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**Datasheet for the decision
of 14 June 2022**

Case Number: T 2964/18 - 3.3.02

Application Number: 12798263.5

Publication Number: 2785807

IPC: C09D133/06, C08K5/5435,
C08K5/544

Language of the proceedings: EN

Title of invention:

COATING COMPOSITION FOR A FOOD OR BEVERAGE CAN

Patent Proprietor:

PPG Industries Ohio Inc.

Opponents:

BASF Coatings GmbH
Evonik Operations GmbH

Headword:

Relevant legal provisions:

EPC Art. 54, 56, 83
RPBA Art. 12(4)
RPBA 2020 Art. 13(2)

Keyword:

Novelty - main request (no)
auxiliary request 1 - admitted (no)
Inventive step - auxiliary requests 2 and 3 (no)
Auxiliary request 4 - admitted (yes)
Auxiliary request 4 - sufficiency of disclosure - (yes)
Evidence not admitted by the opposition division - admitted
(no)
Late-filed evidence - admitted (no)
Auxiliary requests after summons - exceptional circumstances
(no) - admitted (no)
Objections raised at the oral proceedings - exceptional
circumstances (no) - admitted (no)

Decisions cited:

G 0007/93, T 0724/08, T 0217/10, T 1732/10, T 0248/13,
T 0568/14, T 1784/14, T 1480/16, T 1597/16, T 0319/18,
T 0995/18, T 2091/18, T 0261/19, J 0014/19

Catchword:



Beschwerdekammern

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Case Number: T 2964/18 - 3.3.02

D E C I S I O N
of Technical Board of Appeal 3.3.02
of 14 June 2022

Appellant: Evonik Operations GmbH
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Decision under appeal: **Interlocutory decision of the Opposition
Division of the European Patent Office posted on
6 November 2018 concerning maintenance of the
European Patent No. 2785807 in amended form.**

Composition of the Board:

Chairman	S. Bertrand
Members:	M. Maremonti
	R. Romandini

Summary of Facts and Submissions

I. The appeal by opponent 2 ("appellant") lies from the interlocutory decision of the opposition division according to which European patent No. 2 785 807 ("the patent") in its form modified on the basis of the then pending auxiliary request 1, and the invention to which it relates, meets the requirements of the EPC.

II. Auxiliary request 1 found allowable by the opposition division contains independent claims 1, 2, 3 and 12, respectively reciting as follows:

"1. A two component coating composition for coating onto a metal substrate, the coating composition comprising:

*a first component comprising an acrylic latex material;
and*

a second component comprising a functional silane material,

wherein:

the functional silane material comprises an epoxy functional silane and the acrylic latex material comprises an aqueous dispersion of an acrylic material in a core/shell arrangement."

"2. A food or beverage can comprising a surface having a coating on at least a portion thereof, the coating being formed from a two component coating composition, the coating composition comprising:

*a first component comprising an acrylic latex material;
and*

a second component comprising a functional silane material.

"3. A method of repairing a score line on a food or beverage can, the method comprising applying to the score line a two component coating composition, the coating composition comprising:

a first component comprising an acrylic latex material;
and

a second component comprising a functional silane material.

"12. Use of a functional silane material for reducing the curing temperature in a two component coating composition according to claim 1."

III. Oppositions by opponent 1 and opponent 2 had been filed on the grounds under Article 100(a) and (b) EPC. The following documents, *inter alia*, were referred to during the opposition proceedings:

D2: Ming J. Chen *et al.*, "Epoxy silanes in reactive polymer emulsions", Journal of Coatings Technology, vol. 69, Number 875, December 1997, pp. 49-55

D7: Ming J. Chen *et al.*, "Silane curing agent in waterborne coatings", European Coatings Journal, 1998, pp. 532-7

D17: US 5 461 125

D17a: DE 694 12 602 T2

D20: EP 0 401 496 A2

D21: DE 10 2008 007 261 A1

D22: DE 10 2008 023 076 A1

D23: Brock, Groteklaes and Mischke, "Lehrbuch der Lacktechnologie", 2nd edn., 2000, pp. 66-70, 88, 89 and 261-3

D24: WO 2007/085339 A2

D25: US 2009/0291310 A1

D26: Vincentz Network, "*Korrosionsschutz der Zukunft?*",
Farbe & Lack, 07/2007, p. 33

IV. The opposition division came to, *inter alia*, the following conclusions.

- The subject-matter of the claims of auxiliary request 1 was novel in view of the disclosure in document D17.
- The subject-matter of the claims of auxiliary request 1 involved an inventive step.

Moreover, the opposition division did not admit documents D17a and D20 to D26 into the proceedings.

V. In its statement of grounds of appeal, the appellant objected to lack of novelty and inventive step for the subject-matter in independent claims 1 and 12 and several claims dependent on claim 1. Moreover, it objected to the sufficiency of disclosure of the subject-matter of claim 5. The appellant corroborated its arguments by relying on the following newly filed document (denoted as D27 by the appellant, new numeration introduced by the board):

A027: US 2003/0134949 A1

No objections against the subject-matter of independent claims 2 and 3 were raised.

