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**Datasheet for the decision
of 9 December 2022**

Case Number: T 1356/18 - 3.3.03

Application Number: 10750001.9

Publication Number: 2475725

IPC: C09D4/06, A61Q3/02

Language of the proceedings: EN

Title of invention:

REMOVABLE COLOR GEL BASECOAT FOR ARTIFICIAL NAIL COATINGS AND
METHODS THEREFORE

Patent Proprietor:

BrandCo CND 2020 LLC

Opponent:

A. Schenk

Relevant legal provisions:

EPC Art. 56, 123(2)

EPC R. 101, 142(1)

Keyword:

Interruption of proceedings (no)
Admissibility of appeal (yes)
Amendments - allowable (yes)
Inventive step - (yes)

Decisions cited:

G 0002/10, G 0001/12



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Case Number: T 1356/18 - 3.3.03

D E C I S I O N
of Technical Board of Appeal 3.3.03
of 9 December 2022

Appellant: A. Schenk
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Respondent: BrandCo CND 2020 LLC
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Decision under appeal: **Interlocutory decision of the Opposition
Division of the European Patent Office posted on
21 March 2018 concerning maintenance of the
European Patent No. 2475725 in amended form.**

Composition of the Board:

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

Summary of Facts and Submissions

I. The appeal of the opponent is against the interlocutory decision of the opposition division concerning maintenance of European patent No. 2 475 725 in amended form according to the claims of auxiliary request 1c filed with letter of 28 December 2017 and an adapted description.

II. The following documents were *inter alia* cited in the decision under appeal:

D1: US 5 407 666

D2: US 5 965 147

D3: US 5 118 495

D4: US 6 051 242

D5: US 5 785 958

D6: WO 98/48769

D7: US 5 871 573

D8: WO 2011/011304

D8a: US 61/227 257

D9: US 6 015 549

D13: US 8 263 677

D14: Expert report from Chad Conger filed during
US prosecution of D13

III. In that decision, the following conclusions relevant to the present decision were reached:

- Auxiliary request 1c met the requirements of Article 123(2) EPC (whereby it was further noted that no objection had been raised by the opponent);

- The subject-matter of auxiliary request 1c was inventive in view of D1 as the document constituting the closest prior art, even in the light of D9.

For these reasons, the patent as amended on the basis of auxiliary request 1c was held to meet the requirements of the EPC.

- IV. The opponent (appellant) filed an appeal against the above decision. In the statement of grounds of appeal (page 1, first paragraph), the appellant in particular stated:

"We herewith amend the indication of the Opponent, which is not Beetz & Partner mbB, as indicated in our Notice of Appeal of May 25, 2018, but, as before, Dr. Angelika Schenk."

- V. With their rejoinder to the statement of grounds of appeal, the patent proprietor (respondent) filed auxiliary requests 1cA to 1cF and maintained auxiliary requests 3c and 5c filed with letter of 28 December 2017 during opposition proceedings. Oral proceedings were further requested if the appeal were not rejected as inadmissible or not dismissed.

- VI. The parties were summoned to oral proceedings and a communication pursuant to Article 15(1) RPBA 2020 was then issued by the Board, containing the preliminary opinion of the Board for the issues relevant for the present case.

- VII. With letter of 30 November 2022, the appellant stated:

"We herewith inform the Board that the appellant does

not intend to attend the oral proceedings and requests a decision based on the current state of the file."

VIII. The oral proceedings were cancelled on 09.12.22.

IX. **The final requests of the parties were as follows:**

(a) The appellant requested in writing that the decision of the opposition division be set aside and that the patent be revoked.

(b) The respondent requested in writing that the appeal be rejected as inadmissible. In addition, the respondent requested in writing that the appeal be dismissed (main request) or, in the alternative, that the patent be maintained in amended form on the basis of any of auxiliary requests 1cA to 1cF filed with the rejoinder to the statement of grounds of appeal or of any of auxiliary requests 3c or 5c filed with letter of 28 December 2017.

