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**Datasheet for the decision  
of 6 October 2020**

**Case Number:** T 1657/15 - 3.2.07

**Application Number:** 05002160.9

**Publication Number:** 1688188

**IPC:** B05D7/14

**Language of the proceedings:** EN

**Title of invention:**

Metal plate coated with polyester resin, and can using the same

**Patent Proprietor:**

Toyo Kohan Co., Ltd.

**Opponent:**

Tata Steel IJmuiden B.V.

**Headword:**

**Relevant legal provisions:**

EPC Art. 83, 100(b), 113, 116  
RPBA 2020 Art. 12(8), 15(1)

**Keyword:**

Sufficiency of disclosure - (no)

**Decisions cited:**

**Catchword:**



**Beschwerdekammern**

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Case Number: T 1657/15 - 3.2.07

**D E C I S I O N**  
**of Technical Board of Appeal 3.2.07**  
**of 6 October 2020**

**Appellant:**

(Patent Proprietor)

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**Representative:**

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**Respondent:**

(Opponent)

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**Representative:**

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**Decision under appeal:**

**Decision of the Opposition Division of the  
European Patent Office posted on 8 June 2015  
revoking European patent No. 1688188 pursuant to  
Article 101(3) (b) EPC.**

**Composition of the Board:**

**Chairman**

I. Beckedorf

**Members:**

G. Patton

A. Pieracci

## **Summary of Facts and Submissions**

- I. The patent proprietor lodged an appeal in the prescribed form and within the prescribed period against the decision of the Opposition Division revoking European patent No. 1 688 188.
- II. The opposition was directed against the patent as a whole and based on Article 100(a) EPC (lack of novelty and inventive step), Article 100(b) EPC (insufficiency of disclosure) and Article 100(c) EPC (unallowable amendments).

The Opposition Division held that

- the late-filed partial translation (D10) in English of WO 00/58087 A was not admissible;
- the invention was not sufficiently disclosed for the skilled person to carry it out with respect to the then main request and the then auxiliary requests 1-11; and
- the then auxiliary requests 8, 9, 11-13 were inadmissible since late-filed and not overcoming the objection of insufficiency of disclosure.

- III. The patent proprietor (hereafter the "appellant") requested

that the decision be set aside and that the case be remitted to the opposition division for further prosecution on the basis of one of the sets of claims as filed in the opposition proceedings with letter dated 19 March 2015 (main request and auxiliary requests 1 to 11) or with the statement setting out the grounds (auxiliary requests 12 and 13, also filed during

the oral proceedings before the opposition division);  
subsidiarily  
that the decision be set aside and  
that the patent be maintained on the basis of one of the sets of claims as filed in the opposition proceedings with letter dated 19 March 2015 (main request and auxiliary requests 1 to 11) or with the statement setting out the grounds (auxiliary requests 12 and 13, also filed during the oral proceedings before the Opposition Division).

The requests in appeal proceedings are those underlying the impugned decision. The main request and the first to seventh auxiliary requests in appeal proceedings correspond, respectively, to the main request and the first to seventh auxiliary requests of the impugned decision, while the eighth to the thirteenth auxiliary requests in appeal proceedings correspond, in a different order, to the eighth to the thirteenth auxiliary requests underlying the impugned decision.

The opponent (hereafter the "respondent") requested  
  
that the appeal be dismissed.

IV. In a communication pursuant to Article 15(1) RPBA 2020 dated 4 February 2020 the Board provided its preliminary, non-binding opinion that it did not see any mistake in the Opposition Division's finding of not admitting into the proceedings the partial translation D10 of WO 00/58087 A and that the invention of none the appellant's requests was considered as sufficiently disclosed for the skilled person to carry it out.

Neither the appellant nor the respondent reacted in substance to the Board's preliminary opinion.

By letter dated 21 September 2020 the appellant informed the Board that they will not attend the oral proceedings scheduled for 21 October 2020 and explicitly referred to their substantial requests only.

- V. The following documents of the opposition proceedings are relevant for the present decision:

D10': WO 00/58087 A;

D10 : translation of page 4, lines 4-14 of D10'; and

D12 : Tests performed by the respondent and filed with letter dated 4 November 2013, 11 pages.

