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**Datasheet for the decision
of 11 November 2020**

Case Number: T 0353/18 - 3.3.03

Application Number: 06828984.2

Publication Number: 1957579

IPC: C08L27/06, C09D127/06,
B05D7/22, C08L61/06

Language of the proceedings: EN

Title of invention:
BADGE- AND BPA-FREE CAN COATING

Patent Proprietor:
Henkel IP & Holding GmbH

Opponent:
The Valspar Corporation

Relevant legal provisions:
EPC Art. 54, 100(b), 111(1), 123(2)
RPBA 2020 Art. 13(2), 11

Keyword:

Amendments - allowable (auxiliary requests 1 and 2: no)
Grounds for opposition - insufficiency of disclosure (no)
Novelty - (yes)
Amendment after summons - exceptional circumstances (no -
auxiliary request 1a not admitted)
Remittal - special reasons for remittal

Decisions cited:

G 0002/97, G 0002/10

Catchword:

Discrepancies between the clean and the annotated versions of
a request: no provision in the EPC establishing any legal
primacy of the clean version over the annotated version;
special reasons justifying a remittal (reasons: section 8)



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Case Number: T 0353/18 - 3.3.03

D E C I S I O N
of Technical Board of Appeal 3.3.03
of 11 November 2020

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Decision under appeal: **Interlocutory decision of the Opposition
Division of the European Patent Office posted on
1 December 2017 concerning maintenance of the
European Patent No. 1957579 in amended form.**

Composition of the Board:

Chairman D. Semino
Members: O. Dury
W. Ungler

Summary of Facts and Submissions

I. The appeal of the opponent is against the interlocutory decision of the opposition division posted on 1 December 2017 concerning maintenance of European patent No. 1 957 579 in amended form according to auxiliary request 1 filed by letter of 12 September 2017 and an adapted description.

II. Claim 1 of the application as filed read as follows:

"1. Composition, which is useful for producing coatings for metal sheets substrates of metal cans for storing and/or transporting food or beverages or a lid thereof, and which comprises the following components:

(a) 30 to 90 wt.% of a polyvinylchloride-(PVC)-polymer,

(b) 7 to 25 wt.% of an acrylic resin,

(c) 3 to 40 wt.% of a crosslinking agent, which is produced from phenol, para-tert.-butylphenol, xylenol or a mixture thereof, and formaldehyde,

(d) 0 to 8 wt.% additive,

(e) 0 to 50 wt.% pigment and

(f) a solvent-component,

where all weight percentages are on the basis of the total dry weight of the coating composition (without solvents) and the composition is substantially free of bisphenol-A-diglycidyl-ether ("BADGE") and also

substantially free of bisphenol-A-resins."

III. Claim 1 of the patent as granted read as follows (additions compared with claim 1 of the application as filed in **bold**, deletions ~~struckthrough~~):

"1. **Coating** composition, which is useful for producing coatings for metal sheets substrates of metal cans for storing and/or transporting food or beverages or a lid thereof, and which comprises comprising the following components:

(a) 30 to 90 wt.% of a polyvinylchloride-(PVC)-polymer,

(b) 7 to 25 wt.% of an acrylic resin **having an acid number below 20,**

(c) 3 to 40 wt.% of a crosslinking agent, which is produced from phenol, para-tert.-butylphenol, xylenol or a mixture thereof, and formaldehyde,

(d) 0 to 8 wt.% additive,

(e) 0 to 50 wt.% pigment and

(f) a solvent-component,

where all weight percentages are on the basis of the total dry weight of the coating composition (without solvents) and the composition **contains less than** 0.01 wt.% ~~is substantially free~~ of bisphenol-A-diglycidyl-ether ("BADGE"), ~~and also substantially free of~~ bisphenol-A-resins **and other epoxy groups."**

IV. A notice of opposition was filed against the patent as granted, requesting the revocation of the patent in its

entirety.

V. The contested decision was based on the patent as granted as the main request, on auxiliary request 1 filed by letter of 12 September 2017 and on auxiliary requests 2 and 3, both filed by letter of 20 October 2017.

VI. Claim 1 of auxiliary request 1 differed from claim 1 as granted in that the last paragraph read as follows (additions compared with claim 1 of the application as filed in **bold**, deletions ~~struckthrough~~):

"where all weight percentages are on the basis of the total dry weight of the coating composition (without solvents) and the composition **contains less than** 0.01 wt.% ~~is substantially free~~ of bisphenol-A-diglycidyl-ether ("BADGE") and ~~also substantially free of~~ bisphenol-A-resins **and is free of other epoxy groups.**"

Claim 1 of auxiliary request 2 was directed to a method for producing a coated metal substrate wherein a coating composition comprising components (a) to (f) as defined in claim 1 of auxiliary request 1 (in the same amounts and with the same limitation in terms of amounts of BADGE, bisphenol-A-resins and other epoxy groups) is applied directly onto the metal substrate and baked thereafter.

During the oral proceedings before the board, it became apparent that the patent proprietor had filed two different versions of auxiliary request 3 with the letter of 20 October 2017 - a clean copy and an annotated copy (i.e. indicating the amendments made).