X. Claim 1 of the **main request**, which is the sole claim relevant for the present decision, read as follows (additions as compared to claim 1 of the application as filed in **bold**, the components have also been reordered):

"1. A polymerizable composition comprising:

at least one reactive (meth)acrylate;

at least one non-reactive, solvent-dissolvable polymer;

at least one non-reactive solvent; and

at least one reactive polypropylene glycol monomethacrylate **or polyethylene glycol (meth)acrylated monomer**, at least one pyromellitic dianhydride glyceryl-dimethacrylate, at least one reactive urethane (meth)acrylate and at least one polymethylmethacrylate (PMMA) - polymethacrylic acid (PMAA) copolymer;

wherein upon exposure to actinic radiation, said polymerizable composition cures to an acrylic thermoset **lattice** having voids defined therein, said voids containing said at least one non-reactive, solvent-dissolvable polymer."

XI. The appellant's arguments, in so far as they are pertinent for the present decision, may be derived from the reasons for the decision below. They are essentially as follows:

- (a) The appeal was admissible;
- (b) Claim 1 of the main request extended beyond the content of the application as filed;
- (c) The subject-matter of claim 1 of the main request was not inventive starting from document D1 as the closest prior art.

XII. The respondent's arguments, in so far as they are pertinent for the present decision, may be derived from the reasons for the decision below. They are essentially as follows:

- (a) The appeal was to be held inadmissible;

(b) Claim 1 of the main request did not extend beyond the content of the application as filed;

(c) The subject-matter of claim 1 of the main request was inventive starting from document D1 as the closest prior art.

Reasons for the Decision

1. Rule 142(1) EPC - No interruption of proceedings

The Board was informed by letter of 12 July 2022 that the respondent/patent proprietor filed a Chapter 11 bankruptcy case in front of the US Bankruptcy Court. Therefore, the question arose if the proceedings were to be interrupted pursuant to Rule 142 EPC, whereby according to established Case Law, the interruption of proceedings can be decided by the decision-making Board (Case Law of the Boards of Appeal of the EPO, 10th edition, 2022, V.A.2.3.2.a)). In the communication pursuant to Article 15(1) RPBA 2020, the Board indicated its preliminary opinion that the conditions for an interruption of proceedings were not fulfilled. In the absence of any counter-arguments of the parties or additional evidence on file in that regard, the Board sees no reason to deviate from its preliminary considerations. As a consequence, the proceedings are not to be interrupted (Rule 142 EPC).

2. Admissibility of the appeal

2.1 Rule 101(2) EPC reads as follows:

"If the Board of Appeal notes that the appeal does not

comply with Rule 99, paragraph 1(a), it shall communicate this to the appellant and shall invite him to remedy the deficiencies noted within a period to be specified. If the deficiencies are not remedied in due time, the Board of Appeal shall reject the appeal as inadmissible".

In addition, according to Rule 99, paragraph 1(a) EPC, "The notice of appeal shall contain: (a) the name and the address of the appellant as provided in Rule 41, paragraph 2(c)".

2.2 The respondent requested that the appeal be rejected as inadmissible because the notice of appeal was filed in the name of "Beetz & Partner mbB" and not on behalf of the opponent "Dr. Angelika Schenk" (rejoinder: section B).

2.3 In that respect, it is correct that:

- The opponent indicated in form 2300E (page 1, section III) and in the notice of opposition (page 1, first paragraph) is A. Schenk;
- In the header on page 1 of the notice of appeal, the name of the opponent which is indicated is "Beetz & Partner mbB".

