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**Datasheet for the decision
of 26 October 2021**

Case Number: T 0592/17 - 3.3.02

Application Number: 09755680.7

Publication Number: 2283084

IPC: C09D5/00

Language of the proceedings: EN

Title of invention:

PROCESS FOR THE PRODUCTION OF A DARK-COLOR MULTI-LAYER COATING

Patent Proprietor:

Coatings Foreign IP Co. LLC

Opponent:

PPG Industries, Inc.

Headword:

Relevant legal provisions:

EPC Art. 123(2), 84

EPC R. 139

RPBA Art. 12(2), 12(4)

RPBA 2020 Art. 13(1), 13(2), 25(2)

Keyword:

Amendments

Late-filed auxiliary requests

Claims

Correction of error

Decisions cited:

T 1311/11

Catchword:



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Case Number: T 0592/17 - 3.3.02

D E C I S I O N
of Technical Board of Appeal 3.3.02
of 26 October 2021

Appellant: PPG Industries, Inc.
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Decision under appeal: **Interlocutory decision of the Opposition
Division of the European Patent Office posted on
3 January 2017 concerning maintenance of the
European Patent No. 2283084 in amended form**

Composition of the Board:

Chairwoman M. Blasi
Members: S. Bertrand
P. O'Sullivan

Summary of Facts and Submissions

I. The appeal by the opponent lies from the interlocutory decision of the opposition division that European patent no. 2 283 084 in amended form according to the second auxiliary request filed during oral proceedings on 9 December 2016 met the requirements of the EPC.

II. The second auxiliary request contained a set of nine claims, independent claim 1 of which reads as follows:

"A process for the production of a dark-color multi-layer coating, comprising the successive steps:

- (1) applying an NIR-opaque coating layer A' from a pigmented, solvent- or waterborne coating composition A to a substrate,*
- (2) applying a coating layer B' from a pigmented coating composition B onto the substrate provided with coating layer A',*

wherein the pigment content of coating composition A consists 90 to 100 wt.% of at least one 100 to 1000 nm thick aluminum flake pigment and 0 to 10 wt.% of at least one further pigment, which is selected in such a way that NIR-opaque coating layer A' exhibits low NIR absorption,

wherein the pigment content of coating composition B consists 50 to 100 wt.% of at least one black pigment with low NIR absorption and 0 to 50 wt.% of at least one further pigment, which is selected in such a way that coating layer B' exhibits low NIR absorption and that the dark-color multi-layer coating exhibits a brightness L^ (according to CIEL a^*b^* , DIN 6174),*

measured at an illumination angle of 45 degrees to the perpendicular and an observation angle of 45 degrees to the specular, of at most 10 units, wherein the sum of the respective wt.% equals 100 wt.%, wherein the coating layers A' and B' are cured, wherein the term "coating layer A' which exhibits low NIR absorption" shall mean an NIR-opaque coating layer A' which exhibits an NIR reflection of at least 48% over the entire NIR wavelength range of 780 to 2100 nm, wherein the term "NIR-opaque coating layer" refers to a dried or hardened pigmented coating layer with a film thickness at least as thick that underlying substrate surfaces (substrate surfaces located directly beneath the coating layer) with different NIR absorption are no longer discernible by NIR reflection measurement, wherein the term "coating layer B' exhibiting low NIR absorption" shall mean a coating layer B' which would exhibit an NIR reflection of at least 33% over the entire NIR wavelength range of 780 to 2100 nm, if it were applied and dried or hardened on an NIR-opaque coating layer pigmented exclusively with at least one 100 to 1000 nm thick aluminum flake pigment, and wherein a black pigment with low NIR absorption is one which, when pigmenting a coating composition with the respective black pigment and a 100 to 1000 nm thick aluminum flake pigment in a pigment weight ratio of 10 : 90 and without using other pigments, results in the NIR reflection of a dried or cured coating layer applied from the coating composition in an NIR-opaque film thickness being at least 33% over the entire wavelength range of 780 to 2100 nm".