Claim 1 of the clean copy of auxiliary request 3 read as follows (additions compared with claim 1 of the application as filed in **bold**, deletions ~~struckthrough~~):

"1. A method for producing a coated metal substrate, wherein a coating composition consisting of
~~Composition, which is useful for producing coatings for metal sheets substrates of metal cans for storing and/or transporting food or beverages or a lid thereof, and which comprises~~ the following components:

(a) 30 to 90 wt.% of a polyvinylchloride-(PVC)-polymer,

(b) 7 to 25 wt.% of an acrylic resin **having an acid number below 20,**

(c) 3 to 40 wt.% of a crosslinking agent, which is produced from phenol, para-tert.-butylphenol, xylenol or a mixture thereof, and formaldehyde,

(d) ~~0 to 8 wt.% additive~~ **0.1 to 3.0 wt.% of a lubricant,**

(e) ~~0 to 50 wt.% pigment~~ **0.01 to 3.0 wt.% of an accelerator** and

(f) a solvent-component,

where all weight percentages are on the basis of the total dry weight of the coating composition (without solvents) and the composition is ~~substantially~~ free of bisphenol-A-diglycidyl-ether ("BADGE") and ~~also substantially free of~~ bisphenol-A-resins **and other epoxy groups, is applied directly onto the metal substrate and baked thereafter."**

Claim 1 of the annotated copy of auxiliary request 3 differed from claim 1 of the clean copy in that the last paragraph read as follows (additions compared with claim 1 of the application as filed in **bold**, deletions ~~struckthrough~~):

"where all weight percentages are on the basis of the total dry weight of the coating composition (without solvents) and the composition contains **less than** 0.01 wt.% ~~is substantially free~~ of bisphenol-A-diglycidyl-ether ("BADGE") and ~~also substantially free~~ of bisphenol-A-resins **and is free of other epoxy groups, is applied directly onto the metal substrate and baked thereafter.**"

VII. The following document was *inter alia* cited in the opposition division's decision:

D1: WO 2007/021780

VIII. In the contested decision, the opposition division held *inter alia* that:

(a) The main request (patent in suit) did not satisfy the requirements of Article 123(2) EPC. In that respect, in view of pages 2-3 and 5 of the original application, the skilled person would consider that "substantially free" was further limited by "less than 0.01 wt.%" in view of the amounts of BADGE and bisphenol-A-resins. However, the "other epoxy groups" were not considered with the same level of importance in the original application because they were neither discussed in the summary of the invention nor present in original claim 1. Their amount was therefore not an essential technical feature of the invention. This was reflected on

page 5 of the original application, which merely mentioned that the composition was preferably substantially free of other epoxy groups. In addition, it would not make technical sense to limit the amount of "other epoxy groups" to less than 0.01 wt.% because that group of components encompassed a very broad range of compounds that had different toxicities and therefore were not limited to the same amounts. For these reasons, claim 1 as granted contravened Article 123(2) EPC.

- (b) Auxiliary request 1 satisfied the requirements of Article 123(2) and (3) EPC, Article 84 EPC and sufficiency of disclosure, and its subject-matter was novel over D1. It was further noted that, in view of its publication and priority dates, D1 - irrespective of its priority claim - was only potentially relevant under Article 54(3) EPC and that no additional relevant documents had been filed in respect of Article 56 EPC.

In relation to Article 123(2) EPC, it was held that:

- The wording of claim 1 of auxiliary request 1 could be interpreted in two different ways: one where the sum of the amounts of BADGE and bisphenol-A-resins was below 0.01 wt.%, and the other where the amount of each of BADGE and bisphenol-A-resins was below 0.01 wt.%. However, the interpretation was unambiguous in view of page 5 of the original application, according to which the amount of each of BADGE and bisphenol-A-resins should be below 0.01 wt.%.

- According to original page 5, last paragraph, all weight percentages were explicitly based on the total dry weight of the coating composition. Therefore the "total weight" mentioned on page 5 of the application as filed could only be construed as the "total weight of the dry coating composition".

- The wording "substantially free" encompassed "free" as the lower limit. Moreover, the coating composition being "free" of "other epoxy groups" was a preferred possibility, as could be seen from the exemplary composition on original page 9. This was also supported by page 5 of the application as filed, which defined "substantially free" as containing no or no more than a certain amount of a compound.

Regarding sufficiency of disclosure, it was held that the patent in suit contained sufficient information to carry out the invention and that no evidence to the contrary had been provided.

Regarding novelty over D1, the objections based on either the combination of example 18 with passages of the description or the combination of various passages of the description were rejected.

IX. The opponent (appellant) appealed against the above decision. With the statement setting out the grounds of appeal the appellant requested that the decision of the opposition division be set aside and that the patent be revoked.

X. With its response to the statement of grounds of appeal, the patent proprietor (respondent) requested

that the appeal be dismissed (main request) or, in the alternative, that the patent be maintained in amended form according to either auxiliary request 2 or 3 filed by letter of 20 October 2017.

- XI. By letter of 14 August 2020, the parties were summoned to oral proceedings to be held on 11 November 2020.
- XII. The board specified issues to be discussed at the oral proceedings in a communication dated 7 September 2020.
- XIII. By letter of 6 October 2020 the appellant made further submissions, including new objections in respect of auxiliary requests 2 and 3.
- XIV. With the explicit agreement of both parties, oral proceedings were held on 11 November 2020 in the form of a "hybrid" videoconference (the board and the appellant were in a room at the premises in Haar and the respondent was connected via video link). Both parties could hear and see the board and the opposing party, and the board could see and hear both parties.