- VI. Claim 1 of **main request** reads as follows:

"A metal plate coated with non-oriented polyester resin having an intrinsic viscosity of 0.6 to 1.4 on both sides of the metal plate comprising:

a metal plate having the surface roughness Ra (JIS B 0601) of 1  $\mu$ m or less;

a transparent two-layered polyester resin containing no pigment coated on the one side of the metal plate, wherein the transparent two-layered polyester resin includes a lower resin layer contacting the metal plate resin and an upper resin layer coated on the lower layer, and

a melting temperature of the upper layer resin is higher than a melting temperature of the lower layer resin and a half crystallization time of the lower layer resin is 50 seconds or more and longer than that of the upper layer resin,

and;

a colored three-layer polyester resin containing a pigment and coated on the other side of the metal plate,  
wherein the colored three-layer polyester resin comprises a lower resin layer contacting the metal plate, a core resin layer coated thereon and an upper resin layer further coated thereon, and a melting temperature of the upper layer resin and the core layer resin is higher than a melting temperature of the lower layer resin and a half crystallization time of the lower layer resin is 50 seconds or more and longer than that of the resins of any of layers layered thereon."

Since all claims 1 of auxiliary requests 1-13 contain the features at stake and discussed below in the grounds relating to the half crystallisation time, there is no need to provide their exact wording.

VII. The appellant argued essentially as follows:

*Admissibility of D10'*

D10' was *de facto* in the opposition proceedings since it had been considered during the examination proceedings and is cited in the contested patent, paragraph 3. The question of whether D10' is late filed can therefore not arise.

The partial translation D10 of D10' had been filed for facilitating the discussion of the content of D10', which is in Japanese language. The language of a document cited in a contested patent, as presently D10', does not play a role for assessing whether the claimed invention is sufficiently disclosed. Hence, the question of whether the partial translation D10 is

admitted into the proceedings is irrelevant in this respect.

*Sufficiency of disclosure*

As D10' is cited in the contested patent, the skilled person studying the patent in suit as a whole would immediately consider the discussion of its disclosure in paragraph 3 as well as its complete disclosure for carrying out the claimed invention.

By doing so, the skilled person would find in D10' a clear teaching of the method for determining the half crystallisation time of claims 1 of the requests. Hence, the skilled person would be able to carry out the claimed invention.

VIII. The respondent argued essentially as follows:

*Admissibility of D10'*

The document D10' was introduced in the description of the contested patent during the examination proceedings. It is therefore not part of the original disclosure of the contested patent and, as such, cannot be used to supplement a deficient disclosure when assessing whether the requirements of Article 83 EPC are met. The same applies for the partial translation D10 of D10'.

The method disclosed in D10' is not commonly accepted in the present technical field for measuring the half crystallisation time and does not belong to the skilled person's common general knowledge.



The partial translation D10 is not reliable as it has not been certified by a translator.

*Sufficiency of disclosure*

The results of the tests of D12 show that the value of the half crystallisation time measured by the DSC measurement depends on the method used and the heating rate during the measurement. Since they are not specified in the original disclosure of the contested patent the skilled person would not be able to determine the exact value of the half crystallisation time and, hence, to carry out the invention.

**Reasons for the Decision**

1. Introductory remarks
  - 1.1 The case is ready for decision which is taken in written proceedings without holding oral proceedings on the basis of the parties' written submissions. The appellant explicitly declared the intention not to attend the oral proceedings, to which both parties were duly summoned (see letter dated 21 September 2020). In view of said declaration and of the fact that the case is ready for decision on the basis of the extensive parties' written submissions and the decision under appeal, the Board, while cancelling the oral proceedings scheduled for 21 October 2020, issues this decision in written proceedings in accordance with Article 12(8) RPBA 2020 and Articles 113 and 116 EPC.
  - 1.2 The reasons for the decision given below correspond to the Board's preliminary opinion provided in the communication dated 4 February 2020. It has not been

subsequently commented on nor has it been contested by the parties, in particular by the appellant, see point IV above.

Under these circumstances, the Board - having once again taken into consideration all the relevant aspects put forward in the parties' written submissions - sees no reason to deviate from its above-mentioned preliminary opinion and confirms it.

2. Main request

2.1 Admissibility of D10'

2.1.1 According to the appellant, D10' was *de facto* in the proceedings due to the fact that it was considered during the examination proceedings and cited in the contested patent, paragraph 3.