VI. In its reply to the statement of grounds of appeal, the patentee ("respondent") rebutted the arguments of the appellant. Moreover, it filed sets of claims according to auxiliary requests 1 to 17.

VII. The parties were summoned to oral proceedings in accordance with their requests. In preparation for the

oral proceedings, the board issued a communication pursuant to Article 15(1) RPBA 2020. In this communication, the board expressed, *inter alia*, the provisional opinion that the subject-matter of claim 1 found allowable by the opposition division lacked novelty over document D17 and that documents D25 and A027 should not be admitted into the proceedings.

VIII. By letter dated 1 April 2022, the respondent replied to the board's communication. It filed new sets of claims according to auxiliary requests 2a and 2b.

IX. Oral proceedings before the board were held on 14 June 2022. They were continued in the absence of opponent 1 pursuant to Rule 115(2) EPC and Article 15(3) RPBA.

X. Final requests

The appellant requests that the appealed decision be set aside and that the patent be revoked in its entirety. It further requests that all auxiliary requests of the respondent not be admitted into the proceedings. Additionally, it requests that documents D25 and A027 be admitted into the proceedings.

The appellant had also requested that documents D17a, D20 to D24 and D26, which had not been admitted by the opposition division, be admitted into the appeal proceedings. However, the appellant did not rely on these documents for its objections. Therefore, these documents are not relevant to the present decision. As a consequence, a decision of the board on the admittance of these documents is not needed.

The respondent requests that the appeal be dismissed, meaning that the patent be maintained in amended form on the basis of the claims and description pages found allowable by the opposition division. This request is

the respondent's main request in these appeal proceedings. Alternatively, the respondent requests that the patent be maintained on the basis of the claims of one of auxiliary requests 1, 2, 2a, 2b or 3 to 17, where auxiliary requests 1, 2 and 3 to 17 were filed with the reply to the statement of grounds of appeal and auxiliary requests 2a and 2b were filed by letter dated 1 April 2022. The respondent further requests that documents D25 and A027 not be admitted into the proceedings. Additionally, it requests that the novelty objection of the appellant against the subject-matter of claim 11 of auxiliary request 2 in view of document D7 not be admitted into the proceedings. It also requests not to admit into the proceedings the objections of the appellant based on document D7 against claim 11 of auxiliary request 3 when referring to compositions according to alternative (iii) of claim 1. The respondent further requests not to admit into the proceedings the inventive-step objections raised by the appellant at the oral proceedings against claim 11 of auxiliary request 4 based on documents D2, D7 and D17.

Opponent 1, party to the proceedings as of right under Article 107, second sentence, EPC, has not made any submission nor filed any request.

XI. The submissions of the appellant relevant to the decision are summarised as follows. For further details, see the reasons below.

- The subject-matter of claim 1 of the main request was not novel in view of document D17.
- The auxiliary requests of the respondent had not been substantiated, and thus they should not be admitted into the proceedings.

- The subject-matter of the use claim included in the auxiliary requests did not involve an inventive step, especially in view of documents D7 and D2.

XIII. The submissions of the respondent relevant to the decision are summarised as follows. For further details, see the reasons below.

- The coating compositions disclosed in document D17 did not include a silane material within the meaning of claim 1 of the main request. Thus, the subject-matter of claim 1 of the main request was novel over D17.
- An indication on the reasons for filing auxiliary requests 1 to 17 had been provided in the reply to the statement of grounds of appeal. Moreover, several of these requests differed from the main request only in that claims had been deleted. Thus, these claim requests should be admitted into the proceedings.
- Auxiliary requests 2a and 2b, though filed after receiving the summons to oral proceedings, did not constitute an amendment of the case. Moreover, they had been filed in direct response to a new novelty objection raised by the board in its provisional opinion. Therefore, these auxiliary requests should be admitted into the proceedings.
- The use of a functional silane for reducing the curing temperature of a coating composition was not disclosed in D7. It had to be concluded that the subject-matter of the use claim included in the auxiliary requests involved an inventive step.
- The inventive-step objections raised by the appellant at the oral proceedings against the use claim set out in auxiliary requests 3 and 4 were

either based on documents not to be admitted or entirely new. Therefore, these objections should not be admitted into the proceedings.

Reasons for the Decision

Document D25 - admittance into the proceedings

1. The appellant requested that document D25, which was not admitted by the opposition division into the opposition proceedings, be admitted into the appeal proceedings.

The respondent requested that this document not be admitted.

2. To support its request, the appellant only stated in its statement of grounds of appeal (page 12) and at the oral proceedings that D25 was *prima facie* relevant and that for this reason it should have been admitted into the proceedings.

- 2.1 Under Article 12(4) RPBA 2007 (applicable in view of Article 25(2) RPBA 2020), the board has the power not to admit into the proceedings, *inter alia*, evidence not admitted by the opposition division. When revising a non-admittance decision of the opposition division, the board should only assess whether the opposition division correctly exercised its discretion. It is not the board's task to re-examine the case and decide whether it would have exercised the discretion in the same way. The board may overrule the decision of the opposition division only if the department of first instance either failed to exercise its discretion in accordance with the right principles or exercised its discretion in an unreasonable way. If this is not the

case, the evidence concerned must remain unconsidered (see decision G 7/93, OJ 1994, 775, reasons, 2.6).