During the oral proceedings, the respondent submitted new auxiliary request 1a and requested its admittance into the proceedings; it was to be dealt with after auxiliary request 1 filed by letter of 12 September 2017 but before auxiliary requests 2 and 3 filed by letter of 20 October 2017.

Claim 1 of auxiliary request 1a differed from claim 1 of said auxiliary request 1 in that the last paragraph read as follows (additions compared with claim 1 of the application as filed in **bold**, deletions ~~struckthrough~~):

"where all weight percentages are on the basis of the

total dry weight of the coating composition (without solvents) and the composition is ~~substantially~~ free of bisphenol-A-diglycidyl-ether ("BADGE") and ~~also substantially free of~~ bisphenol-A-resins **and other epoxy groups."**

In light of the appellant's arguments in respect of its objection against auxiliary request 3 pursuant to Article 123(2) EPC, it turned out that the parties had considered different versions of auxiliary request 3 during the appeal proceedings - the respondent had used the clean copy, the appellant the annotated copy; see section VI above. When asked by the board, the respondent declared that the clean copy of auxiliary request 3 was the valid version.

XV. The appellant's arguments, in so far as relevant to the present decision, may be summarised as follows:

(a) Claim 1 of auxiliary request 1 allowed by the opposition division did not satisfy the requirements of Article 123(2) EPC for the following reasons:

(i) The amendment "contains less than 0.01 wt.% of bisphenol-A-diglycidyl-ether ("BADGE") and bisphenol-A-resins" was not supported by the application as filed. In particular, its meaning was clear by itself, so there was no need to interpret it in the light of the description.

(ii) Whereas the basis for the "0.01 wt.%" for the BADGE and bisphenol-A-resins in claim 1 was the total dry weight of the composition (i.e. without the solvent), the basis for

the "0.01 wt.%" for the BADGE and bisphenol-A-resins on page 5 of the application as filed was the whole composition, including the solvent.

- (iii) The amendment "free of other epoxy groups" was not supported by the application as filed.
 - (iv) The subgroup of undesirable components mentioned in claim 1 was not originally disclosed.
- (b) The requirements of sufficiency of disclosure were not satisfied because the subject-matter of claim 1 could not be carried out without undue burden.
- (c) The subject-matter of claim 1 of auxiliary request 1 allowed by the opposition division was not novel in view of example 18 read in the light of examples 7, 10 and paragraphs 83-84 of D1.
- (d) Auxiliary request 1a should not be admitted because there were no exceptional circumstances justifying its late filing at the oral proceedings before the board.
- (e) Claim 1 of auxiliary request 2 suffered from at least the same deficiencies in respect of Article 123(2) EPC as claim 1 of auxiliary request 1.
- (f) At the oral proceedings before the board, the appellant's representative declared that he had prepared the case on the basis of the annotated version of auxiliary request 3, on the assumption

that the wording of the clean and the annotated copies of the claims filed by the patent proprietor by letter of 20 October 2017 was identical. As it happened, the annotated copy of auxiliary request 3 included the same non-allowable amendment as auxiliary request 1 whereas the clean copy did not. The discrepancy between the two copies of auxiliary request 3 was not mentioned in any of the written submissions either. Therefore, a remittal to the department of first instance would be fair.

XVI. The respondent's arguments, in so far as relevant to the present decision, may be summarised as follows:

(a) Claim 1 of auxiliary request 1 satisfied the requirements of Article 123(2) EPC for the following reasons:

(i) The amendment "contains less than 0.01 wt.% of bisphenol-A-diglycidyl-ether ("BADGE") and bisphenol-A-resins" was ambiguous and, as reflected by the case law, should be interpreted in the light of the description. In that respect, according to page 5 of the application as filed the amendment imposed a maximum amount of 0.01 wt.% for each of the components BADGE and bisphenol-A-resins.

(ii) In view of both possible meanings of that amendment identified in the contested decision, the interpretation according to section (i) corresponded to the broadest sense that the expression could be given. According to the case law, therefore, that

was the interpretation to be adopted.

- (iii) It was unambiguously stated both in the application as filed and in the patent specification that all weight percentages indicated were based on the total dry weight of the composition (i.e. without the solvent). The passage on page 5 of the application as filed, which defined the term "substantially free of", gave no reason to depart from that interpretation.
 - (iv) The amendment "free of other epoxy groups" was derivable from the third paragraph on page 5 of the application as filed.
 - (v) The subgroup of undesirable components mentioned in claim 1 was also derivable from the third paragraph on page 5 of the application as filed, which stated that all of these components were to be avoided.
- (b) The appellant's objections regarding insufficiency of disclosure should be rejected because they were not supported by any evidence.
- (c) The appellant's objection for lack of novelty in respect of D1 was based on a modification of the disclosure of D1 and/or amounted to a combination of various passages of D1. Therefore, the subject-matter of claim 1 of auxiliary request 1 allowed by the opposition division was not directly and unambiguously derivable from D1.
- (d) Auxiliary request 1a should be admitted because the board's decision in respect of auxiliary request 1

regarding Article 123(2) EPC took the respondent by surprise in deviating from accepted case law on interpreting claims. In addition, due to the Covid-19 pandemic the respondent had trouble obtaining its American client's authorisation to defend auxiliary request 1a in the appeal proceedings. These exceptional circumstances justified the late filing of auxiliary request 1a.

