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**Datasheet for the decision  
of 14 February 2019**

**Case Number:** T 0551/15 - 3.3.01

**Application Number:** 05824625.7

**Publication Number:** 1833926

**IPC:** C09D5/00

**Language of the proceedings:** EN

**Title of invention:**

COMPOSITION SUITABLE FOR A POWDER COATING COMPOSITION COMPRISING  
AT LEAST ONE RESIN AND AT LEAST ONE DISPERSANT

**Patent Proprietor:**

DSM IP Assets B.V.

**Opponent:**

ARKEMA France

**Headword:**

Powder coating composition/DSM

**Relevant legal provisions:**

EPC Art. 56, 83, 108, 112(1), 123(2)  
EPC R. 99(1), 101(1)  
EPC 1973 R. 64(b)  
RPBA Art. 12(4), 13(1)  
RFees Art. 4(1)

**Keyword:**

Admissibility of patent proprietor's appeal - notice of appeal  
- filed within time limit (no)

Amendments - added subject-matter (no)

Inventive step - (yes)

Sufficiency of disclosure - (yes)

**Decisions cited:**

J 0016/82, J 0019/90, T 0925/91, T 0371/92, T 0489/93,  
T 0445/98, T 0778/00, T 0358/08, T 1479/09, T 1943/09,  
T 0377/11, T 0861/12, T 0620/13, J 0005/15



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Case Number: T 0551/15 - 3.3.01

**D E C I S I O N**  
**of Technical Board of Appeal 3.3.01**  
**of 14 February 2019**

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**Decision under appeal:** **Interlocutory decision of the Opposition  
Division of the European Patent Office posted on  
7 January 2015 concerning the maintenance of  
European patent No. 1833926 in amended form**

**Composition of the Board:**

**Chairman** A. Lindner  
**Members:** J. Molina de Alba  
M. Blasi

## Summary of Facts and Submissions

I. The present appeal is against the interlocutory decision of the opposition division concerning the maintenance of European patent No. 1 833 926 in amended form, based on the sole claim filed on 28 November 2014 as auxiliary request 10. The claim reads as follows:

*"1. Process for the preparation of a powder coating composition comprising at least one resin, at least one crosslinker, at least one pigment and at least one dispersant characterised in that the resin is a polyester resin and said resin is prepared in a reactor and that the dispersant is added to the resin either just before the resin leaves the reactor or while the resin leaves the reactor."*

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

D2 US-B-6 669 984

D3 F.L. Duivenvoorde et al., Progress in Organic Coatings, 45, 2002, 127-137

D4 F.L. Duivenvoorde et al., Progress in Organic Coatings, 36, 1999, 225-230

D5 K.H. Siddiqui et al., Advances in Coatings Technology, 6th International Conference, Warsaw, Poland, 23-26 November 2004, Paper No. 36

D5' I.D. Maxwell et al., Focus on Powder Coatings, 2005, Issue 2, 2-3

- D5'' Advances in Coatings Technology, 6th International Conference, Warsaw, Poland, 23-26 November 2004, list of papers
- D7 F.L. Duivenvoorde et al., Journal of Coatings Technology, 74, 2002, 49-57
- D15 Declaration of Anna Pajak dated 19 February 2015
- D16 Experimental report filed by the opponent with the letter of 26 February 2016

III. The patent, granted in 2011, had been opposed on the grounds of Article 100(c), 100(b) and 100(a) EPC for lack of novelty and inventive step.

In the appealed decision, the opposition division had held that the process claimed in auxiliary request 10 did not add subject-matter and that it was novel. In addition, document D5 did not belong to the prior art and the claimed process was inventive starting from either of documents D2 and D3.

IV. Within the two-month period under Article 108 EPC, the opponent filed notice of appeal and paid the corresponding appeal fee.

On 17 March 2015, i.e. prior to the expiry of the two-month period under Article 108 EPC, the patent proprietor submitted, via the electronic filing system, a document entitled "*Letter accompanying subsequently filed items*". The document indicated the patent application number, the name and address of the representative and the representative's reference number. Under the heading "*Fees*" it specified the fee

for appeal, and under the heading "*Payment*" it contained a debit order authorising the EPO to debit the appeal fee from the deposit account, followed by the details as to the deposit account and an indication relating to where any reimbursement was to be made. The document did not contain any further text, nor was it accompanied by any further document. The payment of the appeal fee was effected with the date of 17 March 2015.

- V. With its statement of grounds of appeal, the opponent contested the appealed decision and filed document D15 to prove that D5 belonged to the prior art. Moreover, the opponent argued that the process of auxiliary request 10 added subject-matter, could not be reproduced by the skilled person, and was obvious from the combination of documents D5 and D7.

On 26 February 2016, the opponent filed document D16.

- VI. In its statement of grounds of appeal, the patent proprietor stated: "*Further to the Notice of Appeal filed on 17.03.2015 by the payment of the appropriate fee, we hereby submit the Grounds of Appeal...*". Together with this letter, the patent proprietor filed claim sets as the main request and auxiliary requests 1 to 17; these claim sets were identical to those underlying the appealed decision.

Subsequently, with its reply to the opponent's statement of grounds of appeal and with a letter dated 14 June 2016, the patent proprietor requested respectively that documents D15 and D16 not be admitted into the appeal proceedings.

- VII. In a communication dated 17 February 2016, the board gave its preliminary opinion that the patent

proprietor's appeal had to be considered as not having been filed and that the corresponding appeal fee would be reimbursed. This opinion was contested by the patent proprietor in its letter of 15 June 2016.

