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**Datasheet for the decision
of 13 February 2020**

Case Number: T 0513/15 - 3.3.02

Application Number: 07774203.9

Publication Number: 2001964

IPC: C09D133/06

Language of the proceedings: EN

Title of invention:

FOOD CANS COATED WITH A COMPOSITION COMPRISING AN ACRYLIC
POLYMER

Patent Proprietor:

PPG Industries Ohio, Inc.

Opponents:

Akzo Nobel Coatings International B.V.
The Valspar Corporation

Headword:

Relevant legal provisions:

EPC Art. 123(2), 84
RPBA Art. 13(1)

Keyword:

Amendments - extension beyond the content of the application
as filed (yes)

Claims - clarity (no)

Decisions cited:

T 1129/97, T 0197/10, T 2221/10, G 0003/14, T 2500/16

Catchword:



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Case Number: T 0513/15 - 3.3.02

D E C I S I O N
of Technical Board of Appeal 3.3.02
of 13 February 2020

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Decision under appeal: **Decision of the Opposition Division of the
European Patent Office posted on 15 January 2015
revoking European patent No. 2001964 pursuant to
Article 101(2) and Article 101(3)(b) EPC.**

Composition of the Board:

Chairman M. O. Müller
Members: P. O'Sullivan
 M. Blasi

Summary of Facts and Submissions

- I. The appeal of the patent proprietor (appellant) lies from the decision of the opposition division to revoke European patent 2 001 964.
- II. The patent was opposed under Article 100(a) (lack of inventive step), (b) and (c) EPC.
- III. According to the contested decision, both the set of claims of the main request (patent as granted) and of the first auxiliary request comprised subject-matter extending beyond the content of the application as filed. The sets of claims of the second to seventh auxiliary requests were found not to be allowable under Article 123(2) and (3) EPC and were not admitted into the proceedings. Similarly, the sets of claims of the eighth and ninth auxiliary requests were found not clearly allowable under Article 123(2) EPC and were not admitted into proceedings.
- IV. A communication of the board pursuant to Article 15(1) RPBA 2007 was sent in preparation of oral proceedings, scheduled in accordance with the corresponding requests of the parties.
- V. Oral proceedings before the board were held on 13 February 2020.
- VI. The requests of the parties relevant to the decision were as follows:

The appellant requested that the contested decision be set aside and the case be remitted to the opposition division for examination of the remaining grounds for

opposition on the basis of the set of claims of the main request submitted with the letter of 19 January 2016, or alternatively on the basis of the sets of claims of the first to fifth auxiliary requests filed with the statement of grounds of appeal, or alternatively the sets of claims of the sixth or seventh auxiliary requests filed with the letter of 13 January 2020.

Respondent 1 requested dismissal of the appeal.

Respondent 2 requested dismissal of the appeal. It additionally requested that the sixth and seventh auxiliary requests not be admitted into the proceedings.

VII. Independent claim 1 of the main request reads as follows:

*"1. A food can coated at least in part on the interior with a composition comprising:
(a) greater than 7 wt %, based on total solids weight, of an acrylic polymer having a weight average molecular weight of greater than or equal to 41,000 and an acid value of < 30 mg KOH/g; and
(b) a crosslinker,
wherein the composition is substantially epoxy-free, substantially free of polyvinylchloride and contains polyester in an amount of 5 wt % or less based on total solids weight."*

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

All requests - Amendments - Article 123(2) EPC

The expressions "substantially free of polyvinylchloride" and/or "contains polyester in an amount of 5 wt% or less based on total solids weight" comprised within the respective claim 1 of each request found basis in claim 1 and/or paragraph [0009] of the application as filed.

Third, fourth and fifth auxiliary requests - Article 84 EPC

The term "substantially epoxy-free" in the respective claim 1 of each request was to be interpreted in the light of the application as filed, paragraph [0009], in which clear numerical ranges were provided. Since that definition applied to the entire application, the respective claim 1 in question clearly defined the upper limit for the presence of the compounds concerned, and was consequently clear.