(e) At the oral proceedings before the board, it was agreed that the same conclusion in respect of Article 123(2) EPC reached in relation to auxiliary request 1 found allowable by the opposition division also applied to claim 1 of auxiliary request 2.

(f) At the oral proceedings before the board, it was acknowledged that different versions of auxiliary request 3 had been erroneously filed together with the letter of 20 October 2017, the clean copy being the valid version. The decision regarding a remittal to the department of first instance was left at the board's discretion.

XVII. The appellant requested that the decision under appeal be set aside and that the patent be revoked.

The respondent requested that the appeal be dismissed (main request) or, in the alternative, that the patent be maintained in amended form according to auxiliary request 1a filed during the oral proceedings of 11 November 2020, or according to any of auxiliary requests 2 and 3 filed with letter of 20 October 2017.

Reasons for the Decision

1. Considering that the respondent's main request was the dismissal of the appeal, the highest-ranking request is auxiliary request 1, which was filed by letter of 12 September 2017 and had been found allowable by the opposition division. In line with the numbering in the opposition proceedings, that request is referred to as "auxiliary request 1" hereinafter.

Auxiliary request 1

2. Amendments: Article 123(2) EPC
 - 2.1 For the assessment of Article 123(2) EPC, the question to be answered is whether or not the subject-matter of an amended claim extends beyond the content of the application as filed, i.e. whether after the amendment the skilled person is presented with new technical information (see G 2/10, OJ EPO 2012, 376, point 4.5.1 of the Reasons and Case Law of the Boards of Appeal of the EPO, 9th edition, 2019, II.E.1 and 1.2.1).
 - 2.2 The appellant's objections are directed to the following amendments made in operative claim 1 as compared with claim 1 as originally filed:
 - (a) the replacement of the wording "is substantially free of bisphenol-A-diglycidyl-ether ("BADGE") and also substantially free of bisphenol-A-resins" with "contains less than 0.01 wt.% of bisphenol-A-diglycidyl-ether ("BADGE") and bisphenol-A-resins"; and

(b) the addition of the requirement that the claimed composition should be "free of other epoxy groups".

2.3 Therefore, it has to be assessed whether a direct and unambiguous basis for these amendments individually and in combination may be found in the application as filed.

2.4 **Regarding amendment (a)**

2.4.1 The respondent argued that amendment (a) was derivable from original claim 1 and the third paragraph on page 5 of the application as filed.

Objection regarding the amounts of BADGE and bisphenol-A-resins

2.4.2 In that respect, the wording of claim 1 of the application as filed unambiguously specifies that the claimed compositions are "substantially free" of each of the components BADGE and bisphenol-A-resins.

The third paragraph on page 5 of the application as filed directly follows a paragraph which is directed to a composition according to original claim 1 and in particular contains the same last paragraph "where all weight percentages are ... and the composition is substantially free of bisphenol-A-diglycidyl-ether ("BADGE") and also substantially free of bisphenol-A-resins"; it reads as follows:

The phrase "substantially free", as used within the context of this application, means that the coating compositions of the invention have no BADGE component, or BPA, or at least no more than a de minimus amount of these components, e.g. less than 0.01 wt.%, preferably less than 0.001 % by total wt. It is further preferred that the coating components according to the present invention are substantially free of components of the "BADGE-type", such as bisphenol-F-diglycidyl-ether and novolak-diglycidyl-ether. Finally it is preferred that the coating compositions according to the present invention are also substantially free of other epoxy groups.

Under these circumstances and given that the term "substantially free" has no clear and accepted meaning, the skilled person would infer from the application as filed as a whole that the compositions according to both original claim 1 and page 5 are specified, in an absolute and general manner, as containing less than 0.01 wt.% BADGE and less than 0.01 wt.% bisphenol-A-resins, as agreed by both parties and in accordance with the decision under appeal.

2.4.3 However, in view of the indication of a single quantity and a single condition and in view of the use of the term "and" between the two compounds, the wording "contains less than 0.01 wt.% of ... (BADGE) and bisphenol-A-resins" in claim 1 of auxiliary request 1 unambiguously specifies that the the sum of the amounts of BADGE and bisphenol-A-resins should be below 0.01 wt.%. Therefore, amendment (a) made in claim 1 of auxiliary request 1 does not reflect the combination of requirements in respect of the amount of each of BADGE and bisphenol-A-resins as defined in claim 1 of the application as filed and differs therefrom.

2.4.4 In that respect, as explained in section 2.4.3 above, the board does not share the opposition division's view that the wording of operative claim 1 was ambiguous and

could be interpreted in two ways (see the third paragraph of section VIII b) above). Therefore, there is no reason to turn to the description to interpret the wording of claim 1 of auxiliary request 1 and the respondent's argument that the ambiguous wording of claim 1 of auxiliary request 1 meant it should be read restrictively on the basis of the description is rejected.