- VIII. In view of the parties' requests for oral proceedings, the board summoned both to oral proceedings and addressed several issues in an accompanying communication.
- IX. In the course of the oral proceedings held before the board, the patent proprietor withdrew its main request and auxiliary requests 1 to 9, 12, 14, 16 and 17.
- X. The opponent's arguments, where relevant to the present decision, may be summarised as follows:

*Admission of documents D15 and D16*

Document D15 should be taken into consideration as it had been filed in response to the appealed decision to prove that D5 was available to the public before the priority date of the patent in suit. The statement of grounds of appeal was the first possible occasion for filing D15, since the patent proprietor had contested the publication date of D5 only two months before the oral proceedings in opposition and, although the opponent had quickly reacted by filing document D5'', the opposition division did not attach sufficient probative value to it at oral proceedings and excluded D5 from the prior art.

Document D16 should also be admitted into the proceedings as it contained the comparative examples announced in the statement of grounds of appeal; they could not have been carried out earlier due to the

opponent's limited resources and the need to set priorities. Moreover, the examples merely complemented those in the patent, which already showed a lack of improvement for the claimed process.

*Amendments - claim 1 of auxiliary request 10*

The process in claim 1 of auxiliary request 10 added subject-matter. The application as filed was directed to the preparation of two different compositions: a modified resin obtained by adding a dispersant to the resin (see claim 4; page 1, lines 33 to 34; page 2, lines 3 to 7; page 5, lines 3 to 6), and a powder coating composition prepared by admixing the modified resin with further ingredients, such as a crosslinker or a pigment. So, the preparation of the powder coating compositions according to the application as filed was carried out in two separate steps, the first of which involved the combination of the resin and the dispersant only. By contrast, the process in claim 1 of auxiliary request 10 did not require those two steps because the pigment and/or the crosslinker could be added to the resin together with the dispersant.

*Inventive step - claim 1 of auxiliary request 10*

In the assessment of inventive step, document D5 was the closest prior art because it disclosed powder coating compositions that contained the components cited in claim 1 of auxiliary request 10. The claimed process differed from the one disclosed in D5 (section 2.2) in that the resin and the dispersant were premixed and only then combined with the other ingredients, while in D5 all ingredients were admixed at the same time.



According to paragraph [0006] of the patent, the technical problem to be solved was the provision of improved powder coating compositions. However, in view of the comparative examples in the patent in Table 4 (comparative examples C-1 and C-2 vs example III), Table 6 (comparative example E-1 vs example V) and Graph 1, the problem had not been solved. This conclusion was reinforced by the fact that the examples according to the invention contained systematically a higher amount of dispersant than their corresponding comparative examples. Hence, the problem had to be reformulated in a less ambitious manner as the provision of an alternative process for the preparation of powder coating compositions.

The solution proposed in claim 1 was obvious. In its introduction, D5 referred to document D7 (reference (4)). Like D5, document D7 was concerned with the problem of improving the properties of powder coating compositions, especially viscosity and pigment dispersion. The solution proposed in D7 was the use of a polymeric dispersant which could be combined with the other ingredients in any of two alternative ways (see page 51, left-hand column, paragraph 1): either adsorbing the dispersant on the pigment particles prior to their combination with the rest of the ingredients, or pretreating the resin with the dispersant and then mixing the obtained premix with the rest of ingredients. The powder coating compositions obtained from either of the two alternative processes had equivalent properties (see page 55, right-hand column, paragraph 1). Hence, as the second alternative proposed in D7 (premix resin-dispersant) corresponded to the solution proposed in claim 1, the combination of D5 with D7 rendered the solution obvious.

Regarding the patent proprietor's argument that the skilled person would not have combined documents D5 and D7 because the compositions in the latter did not contain a crosslinker, it had to be noted that the authors of D7 had dispensed with the crosslinker merely to improve performance; there was no reason not to apply the teaching of D7 to the compositions of D5, especially having regard to the fact that D5 explicitly referred to D7.

*Sufficiency of disclosure - auxiliary request 10*

The invention claimed in auxiliary request 10 was not sufficiently disclosed. The examples in the patent could not be reproduced because they lacked essential information, such as the resin used, the reaction conditions and the reactor type. In addition, the feature in claim 1 "*just before the resin leaves the reactor*" was so unclear that the skilled person could not carry out the invention; according to the patent in paragraph [0016], the mentioned feature designated the point in time at which the resin already had all the pre-determined properties and was more or less waiting to leave the reactor. However, the patent did not specify any pre-determined properties of the resin, not even in the examples. This deficiency made it impossible for the skilled person to carry out the invention without undue burden.

- XI. The patent proprietor's arguments, where relevant to the present decision, may be summarised as follows:

*Patent proprietor's appeal*

The patent proprietor's appeal was admissible. The letter submitted on 17 March 2015 fulfilled all the necessary requirements for a notice of appeal.

The legal framework under the EPC 2000 did not require the filing of notice of appeal and payment of the appeal fee to be enacted via separate documents. That the board required a "*clear and unambiguous declaration of intent that an appeal is filed*" was arbitrary and did not find any basis in the relevant legal provisions.

It followed from decision T 620/13, that the request under Rule 99(1)(c) EPC could be implicit.

Furthermore, the present case was similar to the one underlying decision T 925/91.

Decision J 19/90 was correct under the legal framework of the EPC 1973 but was no longer applicable since the entry into force of the EPC 2000 because the requirements as to the filing of an admissible appeal had been lowered: not only had the requirement in Article 108 EPC that the appeal had to be filed "*in writing*" been dropped, thereby allowing submissions in electronic form, but also the criteria concerning notice of appeal had changed. Whereas Rule 64(b) EPC 1973 had required "*a statement identifying the decision which is impugned and the extent to which the amendment or cancellation of the decision is requested*", Rule 99(1)(b) and (c) EPC only required "*an indication of the decision impugned*" and "*a request defining the subject of the appeal*".