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

D3

US 7 211 324 B2

- A014 Horiba, a guide book to particle size analysis, pp. 1-29
- A015 Applicant's reply to the examining division, 22 September 2011
- A016 Applicant's reply to the examining division, 20 January 2011

- IV. In the impugned decision, the opposition division's conclusions included that the claims according to the second auxiliary request did not comprise added subject-matter within the meaning of Article 123(2) EPC.
- V. In its statement setting out the grounds of appeal, the opponent ("appellant") contested the reasoning of the opposition division and submitted, *inter alia*, that the claims according to the second auxiliary request held allowable by the opposition division added subject-matter beyond the content of the application as filed. It submitted document A014.
- VI. In its reply to the grounds of appeal, the patent proprietor ("respondent") provided counter-arguments regarding the appellant's objections. Sets of claims of auxiliary requests 1 to 4 ("new auxiliary requests 3 to 6") were filed and it was requested that the appeal be dismissed, or alternatively, that the patent be maintained in amended form based on one of these claim requests, or "based on Auxiliary Request 7 as filed during opposition proceedings".
- VII. In a further letter, the appellant submitted *inter alia* arguments regarding the admittance of A014 and further arguments regarding added subject-matter. It submitted documents A015 and A016.

- VIII. On 26 February 2020, the board issued a communication in preparation for the oral proceedings, which had been arranged as requested by the parties.
- IX. In further letters dated 26 August 2021 and 27 August 2021, the respondent submitted claim sets of auxiliary requests 2', 3' and 4' and provided clean copies of the sets of claims of auxiliary requests 1 to 5.
- X. In further letters dated 17 August 2021 and 5 October 2021, the appellant submitted further arguments on the disclosure of D3, based on the priority document of D3 and the translation of paragraph [0018] of this priority document. The appellant submitted further arguments against the objection of added subject-matter and objected to the admittance of auxiliary requests 2', 3', 4' and 5 into the proceedings.
- XI. In-person oral proceedings were cancelled and rescheduled to be held by videoconference.
- XII. Oral proceedings before the board were held on 26 October 2020 by videoconference.
- XIII. The parties' final requests were the following:

The appellant requested that:

- the decision under appeal be set aside and that the patent be revoked in its entirety,
- document A014 be admitted into the proceedings, and
- auxiliary requests 2', 3', 4' and 5 not be admitted into the proceedings.

The respondent requested that:

- as the main request, the appeal be dismissed, implying that the second auxiliary request held allowable by the opposition division be upheld,
- alternatively, the patent be maintained in amended form on the basis of one of the sets of claims of auxiliary requests 1, 2, 2', 3, 3', 4, 4' and 5 filed with the letter of 26 August 2021,
- auxiliary requests 2', 3', 4' be admitted into the proceedings,
- A014 to A016 not be admitted into the proceedings, and
- the priority document of D3 and the allegation of fact submitted on 17 August 2021 based on the priority document of D3 not be admitted into the proceedings.

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

Main request and auxiliary request 1 - added subject-matter

- In claim 1 of the main request and auxiliary request 1, the further pigment encompassed also aluminum pigments whose thickness was different from 100 to 1000 nm. Contrary thereto, the disclosure on page 9, lines 5-8 of the application as filed disclosed that the "further pigments" could not be aluminum pigments.

- The term "at least one aluminum flake pigment" in the passage on page 9, lines 5-8 of the application as filed encompassed any aluminum flake pigment. The amount of 90 to 100 % of pigment of coating composition A in said passage encompassed the amount of any aluminum flake pigments present in coating composition A.
- The application as filed did not contain any passage disclosing directly and unambiguously that the further pigment was an aluminum flake pigment.
- Claim 1 of the main request and auxiliary request 1 thus added subject-matter.