Sixth and seventh auxiliary requests - Admittance

These requests were to be admitted into proceedings as they did not introduce new issues, and addressed issues raised by the board in the communication sent pursuant to Article 15(1) RPBA 2007.

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

All requests - Amendments - Article 123(2) EPC

The expressions "substantially free of polyvinylchloride" and/or "contains polyester in an amount of 5 wt% or less based on total solids weight" recited in the respective claim 1 of each request lacked any basis in application as filed.

Third, fourth and fifth auxiliary requests - Article 84 EPC

The term "substantially free of bisphenol A" in the respective claim 1 of each request lacked clarity and consequently contravened Article 84 EPC. Furthermore, the terms "residues" and "adducts" in claim 1 of the fifth auxiliary request lacked clarity.

Sixth and seventh auxiliary requests - Admittance

These requests were not to be admitted into the proceedings. They were late filed, failed to overcome the relevant objections, and introduced new objections with respect to Article 123(2) and (3) EPC.

Reasons for the Decision

Main request

1. Amendments - Article 123(2) EPC

1.1 Claim 1 at issue reads as follows:

"1. A food can coated at least in part on the interior with a composition comprising:

(a) greater than 7 wt%, based on total solids weight, of an acrylic polymer having a weight average molecular weight of greater than or equal to 41,000 and an acid value of < 30mg KOH/g; and

(b) a crosslinker,

wherein the composition is substantially epoxy-free,

***substantially free of polyvinylchloride** and*

*~~substantially polyester-free~~ **contains polyester in an amount of 5 wt % or less based on total solids weight.***

(emphasis added by the board: mark-up shows added or deleted text compared to claim 1 as filed)

1.2 The added text above is denoted in the following as:

Feature A: "substantially free of polyvinylchloride"

Feature B: "contains polyester in an amount of 5 wt % or less based on total solids weight"

Neither feature A nor feature B finds a basis in the application as filed.

1.3 Feature A

1.3.1 The appellant submitted that feature A found basis in claim 1 and/or paragraph [0009] of the application as filed (abbreviated hereinafter as "paragraph [0009]").

1.3.2 The relevant section of paragraph [0009] provides a definition of the term "substantially epoxy-free" and reads as follows:

"[0009] The compositions are substantially epoxy-free. 'Substantially epoxy-free' means that the compositions are substantially free from oxirane rings or residues of oxirane rings; bisphenol A; BADGE or adducts of BADGE; glycidyl groups or residues of glycidyl groups; polyvinylchloride and/or related halide-containing vinyl polymers. It will be understood that trace or minor amounts of one or more of these components can be present, such as 10 wt% or less, 5 wt% or less, 2 or even 1 wt% or less, with wt% based on total solids weight, and still be 'substantially epoxy-free'".

1.3.3 Thus, according to this definition, the term "substantially epoxy-free" includes the requirement that the compositions are also substantially free of polyvinylchloride. The appellant argued that the term "substantially epoxy-free" in claim 1 as filed was to be accorded the definition recited in the above passage. The consequence of this argument would be that said claim should be interpreted as if the above passage were incorporated therein. This would then necessarily lead to the conclusion that claim 1 as filed includes feature A within its scope, i.e. that the composition is substantially free of polyvinylchloride.

1.3.4 The board disagrees with this approach. According to established case law of the boards of appeal, if claims are worded clearly and unambiguously as to be understood without difficulty by the person skilled in the art, the description cannot be used to interpret the claims. In the event of a discrepancy between the claims and the description, the unambiguous claim must be interpreted as it would be understood by the person skilled in the art without the help of the description. Thus, in the event of a discrepancy between clearly defined claims and the description, those elements of the description not reflected in the claims are not, as a rule to be taken into account, e.g., for the examination of novelty and inventive step (see for example decisions T 197/10, reasons 2.2 and 2.3, followed by *inter alia* T 2221/10, reasons 33, and T 2500/16, reasons 1.1).