For the same reason, the board also rejects the respondent's argument that claim 1 should be read according to the broadest interpretation identified by the opposition division, namely that the amount of each of BADGE and bisphenol-A-resins - not the sum of the amounts - should be below 0.01 wt.%.

- 2.4.5 The conclusion in section 2.4.4 is based solely on the wording of claim 1, which is clear by itself. Since that reading was not shown to be either illogical or devoid of technical sense, the board sees no reason to rule out its clear meaning. Moreover, contrary to the respondent's argument during the oral proceedings before the board, the board does not consider that in endorsing this reading it is adopting a mind desirous of misunderstanding, which would be contrary to accepted case law (see Case Law, *supra*, II.A.6.1).

During the oral proceedings before the board, the respondent further argued that the description should be used to interpret claim 1 of auxiliary request 1 in view of Article 69(1) EPC. However, Article 69 EPC deals with determining the extent of protection of a claim, which is possibly relevant for the purposes of Article 123(3) EPC and in infringement proceedings but is not applicable for Article 123(2) EPC. In addition, although the case law on the relevance of

Article 69(1) EPC for interpreting claims has it that the description may be used to interpret the claims and identify their subject-matter, e.g. to judge whether the subject-matter is novel and not obvious or to establish whether the claims are clear and concise, it is also accepted case law that a discrepancy between the claims and the description is not a valid reason to ignore the clear linguistic structure of a claim and interpret it differently (Case Law, *supra*, II.A.6.3.2, see in particular the second and third paragraphs).

Therefore, the conclusion in section 2.4.4 above does not deviate from the general principles on claim interpretations in accepted case law, contrary to the respondent's view.

2.4.6 During the oral proceedings before the board, the respondent argued that BADGE was a subgroup of bisphenol-A-resins and that, as a consequence, the distinction between the two components was artificial. Under these circumstances, there would be no distinction between the two interpretations considered by the opposition division.

However, that interpretation is not in line with the overall content of the application as filed and the patent in suit, according to which BADGE and bisphenol-A-resins are treated as separate components. The board further agrees with the appellant that it is indisputable that BADGE is a single monomeric chemical compound and bisphenol-A-resins are a group of organic polymeric materials. Therefore, BADGE cannot be taken to be a subgroup of bisphenol-A-resins. For these reasons, the respondent's argument is rejected.

Further objections raised by the appellant

2.4.7 According to the appellant, the wording of claim 1 meant that the basis to be considered for the definition of the "0.01 wt.%" of BADGE and bisphenol-A-resins was the composition without solvent; this was not supported by the passage in the third paragraph on page 5 of the application as filed, which stated that said basis was the composition with solvent.

However, the last two lines of page 5 of the application as filed explicitly indicate that "all weight percentages provided herein are based on the total dry weight of the coating composition excluding solvent". For the board, said statement undoubtedly applies to the overall content of the application as filed, i.e. including the third paragraph on page 5. The fact that said statement is found in the section "Detailed Description of the Invention" whereas the third paragraph on page 5 of the application as filed is in the section "Summary of the invention" is not a sufficient reason to deviate from the unambiguous indication in the last two lines of page 5, which the board holds to apply to the application as filed as a whole. For the same reason, in view of the last two lines of page 5, the indication "by total weight" in the third paragraph on page 5 of the application as filed is to be read as being based on the total dry weight, i.e. the composition without solvent. Moreover, it would not appear to make much sense to have the weight percentage defined in two different ways in a given claim and also in the description without any clear explanation. For these reasons, the appellant's arguments fail to convince and give the board no cause to deviate from the opposition division's conclusion in

that respect.

2.5 **Regarding amendment (b)**, the appellant argued that the application as filed did not support the amendment "free of other epoxy groups".

a) It is correct that claim 1 of the application as filed does not contain any limitation in respect of "other epoxy groups" and that the third paragraph on page 5 of the application as filed discloses the claimed compositions being preferably "substantially free of other epoxy groups" only as a preferred embodiment.

However, in view of the whole of the third paragraph on page 5 of the application as filed, the skilled person would undoubtedly read the term "substantially free" in the same way when used with "other epoxy groups" as when indicated in the same paragraph for BADGE and bisphenol-A-resins, i.e. as meaning either "free of other epoxy groups" or "contains less than 0.01 wt%" of them. In that respect, the board does not share the opposition division's view that the "other epoxy groups" should be considered differently from BADGE and bisphenol-A-resins in view of the overall content of the application as filed (section II.1.1.3 of the reasons of the contested decision). On the other hand, the board does agree with the findings of the opposition division that the wording "substantially free" encompasses "free" and is defined in a general manner, i.e. also for "other epoxy groups", in the third paragraph on page 5 of the application as filed (section II.2.2.6 of the reasons of the contested decision).

Under these circumstances, above amendment (b) amounts

to a single selection within a list of preferred alternative embodiments directed to other epoxy groups, which is disclosed in a general manner in the description of the application as filed.

b) The appellant argued that the application as filed did not disclose that the claimed compositions could be free of other epoxy groups because it would not be possible from a technical point of view to prepare such compositions.

