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**Datasheet for the decision
of 12 August 2020**

Case Number: T 0349/17 - 3.2.07

Application Number: 06803385.1

Publication Number: 1943025

IPC: B05B7/32, C09D7/14, C09D175/04

Language of the proceedings: EN

Title of invention:

PROCESS FOR PRODUCING COATING COMPOSITIONS WITH CUSTOMIZABLE
PROPERTIES

Patent Proprietor:

Coatings Foreign IP Co. LLC

Opponent:

BASF Coatings GmbH

Headword:

Relevant legal provisions:

EPC Art. 54, 111(1), 114(2)
EPC R. 80
RPBA 2020 Art. 11, 12(2), 12(8), 15(1), 25(1)
RPBA Art. 12(4)

Keyword:

Late submitted material - document admitted by first instance
(yes)

Novelty - main request (no) - auxiliary request (yes)

Remittal to the department of first instance - (yes)

Decisions cited:

T 1002/92, G 0007/93

Catchword:



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Case Number: T 0349/17 - 3.2.07

D E C I S I O N
of Technical Board of Appeal 3.2.07
of 12 August 2020

Appellant:
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Decision under appeal:

**Decision of the Opposition Division of the
European Patent Office posted on 7 December 2016
revoking European patent No. 1943025 pursuant to
Article 101(3) (b) EPC.**

Composition of the Board:

Chairman I. Beckedorf
Members: A. Pieracci
S. Watson

Summary of Facts and Submissions

- I. The patent proprietor lodged an appeal in the prescribed form and within the prescribed time limit against the decision of the opposition division to revoke the European patent No. 1 943 025.
- II. The opposition had been filed against the patent as a whole based on Article 100(a) EPC (lack of novelty and inventive step) and on Article 100(b) EPC (insufficiency of disclosure). The opposition division considered the ground of opposition under Article 100(a) EPC (lack of novelty) to be prejudicial to the maintenance of the patent as granted and as amended in opposition proceedings.
- III. In the present decision reference is made to the following documents also considered in opposition proceedings:
- E1: WO/0243880 A2;
- E5: EP 0 677 541 A1;
- E7: Instructions - Parts List 309106, Rev. F, ValueMix Proportioning System, pages 1-6, GRACO Inc., copyright 2000.
- IV. To prepare the oral proceedings scheduled upon both parties' requests, the Board communicated its preliminary assessment of the case to the parties by means of a communication pursuant to Article 15(1) RPBA 2020. The Board indicated *inter alia* that the subject-matter of claim 1 of the patent as granted appeared not

to be new, while the subject-matter of claim 1 of the auxiliary request 1 appeared to be novel.

V. Oral proceedings before the Board took place on 12 August 2020 at the end of which the decision was announced and for further details of which reference is made to the minutes thereof.

VI. The appellant's final requests were:

that the decision under appeal be set aside
and
that the patent be maintained as granted (main request),
or, in the alternative,
that the patent be maintained as amended according to auxiliary requests 1 to 4 filed together with the statement setting out the grounds of appeal,
or, in the further alternative,
that, after establishing that any of the aforementioned sets of claims according to the main request and auxiliary requests 1 to 4 were considered novel, the case be remitted to the opposition division for further prosecution for examining inventive step.

The appellant also requested that documents E5 and E7, filed by the respondent, not be admitted into the proceedings contrary to the decision under appeal.

VII. The respondent's final requests were:

that the appeal be dismissed.

The respondent also requested that that none of the appellant's auxiliary requests be admitted into the proceedings.

VIII. The lines of arguments of the parties are dealt with in detail in the reasons for the decision.

IX. Independent claim 1 according to the main request, *i.e.* according to the patent as granted, reads as follows:

A process for making a coating composition, said composition having adjustable properties, and for use in automotive refinish applications, said process comprising:

choosing at least two activatable refinish coating compositions, of same automotive coating layer or of different automotive coating layers, each coating composition having

(a) at least one distinctly different property from the other coating composition,

(b) different binder components and

(c) a common activator component and a common mix ratio between the activator and unactivated film forming binder component

selecting a mix ratio for the unactivated binder portions of each of the coating compositions to achieve a new set of properties; and

mixing, prior to introduction in the spray equipment, the common activator with the aforesaid combined binder portions in the aforesaid common binder to activator

mix ratio, to form a new coating composition with customized properties that can be sprayed onto a vehicle.