1.3.5 The term "epoxy-free" in claim 1 is considered clear, being understood by the person skilled in the art as meaning free exclusively of substances comprising an oxirane moiety. Thus, in line with established case law as outlined above, the description is not to be consulted in order to interpret it.

It follows from the foregoing that the term "substantially epoxy-free" in claim 1 as filed does not include under its scope "substantially free of polyvinylchloride" (feature A).

1.3.6 Consequently, that the composition recited in claim 1 at issue is "substantially free of polyvinylchloride" is not based on the disclosure of "substantially epoxy-free" in claim 1 as filed.

- 1.3.7 Paragraph [0009] as such also fails provide a basis for feature A. This paragraph stipulates that in addition to epoxy-containing substances and polyvinyl chloride, both excluded in claim 1 at issue, the compositions are also **necessarily** substantially free of the other listed substances. This interpretation was confirmed by the appellant in the letter of 19 January 2016, page 2, first full paragraph, which stated that it was an incorrect interpretation of paragraph [0009] to conclude that it was sufficient for the composition to be substantially free of at least one of the listed compounds. Thus paragraph [0009] does not provide a basis for a composition as defined in claim 1 at issue, i.e. being "substantially epoxy-free" and "substantially free of polyvinylchloride", while allowing unlimited quantities of the other substances listed therein not comprising an oxirane moiety.
- 1.3.8 In an alternative argument, the appellant put forward that the feature "substantially epoxy-free" in claim 1 at issue, in view of the definition of this feature in the description of the opposed patent (which is identical to that provided in paragraph [0009] of the application as filed) implied that the composition was substantially free of polyvinylchloride. Hence, the feature "substantially free of polyvinylchloride" in claim 1 at issue did not add anything to this claim and therefore could not contravene Article 123(2) EPC. However, for the same reason as given above (point 1.3.4) with regard to claim 1 as filed, the description of the patent cannot be used to reinterpret the feature "substantially epoxy-free" in claim 1 at issue. Hence, also this argument of the appellant must fail.
- 1.3.9 It follows that the application as filed lacks a basis for feature A.

1.4 Feature B

1.4.1 According to the appellant, feature B, i.e. "contains polyester in an amount of 5 wt% or less based on total solids weight" found basis in paragraph [0009] of the application as filed.

1.4.2 The relevant section of paragraph [0009] reads as follows:

"The compositions are also substantially polyester-free. 'Substantially polyester-free' means that the composition is substantially free from polyester; that is, the composition contains polyester in amounts less than those that would allow the polyester to contribute to the film forming and performance properties of the coating. It will therefore be understood that trace or minor amounts of polyester can be present, such as 10 wt% or less, 5 wt% or less, 2 or even 1 wt% or less, with wt% based on total solids weight, and still be 'substantially polyester-free'".

1.4.3 This passage indeed describes a polyester amount of up to 5 wt% as required by claim 1 at issue. However, in contrast with paragraph [0009], feature B lacks the preceding text in the above passage describing a functional condition, namely that "*... the composition contains polyester in amounts less than those that would allow the polyester to contribute to the film forming and performance properties of the coating*".

1.4.4 According to the appellant, this omission was permissible under Article 123(2) EPC since the word "therefore" in the text of paragraph [0009] beginning "[i]t will therefore be understood ..." related to the

previous sentence. Thus the numerical ranges that follow (of which "5 wt % or less" was selected in feature B) quantitatively enumerated what was to be understood by the preceding functional condition, and therefore did not represent a different, additional requirement. This interpretation was confirmed by the text at the end of said paragraph according to which if the numerical range limits are respected, the composition would "still be 'substantially polyester-free'", and thus by definition, also fulfilled the requirement of said functional condition.