However, the board sees no reason why a composition free of other epoxy groups could not be prepared by selecting each of the components specified in operative claim 1 in such a way as not to contain epoxy groups, as put forward by the respondent. Therefore, there is no reason for the board to consider the embodiment "free of other epoxy groups" to be so illogical or to make so little sense from a technical point of view that the skilled person would have excluded it when reading the application as filed as a whole and in particular the third paragraph on page 5. Therefore, the appellant's objection is not convincing.

2.6 **Regarding the combination of features of operative claim 1, including amendments (a) and (b),** the appellant argued that if the respondent's reading of amendment (a) in the light of the third paragraph on page 5 of the application as filed were adopted, the subgroup of undesirable components specified in claim 1 of auxiliary request 1 would not be originally disclosed; as indicated during the oral proceedings before the board, this meant that the subject-matter of claim 1 could only be arrived at after performing a series of selections within the third paragraph on page 5 of the application as filed in respect of the

specific amounts of BADGE, bisphenol-A-resins and other epoxy groups.

In that respect, the board's view is that the amount of "less than 0.01 wt.%" corresponds to the broadest illustration in absolute terms within the application as filed of the otherwise ambiguous term "substantially free" present in original claim 1. Therefore, if the respondent's reading of amendment (a) were adopted, there would be no need for a selection within the ambit of the original description in order to specify an amount of less than 0.01 wt.% for each of BADGE and bisphenol-A-resins. Moreover, upon reading claim 1 as construed by the respondent, the person skilled in the art would arrive at the subgroup of undesirable components specified in claim 1 of auxiliary request 1 after performing a single selection, namely that the composition should be free of other epoxy groups.

- 2.7 In view of the above, it is concluded that amendment (a) cannot be held to be directly and unambiguously derivable from the application as filed, for the reasons indicated in sections 2.4.2 to 2.4.6 above. However, all the appellant's other objections pursuant to Article 123(2) EPC fail to persuade.
- 2.8 For that reason, auxiliary request 1 does not fulfil the requirements of Article 123(2) EPC and is not allowable.
3. Although the issues of sufficiency of disclosure and novelty are irrelevant for auxiliary request 1 in view of the above decision pursuant to Article 123(2) EPC, the board deems it appropriate to address them in the present decision since they were discussed in full during the appeal proceedings, in particular at the

oral proceedings before the board (in view of their relevance for the then remaining pending requests), and may be relevant at a later stage in view of the remittal of the case to the department of first instance (see section 8 below).

4. Article 100(b) EPC

4.1 To meet the requirements of sufficiency of disclosure, an invention has to be disclosed in a manner sufficiently clear and complete for it to be carried out by the skilled person, without undue burden, on the basis of the information provided in the patent specification, if needed in combination with the skilled person's common general knowledge. In the case in hand, this means that the skilled person should in particular be able to prepare a coating composition according to claim 1, which is contested by the appellant.

4.2 The appellant argues that the information provided in the patent in suit does not allow the skilled person to know which specific conditions to apply in order to arrive at a useful composition.

However, there is no evidence to support the appellant's objection. Therefore, the board has no reason to believe that the skilled person would have any difficulty preparing compositions according to claim 1 of auxiliary request 1 by following e.g. the teaching in the table in paragraph 33 of the patent in suit and using a preparation process described in paragraphs 31, 32 and 34, if needed complemented by common general knowledge. There is also no evidence on file that any such composition would be unsuitable for producing coatings for metal sheet substrates of metal

cans as defined in operative claim 1. In particular, the appellant did not furnish any evidence on appeal to refute the opposition division's conclusion that the requirements of sufficiency of disclosure were fulfilled.

Under these circumstances, the appellant's arguments give the board no cause to overturn the opposition division's decision regarding sufficiency of disclosure.

5. Article 54(3) EPC

5.1 The novelty objection put forward by the appellant on appeal is based on document D1 and made pursuant to Article 54(3) EPC.

5.2 The appellant's objection is based on the modification to example 18 of D1, in which the copolymer according to example 7 (an acrylic resin which differs from component (b) as defined in operative claim 1 only in that it has an acid number of 29.8, not of "below 20") would be replaced by that according to example 10 of D1 (a component (b) according to operative claim 1); according to the appellant, this replacement was supported by paragraphs 83 and 84 of D1.

5.3 In that respect, the respondent did not dispute that the overcoat composition according to example 18 of D1 differed from the composition according to operative claim 1 only in that the acrylic resin used in it had an acid number outside the range defined in claim 1.

5.4 In the board's view, paragraphs 83 and 84 of D1, do not explicitly teach specifically replacing copolymers, as contemplated by the appellant, but rather mention a

larger number of alternative replacement options. In that respect, paragraph 83 teaches that the functional (meth)acrylic (co)polymer to be used in the overcoat compositions according to D1 may be a (co)polymer containing one or more functional groups selected from carboxyl, hydroxyl and oxirane, i.e. selected among three generic groups of copolymers. Furthermore, paragraph 84 addresses that first group of carboxyl-functional copolymers in more detail, particularly as regards the nature and amounts of the suitable comonomers which may be used.