- X. Independent claim 1 according to auxiliary request 1 corresponds to claim 1 of the main request with the addition of the combination of features of dependent claims 3 and 5 of the patent as granted, namely:

wherein said activatable coating compositions are two or three-component and include at least one binder component and at least one activator component which is reactive with the binder component, and optionally at least one reducer component, and wherein the different unactivated binder portions are mixed first and then the combined binder is mixed with the common activator component in the common volumetric mix ratio to form the new coating composition, prior to introduction in the spray equipment.

- XI. The dependent claims of auxiliary request 1 correspond to those of the patent as granted with the exception of claims 3 and 5, added to claim 1, and of claim 8, which has been deleted.

Reasons for the Decision

1. Consideration of documents E5 and E7

- 1.1 The appellant requests that the decision of the opposition division to admit documents E5 and E7 into the proceedings be overruled.
- 1.2 The appellant argues that documents E5 and E7 do not possess any *prima facie* relevance and are also not more

relevant than documents E1 to E4, which were filed with the grounds of opposition. The appellant argues that allowing these documents into the proceedings would enable the opponent to furnish an opposition with further and less relevant documents well after expiry of the opposition time limit.

This approach is against the procedural rule of opposition proceedings that evidence should be provided by the opponent within the nine-month opposition period and should only be introduced into the proceedings if clearly prejudicing the maintenance of the opposed patent (see T1002/92).

- 1.3 The Boards cannot follow the opinion of the appellant for the following reasons.

According to Article 114(2) EPC it is at the opposition division's discretion whether to admit late-filed documents. According to the settled case law the opposition division must examine them as to their *prima facie* relevance (see T 1002/92, OJ EPO 1995, 605, also cited by the appellant).

The discretionary power conferred by Article 114(2) EPC necessarily implies that the competent EPO administrative divisions must have a certain degree of freedom in exercising their power. A Board of Appeal should only overrule the way in which a division has exercised its discretion when deciding on a particular case, if it concludes that it has done so according to the wrong principle, or without taking into account the right principles, or in an unreasonable way, and has thus exceeded the proper limit of its discretion (see G 7/93, OJ EPO 1994, 775).

The Board considers that the opposition division has considered the right criteria, that of *prima-facie* relevance, for admitting documents E5 and E7 and has done this in a reasoned manner (see point 3. and point 10. of the appealed decision).

This has not been contested by the appellant, who disputes the conclusion reached by the opposition division in exercising its discretion.

However, it is not the function of a Board of Appeal to review all the facts and circumstances of the case as if it were in the place of the opposition division, in order to decide whether or not it would exercise the discretion in the same way.

The Board, taking into account all the facts of the case, considers that the opposition division has exercised its discretion according to the right principle and in a reasonable way.

Hence, the Board concludes that there appears to be no reason to allow the request of the appellant and overrule the discretionary decision of the opposition division to admit documents E5 and E7 into the proceedings.

2. Novelty of the subject-matter of claim 1 of the patent as granted in view of document E1 (Articles 100(a) and 54 EPC)

2.1 The Board cannot follow the appellant's argument that document E1 does not show feature M1.2, namely:

that each coating composition has

"different binder components",

or feature M1.3, that each coating composition has

"a common activator and a common mix ratio between the activator and unactivated film forming binder component",

or feature M3, namely:

"mixing, prior to introduction in the spray equipment, the common activator with the aforesaid combined binder portions in the aforesaid common binder to activator mix ratio".

- 2.2 The Board does not agree with the appellant's argument that feature M1.2 of claim 1 requiring "different binder components" implies that these must be chemically different.