1.4.5 The board does not agree. Claim 1 merely requires the presence in the coating composition of a specific acrylic polymer in an amount greater than 7 wt % (component a)) and an unspecified and thus potentially low amount of crosslinker (component b)). At these low amounts of further components (a) and (b), an amount of 5 wt % polyester constitutes a significant part of the coating composition. The skilled person would understand from a technical perspective that in this situation, the polyester would contribute to the film forming performance properties of the coating, contrary to what was required in the application as filed by the functional condition addressed above. Indeed, the amount of polyester below which the film forming performance properties of the coating will remain unaffected must logically depend on the nature of and amount of the further components of the composition claim.

1.4.6 Said functional condition is therefore a requirement additional to the numerical requirements recited in paragraph [0009] and is thus limitative thereon.

1.4.7 Since feature B fails to recite said condition, it follows that it lacks basis in the application as filed.

1.4.8 Since neither feature A nor feature B of claim 1 find basis in the application as filed, claim 1 of the main request contravenes Article 123(2) EPC.

First auxiliary request

Claim 1 of this request differs from claim 1 of the main request in that feature B is replaced with "free of polyester".

2. Amendments - Article 123(2) EPC

Since claim 1 still comprises feature A, it follows that it contravenes Article 123(2) EPC for the same reasons as provided for claim 1 of the main request with respect to said feature.

Second auxiliary request

3. Amendments - Article 123(2) EPC

Claim 1 of this request is identical to claim 1 of the main request, and consequently contravenes Article 123(2) EPC for the same reasons.

Third auxiliary request

Claim 1 of this request differs from claim 1 of the main request in the further specification that the composition is substantially free of bisphenol A.

4. Amendments - Article 123(2) EPC

Since claim 1 still comprises feature B, it follows that it contravenes Article 123(2) EPC for the same reasons as provided for claim 1 of the main request with respect to said feature.

5. Article 84 EPC

5.1 In contrast to feature A, the expression "substantially free of bisphenol A" is not comprised within the granted claims and is therefore open to objection under Article 84 EPC (see decision G 3/14, OJ EPO 2015, A102, Order).

5.2 Article 84 EPC stipulates *inter alia* that the claims shall be clear. Since the term "substantially" within the feature "substantially free of bisphenol A" lacks a generally accepted definition, it leads to a lack of clarity in the claim. More specifically, the amount of bisphenol A covered by claim 1 is unclear. The appellant's argument that this amount was clear in view of the clear numerical ranges given in the description of the patent is not accepted by the board. As set out in decision T 1129/97 (OJ EPO 2001, 273; reasons 2.1.9), "...the practice of using an ambiguous and therefore imprecise term in the wording of a claim, and relying for its interpretation on an implicit but essential reference to the description, must remain prohibited. The principle of the self-sufficiency of the claim must be retained."

It follows that claim 1 at issue contravenes Article 84 EPC.

Fourth auxiliary request

Claim 1 of this request differs from claim 1 of the third auxiliary request in the further specification that the composition is substantially free of halide containing vinyl polymers.

6. Amendments - Article 123(2) EPC

Since claim 1 still comprises feature B, it follows that it contravenes Article 123(2) EPC for the same reasons as provided for claim 1 of the main request with respect to said feature.

7. Article 84 EPC

Comprising the expression "substantially free of bisphenol A", and now including the expression "substantially free of ... halide containing vinyl polymers", both expressions in claim 1 contravene Article 84 EPC for the same reason as provided for the former in claim 1 of the third auxiliary request.

Fifth auxiliary request

Claim 1 of this request differs from claim 1 of the main request in that it specifies that the substances of which the composition is "substantially epoxy-free" correspond to those listed in paragraph [0009], albeit with the expression in paragraph [0009] "and/or related halide-containing vinyl polymers" amended to "and halide-containing vinyl polymers". Furthermore the expression "contains polyester in an amount of 5 wt % or less based on total solids weight" (feature B) in claim 1 of the main request is amended to "is substantially polyester free i.e. contains polyester in

an amount of 5 wt % or less based on total solids weight".