In addition, whereas example 10 of D1 is disclosed as being illustrative of a (meth)acrylic acid (co)polymer comprising a hydroxyl functionality, example 7 of D1 is disclosed as being a (meth)acrylic acid (co)polymer comprising a carboxylic functionality, both of which are taught by D1 as being suitable embodiments for the functional (meth)acrylic (co)polymer of the overcoat composition according to claim 1 of D1 (see claim 14, paragraphs 83, 84, 88, 89 and tables II, III and IV of D1). Therefore, the replacement contemplated by the appellant means that the skilled person would have to use and actively select, in example 18, a different kind of functional (meth)acrylic (co)polymer taught in D1.

Under these circumstances, it cannot be held that replacing, in example 18 of D1, the copolymer according to example 7 with that according to example 10 is directly and unambiguously derivable from D1.

5.5 The appellant further argued that the person skilled in the art would understand that they could replace the carboxyl-functional (meth)acrylic copolymer according

to example 7 used in example 18 of D1 with either

- a copolymer of 2-hydroxyethylmethacrylate (HEMA) with ethyl methacrylate or
- a carboxyl-functional (meth)acrylic copolymer in which less methacrylic acid is used compared with example 7, such as 0.5% , 1 % , or 2% ,

because paragraph 84 of D1 disclosed both of these as suitable alternative functional (meth)acrylic acid (co)polymers.

However, in the absence of a pointer in D1 to any such modifications to example 18, it cannot be held that they constitute disclosure that is directly and unambiguously derivable from that document. Therefore, the appellant's objections fail for the same reason as outlined in section 5.4 above.

5.6 During the oral proceedings before the board, the appellant further argued that under accepted case law the specific disclosures of carboxyl-functional (meth)acrylic copolymer containing 0.5 wt.%, 1 wt.% and 2 wt.% methacrylic acid, as indicated in paragraph 84 of D1, constituted explicit disclosure for the carboxyl-functional (meth)acrylic copolymer to be used in example 18 of D1.

However, even if the passage in paragraph 84 of D1 were to constitute an explicit disclosure for an acrylic resin having an acid number below 20 according to component (b) of operative claim 1, there would still be no explicit or implicit disclosure to modify example 18 of D1 using specifically an acrylic resin of this kind. Therefore, the appellant's

objection must fail for the same reasons as outlined in sections 5.4 and 5.5 above.

5.7 The board further concurs with the opposition division (section II.2.6.2 of the reasons of the contested decision) and the respondent that the skilled person has to make a series of choices within the ambit of D1 as a whole in order to arrive at the specific combination of features in operative claim 1, at least regarding e.g. the amount and acid number of the acrylic resin (component (b) of operative claim 1; paragraphs 81 and 83-93 of D1) and the nature of the crosslinker (component (c) of operative claim 1; paragraphs 73-80 of D1). Therefore, it cannot be concluded that the subject-matter of claim 1 is directly and unambiguously derivable from the description of D1.

In that respect, the appellant's considerations on the concept of selection inventions (statement of grounds of appeal: bottom of page 12 and page 13), i.e. the selection of a sub-range of numerical values from a broader disclosed range (Case Law, *supra*, I.C.6.3.1), are irrelevant since multiple selections within the ambit of D1 have to be made in order to arrive at the subject-matter of operative claim 1. Therefore, the question to be answered is whether or not D1 contains any pointer to the specific combination of selections to be made (Case Law, *supra*, I.C.6.3.3); as outlined in sections 5.4 to 5.6 above, that is not the case here.

5.8 In view of the above, the appellant's novelty objections in view of D1 fail to convince and give the board no cause to overturn the opposition division's decision in that respect.

5.9 Under these circumstances, there is no need for the board to address the issue of the validity of the priority of D1, which was in dispute between the parties.

Auxiliary request 1a

6. Admittance

6.1 The appellant objected to the admittance into the proceedings of auxiliary request 1a, which was filed at the oral proceedings before the board.

6.2 Considering that in this case the parties were sent the summons to oral proceedings in August 2020, the admittance of auxiliary request 1a is subject to the stipulations in Article 13(2) RPBA 2020 (see transitional provisions according to Article 25(1) and (3) RPBA 2020), according to which an amendment to a party's 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.

6.3 In that respect, the respondent argued that the board's decision regarding Article 123(2) EPC took it by surprise, in particular in view of the accepted case law on interpreting claims.

However, as outlined in sections 2.4.2 to 2.4.6 above, the board does not consider the decision pursuant to Article 123(2) EPC to be surprising in view of the case law. In addition, the issue of the reading of amendment (a) identified in section 2.2 above had already arisen during the opposition proceedings; it

was dealt with in the contested decision and further pursued in the statement of grounds of appeal. From the outset of the appeal proceedings, the respondent should have taken into account that the board may overturn the opposition division's decision in that respect; the fact that the board did so cannot be deemed surprising in order to justify the filing of an additional auxiliary request addressing the issue at such a late stage of the proceedings. In the case in hand, there is no doubt that the respondent could have filed such a request earlier e.g. in direct reply to the statement of grounds of appeal.

- 6.4 The respondent further held that due to the current Covid-19 pandemic it had trouble obtaining its American client's authorisation to defend auxiliary request 1a.

However, the board sees no reason why the Covid-19 pandemic would have stopped the representative from contacting their client using usual communication means such as phone, emails or videoconferences.

