseed oil, tung oil or oiticica oil (see page 2, lines 48-55; page 3, lines 123-125; and examples I and VI). Accordingly, the claimed compositions and document (15) differed only in one feature.

The board does not share the appellant's view. Firstly, because, as noted by the respondent in its letter dated 28 August 2013 (see page 3, paragraph 4), the paraffin hydrocarbon solvents in document (15) are removed during the coating process (see page 3, lines 100-105 and 126-130; page 4, lines 100-102; and page 6, lines 48-51). So, they do not remain in the coating and cannot play the role of a lubricant. Secondly, because the fatty acids and animal or plant oils in component C of document (15) are not present as such in the coating composition; they react with the film forming resins to produce modified resins (see document (15): page 2, lines 48-55; page 4, lines 79-82; and page 6, lines 28-31) and therefore cannot act as lubricants. Consequently, document (15) does not disclose any lubricant and its compositions differ from those in claim 1 in two technical features.

In view of the above considerations concerning the problem dealt with, and of the number of distinguishing features, document (15) is not a more suitable starting point than document (6).

- 3.3 Following on from the board's conclusions in points 3.1 and 3.2 above, document (15) was not admitted into the appeal proceedings.

As a direct consequence, document (16) was not admitted either, since it had been filed exclusively to support the appellant's argument that the paraffin hydrocarbons disclosed in document (15) were lubricants.

4. In the statement of grounds of appeal (see point 2), the appellant submitted that it maintained its arguments presented during the opposition proceedings. It is however established case law that such a statement cannot replace an explicit explanation of the legal and factual reasons for the appeal (see Case Law of the Boards of Appeal of the European Patent Office, 8th Edition 2016, chapter IV.E.2.6.4, point a). Accordingly, the submissions made by the appellant in opposition proceedings do not form part of the present appeal proceedings.
5. Hence, there are no facts, evidence or arguments on file against the decision under appeal.

Order

For these reasons it is decided that:

The appeal is dismissed.

The Registrar:

The Chairman:



M. Schalow

A. Lindner

Decision electronically authenticated