The letter of 17 March 2015 was not simply a mere debit order; it also contained an indication that it related to the filing of an appeal, and, hence, the situation was different from the one underlying decision J 19/90. The letter expressly mentioned a "*fee for appeal*", separate from the mode of payment. There was no apparent reason why a party would pay the fee for appeal within the time limit for a specific case other than for the purpose of filing an appeal.

The registrar's communication dated 20 March 2015 announcing the commencement of proceedings before the board confirmed that the letter of 17 March 2015 was not only considered as a debit order.

It was unclear what the substantive contribution and purpose of the board's stance were. Irrespective of the presence of any explicit declaration of the intent to appeal within the first two months of notification of the decision, it was only after expiry of the four-month period for filing the statement of grounds of appeal under Article 108, third sentence, EPC that there could be legal certainty as to the filing of an appeal.

However, if the board considered that no admissible appeal had been filed by the patent proprietor, it was accepted that this had, in view of the principle of prohibition of *reformatio in peius*, consequences as to which claim requests could be permissibly pursued.

#### *Admission of documents D15 and D16*

Document D15 should not be admitted. The opponent had failed to fulfil its obligation to present its complete

case in the opposition proceedings because, knowing from the beginning that the publication date of document D5 could be challenged, it had not filed any proof of its availability to the public. In addition, D15 was not a sworn declaration and therefore lacked sufficient legal weight.

Document D16 should not be admitted. The opponent should have presented its complete case at the beginning of the appeal proceedings; the late filing of D16 was not justified by any change in the proceedings. The announcement in the opponent's statement of grounds of appeal that further experimental evidence would be filed was formulated in conditional form ("*if necessary*") and was therefore not a clear declaration that additional evidence would indeed be filed. The opponent's argument that D16 could not have been submitted earlier due to a need for prioritising resources should not be accepted because such an argument could be adduced for any late submission. If, as submitted by the opponent, the content of document D16 was only complementary, D16 was not particularly relevant.

*Amendments - claim 1 of auxiliary request 10*

The method in claim 1 of auxiliary request 10 was unambiguously derivable from a reading of the application as filed in its entirety and, in particular, from the following passages:

- page 1, lines 4 to 7
- page 1, line 31 to page 2, line 12
- page 2, lines 3 to 7
- page 3, lines 19 to 26
- page 4, lines 8 to 20 and 27 to 31

- page 5, lines 3 to 15
- page 6, lines 1 to 24
- claims 1, 2 and 4 to 6

The application disclosed two compositions: an intermediate composition containing a resin and a dispersant, and a final powder coating composition obtained by the combination of the intermediate composition with further ingredients, such as a pigment and a crosslinker. Claim 1 of auxiliary request 10 defined a process for preparing the final composition; it was derivable from the application as filed because the latter taught the preparation of the intermediate composition and its use, together with further ingredients such as a pigment and a crosslinker for obtaining the final composition. Moreover, the process was illustrated in the examples in the application.

*Inventive step - claim 1 of auxiliary request 10*

Inventive step could be assessed starting from the disclosure of document D5. The claimed process differed from the one in D5 in that the dispersant was added to the resin just before or while the resin left the reactor. According to the patent in paragraphs [0006] and [0046], the problem to be solved was the provision of a process for the preparation of a powder coating composition with improved flow and no deterioration of haze or gloss. The examples in Tables 3, 4 and 6 in the patent proved that this problem had been solved. In this connection, only comparative examples containing a dispersant (examples A-2 to F-2) were suitable for comparison; the examples lacking a dispersant (examples A-1 to F-1) did not represent the closest prior art.

With regard to the question of obviousness, the skilled person had no motivation to combine the teachings of documents D5 and D7 because the powder coating compositions of D5 contained a crosslinker, while those of D7 explicitly did not (see page 50, right-hand column, lines 1 to 3). Furthermore, even if the documents were combined, neither of them taught the addition of the dispersant just before or as the resin left the reactor, since the resins used in both documents had been purchased on the market and had therefore been synthesised a long time before the dispersant was added.

*Sufficiency of disclosure - auxiliary request 10*

The claimed invention was sufficiently disclosed. The skilled person was not limited to the patent teaching in paragraph [0016] or in the examples; the common general knowledge in the field of powder coating compositions had to be taken into consideration too. In this respect, the skilled person knew the general properties of the polyesters used in powder coating compositions; the patent mentioned, for instance, the acid and hydroxyl values (see paragraph [0032]). In addition, monitoring such properties was common practice. Lastly, the examples showed how to carry out the invention, the core of which was the time at which the dispersant was added to the polyester resin, rather than the specific resin used or the conditions for its synthesis.

XII. The parties' final requests were the following:

- The opponent requested that the decision under appeal be set aside and the patent be revoked in its entirety.

- The patent proprietor requested that the decision under appeal be set aside and that the patent be maintained in amended form on the basis of any of the claim sets filed with the statement of grounds of appeal as auxiliary requests 10, 11, 13 and 15, auxiliary request 10 being the request held allowable by the opposition division.

XIII. At the end of the oral proceedings, the board's decision was announced.

### **Reasons for the Decision**

1. The opponent's appeal complies with Articles 106 to 108 and Rule 99 EPC and is therefore admissible.

2. *Patent proprietor's appeal*

No appeal was validly filed by the patent proprietor. The appeal fee was duly paid, but nothing had been received within the two-month time limit under Article 108, first sentence, EPC which could be considered a notice of appeal.

2.1 Mere payment of the appeal fee within the two-month time limit under Article 108, first sentence, EPC does not constitute the valid filing of an appeal.