The Board can also not follow the line of argument of the appellant (see point 6.1.4, second paragraph, of the statement setting out the grounds of appeal and point 3.1.3 of the appellant's submissions dated 12 June 2020) that according to the invention the term "binder component" means the binder alone, without any solvents or pigments while "binder portion" refers to a mixture containing the binder and additionally further components. According to the appellant, this would be the interpretation of the term understood by the person skilled in the art due to the literal difference of the terms used in the claim, this interpretation is also supported by paragraphs [0017], [0033], [0036], [0037], [0050] and [0051] of the patent in suit.

2.3 The Board rather follows the opinion of the respondent (see the reply to the statement setting out the grounds of appeal, point 3.3) that the limitative interpretation of the term "different binder component" given by the appellant is not derivable from the wording of the claim and in particular not from the fact that the term "binder portion" is also present in the claim.

A specific meaning and thus difference between the terms "binder component" and "binder portion" is not to be derived by the person skilled in the art from the claim as such.

The Board notes that when considering a claim, although illogical interpretations should be excluded, a broad term should not be interpreted more narrowly than its plain meaning (see the Case Law of the Boards of Appeal, 9th edition 2019, II.A.6.1, second paragraph). Should a restrictive interpretation be sought it is up to the patent proprietor to amend the claim accordingly (*supra*, II.A.6.3.4, first paragraph).

The Board also shares the opinion of the respondent that the restrictive interpretation of the terms of the claim given by the appellant cannot be directly and unambiguously derived from the description.

In paragraph [0040] of the patent in suit it is stated that:

"A variance in the amount of catalyst in the binder or activator components can also change the reactivity of the respective components.",

meaning that the binder "component" can also contain a catalyst.

As indicated by the opposition division (see page 14, lines 2 to 10 of the appealed decision) and by the opponent (see point 3.3, third paragraph of the reply to the statement setting out the grounds of appeal), example 1 of the patent in suit is also not unambiguous in this respect, since although the tables of paragraphs [0050] and [0051] refer to "binder portions" having each a plurality of components, the sentence before these tables reads:

"The following two different binder and one activator components were provided...",

thus implying that a binder component comprises a plurality of different elements as set out in the tables of paragraphs [0050] and [0051].

The other passages of the patent in suit indicated by the appellant need not be addressed since those discussed above already cast sufficient doubt on the support for the pursued interpretation of the term "different binder components".

The Board is therefore of the opinion that the elements A(2) and B(2) shown in example 2 of E1, pages 14 and 15, although being based on the same acrylic binder system, can be seen as "different binder components" within the meaning of claim 1.

The Board is therefore not convinced by the argument of the appellant that feature M1.2 is not disclosed in E1.

2.4 The Board cannot follow the argument of the appellant (see point 6.1.3 of the statement setting out the grounds of appeal) that feature M1.3 is not disclosed

in E1 since it is not correct that example 2 of E1 refers to two different experiments (see the appealed decision, page 8, last paragraph) and since in E1, page 15, lines 7 to 9, it is said that "...flexibility for the repair process can be obtained by simply changing the mixing ratios of the components.", which clearly indicates that any mixing ratio between the components can be varied. This was shown in example 2 of E1 in which the activator to binder mixing ratio in the first three experiments is 5:2 and in the last three experiments is 3:2.

- 2.5 The Board rather follows the argument of the respondent (see the paragraph bridging page 11 and page 12 of the reply to the statement setting out the grounds of appeal), that for assessing the presence of the feature of the "common mix ratio", it is not relevant whether one considers example 2 as being composed of two different experiments, as the opposition division did, or not.

According to the table at page 15 of E1, the components A(2) and B(2) are mixed together with the same activator C(2) and with the same mix ratio, once with a mix ratio of 5:2 and then with a mix ratio of 3:2. The table presents two compositions, the second and the fifth, with different mix ratio of the components but each time, within the same composition, the mix ratio of components A(2) and B(2) with component C(2) is the same.