Auxiliary requests 2, 3 and 4 - added subject-matter

- The insertion of the term "exclusively" in claim 1 of each of auxiliary requests 2, 3 and 4 did not change the meaning of the term "consist of" and did not exclude that coating composition A comprised 0 to 10 wt.% of at least one further pigment.
- Claim 1 of each of auxiliary requests 2, 3 and 4 did not meet the requirements of Article 123(2) EPC.

Auxiliary requests 2', 3' and 4' - Admittance

- The objection of added subject-matter in relation to the term "at least one aluminum flake pigment" had already been raised in 2014 before the opposition division, and was known to the respondent since then.

- The objection was thus not an amendment to the appellant's appeal case that could justify the filing of auxiliary requests 2', 3' and 4' at such advanced stage of the appeal proceedings (Article 13(2) RPBA 2020).
- The feature "which is selected in such a way that NIR-opaque coating layer A' exhibits low NIR absorption" was disclosed, in the application as filed, in combination with the "at least one further pigment", which was deleted in claim 1 of each of auxiliary request 2', 3' and 4'. Thus, claim 1 of said requests still contravened Article 123(2) EPC.
- Furthermore the feature "which is selected in such a way that NIR-opaque coating layer A' exhibits low NIR absorption" was not clear in claim 1 of each of auxiliary request 2', 3' and 4', since the skilled person did not know what should be selected.
- Auxiliary request 2', 3' and 4' thus also gave rise to new objections.
- Since the respondent's request for correction under Rule 139 EPC and associated arguments were only submitted during oral proceedings before the board, the respondent's request should not be admitted into the proceedings. Moreover, the requirements for a correction were not met, *inter alia* because the claim sets filed in appeal also differed with respect to the substrate claim.

Auxiliary request 5 - Admittance

- The allowability of auxiliary request 5 had not been substantiated and the requirements of Article 12(2) RPBA 2007 were not met.

- Auxiliary request 5 should not be admitted into the proceedings.

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

Main request and auxiliary request 1 - added subject-matter

- The pigment content of coating composition A according to claim 1 was based on the passages on page 9, lines 5-8 and page 7, lines 9-10 of the application as filed.
- The passage on page 7, lines 9-10 of the application as filed did not exclude that the further pigment could be an aluminum flake pigment. The only requirement of this passage, referring to one aluminum flake pigment, was that the further pigment was different from the pigment "one aluminum flake pigment".

Auxiliary requests 2, 3 and 4 - added subject-matter

- The insertion of the term "exclusively" in claim 1 of each of auxiliary requests 2, 3 and 4 made it clear that the 100 to 1000 nm thick aluminum flake pigment was the only pigment present in coating composition A, i.e. that coating composition A no longer included "0 to 10 wt % of at least one further pigment".

Auxiliary requests 2', 3' and 4' - Admittance

- The objection of added subject-matter regarding the term "at least one aluminum flake pigment" was

raised for the first time in the board's communication dated 26 February 2021.

- Auxiliary requests 2', 3' and 4' were thus filed in response to the board's communication.
- The amendment to each respective claim 1 by deletion of the feature "and 0 to 10 wt.% of at least one further pigment" prima facie overcame the issues under Article 123(2) EPC for claim 1 of auxiliary requests 2, 3 and 4 and did not change anything concerning the assessment of sufficiency, novelty and inventive step.
- The conclusion that the insertion of the term "exclusively" in auxiliary requests 2, 3 and 4 would not solve said issue had been addressed for the first time during oral proceedings before the board; the appellant's argument relating to "consists exclusively of" was never raised before; thus auxiliary requests 2', 3' and 4' were a direct response to this finding.
- Auxiliary request 2' was identical to the fourth auxiliary request filed in opposition proceedings with the letter of 17 January 2014, which request had never been withdrawn; the situation was similar for auxiliary requests 3' and 4' filed with that same letter.
- The appellant could not be surprised by the filing of these requests since they did not represent the filing of new auxiliary requests, i.e. it did not represent a fresh case on the part of the respondent.

