

Internal distribution code:

- (A) [-] Publication in OJ
- (B) [-] To Chairmen and Members
- (C) [-] To Chairmen
- (D) [X] No distribution

**Datasheet for the decision
of 18 May 2022**

Case Number: T 1162/16 - 3.2.07

Application Number: 05760562.8

Publication Number: 1776195

IPC: B05D7/14, B05D7/00, B05D5/06,
C09D7/00

Language of the proceedings: EN

Title of invention:
COATED ARTICLES AND MULTI-LAYER COATINGS

Patent Proprietor:
PPG Industries Ohio, Inc.

Opponent:
Axalta Coating Systems Germany GmbH

Headword:

Relevant legal provisions:
EPC Art. 54(2), 56, 83, 123(2)
RPBA Art. 12(2), 12(4)
RPBA 2020 Art. 12(3), 13(2), 15(1)

Keyword:

Novelty - (yes)

Inventive step - (yes)

Sufficiency of disclosure - (yes)

Amendments - allowable (yes)

Amendment of party case after summons - cogent reasons (no) -
taken into account (no)

Late-filed evidence - request could have been filed in first
instance proceedings (yes)

Decisions cited:

G 0003/14, T 0727/00, T 1707/17, T 0348/18, T 0713/18,

T 1115/18

Catchword:



Beschwerdekammern

Boards of Appeal

Chambres de recours

Boards of Appeal of the
European Patent Office
Richard-Reitzner-Allee 8
85540 Haar
GERMANY
Tel. +49 (0)89 2399-0
Fax +49 (0)89 2399-4465

Case Number: T 1162/16 - 3.2.07

D E C I S I O N
of Technical Board of Appeal 3.2.07
of 18 May 2022

Appellant: Axalta Coating Systems Germany GmbH
(Opponent) Christbusch 25
42285 Wuppertal (DE)

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

Respondent: PPG Industries Ohio, Inc.
(Patent Proprietor) 3800 West 143rd Street
Cleveland, OH 44111 (US)

Representative: f & e patent
Braunsberger Feld 29
51429 Bergisch Gladbach (DE)

Decision under appeal: **Interlocutory decision of the Opposition
Division of the European Patent Office posted on
2 March 2016 concerning maintenance of the
European Patent No. 1776195 in amended form.**

Composition of the Board:

Chairman A. Pieracci
Members: S. Watson
R. Cramer

Summary of Facts and Submissions

- I. An appeal was filed by the opponent in the prescribed form and within the prescribed time limit against the decision of the opposition division maintaining European patent No. 1 776 195 in amended form according to the then auxiliary request 1.
- II. The opposition division found that the subject-matter of claims 5 and 6 of the then main request did not fulfil the requirements of Article 123(2) EPC. The subject-matter of the set of claims of the then auxiliary request 1 was found to fulfil the requirements of Articles 83, 54 and 56 EPC.
- III. In the present decision reference is made to the following documents:
- D1: DE 101 55 709 C1;
D2: Oyarzún, J., "Handbuch der Pigmentverarbeitung, physikalisch-chemische Grundlagen", 1998, pages 84-87;
D3: Meichsner, G. et al, "Lackeigenschaften messen und steuern, Rheologie-Grenzflächen-Kolloide", 2003, page 189;
D4: WO 2004/014572 A1;
D5: Industry standard ASTM D:1003-11, 2011;
D6: US 4 409 285 A;
D7: US 2003/0125417 A2.
- IV. In preparation for oral proceedings, arranged at the request of both parties, the Board communicated its preliminary assessment of the case by means of a communication pursuant to Article 15(1) RPBA 2020. The

Board indicated its preliminary opinion that the appeal should be dismissed.

V. Neither party responded substantively to this communication.

VI. Oral proceedings before the Board took place on 18 May 2022. At the conclusion of the proceedings the decision was announced. Further details of the proceedings can be found in the minutes.

VII. The final requests of the parties are as follows:

for the opponent (appellant):

that the decision under appeal be set aside
and
that the patent be revoked;

for the patent proprietor (respondent):

that the appeal be dismissed.