According to Article 108, first sentence, EPC, notice of appeal has to be filed within two months of notification of the decision. The second sentence of this provision stipulates that notice of appeal shall



not be deemed to have been filed until the fee for appeal has been paid.

It clearly follows from the wording of Article 108, first and second sentences, EPC that filing notice of appeal and payment of the appeal fee are two distinct requirements, each of which has to be fulfilled separately (see also T 778/00, OJ EPO 2001, 554, point 2.2 of the reasons). This did not change in the course of the revision of the EPC in the year 2000 (see also T 861/12, point 4.4.1 of the reasons; Special edition No. 4, OJ EPO 2007, pages 100, 120), in contrast to, for instance, the legal remedy of further processing, which, since the entry into force of EPC 2000, can be requested by mere payment of the prescribed fee (see Article 121(1) and Rule 135(1) EPC).

Even though the board agrees with the patent proprietor in that the two acts - filing notice of appeal and paying the appeal fee - do not necessarily have to be performed via separate documents, the mere payment of the appeal fee still cannot replace the filing of notice of appeal.

- 2.2 The "*Letter accompanying subsequently filed items*" submitted on 17 March 2015 ("the letter") being the sole document received by the EPO from the patent proprietor before the expiry of the two-month time limit under Article 108 EPC, does not, however, qualify as a notice of appeal.
- 2.2.1 A notice of appeal is a declaration directed to the EPO of the intention to challenge a particular decision by means of an appeal. The declaration of the intent to file an appeal must be clear and unambiguous (see also

J 19/90, Headnote and point 2.1.3 of the reasons;  
T 371/92, OJ EPO 1995, 324, point 3.5 of the reasons;  
J 16/94, OJ EPO 1997, 331, point 4 of the reasons;  
T 460/95, OJ EPO 1998, 587, 594, second paragraph;  
T 445/98, point 3 of the reasons; T 778/00, *supra*,  
point 2.1 of the reasons; T 377/11, point 5.1 of the  
reasons; T 620/13, point 5 of the reasons). This  
prerequisite is also reflected in Rule 99(1)(c) EPC,  
according to which the notice of appeal must contain a  
*"request for defining the subject of the appeal"*.

The board accepts, in line with established case law,  
that the request under Rule 99(1)(c) EPC can be  
implicit. What may be implicit in this context,  
however, relates only to the indication of whether the  
impugned decision is to be set aside in whole or only  
in part (see also T 620/13, point 7 of the reasons with  
reference to T 358/08). It does not mean that a clear  
and unambiguous declaration of intent that an appeal is  
filed, constituting notice of appeal within the meaning  
of Article 108 EPC, is not required. Accordingly, the  
patent proprietor's reference to decision T 620/13  
provides no support for its case.

Nor can decision T 925/91 (OJ EPO 1995, 469) be of  
assistance to the patent proprietor, since, in the  
situation underlying that decision, an explicit  
declaration expressing the definite intention to  
contest a particular decision by means of an appeal,  
and consequently a statement qualifying as notice of  
appeal, had in fact been filed (*"Gegen die  
Entscheidung... legen wir... hiermit... Beschwerde  
ein"*; see letter of 3 December 1991 referred to in  
T 925/91, point 1.1 of the reasons; translation by the  
board: *"Against the decision ... we ... herewith  
file ... notice of appeal"*).

Furthermore, the changes introduced by the EPC 2000 revision into the provisions governing the filing of an appeal as referred to by the patent proprietor (see section XI above) did not change the concept of what constitutes notice of appeal under Article 108 EPC (see first paragraph of this point; also e.g. T 1943/09, point 4 of the reasons; T 377/11, point 5.2 of the reasons). Therefore these changes need not be further addressed.

- 2.2.2 The letter received on 17 March 2015 indicates the particulars necessary for the payment to be effected via debiting of the appeal fee from a deposit account in accordance with point 6.3 of the Arrangements for Deposit Accounts (in the version of 1 April 2014, Supplementary publication 4, OJ EPO 2014, 5), and provides information concerning any re-payments. In the absence of any further statement in it, the letter cannot be considered as going beyond a mere debit order.

In particular, the letter does not represent a clear and unambiguous declaration of intent that an appeal is being filed at the moment of its submission. Considered objectively from the point of view of the adverse party, the EPO and the public, the sending of a debit order for the payment of the appeal fee implies, at most, that the party envisages filing an appeal. It still leaves the party the choice of whether, or at what point in time, to file notice of appeal as the necessary second act for an appeal to come into existence.

- 2.2.3 It is also established case law that filing the form for the payment of fees and costs (EPO Form 1010) or

filing a "*Letter accompanying subsequently items*" that contains nothing more than a debit order for the payment of the appeal fee does not qualify as filing notice of appeal (see in particular J 19/90, Headnote; T 371/92, *supra*, point 3.6 of the reasons; T 445/98, point 3 of the reasons; T 778/00, *supra*, points 1 and 2.4 of the reasons). Further, it has been explicitly confirmed in decisions analysing the EPC 2000-related changes that this case law continues to be relevant following the entry into force of the EPC 2000 (see T 1479/09, point 4 of the reasons; T 1943/09, point 4 of the reasons; T 377/11, point 5.2 of the reasons; T 861/12, point 4 of the reasons).

2.2.4 In contrast to the patent proprietor's opinion, it is of no relevance to the present case that the board's registrar had been able to identify the letter as associated with a potential appeal, which resulted in the issuance of EPO Form 3204 informing the parties of the commencement of proceedings before the board and the allotted appeal number. This is the sole, stated purpose of this communication. In no way does such a communication reflect on whether or not an appeal has been validly filed or is well founded (see also T 620/13, point 6 of the reasons; J 5/15, point 2 of the reasons).