2.3.1 However, in view of the indication in the notice of appeal that the appeal was filed "In the name and by order of the opponent", the Board has no doubts that the true intention of the representative was to file an appeal in the name of A. Schenk, who was the sole opponent in the opposition proceedings and, therefore, the sole opposing party who was adversely affected by the decision of the opposition division. The identity

of the true appellant was therefore identifiable from the file. This is fully in line with the statement made by the appellant at a later stage, namely in the statement of grounds of appeal, as indicated in section IV above. Under these circumstances, the Board is satisfied that the incorrect indication of the opponent's identity in the header of the notice of appeal may be remedied in agreement with decision G 1/12 (OJ EPO 2014, A114: Catchword, in relation to Questions (1) to (3); see also Case Law, *supra*, V.A.2.5.2.a): sub-sections "Error in information identifying the appellant" and "Correction of wrong name under Rule 139 EPC").

- 2.3.2 That view was communicated to the parties well in advance of the date scheduled to hold oral proceedings (Board's communication: section 6.2). Considering that no counter-arguments were put forward in reaction to that communication, there is no reason for the Board to deviate from the view expressed therein.
- 2.3.3 As a consequence, the respondent's arguments provide no reason to reject the appeal as inadmissible (Rule 101 EPC) and the respondent's request in that regard is to be refused.

Main request (auxiliary request 1c allowed by the opposition division)

- 3. Considering that the respondent requested as main (substantive) request that the appeal be dismissed, the operative main request for the appeal proceedings is auxiliary request 1c allowed by the opposition division.

4. Article 123(2) EPC

4.1 The appellant disagreed with the opposition division's finding that the combination of features now being defined in operative claim 1 met the requirements of Article 123(2) EPC, whereby the appellant's objection was solely directed to the addition of the feature "or polyethylene glycol (meth)acrylated monomer".

4.2 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 amendments made 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, *supra*, II.E.1.1). In that respect, it has to be assessed if a direct and unambiguous basis for the subject-matter being claimed may be found in the application as filed.

4.2.1 In that regard, the Board agrees with the opposition division and the respondent that, according to the paragraph bridging pages 6 and 7 of the application as filed, either polypropylene glycol-4-monomethylacrylate or any acrylated or methacrylated monomer in the polypropylene glycol (PPG) or polyethylene glycol (PEG) family may be used as "unzipping" monomer. Therefore, the Board is satisfied that it is directly and unambiguously derivable from said passage of the application as filed that any polyethylene glycol (meth)acrylated monomer - according to the amendment made in claim 1 - may be used (as "unzipping" monomer) in alternative to the polypropylene glycol monomethylacrylate defined in the compositions according to claim 1 of the application as filed. Although it is correct that the definition of the

"unzipping" monomer so amended is broader than in claim 1 of the application as filed (statement of grounds of appeal: bottom of page 5 and page 6), it remains that the amendment made is - as explained above - derivable from the application as filed as a whole, which is allowable.

4.2.2 In view of the above, the appellant's arguments do not justify that the decision of the opposition division regarding Article 123(2) EPC be overturned.

5. Article 56 EPC

5.1 Closest prior art

It is common ground that D1 constitutes the closest prior art document, whereby examples C and F thereof constitute particularly relevant starting points for the assessment of inventive step. There is no reason for the Board to deviate from that view.

5.2 Distinguishing features

5.2.1 The composition according to operative claim 1 is characterised by the combination of the following structural features

a) at least one reactive (meth)acrylate;

b) at least one non-reactive, solvent-dissolvable polymer;

c) at least one non-reactive solvent;

d) at least one reactive

- d1) polypropylene glycol monomethacrylate or
- d2) polyethylene glycol (meth)acrylated monomer;

e) at least one pyromellitic dianhydride glyceryl-dimethacrylate;

f) at least one reactive urethane (meth)acrylate;

g) at least one polymethylmethacrylate (PMMA) - polymethacrylic acid (PMAA) copolymer;

with the additional functional feature

h) "wherein upon exposure to actinic radiation ..., said voids containing ... solvent-dissolvable polymer".