VIII. Independent claim 1 of the sole request reads as follows:

"A multi-layer coating system comprising:

(a) a basecoat layer deposited from a film-forming composition comprising a resinous binder and a metallic pigment;

(b) a color-imparting non-hiding coating layer deposited over at least a portion of the basecoat layer, wherein the color-imparting non-hiding layer is deposited from a protective coating composition comprising (i) color-imparting particles having a

maximum haze of about 5%; and (ii) a film-forming resin; and
a clearcoat layer deposited over at least a portion of the color-imparting non-hiding layer, wherein the clearcoat layer is deposited from a film-forming composition comprising a resinous binder."

IX. The lines of argument of the parties are dealt with in detail in the reasons for the decision.

Reasons for the Decision

1. *Rules of Procedure of the Boards of Appeal - transitional provisions*

The present proceedings are governed by the revised version of the Rules of Procedure which came into force on 1 January 2020 (Articles 24 and 25(1) RPBA 2020), except for Article 12(4) to (6) RPBA 2020 instead of which Article 12(4) RPBA 2007 remains applicable (Article 25(2) RPBA 2020).

2. *Sufficiency of disclosure - Article 83 EPC - claim 1*

2.1 In the contested decision the opposition division found that the skilled person was able to carry out the invention as the examples of the patent were regarded as "clear and sufficiently instructive" and no evidence of the contrary had been filed by the appellant (see decision under appeal, II.4.).

2.2 With its statement of grounds of appeal (section 5.), the appellant brought forward the argument that the opposition division was incorrect in finding that the examples were clear and sufficiently instructive for the skilled person to determine the haze value, as the

description discloses a different transmittance at the wavelength of maximum absorbance to that of the examples, namely of about 15% to about 20%, rather than 17.5%. In addition three different measuring methods were mentioned in the description and the choice of solvent and particle concentration in the test sample was left open. The skilled person was therefore not able to identify colour-imparting particles which had a maximum haze of 5% nor determine whether they were working within the ambit of claim 1 of the patent in suit.

Furthermore, the worked examples given showed only specific, complex compositions, such that there was no consistent and concrete disclosure to the skilled person of how to generally prepare suitable mixtures of the colour-imparting particles for reliably determining the haze of the colour-imparting particle without performing extensive experimental effort. The skilled person therefore was not able to select suitable particles for the multi-layer coating system and could not carry out the claimed invention.

The appellant further argued during the oral proceedings before the Board that it was not necessary to provide any evidence substantiating its allegations as the burden of proof had shifted to the respondent due to the very serious doubts as to whether the haze value of the particles could be reliably determined.

2.3 The Board is not convinced by the appellant's arguments.

Firstly, the Board notes that it is established case law of the Boards of Appeal that a lack of sufficiency of disclosure presupposes that there are serious

doubts, substantiated by verifiable facts. In order to establish insufficiency of disclosure in inter partes proceedings, the burden of proof is on the opponent to show, on the balance of probabilities, that the skilled person is unable to carry out the invention (Case Law of the Boards of Appeal (CLB), 9th edition, 2019, II.C.9.).

The Board cannot see that there are such serious doubts regarding the sufficiency of the disclosure that the burden of proof should shift to the respondent. As the respondent argued (see reply to statement of grounds of appeal, 3., second paragraph), it is clear from the patent specification that measuring method B of the cited standard ASTM D1003 (D5) is to be applied.

This can be derived from paragraph [0018] of the patent specification, indicating that the standard ASTM D1003 is the relevant norm for the definition of "haze" and from paragraph [0019] indicating that a Byk-Gardner TCS (The Colour Sphere) instrument is used. As this instrument is a spectrophotometer, the person skilled in the art understands that procedure B of ASTM D1003 is to be applied.

Furthermore, a number of worked examples are given in the patent in suit which appear to clearly teach the skilled person how to prepare the multi-layer coating system including the color-imparting particles. In the examples the transmittance value and solvent are specified.