- The requests were easy to understand and had been filed two months in advance of oral proceedings, which in opposition proceedings was deemed sufficiently timely for final submissions.
- The filing of these requests represented the correction of an obvious error under Rule 139 EPC which first had occurred in opposition.

Auxiliary request 5 - Admittance

- The claims of auxiliary request 5 were identical to the claims of auxiliary request 7 filed on 10 October 2016 before the opposition division. The amendments made in the latter request were substantiated during the proceedings before the opposition division.
- Auxiliary request 5 should be admitted into the proceedings.

Reasons for the Decision

Main request ("NEW 2.AUXILIARY REQUEST", filed during oral proceedings on 9 December 2016)

1. Added subject-matter - Claim 1
 - 1.1 The appellant argued that the subject-matter of claim 1 of the main request extended beyond the content of the application as filed. In particular, it submitted that the feature "*the pigment content of coating composition A consists 90 to 100 wt.% of at least one 100 to 1000 nm thick aluminum flake pigment and 0 to 10 wt.% of at least one further pigment*" in claim 1 of the main request was not based on the application as filed.

1.2 The respondent submitted that the pigment content of coating composition A was clearly based on the passages on page 9, lines 5-9 and page 7, lines 9-10 of the application as filed.

1.3 Claim 1 of the main request (II, *supra*) mentions that "*the pigment content of coating composition A consists 90 to 100 wt.% of at least one 100 to 1000 nm thick aluminum flake pigment and 0 to 10 wt.% of at least **one further pigment***" (emphasis added).

The passage on page 9, lines 5-9 of the application as filed states that "*the pigment content of coating composition A consists exclusively of the at least one aluminum flake pigment*" and "*it may also comprise about 0 to 10 wt.% of at least one further pigment which is selected in such a way that NIR-opaque coating layer A' exhibits low NIR absorption*".

The passage on page 7, lines 9-10 of the application as filed refers to aluminum flake pigments comprising "*one or more 100 to 1000 nm thick aluminum flake pigments*".

The features relating to the pigment content in the coating composition A of claim 1 of the main request are each disclosed in the above passages.

However, from the wording of claim 1 of the main request, the skilled person would understand that the further pigment in said claim is not a 100 to 1000 nm thick aluminum flake pigment. Consequently, the skilled person would not exclude, as one further pigment, an aluminum flake pigment having a different thickness (i.e a thickness of below 100 or 1000 nm).

Contrary thereto, the passage on page 9, lines 5-9 clearly and unambiguously discloses that the further pigment cannot be an aluminum flake pigment.

Thus, the term "further pigment" in claim 1 of the main request does not refer to the same pigment as disclosed in the passage on page 9, line 5-8 of the application as filed.

- 1.4 The respondent submitted that the passage on page 9, lines 5-9 of the application as filed did not exclude that the further pigment could be an aluminum flake pigment. The only requirement of this passage, referring to "one aluminum flake pigment", was that the further pigment was different from the "one aluminum flake pigment". If the aluminum flake pigment had a certain property, the further pigment had only to be different from the specific aluminum flake pigment and, thus, could be an aluminum flake pigment having a different property. The application as filed did not exclude that the further pigment was an aluminum flake pigment.

The board does not agree. First, as submitted by the appellant, the passage on page 9, lines 5-9 of the application as filed refers to "**at least one aluminum flake pigment**" (emphasis added by the board), meaning that any aluminum flake pigment is encompassed by the term "at least one aluminum flake pigment" and that the amount of 90 to 100 % of pigment of coating composition A derived from the above passage encompasses the amount of any aluminum flake pigment.

Second the board acknowledges that the application as filed does not *expressis verbis* exclude that the further pigment is an aluminum flake pigment. However, the board did not find, and the respondent did not indicate any passage in the application which directly and unambiguously discloses that the further pigment

can be an aluminum flake pigment. In the absence of such a disclosure, the respondent's argument must fail.