8. Amendments - Article 123(2) EPC

The slight adjustment in claim 1 of this request in respect of feature B compared to claim 1 of the main request does not change the board's conclusion set out for the main request, above. Thus, it remains the case that the functional condition recited in paragraph [0009] is a requirement additional to the numerical requirements recited therein and is thus limitative thereon. Consequently, claim 1 of this request, which still does not comprise this functional requirement, contravenes Article 123(2) EPC for the same reason as provided for feature B of the main request.

9. Article 84 EPC

Comprising *inter alia* the expressions "substantially free from ... bisphenol A", and "substantially free from ... halide-containing vinyl polymers", claim 1 contravenes Article 84 EPC at least for the same reasons as provided for claim 1 of the fourth auxiliary request.

Sixth and seventh auxiliary requests

Claim 1 of the sixth auxiliary request differs from claim 1 of the fifth auxiliary request by introduction of a numerical range for the compounds of which the composition is epoxy-free, namely "i.e. comprises 10 wt% or less based on total solids weight ...".

Claim 1 of the seventh auxiliary request differs from claim 1 of the sixth auxiliary request in the limitation of the inserted numerical range to "5 wt% or less".

10. Admittance into the appeal proceedings

10.1 The sets of claims of the sixth and seventh auxiliary requests were filed by the appellant with the letter dated 13 January 2020. Respondent 2 requested that they not be admitted into appeal proceedings.

10.2 According to the appellant, said requests served to clarify the situation by introducing numerical values disclosed in paragraph [0009], did not introduce any new issues into the proceedings, and could not represent a surprise for the other parties. Furthermore, the requests addressed issues raised by the board in the communication pursuant to Article 15(1) RPBA and were consequently to be admitted into the proceedings.

10.3 Summons to oral proceedings were issued on 12 April 2019. According to Article 25(3) RPBA 2020, where the summons to oral proceedings has been notified before the date of entry into force of the revised version of the RPBA, i.e. before 1 January 2020 (which corresponds to the situation in the present case), Article 13(2) RPBA 2020 shall not apply. Instead, Article 13 of the RPBA 2007 shall continue to apply. Accordingly, this provision prescribes that Article 13 RPBA 2007, which comprises Article 13(1) RPBA 2007, applies to the present case. In addition, not being excluded by the transitional provisions of Article 25(3) RPBA 2020,

Article 13(1) RPBA 2020 also applies (see decision T 2227/15, reasons 1).

- 10.4 The board decided not to admit the sixth and seventh auxiliary requests into the proceedings. Both requests were filed at a late stage of the appeal proceedings, namely one month before oral proceedings. Although their filing can be seen as a reaction to the issue raised by the board in the communication under Article 15(1) RPBA in respect of the term "substantially" (communication, point 5), the new requests fail to deal fully with the issues raised therein, for example, the lack of clarity in the terms "residues of oxirane rings", "adducts of BADGE" and "residues of glycidyl groups" (communication of the board, point 9). At least these latter issues were not raised for the first time with the communication of the board, but were submitted as early as with the reply of respondent 2 dated 13 October 2015 (section 6) in respect of the fifth auxiliary request.
- 10.5 Furthermore, the amendment to the respective claim 1 of each request raises new issues, at least concerning the question of whether claim 1 in view of the selection and combination of specific ranges taken from paragraph [0009] meets the requirements of Article 123(2) EPC.
- 10.6 Finally, claim 1 of both requests still comprises feature B, amended as in claim 1 of the fifth auxiliary request (supra), for which the board concluded that the requirements of Article 123(2) EPC are not met.
- 10.7 Accordingly, the sixth and seventh auxiliary requests were not admitted into the proceedings pursuant to Article 13(1) RPBA 2007 and 2020.

11. Conclusion

None of the requests on file are allowable.

Order

For these reasons it is decided that:

The appeal is dismissed.

The Registrar:

The Chairman:



N. Maslin

M. O. Müller

Decision electronically authenticated