5.2.2 The analysis of the appellant regarding the presence of components a) to c) and d2) in the compositions according to examples C and F of D1 (statement of grounds of appeal: page 9, first full paragraph) was not disputed by the respondent (rejoinder: section 19) and the Board sees no reason to be of a different opinion. Therefore, it is common ground that operative claim 1 differs from the compositions according to examples C and F of D1 in that it further comprises components e), f) and g) as above defined.

5.2.3 Although no arguments regarding whether or not the functional feature h) is satisfied or not by the compositions of examples C and F of D1 was submitted by the parties or dealt with by the opposition division, the Board considers that said requirement is implicitly fulfilled by the compositions according to examples C and F of D1 which are indicated to be used as nail coating (i.e. they were cured upon actinic radiation) that can be easily removed by nail polish remover/

solvents (D1: column 4, lines 17-22), which according to the description of the patent in suit is related to the presence of component b) in the "voids" defined in operative claim 1 (see e.g. paragraphs 9, 10 and 29 of the patent in suit). That view was communicated to the parties in the Board's communication (section 9.2.3) and was not disputed. Therefore, there is no reason for the Board to deviate from its preliminary conclusion in that regard.

- 5.2.4 In view of the above, the subject-matter of operative claim 1 is considered hereinafter to differ from the compositions according to examples C and F of D1 only in the presence of components e), f) and g) as defined in section 5.2.1 above.
- 5.3 Problem effectively solved over the closest prior art
 - 5.3.1 The respondent argued that the problem solved over the closest prior art resided in the provision of a polymerisable composition with improved adhesion properties and improved removal properties (rejoinder: sections 20 to 26), whereby it was further held that D14 demonstrated that the claimed beneficial properties were effectively related to the presence of component g) (data related to the comparison of the compositions prepared according to formulae 1 and 2 of D14, whereby formula 1 was said to illustrate the subject-matter of operative claim 1 and formula 2 was for comparison).
 - 5.3.2 However, it is derivable from D14 that formula 2 prepared therein is illustrative of the teaching of document US 4 572 888 (see sections 2 and 3 of D14), which was at stake in different proceedings. It was further neither shown, nor even argued, that said formula 2 illustrates the compositions according to the

closest prior art identified above, namely compositions C and F of D1 (which is not US 4 572 888). Also, considering that no indication is given in D14 of the amounts in which most of the various components of formulae 1 and 2 were used (only the amount of the PMMA-PMAA copolymer of formula 1 and of the ethyl methacrylate polymer of formula 2 is given at the top of page 2 of D14), it is not possible to assess whether or not the results shown in D14 are also valid for the compositions of examples C and F of D1. Under these circumstances and further taking into account the teaching of the patent in suit that the adhesion and removal properties of the compositions being claimed are dependent on the interplay between the various components contained therein (paragraphs 28-29, in combination with paragraphs 18-27, which are related to the components mentioned in operative claim 1) and that the respondent considers that a combination of cellulose derivatives and acrylic polymers (used as film forming polymers in D1 - see section 5.4.4 below - and both of which being present in formula 2 of D14) is not illustrative of the teaching of D1, it cannot be agreed with the respondent that D14 shows that the improvements claimed over the closest prior art are effectively achieved.

5.3.3 Considering that no counter-arguments were filed against that conclusion, which was communicated to the parties well in advance of the date originally scheduled to hold oral proceedings (Board's communication: section 9.3.2), the Board sees no reason to deviate from its preliminary consideration in that regard.

5.3.4 In view of the above, the problem effectively solved over the closest prior art resides in the provision of

a further polymerisable composition for nail coating in alternative to the ones of examples C and F of D1, as put forward by the appellant (statement of grounds of appeal: page 8, penultimate paragraph).

5.4 Obviousness

5.4.1 The question remains to be answered if the skilled person, desiring to solve the problem(s) identified as indicated above, would, in view of the closest prior art, possibly in combination with other prior art or with common general knowledge, have modified the disclosure of the closest prior art in such a way as to arrive at the claimed subject matter. In that respect, it has to be assessed whether or not it would be obvious to use components e), f) and g) in the compositions according to examples C and F of D1 in order to provide another nail coating composition.