- 1.5 Therefore the board concludes that claim 1 of the main request introduces subject-matter beyond the content of the application as filed, contrary to Article 123(2) EPC.
2. For this reason, the main request is not allowable.
3. A015 and A016 were submitted by the appellant in support of its arguments on added subject-matter. A015 and A016 are letters of the respondent filed during examination proceedings leading to the present patent and indicate how the respondent interpreted the term "further pigment". The respondent requested that the documents not be admitted into the proceedings. Since the board accepted the appellant's point of view without taking documents A015 and A016 into account, there was no need for the board to address the admittance of these documents. Document A014 which had been filed by the appellant in support of an objection of lack of clarity in relation to the main request had not had to be addressed either.

Auxiliary request 1 - claims filed on 26 August 2021

4. The claims of auxiliary request 1 are identical to the claims of "New auxiliary request 3" submitted with the reply to the grounds of appeal.
5. Added subject-matter

Claim 1 of auxiliary request 1 comprises the feature "*the pigment content of coating composition A consists 90 to 100 wt.% of at least one 100 to 1000 nm thick aluminum flake pigment and 0 to 10 wt.% of at least one further pigment*", i.e. the feature of claim 1 of the

main request which was found to add subject-matter contrary to Article 123(2) EPC (point 1, *supra*). Thus the same reasons as those given for claim 1 of the main request apply *mutatis mutandis* to claim 1 of auxiliary request 1.

6. Therefore, auxiliary request 1 is not allowable.

Auxiliary requests 2, 3 and 4 - claims filed on 26 August 2021

7. The claims of auxiliary requests 2, 3 and 4 are identical to the claims of "New auxiliary request 4", "New auxiliary request 5" and "New auxiliary request 6" submitted with the reply to appeal.

8. Added subject-matter

Claim 1 of each of auxiliary request 2, 3 and 4 comprises the feature "*the pigment content of coating composition A consists **exclusively** of ~~90 to 100 wt.%~~ of at least one 100 to 1000 nm thick aluminum flake pigment and 0 to 10 wt.% of at least one further pigment*" (emphasis added by the board; strike through and bold text representing deletion and addition respectively compared to the corresponding feature of claim 1 of the main request).

The respondent argued that the insertion of the term "exclusively" in the respective claim 1 of each request made it clear that the 100 to 1000 nm thick aluminum flake pigment was the only pigment present in coating composition A, i.e. that coating composition A no longer included "0 to 10 wt % of at least one further pigment".

The board does not agree. As submitted by the appellant, the insertion of the term "exclusively" in the claim does not add anything that was already

expressed by the term "consist of". Since claim 1 of each of auxiliary request 2, 3 and 4 still comprises the feature "0 to 10 wt.% of at least one further pigment", the skilled person, when reading the claim, understands that coating composition A may comprise 0 to 10 wt.% of at least one further pigment, even if the term "exclusively" is present in the claim. In particular, the term "exclusively" would not be understood to indicate that the at least one further pigment may no longer be present, since it refers to both the aluminium pigment and the further pigment. Thus, contrary to the respondent's argument, the presence of the term "consists exclusively of" does not change the pigment content of coating composition A with respect to the term "consist of" found in claim 1 of the main request and auxiliary request 1.

Consequently, claim 1 of each of auxiliary requests 2, 3 and 4 does not comply with Article 123(2) EPC for the same reasons given above for claim 1 of the main request (points 1.3-1.4).

9. For this reason, auxiliary requests 2, 3 and 4 are not allowable.

Auxiliary request 2', 3' and 4' - claims filed on
26 August 2021

10. Admittance of auxiliary requests 2', 3' and 4'
 - 10.1 Claim 1 of each of auxiliary requests 2', 3' and 4' differs from claim 1 of each of auxiliary requests 2, 3 and 4, respectively in that the feature "and 0 to 10 wt.% of at least one further pigment" was deleted.
 - 10.2 The appellant requested that auxiliary requests 2', 3' and 4' not be admitted into the appeal proceedings.