2.2.5 It is true that where notice of appeal has been filed, it is only after expiry of the four-month time limit for filing the statement of grounds of appeal pursuant to Article 108, third sentence, EPC, that there can be legal certainty as to whether there might be an admissible appeal. However, it is not this kind of consideration which matters here. It is simply the application of the legal concept as established by the EPC legislator for the initiation of admissible appeal

proceedings (as to the legislative history, see T 778/00, *supra*, point 4 of the reasons).

3. *Referral G 1/18*

Even though the appeal fee had been paid on time, no notice of appeal was filed by the patent proprietor within the two-month time limit under Article 108, first sentence, EPC. Thus, the patent proprietor's appeal did not come into existence and, accordingly, the patent proprietor's appeal is deemed not to have been filed.

- 3.1 When making its decision, the board was well aware of a point of law referred to the Enlarged Board of Appeal and pending as referral G 1/18. The referred question comprises several alternatives one of them directed to the issue of whether the filing of the notice of appeal after expiry of the two-month time limit under Article 108 EPC results in the appeal being inadmissible or deemed not filed.

The present case may be considered as falling under this alternative because the patent proprietor's statement of grounds of appeal comprises all the necessary elements of a notice of appeal pursuant to Article 108, first sentence, and Rule 99(1) EPC, and thus it can be said that notice of appeal was filed late.

Where a referral under Article 112(1) EPC is pending before the Enlarged Board of Appeal and the outcome of an appeal case entirely depends on the outcome of the referral, a board can stay its proceedings at the request of a party or *ex officio*. Even though there is no explicit legal provision in this regard, the board

considers it as established practice amongst the boards of appeal that a stay of proceedings may, *inter alia*, be based on considerations relating to the binding effect of opinions or decisions of the Enlarged Board as provided for in Article 21 RPBA and a uniform application of the law.

In the present case, the board did not stay the appeal proceedings because the outcome of the case did not depend entirely on the outcome of the referral - except for the question of whether the board's order regarding the patent proprietor's appeal was correct. Whether the patent proprietor's appeal is to be considered as inadmissible or deemed not filed leads, in both situations, to the same procedural consequence, which is that the patent proprietor is limited to defending the patent in amended form as considered allowable by the opposition division.

The point in relation to which the outcome of referral G 1/18 is indeed relevant concerns the question of the refund of the appeal fee paid by the patent proprietor (see point 3.2 below). However, the board's decision is favourable for the patent proprietor, who is the sole person concerned by this question. No other person - be it the opponent or any third party - can be affected by the outcome of the board's decision on the refund of the patent proprietor's appeal fee. Furthermore, neither of the two parties to the proceedings had requested a stay of proceedings in view of referral G 1/18, nor had they any objections to the way the board intended to proceed as indicated at the oral proceedings.

- 3.2 The board bases its conclusion, which is that the patent proprietor's appeal should be deemed not to have

been filed, on Article 108, first and second sentences, EPC read together (see also J 16/82, OJ EPO 1983, 262, point 9 of the reasons; T 778/00, *supra*, point 2.2 of the reasons). Only notice of appeal filed on time can trigger the falling due of the appeal fee pursuant to Article 4(1) RFees, payment of which in turn leads to the consequence that the notice of appeal is deemed filed. Accordingly, for an appeal to come into existence, in the board's opinion the two acts - filing notice of appeal and payment of the appeal fee - must take place within the two-month time limit under Article 108 EPC. If, as in the present case, the notice of appeal is filed after expiry of the two-month time limit, it cannot be deemed to have been filed because the appeal fee, even if paid within the two-month time limit, has not in fact fallen due in the absence of notice of appeal being filed on time. Thus, the appeal fee has been paid without a legal basis.

Non-compliance with any of these two requirements leads, in the board's opinion, to a finding of the appeal being deemed not filed and to a corresponding order by the board (see also T 445/98, point 5 of the reasons).

The legal consequence of the appeal being deemed not filed is defined in Article 108 EPC itself. Rule 101(1) EPC, which provides for a rejection of an appeal as being inadmissible, is construed by the board as relating to situations in which an appeal had already come into existence (i.e. decision T 489/93, point 9 of the reasons, is not followed by this board).

4. *Admission of document D15 - Article 12(4) RPBA*

Document D15 was filed by the opponent with the statement of grounds of appeal in order to prove that document D5 was publicly available at the priority date of the patent in suit. The patent proprietor objected to the admission of D15, asserting that it should have been filed with the notice of opposition, anticipating that the publication date of D5 would be challenged.

The board cannot agree with that view and considers that the filing of D15 was an appropriate reaction to the appealed decision, where the opposition division had disregarded D5 because it had not been convinced that the document was available at the priority date of the patent in suit. The opponent had, with its notice of opposition and together with document D5, also filed document D5', submitting that document D5 had not only been made available at a conference in Warsaw 23-26 November 2004 but also that an equivalent document had been made available at the ICE 2004 conference in Chicago on 27-29 October 2004. The patent proprietor, however, only questioned the prior-art status of document D5 on the final date for making written submissions before the oral proceedings in opposition, even though in the notice of opposition D5 had been presented as a highly relevant document for both novelty and inventive step. It thus cannot be concluded that the opponent should have filed D15 during opposition proceedings.

In view of the considerations above, the board saw no reasons to disregard document D15 under Article 12(4) RPBA and, hence, it was admitted into the proceedings.



5. *Document D5 - prior art under Article 54(2) EPC*

In view of documents D5', D5'' and D15, the board is convinced that document D5 was made available to the public at the ACT '04 conference held in Warsaw 23-26 November 2004, i.e. before the priority date of the patent in suit.