5.4.2 Regarding component e), whereas the appellant argued that its use was obvious from the teaching of D9, the respondent was of the opinion that the skilled person would not consider the teaching of D9 since it belonged to a different technical field (nail repairing) than D1 (removable nail coating compositions).

In that respect, the Board considers that the technical fields of D1 and D9 are at least somehow related, in particular taking into account that the main components used for nail repairing in D9 and the ones used for nail coating in D1 are polymeric components of similar nature. Therefore, it can be expected that the skilled person aiming at providing further nail coating compositions in alternative to the ones of D1 would take into account the teaching of D9 regarding adhesion promoters for the polymeric components used therein

(D9: column 1, lines 15-18; column 2, lines 45-50; column 3, line 66 to column 4, line 32; column 5, lines 5-8; claims 1, 9 and 11). Under these circumstances, the Board agrees with the appellant that, based on the teaching of D9, it would be obvious to provide a mere alternative to the compositions according to examples C and F of D1 by adding thereto (even a very low amount of) component e) as taught in D9 (statement of grounds of appeal: paragraph bridging pages 10 and 11).

- 5.4.3 Regarding component f), it is further agreed with the appellant that D1 itself discloses that component f) may be used as an optional ingredient (D1: column 3, lines 23-27 and claim 1, feature d); see statement of grounds of appeal: page 9, second full paragraph). Therefore, taking into account that the problem to be solved resides in the provision of a mere alternative to D1, said feature can only be seen to be obvious, contrary to the respondent's view (rejoinder: section 34).
- 5.4.4 Regarding component g), it is however agreed with the respondent that D1 teaches the use of cellulose derivatives (which fall under component b) according to operative claim 1 and are used in the compositions of examples C and F (as film forming component) as *alternative to acrylic polymers* such as polymethylmethacrylate (PMMA) or some copolymers thereof (D1: column 1, lines 44-48; column 2, lines 54-58; column 3, lines 4-14; taking into account that the examples in the table bridging columns 3 and 4 of D1 are conducted with either cellulose derivatives or PMMA copolymers and that it is indicated at column 4, lines 23-25 of D1 that it "was found to be surprising that film forming polymers with such diverse

chemistries as cellulose derivatives and acrylic copolymers ..."). In addition, it was not contested by the appellant that, as argued by the respondent (rejoinder to the statement of grounds of appeal: section 29), neither D1 nor any of documents D2 to D9 effectively discloses PMMA-PMAA copolymers as specified in operative claim 1 (component g) as defined above). Therefore, in view of the evidence on file and of the arguments put forward by the parties, it cannot be concluded that the addition of a PMMA-PMAA copolymer would amount to an arbitrary choice within a host of components/additives known in the art. In other words, the appellant's arguments do not show that it would be obvious to add component g) to the compositions of examples C or F of D1, even in order to provide a mere alternative to the closest prior art, as was put forward by the respondent (rejoinder: sections 28-29).

- 5.4.5 Also in that regard, no counter-arguments were filed against that conclusion, which was communicated to the parties well in advance of the date originally scheduled to hold oral proceedings (Board's communication: section 9.4.4). Therefore, the Board sees no reason to deviate from its preliminary consideration in that regard.
- 5.4.6 In view of the above, the appellant's arguments provide no cause for the Board to overturn the decision of the opposition division in respect of the inventive step.
6. Considering that none of the objections put forward by the appellant is successful, the appeal is to be dismissed.
7. In view of the parties' respective requests and of the circumstances of the present case, the Board is

satisfied that a final decision can be taken in writing and decided, therefor, to cancel the oral proceedings.

Order

For these reasons it is decided that:

The appeal is dismissed.

The Registrar:

The Chairman:



D. Hampe

D. Semino

Decision electronically authenticated