Auxiliary requests 2', 3' and 4' were filed on 26 August 2021, i.e. after issuance of the summons to oral proceedings and the board's communication pursuant to Article 15(1) RPBA 2020 dated 26 February 2021. In accordance with Article 13(2) RPBA 2020, which applies to the case at hand in accordance with the transitional provisions set out in Article 25(1) RPBA 2020, any amendment to a party's appeal case made after notification of a summons to oral proceedings shall, in principle, not be taken into account unless there are exceptional circumstances, which have been justified with cogent reasons by the party concerned.

In exercising its discretion, the board considers, *inter alia*, the current state of the proceedings, the suitability of the amendment to resolve the issues which were admissibly raised by another party in the appeal proceedings, whether the amendment is detrimental to procedural economy, and, in the case of an amendment to a patent, whether the party has demonstrated that any such amendment, *prima facie*, overcomes the issues raised by another party in the appeal proceedings and does not give rise to new objections (Article 13(1) RPBA 2020).

10.3 In view of the following considerations, the board decided not to admit auxiliary requests 2', 3' and 4' into the proceedings

The objection under Article 123(2) EPC against the feature "*at least one 100 to 1000 nm thick aluminum flake pigment and 0 to 10 wt.% of at least one further pigment*", present in claim 1 of each of the main request and auxiliary requests 1 to 4, was raised by the appellant for the first time in the letter of 2 June 2014 (second full paragraph on page 2), discussed during the oral proceedings before the

opposition division, considered in the impugned decision (point 5.1) and re-presented in the statement of grounds of appeal (point 4). The objection raised by the appellant was thus not associated with any new aspect on appeal. Moreover, the appellant, in its letter dated 5 April 2018, further addressed the issue of added subject-matter in relation to claim 1 of auxiliary requests 2, 3 and 4 (then auxiliary requests 4, 5 and 6, see points 3.2, 3.3 and 3.4 of said letter). The board therefore does not agree with the respondent that the issue was raised by the board for the first time in its communication dated 26 February 2021. The respondent further argued that the submission of claim requests about two months in advance of oral proceedings was generally considered as sufficiently timely in opposition proceedings. The board considers this argument irrelevant in the proceedings before it, since appeal proceedings are governed by a different legal framework. Hence, no convincing justification for the submission of these claim requests at this late stage of the proceedings was provided by the respondent.

10.4 Furthermore, the amendments give rise to new objections, under Article 123(2) and Article 84 EPC. Claim 1 of each of auxiliary request 2', 3' and 4' comprised the following amendment:

"wherein the pigment content of coating composition A consists exclusively of at least one 100 to 1000 nm thick aluminum flake pigment ~~and 0 to 10 wt.% of at least one further pigment~~, which is selected in such a way that NIR-opaque coating layer A' exhibits low NIR absorption" (emphasis added by the board; strike through text representing deletion respectively

compared to the similar feature of claim 1 of each of auxiliary requests 2, 3 and 4).

As set out above, the feature "0 to 10 wt.% of at least one further pigment" was deleted in claim 1 of each of auxiliary requests 2', 3' and 4'. This deletion overcame the objection raised under Article 123(2) EPC in relation to claim 1 of each of auxiliary requests 2, 3 and 4.

However claim 1 of each of auxiliary requests 2', 3' and 4' still comprised the feature "which is selected in such a way that NIR-opaque coating layer A' exhibits low NIR absorption". As set out above (point 1.2, *supra*), and as argued by the appellant, said feature is disclosed, in the application as filed, in combination with the "at least one further pigment" and not in combination with the "at least one 100 to 1000 nm thick aluminum flake pigment" as recited in claim 1 of each of auxiliary request 2', 3' and 4'. Consequently the subject-matter of claim 1 of each of auxiliary requests 2', 3' and 4' still extends beyond the content of the application as filed within the meaning of Article 123(2) EPC.