Document D5, first page, mentions the title and the authors and has, *inter alia*, the following indications: "*Advances in Coatings Technology ACT '04*", "*Paper 36*", "*23-26 November 2004, Warsaw, Poland*". Document D5'' contains the table of contents of the conference papers for ACT '04, and lists on page 6 the title and the authors of document D5 as paper 36. The first page of D5'' indicates the title of the document ("*Advances in Coatings Technology*", "*ACT '04*", "*Conference Papers*"), and the same place and dates as document D5. That the latter information represents not only the date and place of the conference event but also the time and place of publication is confirmed by document D15. This is a declaration signed by Ms Pajak in her capacity as Chair of the Organising Committee of the ACT '04 Conference. Ms Pajak confirms therein that the conference papers from the 6th International Conference ACT '04 had been available to the participants on the dates of the conference, which was held on 23-26 November 2004 in Warsaw. From document D5' it is further derivable that a paper with the same title and the same authors as document D5 had been presented at the ICE 2004 conference in October 2004 in Chicago.

The patent proprietor referred to the fact that document D15 was not a sworn declaration. However, there is no requirement under the EPC with regard to

the kind of evidence a party is allowed to submit. Article 117(1) EPC lists various means of evidence in a non-exhaustive manner, and it is for a party to submit the evidence on the basis of which its assertions would have to be assessed, if necessary. In the circumstances of the present case, the board had documents D5, D5', D5'' and D15 as a basis on which to consider the opponent's assertions.

Accordingly, the content of document D5 forms part of the state of the art within the meaning of Article 54(2) EPC.

6. *Admission of document D16 - Article 13(1) RPBA*

Document D16 is an experimental report with comparative examples filed by the opponent after the four-month period for replying to the patent proprietor's statement of grounds of appeal.

The filing of document D16 therefore represented an amendment of the opponent's case, and the admission of the document into the appeal proceedings is at the board's discretion, taking into account, *inter alia*, the complexity of the new subject-matter submitted, the state of the proceedings and procedural economy. The clause in the opponent's statement of grounds of appeal in paragraph 3, page 7, which states that it reserved the right to later provide, if needed, experimental support for the line of argument by submitting comparative results to demonstrate that the technical problem had not been solved, has no impact on the consideration of there being an amendment to the opponent's case. It is not only a general, unspecific statement, but also a conditional one, leaving it

completely open whether experimental data would be filed at all.

Document D16 was filed 10 months after the opponent's statement of grounds of appeal and five months after the patent proprietor's reply to that statement. By that time, no change in the appeal proceedings had occurred which justified the filing of further comparative examples. The lack of resources invoked by the opponent for filing D16 at that late stage cannot be considered as a convincing reason, as this was related to the opponent's internal priority setting and was thus a matter of deliberate choice on its part.

Moreover, the opponent itself considered the data in document D16 as complementary. The data were therefore regarded by the board as no more relevant than the opponent's submissions already on file.

In view of the considerations above, the board, exercising its discretion under Article 13(1) RPBA, decided not to admit document D16 into the appeal proceedings.

7. *Amendments - claim 1 of auxiliary request 10*

The application as filed states on page 1, lines 4 to 7, that it relates, among other things, to a process for preparing a powder coating composition. On page 4, lines 27 to 29, it mentions that a powder coating composition generally comprises a resin, a crosslinker, a pigment and a dispersant. On page 2, lines 18 and 19, it cites polyester resins as one out of the three most preferred resin types. And on page 4, lines 11 to 14, it states that the dispersant is added either during the resin synthesis, preferably just before the resin

leaves the reactor, or while the resin leaves the reactor. So, all the features in present claim 1 were disclosed in the application as filed, and only one selection was required, namely that the resin be a polyester.

The opponent contended that the application as filed required that the powder coating composition be prepared in two steps: modifying a resin with a dispersant followed by admixing the modified resin with the rest of components. This obligatory condition, however, was dispensed with in claim 1.

On this point, the board notes that the application as filed teaches on page 5, lines 7 to 10, and in claim 5, that the powder coating composition of the invention comprises at least one resin and at least one crosslinker, and that at least one dispersant is added during the resin synthesis or while the resin leaves the reactor. In the same context, on page 5, lines 14 and 15, and in claim 6, the powder coating composition comprises preferably at least one pigment. Thus, even if the primary teaching of the application indeed was the preparation of a powder coating composition in the two steps mentioned by the opponent, the passages cited above support a preparation process as defined in claim 1, which is limited only by the fact that the dispersant is added to the resin either just before or as the resin leaves the reactor.

For this reason, claim 1 of auxiliary request 10 does not add subject-matter (Article 123(2) EPC).

8. *Inventive step - claim 1 of auxiliary request 10*

8.1 Claim 1 of auxiliary request 10 is directed to the preparation of a powder coating composition comprising a polyester resin, a dispersant, a pigment and a crosslinker, which is characterised by the fact that the dispersant is added to the polyester resin just before or at the end of the resin synthesis. According to the patent in paragraphs [0006] and [0046], this process results in powder coating compositions with improved flow and improved or at least equivalent haze and gloss.

8.2 In the appeal proceedings, the opponent assessed inventive step starting from document D5 as the closest prior art. The patent proprietor did too, following the board's finding that D5 belonged to the prior art. The board saw no reason to take a different stance.

D5 discloses rheology studies and final coating properties of three powder coating compositions comprising, among other things, the ingredients recited in present claim 1: a polyester resin (Uralac P815), a dispersant (A, B or Solplus L300), a pigment (Carbon Black FW200, Kronos 2310 or Paliotan Yellow L1945), and a crosslinker (Araldite PT910 or Primid XL552) (see Tables 3.1, 4.1, 5.1 and 5.2). The compositions were prepared by premixing in a tumble mixer, extruding, and milling the extrudate (see section 2.2). The results reported in section 6 revealed that the use of a polymeric dispersant reduces the compositions' viscosity and improves their dispersion and gloss.