The Board cannot share this view since according to the established case law a document considered during the examination proceedings **is not automatically** scrutinised in opposition or opposition appeal proceedings, even if it is quoted and acknowledged in the contested European patent (Case Law of the Boards of Appeal, 9<sup>th</sup> edition 2019, IV.C.4.4).

2.1.2 The appellant also argues that the translation D10 had been filed for facilitating the discussion and that the language (Japanese) of the original document D10' cited in the contested patent was irrelevant for assessing whether the claimed invention was sufficiently disclosed.

These appellant's arguments do not relate, however, to the established case law that a Board of Appeal should

only overrule the way in which a department of first instance has exercised its discretion when deciding on a particular case if it concludes that it has done so according to the wrong principles, or without taking into account the right principles, or in an unreasonable way, and has thus exceeded the proper limits of its discretion (Case Law of the Boards of Appeal, *supra*, IV.C.4.5.2).

In this respect, the Board is of the opinion that the opposition division applied the correct criteria of *prima facie* relevance in a reasonable manner, see impugned decision, point 11.2.1(iii).

2.1.3 Hence, the Board fails to see in which respect the finding of the impugned decision, point 11.2.1, of not admitting D10 is wrong.

2.2 Sufficiency of disclosure - Articles 100(b) and 83 EPC

Despite the above conclusion on inadmissibility of D10 (D10'), it will be taken into consideration in the following discussion for the sake of a complete discussion.

2.2.1 The issue at stake relates to whether the skilled person would have been able to carry out the invention **at the filing date** of the contested patent in view of the following features included in claim 1 concerning the half crystallisation time:

*"a half crystallization time of the lower layer resin is 50 seconds or more and longer than that of the upper layer resin"; and*

*"a half crystallization time of the lower layer resin is 50 seconds or more and longer than that of the resins of any of layers layered thereon."*

According to the impugned decision, point 11.2.2, the patent lacks sufficient information for the skilled person to measure said half crystallisation time such that they cannot carry out the invention.

2.2.2 As pointed out by the respondent, the introduction of D10' in paragraph 3 of the description of the contested patent was performed during the examination phase, i.e. after the filing date of the contested patent. As a result, the method and the parameters used in D10' (D10) are not necessarily those originally applied in the contested patent. Hence, the appellant's argument that the skilled person would look to D10' in order to find an appropriate method on how to determine the claimed parameter because it is mentioned in the contested patent **does not apply for the original disclosure** of the application at the filing date. This is notwithstanding the fact that there is not even a hint in the contested patent itself that the method and the parameters for measuring the half crystallisation time should be those of the prior art cited in paragraph 3.

In view of the publication date of D10' of 5 October 2000 prior to the filing date of the contested patent of 2 February 2005, the skilled person was aware of the method disclosed in D10' (D10) at the filing date of the contested patent, even if published in Japanese. There is, however, **no indication** in the translation D10 which would state that the method disclosed therein with the used parameters (crystallisation temperature and heating rate) would correspond to **the standard method to be applied** in the

technical field at stake. As shown in D12, the crystallisation temperature and the heating rate **strongly influence the results** (see pages 4-5, "Cold recrystallization at different crystallization temperatures", Table 2 and Figure 4; page 5, "Effect of heating rate", Table 4 and Figure 5).

In fact, and taking the above into consideration, the contested patent does not provide the skilled person with parameters (crystallisation temperature and heating rate) to be used in the method described in paragraph 10 of the contested patent, see paragraph 19 of the application as originally filed. Since these parameters are paramount for measuring the half crystallisation time which is specified in claim 1, the skilled person is not able to carry out the invention pursuant to Articles 100(b) and 83 EPC.

3. Auxiliary requests 1-13

Since each claim 1 of auxiliary requests 1-13 contains the features at stake relating to the half crystallisation time, they are also open to the same objection as above for the main request pursuant to Articles 100(b) and 83 EPC.

4. Since the appellant has failed to demonstrate in a convincing manner the incorrectness of the decision under appeal as to the findings and the reasons given by the opposition division, the appeal is unallowable.

**Order**

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

The appeal is dismissed.

The Registrar:

The Chairman:



G. Nachtigall

I. Beckedorf

Decision electronically authenticated