Furthermore, claim 1 of each of said requests is not clear. More specifically, as submitted by the appellant, the feature "which is selected in such a way that NIR-opaque coating layer A' exhibits low NIR absorption" is not clear in claim 1 of each of auxiliary request 2', 3' and 4'. In fact, the pigment content of coating composition A consist only of 100 to 1000 nm thick aluminum flake pigment. There is thus nothing else to be selected. Therefore, the skilled person cannot determine the entity to which this

feature refers and does not know what should be selected.

- 10.5 During oral proceedings, the respondent also requested a correction pursuant to Rule 139 EPC, arguing that the filing of the claims of auxiliary requests 2', 3' and 4' represented the filing of the corrected sets of claims. The sets of claims of auxiliary requests 2, 3 and 4, which had been filed with the reply to the appeal as auxiliary requests 4, 5, and 6, had erroneously contained the feature "and 0 to 10 wt.% of at least one further pigment". This feature had been deleted from each of claim 1 of the corresponding auxiliary requests 4, 5, and 6 in the proceedings before the opposition division, as could be seen from the claim requests containing hand-written amendments filed in reply to the opposition. By mistake, however, in the typed versions of these claims requests filed subsequently, the deletion was not implemented and this had remained unnoticed until the submission of the correct versions.

The appellant requested that the respondent's request for a correction under Rule 139 EPC not be admitted into the proceedings. The correction was requested late and the associated submissions only made at the oral proceedings before the board. Moreover, the requirements for a correction were not met since the requirements that it had to be clear what the error was and what the correction should be were not met.

Irrespective of the late stage at which correction was requested, the board could neither agree that an error was recognisable nor that the correction of the error would have been obvious in the sense that it would have been immediately evident that nothing else would have been intended than what was offered as the correction.

While there was indeed an inconsistency concerning the presence or absence of the feature "and 0 to 10 wt.% of at least one further pigment" in claim 1 between the sets of claims of then auxiliary requests 4, 5 and 6 showing hand-written amendments filed in reply to the notice of opposition as compared to those filed as typed version with a subsequent letter during opposition proceedings, it is not apparent whether the typed version comprised an error, or alternatively, whether there was a subsequent amendment. The respondent's associated explanations relating to the amendments carried out covered both versions and a later change of mind on the part of the respondent cannot be excluded. In addition, claim sets of all auxiliary requests as upheld by the respondent in opposition proceedings were filed at the oral proceedings before the opposition division and attached to the minutes. In these versions the above-mentioned feature in claim 1 was present, and no correction had been requested. Furthermore, as also highlighted by the appellant, none of the sets of claims of the auxiliary requests filed with the reply to the appeal was identical to any of the sets filed during opposition because they contained additional amendments, more specifically the deletion of a claim. Hence, in the light of the upheld auxiliary requests and the additional amendments made on appeal, it can neither be established that there was any recognisable error at all, nor that the proposed correction would have been obvious in the sense that it would have been immediately evident that nothing else would have been intended.

10.6 In view of the above, the board decided not to admit auxiliary requests 2', 3' and 4' into the appeal

proceedings in accordance with Article 13(1) and (2) RPBA 2020.

Auxiliary request 5 - claims filed on 26 August 2021

11. The claims of auxiliary request 5 are identical to the claims of auxiliary request 7 filed on 10 October 2016.

Claim 1 of auxiliary request 5 differs from claim 1 of the main request in the pigment content of coating composition A and in the additional feature that *"coating layer A' is cured prior to application of a further coating layer"*.

The pigment content of coating composition A in claim 1 of auxiliary request 5 reads as follows:

"wherein the pigment content of coating composition A consists 90 to 100 wt.% of at least one ~~100 to 1000 nm thick~~ aluminum flake pigment and 0 to 10 wt.% of at least one further pigment, which is selected in such a way that NIR-opaque coating layer A' exhibits low NIR absorption,

wherein the pigment content of coating composition A comprises <90 wt.% of 10 to 80 nm thick aluminum flake pigment," (emphasis added by the board; strike through and bold text representing deletion and addition respectively compared to the similar feature of claim 1 of the main request).