Serious doubts relating to the sufficiency of the disclosure of the claimed invention are therefore not apparent, nor has the opponent provided any evidence to support its doubts. It has not been shown for example that the invention cannot be put into practice without undue burden or that the examples cannot be reproduced.

In the absence of serious doubts substantiated by any verifiable facts, the Board maintains that the opponent has not discharged its burden of proving that the person skilled in the art is not in the position of carrying out the invention with the teaching of the opposed patent and making use of the common general knowledge.

Regarding the objection of the appellant that it is not possible for the skilled person to reliably determine whether or not they are working within the scope of the claim, this Board follows the predominant opinion among the Boards of Appeal, that this issue does not relate to the question of sufficiency of disclosure but is rather a question of clarity (CLB, *supra*, II.C.6.6.4). Since the feature objected to was present in the patent as granted this issue is of no relevance in the present proceedings (see G 3/14).

The Board has therefore no reason not to follow the findings of the opposition division in the contested decision, that the patent does disclose the invention sufficiently.

3. *Added subject-matter - Article 123(2) EPC - claim 1*
- 3.1 The appellant submitted two objections relating to an extension of subject-matter found in claim 1 (section 4 of the statement grounds of appeal), the first objection being that the features that the pigments are metallic and that the particles have a maximum haze of 5% were not originally disclosed in combination (see statement of grounds of appeal, section 4, first paragraph) and the second objection being that not all features which were disclosed as being necessary for

achieving the desired haze have been specified in the claim (see statement of grounds of appeal, page 7, third paragraph).

- 3.2 During oral proceedings the respondent requested that the objections under Article 123(2) EPC not be admitted under Article 12(4) RPBA 2007, following the preliminary opinion of the Board given in section 12. of its communication pursuant to Article 15(1) RPBA 2020, that the objections were raised against the current main request for the first time with the statement of grounds of appeal.

The appellant argued that the first objection was the same objection as had been raised with respect to the then main request throughout the opposition proceedings and had not been explicitly withdrawn. It was not contested that the second objection had not been raised during opposition proceedings, but the appellant argued at the oral proceedings before the Board that the objection was prima facie relevant so should be admitted.

- 3.3 The Board does not exercise its discretion pursuant to Article 12(4) RPBA 2007 to not admit the first objection because the opposition division had at the oral proceedings given a positive opinion with respect to the combination of features of claim 1 of the main request objected to by the opponent. Claim 1 of auxiliary request 1 (corresponding to the present main request), that was subsequently filed at the oral proceedings, contained the same combination of features. It was therefore immediately recognizable by the patent proprietor and by the opposition division without any further qualification and substantiation of

the objection that it would also apply to the same combination of features in auxiliary request 1.

However, the second objection, which was raised for the first time in appeal proceedings was not admitted under Article 12(4) RPBA 2007 as it could have been submitted in the opposition proceedings allowing a decision to be taken on it by the opposition division (see CLB, *supra*, V.A.4.11.3 a)).

- 3.4 In the decision under appeal, point II.2., the opposition division found that claim 1 of the then main request fulfilled the requirements of Article 123(2) EPC.
- 3.5 The appellant argued that the opposition division was incorrect in finding that the selection of "metallic" pigments together with the selection of 5% for the maximum haze value did not result in a combination, which was not originally disclosed in the application as filed, of features from separate independent lists of considerable length (statement of grounds of appeal, point 4., third paragraph).
- 3.6 It was uncontested by the parties that the basis for the subject-matter of claim 1 of the main request was found in claim 48 of the application as published together with paragraphs [0023] and [0055] of the application as published.
- 3.7 The appellant argued that the selection of "metallic" from "metallic", "non-metallic" and "organic", together with the selection of 5% from "a maximum haze of 10%, such as a maximum haze of 5%, or a maximum haze of 1% or, in yet other embodiments a maximum haze of 0.5%" resulted in an embodiment which was the combination of

two features taken from separate independent lists of considerable length, which was not allowable according to the case law related to the selection from lists (see statement of grounds of appeal, point 4., third paragraph).

