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**Datasheet for the decision
of 3 May 2018**

Case Number: T 0285/15 - 3.4.02

Application Number: 08742374.5

Publication Number: 2130014

IPC: G01J3/46

Language of the proceedings: EN

Title of invention:

SYSTEM FOR COLOR MATCH AND DIGITAL COLOR DISPLAY

Applicant:

Coatings Foreign IP Co. LLC

Headword:

Relevant legal provisions:

EPC Art. 113(1)
RPBA Art. 11
EPC R. 103(1)(a)

Keyword:

Substantial procedural violation - reimbursement of appeal fee
(yes)
Remittal to the department of first instance - (yes)

Decisions cited:

T 0305/14

Catchword:



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Case Number: T 0285/15 - 3.4.02

D E C I S I O N
of Technical Board of Appeal 3.4.02
of 3 May 2018

Appellant: Coatings Foreign IP Co. LLC
(Applicant) The Corporation Trust Company
Corporation Trust Center
1209 Orange Street
Wilmington, DE 19801 (US)

Representative: LKGLOBAL
Lorenz & Kopf PartG mbB Patentanwälte
Brienner Straße 11
80333 München (DE)

Decision under appeal: Decision of the Examining Division of the
European Patent Office posted on 16 September
2014 refusing European patent application No.
08742374.5 pursuant to Article 97(2) EPC.

Composition of the Board:

Chairman R. Bekkering
Members: H. von Gronau
G. Decker

Summary of Facts and Submissions

I. The appeal of the applicant is directed against the decision of the examining division to refuse the European patent application 08742374.5. The examining division refused the application on the ground that the subject-matter of independent claim 1 was not new in view of each of documents

D2: US 7 145 656 B2, and

D3: US 2004/093112 A1, and

did not involve an inventive step over document

D1: US 2007/032965 A1

as closest prior art document in combination with document

D2 or D3.

II. In the examination proceedings in the European phase the examining division issued a first communication dated 14 February 2011 and the applicant responded thereto with letter dated 21 June 2011 including amended claims.

III. In response to a second communication of the examining division dated 29 October 2012, the applicant filed amended claims with letter dated 6 March 2013. Amended claim 1 contained for the first time the features under point v. (see point VIII below; in the contested decision, this feature is designated as "E5").

IV. The examining division issued subsequently the contested decision. In particular with respect to newly

introduced feature E5 the examining division stated in the contested decision under point 1.2: "It is noted that feature (E5), defining the selection of one or more formulas, is actually performed by a human, cf. the description on page 13, line 32. Hence the selection step itself in feature (E5) is not within the scope of the claimed device.

This feature is therefore understood as defining means suitable for allowing a person to select one or more matching formulas through the use of individual matching images."

The examining division further stated that this selecting step according to feature E5 was known from documents D1, D2 and D3 (cf. points 2.1, 2.2 and 3.1 of the contested decision).

- V. With the statement setting out the grounds of appeal, the appellant requested that the decision of the examining division be set aside and a patent be granted on the basis of the refused claims. As an auxiliary measure, it requested that a patent be granted on the basis of the claims filed with the grounds of appeal according to one of the first to third auxiliary requests.

As a further auxiliary measure oral proceedings were requested.

- VI. In a communication annexed to the summons to oral proceedings the board expressed its provisional opinion.

- VII. In a letter dated 3 April 2018 the appellant put forward that the decision of the examining division to refuse the application presented surprising grounds to which the applicant had not had the opportunity to

respond in the first instance proceedings. This violated the applicant's right to be heard, because the examining division presented its position with regard to feature E5, which had been included in the claims in response to the second office action, for the first time in the grounds for the decision to refuse. The appellant requested therefore that the matter be remitted to the examining division and that the appeal fee be reimbursed.

If the board did not allow the request to remit the case to the examining division, the appellant requested that a patent be granted based on the main request with application documents as pending when refused by the examining division, first to third auxiliary requests with application documents filed with letter dated 3 April 2018, fourth to sixth auxiliary requests with application documents filed with the statement setting out the grounds of appeal as first to third auxiliary requests, respectively.

VIII. Independent claim 1 of the main request was subject to the contested decision and reads as follows:

"1. A system for displaying one or more images to select one or more matching formulas to match color and appearance of an article or to match color and appearance of a target coating of an article, said system comprising:

a) a computing device;

b) a display device;

c) one or more data input devices;

d) a database comprising interrelated repair formulas, identification information of articles, color characteristics, and optionally appearance characteristics; and

e) a computer program product that is accessible to the computing device and performs a computing process comprising the steps of:

i. receiving from the one or more input devices identification information of the article;

ii. retrieving one or more preliminary matching formulas from the database that match the identification information;

iii. generating individual matching images;

iv. displaying the individual matching images on the display device, and

v. selecting one or more matching formulas from the preliminary matching formulas by comparing the individual matching image and the target coating,

wherein individual matching images are generated based on the color characteristics, and optionally appearance characteristics interrelated to each of the preliminary matching formulas, by converting L, a, b or L*, a*, b* values of the color characteristics to XYZ values, if needed, and calculating corresponding R, G, B values from the XYZ values."

Reasons for the Decision

1. Right to be heard (Article 113(1) EPC)
 - 1.1 According to the principle of the right to be heard pursuant to Article 113(1) EPC, the decision of the examining division must be based on grounds on which the applicant has had an opportunity to present comments.
 - 1.2 The board notes that in the present case the applicant has filed with letter dated 6 March 2013 an amended independent claim 1 which comprised for the first time the additional feature under point v. (E5) which was taken from the originally filed description on page 13, lines 27 to 36.
The board further notes that the grounds the examining division held against this feature E5 were communicated to the applicant for the first time in the contested decision.
 - 1.3 The board concludes therefore that the examining division expressed its grounds against feature E5 for the first time in the contested decision and that the applicant did not have an opportunity to comment on the grounds of the examining division with respect to feature E5 before the contested decision was issued. Thus the applicant's right to be heard has been violated.
2. Remittal to the department of first instance (Article 11 RPBA)
 - 2.1 According to Article 11 RPBA a board shall remit a case to the department of first instance if fundamental

deficiencies are apparent in the first instance proceedings, unless special reasons present themselves for doing otherwise.

2.2 The violation of the principle of the right to be heard is considered a fundamental deficiency of the first-instance proceedings and remittal is normally ordered in such a case (cf. Case Law of the Boards of Appeal, 8th edition 2016, section IV.E.7.4.2).

The appellant has requested to remit the case to the department of first instance. The board cannot identify any special reasons justifying not to remit the case.

2.3 The board therefore remits the case to the first instance for further prosecution.

3. Reimbursement of the appeal fee (Rule 103(1)(a) EPC)

3.1 According to Rule 103(1)(a) EPC one of the preconditions for reimbursement of the appeal fee is that a substantial procedural violation has taken place.

3.2 The board has concluded that the first-instance proceedings were affected by a substantial procedural violation (cf. point 1.3 above). Therefore the board considers reimbursement of the appeal fee equitable.

Order

For these reasons it is decided that:

1. The decision under appeal is set aside.
2. The case is remitted to the department of first instance for further prosecution.
3. The request for reimbursement of the appeal fee is allowed.

The Registrar:

The Chairman:



M. Kiehl

R. Bekkering

Decision electronically authenticated