8.3 The process in claim 1 differs from the one in D5 in that the resin is prepared in situ and the dispersant

is added to the resin just before or as the resin leaves the synthesis reactor; in D5, the preparation process does not involve the synthesis of the resin in situ and the components are all mixed together without the resin being previously combined with the dispersant.

8.4 The technical problem to be solved, as defined in paragraphs [0006] and [0046] of the patent, is the preparation of powder coating compositions with improved flow, without deteriorating the haze and gloss. The solution proposed is the process defined in claim 1.

8.5 The board is satisfied that the process in claim 1 effectively solves the problem posed, as demonstrated by the examples in the patent.

The patent discloses in paragraphs [0035], [0037], [0039] to [0041] and [0043] the preparation of six powder coating compositions according to the process of claim 1: the compositions contained a polyester resin (Uralac<sup>®</sup> P 865, P 4050 or P 1580), a dispersant (Disperbyk<sup>®</sup> 180), a pigment (Kronos<sup>®</sup> 2160) and a crosslinker (Primid<sup>®</sup> XL552, Araldite<sup>®</sup> GT 7004 or Vestagon<sup>®</sup> B 1530), and the process started with the synthesis of three polyester resins, at the end of which the dispersant was added (15 min. before the resin left the reactor). Each of these dispersant-modified resins was then combined in a pre-mixer with further ingredients, including a pigment and a crosslinker. The resulting mixtures were then extruded and milled, and the obtained powder coating compositions were then designated as examples I to VI in Tables 1, 2 and 5.

Similarly, six comparative powder coating compositions based on the same polymer resins as the examples according to claim 1 were prepared. This time, however, the dispersant was not added to the resin in a previous step but together with all the other components (see paragraphs [0034], [0036], [0038], [0040] and [0043]). The resulting comparative powder coating compositions were designated as A2 to F2 in Tables 1, 2 and 5; they are comparable with examples I to VI, respectively.

The flow, haze and gloss of all the compositions were then tested and the results reported in Tables 3, 4 and 6. The table below summarises those results, where the higher the flow and gloss and the lower the haze, the better the properties.

Example	A-2	I	B-2	II	C-2	III	D-2	IV	E-2	V	F-2	VI
Flow	5	7.5	2	6	6	7	1	3	3	9	2	5.5
Haze	74	21	189	45	69	73	479	155	155	76	255	140
Gloss 20°	87	90	70	78	90	93	18	77	71	76	50	60
Gloss 60°	97	96	90	87	98	99	63	93	90	90	81	83

It is apparent from the table that examples I to VI have superior flow properties than their corresponding comparative examples and have better or at least equivalent haze and gloss. In addition, Graph 1 on page 9 of the patent shows that the haze of the comparative ("*in premix*") and inventive ("*in resin*") compositions is within the same range up to a pigment concentration of about 55 wt%, where the compositions according to the invention become superior.

8.5.1 In this context, the opponent contended that compositions A-2 to F-2 could not be compared with examples I to VI because the latter contained

systematically a higher concentration of dispersant (see Tables 1, 2 and 5).

A calculation by the board of the dispersant contained in each of the examples gives the following results in wt.% (calculation based on the amounts indicated in tables 1, 2 and 5, and the dispersant content in resins B, D and F disclosed in paragraphs [0035], [0037] and [0039]):

A-2	I	B-2	II	C-2	III	D-2	IV	E-2	V	F-2	VI
1.23	1.25	0.85	0.85	0.66	0.67	0.46	0.46	0.66	2.33	1.35	1.35

The data show that the opponent was right for the case of examples E-2 and V, where example V contains more than three times the dispersant concentration of example E-2. However, the other examples are clearly comparable, since the slight difference in dispersant concentration between comparative and inventive compositions is so small that it falls within the margin of error in the measure and cannot account for the improvement shown. Hence, the examples in the patent, with the exception of examples E-2 and V, are comparable and conclusively prove that the technical problem is solved by the process of claim 1.

- 8.5.2 Another argument from the opponent in relation to the solution of the problem was based on the comparison of examples I to VI with those that did not contain a dispersant, namely examples A-1 to F-1 (see Tables 1, 2 and 5). In particular, the opponent drew attention to examples III, V and VI, which did not show improved properties with regard to their corresponding comparative examples C-1, E-1 and F-1.



On this point, the board agrees with the patent proprietor that compositions lacking a dispersant do not represent the closest prior art, since the gist of the latter was the benefit that polymeric dispersants bring to powder coating compositions; this is already apparent from the title of D5: "*Power coatings - Improving problem formulations with the use of polymeric dispersants*". Accordingly, comparative examples A-1 to F-1 are not suitable for assessing whether the problem has been solved.

- 8.5.3 The opponent also argued that comparative examples A-2 to F-2 did not exactly reproduce the compositions of D5 and therefore did not provide a valid comparison with the closest prior art.

The board disagrees. Although the compositions of examples A-2 to F-2 are not identical to the ones in document D5, they are valid comparative examples inasmuch as they differ from the examples according to claim 1 exclusively in the feature that distinguishes the process of claim 1 from the process of D5, namely the combination of the dispersant with the resin previous to the addition of the further ingredients. Hence, the comparison with examples A-2 to D-2 and F-2 is conclusive (E-2 has been excluded for its excess of dispersant, as explained above).

- 8.6 Lastly, the board needs to assess whether the solution proposed in claim 1 was obvious to the skilled person in view of the available prior art. In this respect, the opponent argued that the skilled person would have combined the teaching of documents D5 and D7, especially considering that D5 cites D7 in its introduction (see reference (4)); this combination necessarily led to the claimed process.