- 3.8 The Board can agree with the appellant that it is not relevant that the two independent groups of features relate to different component layers of the coating. Decision T 0727/00 cited for this purpose by the appellant therefore does not need to be further discussed (see statement of grounds of appeal, point 4., passage bridging pages 6 and 7).

However the Board does not find that the features have been selected from lists of equivalent alternatives of some length as is required for an unallowable multiple selection (CLB, *supra*, II.E.1.6.2 and I.C.6.2.1).

In particular, the Board follows the respondent's argument made during oral proceedings that the metallic pigment has not been selected from a list as it represents only a choice of either metallic or non-metallic pigments and that therefore the choice made is not a selection from a list of some length and certainly not of "considerable length" as argued by the appellant but rather a selection between two options as argued by the respondent. The appellant argued at the oral proceedings before the Board that the selection was between metallic, non-metallic or organic pigments as indicated by the punctuation used in the relevant passage of the original application. However, organic pigments are also non-metallic so that organic pigments has to be seen as a sub-group of non-metallic pigments and the person skilled in the art when faced with paragraph [0055] would indeed derive from that

paragraph that the pigments are to be understood as being therein primarily classified as being metallic or non-metallic.

The Board thus concludes that the case law related to the selection from lists is not applicable to the present case and that the argument of the appellant is thus not convincing.

3.9 Therefore the Board finds that the argument of the appellant that the subject-matter of claim 1 has been extended beyond the content of the application as originally filed is not convincing.

4. *Novelty - Article 54 EPC - claim 1*

4.1 In the decision under appeal (see point II.5.) the opposition division found that the subject-matter of claim 1 of the then auxiliary request 1 was novel over the disclosure of either of documents D1 or D4. Neither document, explicitly or implicitly, disclosed the feature of colour-imparting particles having a maximum haze of 5%.

4.2 With its statement of grounds of appeal (section 6.) the appellant argued that this finding was incorrect as either

(a) the feature is unclear due to different measurement methods leading to differing results for the same particles and has to be disregarded; or

(b) the particles of D1 and D4 implicitly disclose the haze value of 5%.

4.3 Objection (a)

In its communication pursuant to Article 15(1) RPBA 2020, the Board raised the issue that the appellant submitted objection (a) for the first time with its statement of grounds of appeal.

At the oral proceedings before the Board, the respondent requested that this objection be disregarded by the Board because it was late and unsubstantiated.

It was not contested by the appellant that this objection had not been raised during the opposition proceedings. The appellant argued at the oral proceedings before the Board that its objection was an argument which must always be admitted into proceedings as the Board only had discretion under Article 12(4) RPBA 2007 to not admit facts, evidence and requests not filed in due time.

The Board does not share the view of the opponent that the new line of attack submitted is limited only to a new argument. The objection is based on the alleged fact that different methods provide different results and is therefore subject to the Board's discretion pursuant to Article 12(4) RPBA 2007.

The Board considers that the objection should have been submitted in the context of novelty in opposition proceedings in order to allow the patent proprietor to react to it in those proceedings and the opposition division to decide on it, thereby allowing the Board to review the opposition division's decision.

Furthermore the Board notes that no evidence has been submitted by the opponent to support its allegation that thus remains unsubstantiated.

For the above reasons the Board finds it appropriate to exercise its discretion not to admit the above

objection into the proceedings pursuant to Article 12(4) RPBA 2007.

4.4 Objection (b)

The appellant argued, that documents D1 and D4 implicitly disclose colour-imparting particles with a maximum haze value of 5% (statement of grounds of appeal, page 11, second paragraph).

As argued by the respondent (reply to the statement of grounds of appeal, section 4., paragraph bridging pages 4 and 5), the appellant has, however, failed to show any experimental evidence that the colour-imparting pigments disclosed in the prior art of D1 and D4 have the claimed haze value.

The appellant regards the disclosure in D1 of "*lasierend*" (D1, paragraph [0063]) and the disclosure in D4 of "transparent" (D4, page 2, lines 20-33) as implicitly disclosing colour-imparting particles having a maximum haze of 5 %, as it is "obvious from D2 and/or D3, that these terms refer to a very small haze".