11.1 The appellant requested that auxiliary request 5 not be admitted into the proceedings.

11.2 Under Article 12(4) RPBA 2007 (applicable to the present case pursuant to Article 25(2) RPBA 2020, the reply to appeal having been filed before 1 January 2020) the board, without prejudice to the power to hold inadmissible certain facts, evidence or

requests, takes into account everything presented by the parties in the statement of grounds of appeal and the reply if and to the extent it relates to the case under appeal and meets the requirements under Article 12(2) RPBA 2007.

Article 12(2) RPBA 2007 stipulates *inter alia* that the statement of grounds of appeal and the reply shall contain a party's complete case and set out clearly and concisely why the decision under appeal be amended or upheld and should specify all the facts, arguments and evidence relied on.

As set out above, claim 1 of auxiliary request 5 refers to aluminum flake pigments defined with only one thickness of 10 to 80 nm. With the reply to the grounds of appeal, while identifying the amendments made in auxiliary requests 1 to 4 (point 2 of the reply), the respondent did not provide any substantive arguments concerning the subject-matter of the claims of auxiliary request 5, let alone regarding the relevance of the aluminum flake pigments defined with the thickness of 10 to 80 nm and the feature "*coating layer A' is cured prior to application of a further coating layer*" comprised in claim 1 of auxiliary request 5, the set of claims of which was first filed on 26 August 2021. More specifically, no arguments were submitted in the reply to the grounds of appeal as to why the subject-matter of auxiliary request 5 would overcome the objections of added subject-matter, novelty and inventive step raised by the appellant in the grounds of appeal, nor was any such argument self-evident. The respondent simply stated that it requested alternatively that the patent be maintained "based on Auxiliary Request 7 as filed during opposition proceedings".

11.3 During the oral proceedings, the respondent submitted that the claims of auxiliary request 5 were identical to the claims of auxiliary request 7 filed on 10 October 2016 before the opposition division and the amendments made in the latter request were substantiated during the proceedings before the opposition division which was sufficient. In relation to the substantiation, the respondent also referred to its submissions presented on appeal.

The board does not agree that a substantiation presented during proceedings before the opposition division is sufficient for the purposes of Article 12(2) RPBA 2007. It is established Case Law of the Boards of Appeal that a mere reference to a party's earlier submissions made during the proceedings before the opposition division is not sufficient as a submission in reply to a statement of grounds of appeal (see e.g. T 1311/11, reasons 19). In the present case, not even a reference to a substantiation made during the proceedings before the opposition division was provided in the reply to the appeal. Rather, the respondent's submission was limited merely to a statement that the auxiliary request was maintained.

11.4 Since the relevance of the amendment of claim 1 of auxiliary request 5 was not substantiated, the respondent failed to submit its complete case in accordance with Article 12(2) RPBA 2007 and, hence, the board did not need to take this request into account in the appeal proceedings under Article 12(4) RPBA 2007. Only in the letter dated 26 August 2021, i.e. two months prior to the oral proceedings, was the claim request addressed as to its merits, but confined to an explanation as to where basis in the application as filed could be found and to the statement that novelty and inventive step should be acknowledged for the same

reasons as for the main request (see point 8 of said letter). These submissions were presented at an extremely late stage of the appeal proceedings and, in addition, the amendments further distinguishing claim 1 from claim 1 of the main request had not been addressed at all. This resulted in both the board and the appellant being left in the dark as to the purpose of this claim request and how it was intended to overcome the grounds for opposition raised by the appellant.

- 11.5 In view of the foregoing, the board decided not to admit auxiliary request 5 into the appeal proceedings in accordance with Article 12(4) RPBA 2007 and Article 13(1) and (2) RPBA 2020.

Order

For these reasons it is decided that:

1. The decision under appeal is set aside.
2. The patent is revoked

The Registrar:

The Chairwoman:



N. Maslin

M. Blasi

Decision electronically authenticated