The absence of a general teaching in relation to the mix ratio of the binder components with the activator component and the fact that the mix ratio is different in the second and fifth case of the table of page 15 is

not relevant for assessing novelty in view of the wording of the claim.

In fact it is enough that both the second and fifth case of the table of E1 are compositions according to feature M1.3 of claim 1.

The Board is therefore not convinced by the appellant's argument that document E1 does not disclose feature M1.3.

- 2.6 The Board cannot follow the argument of the appellant that document E1 does not disclose feature M.3. According to this feature the common activator is to be mixed with the "combined binder portions", meaning that the binder portions have already been combined with each other before being mixed with the common activator.

The Board follows the argument of the appellant that this interpretation is not directly and unambiguously derivable from the wording of the claim and that the complete expression, "aforesaid combined binder portions", could also mean that the binder portions previously mentioned in the claim are combined with other elements but not necessarily with each other.

The Board notes that the fact that the respondent shared the view of the appellant on the interpretation of the expression "combined binder portions" in opposition proceedings is not relevant for the decision to be taken in the present proceedings.

The Board is therefore not convinced by the argument of the appellant that, for the reasons given above, feature M3 is not disclosed by E1.

2.7 The Board cannot follow the further argument of the appellant (see point 3.1.1 of the submissions dated 12 June 2020) as to why document E1 does not disclose feature M.3. The appellant has brought forward that example 2 of E1 does not show that the mixing of the common activator with the combined binder components takes place "prior to introduction in the spray equipment".

The appellant clarified its position at the oral proceedings indicating that the passage on page 15, lines 1 to 4 of E1, namely:

"Using the ValueMix plural component apparatus of Graco the above-mentioned components in various ratios set forth in the table below were mixed and immediately applied to a substrate, without changing the components on the plural apparatus.",

implies that the mixing and the application of the components takes place simultaneously in the spray equipment, and that therefore the process of E1 is not carried out in a stepwise manner as required by the claimed invention.

The Board however follows the argument of the respondent that the passage of E1 that states that the components were "mixed and immediately applied" clearly indicates a sequence of steps, however small the time scale might be, so that the argument of the appellant cannot be followed.

The Board is therefore not convinced by the argument of the appellant that feature M3 is not disclosed in E1.

2.8 The Board thus sees no reason not to concur with the opposition division that document E1 deprives the subject-matter of claim 1 of novelty.

3. **Admittance of auxiliary request 1**

3.1 Auxiliary request 1 was submitted by the appellant with the statement setting out the grounds of appeal and consists of claim 1 according to auxiliary request 2 decided upon in opposition proceedings and the dependent claims of the patent as granted with the exception of claims 3 and 5, which have been incorporated in claim 1, and claim 8, which has been deleted.

3.2 The Board cannot follow the opinion of the respondent (see point 7.2 of the reply to the statement setting out the grounds of appeal and point 4. of the submissions dated 28 April 2020) that auxiliary request 1 should not be admitted into the proceedings as the deletion of claim 8 does not fulfill the requirements of Rule 80 EPC.

Since the appellant argues that the deletion of claim 8 is in reaction to an objection under Article 100(b) EPC raised by the respondent in opposition proceedings (see the last paragraph of page 15 of the appellant's submissions dated 12 June 2020 and point 3.3.2 of the notice of opposition), the Board is convinced that this amendment can be seen as being occasioned by a ground of opposition and that therefore the requirements of Rule 80 EPC are fulfilled.

3.3 The Board also cannot follow the argument of the respondent that since auxiliary request 1 is late filed it should not be admitted in the proceedings.

The Board notes that Article 12(4) RPBA 2007 gives the Board the discretionary power not to admit *i.a.* requests which could have been presented in the first instance proceedings.

In the present case the Board considers it appropriate not to exercise its discretion to hold inadmissible auxiliary request 1 since claim 1 of this request is identical to claim 1 of auxiliary request 2 on which the decision under appeal is based. The subject-matter to be discussed has therefore already been debated and decided upon in opposition proceedings.