The Board agrees with the findings of the opposition division (page 5, second paragraph), that neither D1 nor D4 explicitly or implicitly disclose particles having a maximum haze of 5%.

It is established case law of the Boards of Appeal that, for a feature to be implicitly disclosed in a document, it must be immediately apparent to the skilled person that nothing other than the alleged implicit feature is disclosed (CLB, *supra*, I.C.4.3). In the present case this means that the particles

disclosed in D1 or D4 must inevitably have a maximum haze of 5%.

Neither of the passages in documents D2 and D3 which were cited by the appellant can be seen as proof that the skilled person understands the terms "transparent" or "*lasierend*" as meaning that the particles must have a maximum haze of 5 %. Document D2, page 85, final paragraph, discloses that transparent means low light scattering and document D3, page 189, last paragraph, discloses that, for a transparent coating, particles of less than 100 nm may be used. However nothing can be directly and unambiguously derived regarding maximum haze in these documents.

Therefore the skilled person, taking into account common general knowledge, would not consider that the use of the term "transparent" or "*lasierend*" implies that the colour-imparting particles of D1 and D4 inherently have a maximum haze of 5%.

4.5 Therefore the appellant has not convincingly shown that the decision taken by the opposition division regarding novelty was incorrect.

5. *Inventive Step - Article 56 EPC - claim 1*

5.1 Combination of teaching of documents D1 and D6

In the contested decision (point II.7, final paragraph), the opposition division found that, even if the objective technical problem was merely to find an alternative coating, the subject-matter of claim 1 was not obvious in view of the combination of the teachings of document D1 and D6 because document D6 did not "give

a serious hint" to any particular maximum haze % of the colour-imparting particles.

5.1.1 The appellant argued that the opposition division was incorrect as document D6 clearly related to the reduction of surface misting and light reflection of coating compositions and explicitly mentioned that there should be no increase in haziness or translucency (D6, column 1, lines 28-35). Document D6 further taught that this could be achieved by coating compositions having an average particle size of 7 to 50 nm. Therefore, document D6 "establishes the link between particle size and low surface misting as well as haze" (see statement of grounds of appeal, point 7.2).

5.1.2 The Board however follows the submissions of the respondent (see reply to the statement of grounds of appeal, page 6, first two paragraphs), and concludes that D6 does not disclose particles with the claimed maximum haze %. As argued by the respondent and reasoned in the contested decision, there is no link disclosed in document D6 between a specific particle size and a specific haze % for that particle.

The appellant argues that by lowering the particle size of the colour-imparting particles of D1 to a size of 7 to 50 nm, as suggested in D6, the skilled person inevitably arrives at a haze value of the particles of 5 % or less.

However, document D6 does not disclose any haze value for the small particles of the coating composition (average size of 7 to 50 nm), only for the coating composition as a whole. It is therefore not possible, without experimental evidence, to determine whether the small particles in D6 inevitably show the claimed haze

% values and whether this would equally be the case for the colour-imparting particles of D1 if they had a particle size between 7 and 50 nm.

As D6 does not show particles with a maximum haze of 5 % it cannot be seen how the combination of D1 and D6 would lead to the claimed subject-matter.

- 5.1.3 At the oral proceedings before the Board, the appellant formulated new objections based on the specific examples used in document D6 and including calculations relating to the concentration of pigments in these examples.

The appellant argued that the new objections should be taken into account as they were a direct response to the Board's comment in point 11.3 of the communication under Article 15(1) RPBA 2020, that document D6 did not disclose any values of haze for the small particles in the coating composition.

The respondent requested that the amendments to the appellant's case be disregarded under Article 13(2) RPBA 2020 as they were raised for the first time at the oral proceedings, *i.e.* at the very latest stage of the appeal proceedings and no exceptional circumstances, justified by cogent reasons, had been shown. The respondent also argued that the amendment to the appellant's case was not related to the Board's communication.