- 6.5 In view of the above, there are no exceptional circumstances in the case in hand that justify not submitting auxiliary request 1a until the oral proceedings before the board. Therefore, auxiliary request 1a is not admitted into the proceedings (Article 13(2) RPBA 2020).

Auxiliary request 2

7. Article 123(2) EPC

Claim 1 of auxiliary request 2 contains the same amendment (a) as identified in section 2.2 above, which is not allowable pursuant to Article 123(2) EPC for the

reasons outlined in section 2.4.2 to 2.4.6 above. Under such circumstances, the same conclusion in respect of Article 123(2) EPC for auxiliary request 1 is also inevitably reached for auxiliary request 2.

Auxiliary request 3

8. Remittal for further prosecution
- 8.1 During the oral proceedings before the board when discussing the admittance of objections under Article 123(2) EPC against claim 1 of auxiliary request 3, there turned out to be a discrepancy between the wording of that claim in the clean and the annotated versions of that request. The respondent declared that the clean version was the valid one and that the discrepancy was due to an error when preparing the annotated version of auxiliary request 3.
- 8.2 The appellant pointed out that it had worked on the assumption that the two versions were identical and had prepared the case only on the basis of the annotated version.
- 8.3 In proceedings before the EPO, users of the European patent system who are parties to proceedings must act in good faith. In the case in hand, there is no indication on file, and nor has the appellant alleged, that the respondent acted contrary to the principle of good faith when preparing the annotated version of auxiliary request 3. However, the same is also valid for the appellant. The respondent filed auxiliary request 3 during the opposition proceedings by letter of 20 October 2017. When filing that request, and even later on in the appeal proceedings, the respondent did not provide detailed information on the basis for the

amendments in the application as originally filed. In view of the information provided by the respondent, the appellant had no reason to doubt that the annotated version of auxiliary request 3 was correct and matched the clean version.

8.4 While in view of these considerations the board has no doubt that both parties acted in good faith, account needs to be taken of the principle of protection of legitimate expectations, under which users of the European patent system should not suffer a disadvantage as a result of having relied on erroneous information received from the department of first instance or the Boards of Appeal (cf. G 2/97, OJ 1999, 123, point 4.1 of the reasons). While there was no erroneous information from the opposition division or the board in this case, the outcome was the same as the appellant received erroneous information as a result of the respondent providing two different versions of auxiliary request 3 and was given no indication of this discrepancy.

8.5 Furthermore, there is no provision in the EPC establishing any legal primacy of the clean version over an annotated version of a request, so if they are different only a declaration by the proprietor can establish the valid one. In the case in hand, however, this declaration was not provided until the oral proceedings before the board. Thus, in view of the above, the appellant could assume the annotated version of auxiliary request 3 was correct up to that point in time and should not suffer a disadvantage as a result of having done so, even though the respondent declared later that the annotated version was not the valid one.

- 8.6 Pursuant to Article 111(1) EPC the board may either exercise any power within the competence of the department which was responsible for the decision appealed or remit the case to that department for further prosecution. Under Article 11 RPBA 2020, the board shall not remit a case to the department whose decision was appealed for further prosecution, unless special reasons present themselves for doing so.
- 8.7 The discrepancy between the two versions of auxiliary request 3 concerns the amounts of BADGE and bisphenol-A-resins in the composition, i.e. a feature which was central to the appellant's objections under Article 123(2) EPC and which could not be interpreted in isolation from other features, for instance the weight percentages of the further components, especially in view of the use of the term "consisting of" in the preamble of the claim. Consequently, the allowability of any such amendment pursuant to Article 123(2) EPC may additionally depend on further amendments made to the claims; if several amendments are made compared with the application as filed, which appears to be the case here, the question arises as to whether the application as filed provides a basis for the claimed combination of features.
- 8.8 Since the appellant relied on the correctness of the annotated version of auxiliary request 3, it did not provide any written submissions on the specific wording of claim 1 of the clean version of auxiliary request 3, in particular as far as Article 123(2) EPC is concerned. Not raising objections in this respect until the oral proceedings was therefore justified and, as explained above, cannot result in a disadvantage for the appellant.

- 8.9 However, a ruling on the valid version of auxiliary request 3, namely the clean version filed by letter of 20 October 2017, would have required a substantive discussion for the first time during the oral proceedings before the board, without any prior exchange of arguments between the parties. Handling the case in this way would clearly run contrary to the primary object of the appeal proceedings, which is to review the decision under appeal in a judicial manner (Article 12(2) RPBA 2020).
- 8.10 In view of the above, the board considers that in the case in hand there are "special reasons" in the sense of Article 11 RPBA 2020 justifying the remittal of the case to the department of first instance for further prosecution; this was explicitly agreed to by the appellant and was not contested by the respondent at the oral proceedings before the board.
- 8.11 For these reasons, the case is remitted to the department of first instance for further prosecution (Article 111(1) EPC; Article 11 RPBA 2020).

Order

For these reasons it is decided that:

1. The decision under appeal is set aside.
2. The case is remitted to the department of first instance for further prosecution.

The Registrar:

The Chairman:



B. ter Heijden

D. Semino

Decision electronically authenticated