Document D7 is directed to the use of polymeric dispersants for improving the viscosity and pigment dispersion of powder coating compositions. As noted by the opponent, the document proposes on page 51 (see left-hand column, paragraph 1) two alternative ways of preparation: a first one where the dispersant is adsorbed on the pigment prior to the addition of the remaining ingredients, and a second one where the dispersant is admixed with the resin prior to their combination with the other ingredients. The powder coating compositions obtained by either of the two processes have equivalent properties (see page 55, right-hand column, paragraph 1).

As a first remark, the board notes that document D5 cites D7 as a piece of prior art which shows the beneficial effect of dispersants in powder coating compositions, not as a document teaching advantageous preparation processes to be applied to the compositions of D5. This is apparent from the sentence in document D5 which refers to D7: "*Recent studies have shown positive dispersant effects, in powder compositions also<sup>(4)</sup>*". Furthermore, as pointed out by the patent proprietor, the authors of D7 deliberately dispensed with the use of crosslinkers in their coating compositions (see D7, page 50, right-hand column, lines 1 to 3). So, it would not have been immediately obvious to the skilled person to have applied the processes of D7 to the preparation of the compositions in D5, all of which contain crosslinkers.

But, more importantly, the preparation methods disclosed in document D7 yield powder coating compositions with equivalent properties. Thus, in view of documents D5 and D7, the skilled person was aware of

three possible (equivalent) ways of preparing powder coating compositions. However, nothing in these two documents hinted that the choice of pretreating the resin with dispersant could result in an improvement of flow without impairing haze and gloss with regard to the option of mixing all ingredients together, as in D5. This was even less obvious having regard to the fact that the authors of D5 were aware of the processes disclosed in D7 but nevertheless did not follow them.

Therefore, the board cannot agree with the opponent that the process of claim 1 was obvious from the disclosures in documents D5 and D7, taken alone or in combination.

8.7 In the appealed decision, the opposition division had considered the disclosures in documents D2 and D3 as the closest prior art and come to the conclusion that the process in claim 1 of auxiliary request 10, which is identical to the process in present claim 1, was inventive. During the appeal proceedings, the opponent did not contest the opposition division's approach starting from D2 or D3 and presented inventive-step objections starting from the disclosure in document D5 only. Hence, the board has no reason to review the opposition division's finding on inventive step starting from the disclosures in document D2 or D3.

8.8 Having regard to the above, the board concludes that the process in claim 1 of auxiliary request 10 is inventive (Article 56 EPC).

9. *Sufficiency of disclosure - auxiliary request 10*

The opponent contended that the skilled person was not able to reproduce the claimed process due to the high

degree of uncertainty made by the feature in claim 1 "*just before the resin leaves the reactor*" and by the lack of detail in the examples in the patent. In order to understand what was meant by the cited expression, the skilled person needed to read paragraph [0016] of the patent, which explained that "*[w]ith 'just before the resin leaves the reactor' is meant the moment in time where the resin has already all pre-determined properties and is more or less waiting to leave the reactor*". The patent, however, neither provided information about said pre-determined properties and how to measure them, nor specified the reaction conditions and the type of reactor for preparing the resin. This information was also missing from the examples in the patent, which did not even specify the polyester resin used.

The board does not share the opponent's viewpoint. Firstly, polyester resins were broadly known and used in the field of powder coating compositions at the priority date of the patent. In fact, the most relevant documents cited in the present proceedings, namely documents D2 to D5 and D7, disclose such polyester resins, and there is nothing in those documents which would lead the reader to believe that the polyester synthesis could possibly be associated with particular difficulties or that essential details or properties needed to be specified; the polyester resins used in those documents were in fact commercially available. Secondly, the patent in paragraph [0032] gives some orientation to the properties that suitable polyesters should have, such as acid value, hydroxyl value and glass transition temperature. So, in the board's view, there is no reason to seriously doubt that the properties of the polyester resins suitable for use in powder coating compositions were broadly known at the

priority date and that the skilled person knew how to synthesise such polyester resins. Moreover, monitoring the polyester synthesis reaction or the properties of the reaction product not only belonged to the basic knowledge of the person skilled in polymer chemistry; the patent also provided some information on how to do it: paragraph [0032] taught that the acid value could be calculated by resin neutralisation with KOH and the hydroxyl value could be obtained by acetylation of the hydroxyl groups with a known amount of acetic anhydride followed by hydrolysis and titration of the acetic anhydride excess.

In conclusion, at the effective date, the skilled person was able to prepare a powder coating composition by the process defined in claim 1 without undue burden. Hence, the invention as defined in auxiliary request 10 is sufficiently disclosed (Article 83 EPC).

10. Having regard to the above, the board has no reason to set aside the opposition division's decision that the patent as amended in the form of auxiliary request 10 and the invention to which it relates meet the requirements of the EPC. Hence, the opponent's appeal is to be dismissed.

11. *Reimbursement of the patent proprietor's appeal fee*

As no notice of appeal had been received from the patent proprietor within the two-month time limit under Article 108, first sentence, EPC, the corresponding appeal fee did not fall due pursuant to Article 4(1) RFees. Thus, the appeal fee was paid without a legal basis and must therefore be refunded (see also e.g. T 778/00, *supra*, point 6 of the reasons).

**Order**

**For these reasons it is decided that:**

1. The patent proprietor's appeal is deemed not to have been filed.
2. The opponent's appeal is dismissed.
3. The patent proprietor's appeal fee is to be reimbursed.

The Registrar:

The Chairman:



T. Buschek

A. Lindner

Decision electronically authenticated