The Board follows the recent development of case law as set out in a number of decisions, where it was found that even if an amendment to a party's case had been raised in reaction to a communication of the Board, it is incumbent on the party to submit its response as

early as possible or to provide cogent reasons why the response could only be raised at the oral proceedings (see T 1707/17, Reasons 2.4; T 1115/18, Reasons 4.3 and 4.4; T 0713/18, Reasons, page 23, first paragraph; and T 348/18, Reasons 2.5).

In the present case the Board's communication was sent some eleven months before the oral proceedings and the appellant did not give any reasons justifying its response to the communication for the first time at the oral proceedings before the Board.

To respond to the amendment to the appellant's case would have required the respondent and the Board to consider for the first time at oral proceedings the relevance of the examples shown in document D6, which had not previously been mentioned by the appellant, including performing calculations relating to these examples.

Therefore the Board does not admit the amendments to the appellant's case into the appeal proceedings under Article 13(2) RPBA 2020 due to a lack of cogent reasons justifying any exceptional circumstances.

It does not therefore appear necessary to consider whether any new points were indeed raised with the Board's communication pursuant to Article 15(1) RPBA 2020 and whether these new points represented exceptional circumstances.

- 5.2 Admittance into the appeal proceedings of document D7 and the objection of lack of inventive step based on document D7
 - 5.2.1 The appellant filed document D7 for the first time with its statement of grounds of appeal (see page 5, lines 5 to 32) and requested the admittance of D7 into the

appeal proceedings. The appellant argued that only during oral proceedings and with the written decision of the opposition division had it become apparent that the existence of "a clear pointer in any of the prior art on file indicating that haze is an important factor in the colour persistence properties of a coated substrate" was of crucial importance.

In addition, the appellant argued that D7 merely represented the common general knowledge of the skilled person at the priority date.

5.2.2 The Board does not agree that it was not clear before the oral proceedings were held and the written decision issued, that the effect of haze on the colour properties was of crucial importance. The respondent had already argued with its reply to the notice of opposition, two years before the oral proceedings before the opposition division, that colour-imparting particles having a haze of maximum 5% compared with a haze above 5% showed "improved color effect" (see reply to the notice of opposition, 8 November 2013, point 6.).

Therefore the appellant could and should have reacted to this statement of the proprietor during the opposition proceedings, rather than waiting until the appeal proceedings.

5.2.3 In addition, the Board does not agree that D7 represents the common general knowledge of the skilled person. It is established jurisprudence of the Boards of Appeal that patent literature does not normally constitute common general knowledge (CLB, *supra*, I.C.2.8.2). The passages of D7 relating to maximum haze are presented as part of the invention, and do not appear to indicate any particular common general knowledge of the skilled person in relation to maximum

haze being a factor in colour persistence properties of a substrate.

The argument of the appellant that D7 was known to the patent proprietor as it was considered in the examination proceedings and cited in the opposed patent does not mean it has to be considered even if filed late (CLB, *supra*, IV.C.4.4).

5.2.4 The appellant's arguments that document D7 is prima facie highly relevant do not outweigh the fact that the document could and should have been filed during opposition proceedings, particularly as the subject-matter of claim 1 of the sole request is found in the claims of the patent in suit as granted.

The primary objective of the appeal proceedings is to review the decision under appeal (Article 12(2) RPBA 2020) not to re-open opposition proceedings and take decisions on matter which the opposition division did not decide upon (see CLB, *supra*, V.A.4.11.3 a), first to third paragraphs).

The Board therefore decided that document D7, and the corresponding new line of attack for inventive step, should not be admitted into the appeal proceedings (Article 12(4) RPBA 2007).

5.3 Therefore the appellant has not convincingly shown that the decision taken by the opposition division regarding inventive step was incorrect.

Conclusion

6. As none of the objections admissibly raised by the appellant prejudice the maintenance of the patent in

amended form according to the sole request, the appeal should be dismissed.

Order

For these reasons it is decided that:

The appeal is dismissed.

The Registrar:

The Chairman:



G. Nachtigall

A. Pieracci

Decision electronically authenticated