Auxiliary request 1 is therefore admitted in the proceedings.

4. **Novelty of the subject-matter of claim 1 of auxiliary request 1 in view of documents E1 and E5 (Article 54 EPC)**

4.1 Claim 1 of auxiliary request 1 corresponds to the combination of the subject-matter of claims 1, 3 and 5 of the patent as granted.

4.2 Novelty in view of E1

The Board cannot share the opinion of the respondent that, since the description of the preparation for example 2 of E1 states (page 15, lines 1 to 4) that the

"...components ...were mixed and immediately applied...",

the binder components would, at least in part, inevitably have been mixed with each other before

mixing with the activator as required by the subject-matter of claim 5 as granted, now part of claim 1.

The Board shares the view of the appellant that this is an assertion which remains unsubstantiated and that therefore cannot be followed.

The Board is thus convinced by the argument of the appellant that the subject-matter of claim 1 is new in view of E1.

4.3 Novelty in view of E5

The Board cannot share the view of the respondent that the passage at page 3, lines 7 to 10 of E5 implicitly discloses the feature added from granted claim 5 to claim 1 that

"the different unactivated binder portions are mixed first and then the combined binder is mixed with the common activator component in the common volumetric mix ratio...".

The passage at page 3, lines 7 to 10 of E5 reads:

"It is vitally important that the end user can mix any coloured paint pack in a fixed ratio with the hardener and that the composition produced has consistent application characteristics across all colours."

From this passage it cannot be directly and unambiguously derived that the mixing is carried out by combining the different components, according to a "volumetric mix ratio", *i.e.* that defined volumes of the components are purposely mixed according to a defined ratio.

The argument of the respondent is therefore an assertion that remains unsubstantiated and cannot be followed.

The Board shares the opinion of the appellant that also the other passages of E5 indicated in the appealed decision (see page 14, fourth paragraph), namely page 7, line 23 and page 10, line 39, do not disclose the disputed feature, since a "common volumetric mix ratio" cannot be directly and unambiguously derived therefrom.

The Board is thus convinced by the argument of the appellant that the subject-matter of claim 1 of auxiliary request 1 is new in view of E5.

5. Therefore, in reviewing the decision under appeal, the Board finds that the appellant, while not demonstrating the incorrectness of the decision of the opposition division that the subject-matter of claim 1 of the patent as granted is not new, has convincingly demonstrated that the subject-matter of claim 1 of auxiliary request 1 is novel.

In view of this finding, the present case is in a position to be decided on with regard to the question of novelty according to Article 54 EPC, which was the sole ground for refusal mentioned in the contested decision.

6. **Remittal of the case to the opposition division
(Article 111(1) EPC and Article 11 RPBA 2020)**

The Board is aware that, according to Article 11 RPBA 2020, which is in the present case applicable under Article 25(1) RPBA 2020, a remittal for further

prosecution should only be undertaken, exceptionally, when special reasons apply.

The Board notes that the opposition division has not decided on inventive step or addressed this issue for any of the appellant's requests and that, according to Article 12(2) RPBA 2020, the primary object of the appeal proceedings is to review the decision under appeal in a judicial manner.

The Board also notes that the appellant has requested remittal of the case to the opposition division for further prosecution and that the opponent has not objected to it.

Against this background, after considering all the relevant circumstances of the case at hand, the Board comes to the conclusion that in the present case there are special reasons within the meaning of Article 11, first sentence, RPBA 2020 that apply, and that it is appropriate to remit the present case to the opposition division for further prosecution and examination of the requirements of inventive step, in accordance with Article 111(1) EPC.

Order

For these reasons it is decided that:

1. **The decision under appeal is set aside.**

2. **The case is remitted to the opposition division for further prosecution.**

The Registrar:

The Chairman:



G. Nachtigall

I. Beckedorf

Decision electronically authenticated