- 2.2 In the current case, the opposition division (appealed decision, page 11, point 5.2.5 and pages 14 to 15, point 8.1) decided not to admit into the proceedings document D25, filed after the expiry of the opposition period (Article 99(1) EPC), because, after examining its content, it considered it not to be *prima facie* relevant. According to the opposition division, D25 did not disclose a two-component coating composition, let alone the combination of a core/shell acrylic latex and an epoxy silane. Furthermore, the opposition division observed that no valid reasons for filing this document late had been presented. In view of this, the board is satisfied that the opposition division exercised its discretion in not admitting D25 according to the right principles and in a reasonable way. As a consequence, there was no reason for overruling the non-admittance decision of the opposition division. Thus, document D25, and any objection based on it, was not admitted into the proceedings.

Document A027 - admittance into the proceedings

3. Document A027 was filed by the appellant with its statement of grounds of appeal. The respondent requested that document A027 not be admitted into the proceedings.
- 3.1 Under Article 12(4) RPBA 2007, the board has the discretion to hold inadmissible, *inter alia*, evidence and submissions based on it which could have been presented before the opposition division.
- 3.2 In view of Article 99(1) in conjunction with Rule 76(2) (c) EPC, the time limit for an opponent to file all relevant facts and evidence is the nine-month opposition period. In its statement of grounds of

appeal, the appellant did not mention any reason why document A027 was not filed within this time limit or at least in advance of the oral proceedings before the opposition division. At the oral proceedings before the board, the appellant stated that the search for "*an acrylic material in a core/shell arrangement*" as mentioned in claim 1 of the main request proved to be extremely difficult. The term "*core/shell arrangement*" was not frequently used in the art. This was why A027 had been found only at a later stage. It was then promptly filed.

3.3 The board finds the appellant's arguments unconvincing. The difficulties that a party may encounter in finding documents disclosing features relevant for anticipating the subject-matter of a claim cannot, as a rule, justify the filing of a document only in appeal proceedings. In this case, the feature mentioned in claim 1 of "*an acrylic material in a core/shell arrangement*" referred to by the appellant as being difficult to find is even disclosed at least in D17 (see below), a document filed by the appellant itself during the opposition period (appealed decision, page 2). Thus, the argument put forward by the appellant is, alone on its premise, not founded and does not justify the admittance of A027.

3.4 Since the appellant based entirely new novelty and inventive-step objections on document A027, it can be assumed that it regarded A027 as being *prima facie* relevant. However, the board does not need to consider *prima facie* relevance when exercising its discretion under 12(4) RPBA 2007 (see e.g. T 0724/08, reasons, point 3.4). Rather, a primary consideration in this exercise is to preserve the nature and purpose of the appeal proceedings as mainly directed to the judicial review of the decision under appeal (Article 12(2) RPBA

2020). The parties should not be allowed to start new opposition proceedings when filing an appeal.

3.5 The admittance of A027 and the novelty and inventive-step objections based on it would have meant that entirely new novelty and inventive-step objections (a *fresh case*) would have to be examined for the first time in appeal proceedings. In such a situation, the appellant would have been provided with the possibility of using the appeal proceedings as a second round of opposition proceedings. However, this would not be consistent with the above-mentioned primary object of appeal proceedings as stated in Article 12(2) RPBA 2020.

3.6 For these reasons, document A027 could and should have been filed before the opposition division. Pursuant to Article 12(4) RPBA 2007, and under consideration of Article 12(2) RPBA 2020, the board thus decided not to admit into the proceedings document A027 and any novelty or inventive-step objection based on it.

Main request - interpretation of claim 1

4. Claim 1 (complete wording under point II above) defines "*a two component coating composition [...], the coating composition comprising:
a first component comprising an acrylic latex material;
and a second component comprising a functional silane material.*"

4.1 The respondent argued that the expression "*two component coating composition*" made clear to the skilled person that claim 1 was limited to so-called 2-K compositions, i.e. compositions in which the two mentioned discrete components were kept separated from each other and contacted only immediately prior to or on application of the coating. This interpretation was well known in the art and supported by paragraph [0080]

of the patent. Here, the patent clarified that coatings were prepared as two parts, Part A and Part B, and stored separately as stable components. Part A contained the acrylic latex material and Part B the functional silane material, in accordance with the wording of claim 1. This interpretation of claim 1 had been accepted by the opposition division and also by opponent 2 during the opposition proceedings.

4.2 However, the board concurs with the appellant that the subject-matter of claim 1 is open to two interpretations, namely, either:

- the claimed composition comprises the two mentioned first and second components mixed to each other
- the claimed composition comprises the two mentioned first and second components kept separated from each other

Had the intention been to limit the claimed subject-matter only to the second interpretation, expressions like "*kit of parts*" or "*kit comprising two components kept in a separated state*" or "*Two-pack coating composition*" would have been used.

4.3 Separated *Parts* corresponding to Parts A and B as mentioned in paragraph [0080] of the patent are not recited in claim 1. Moreover, the same paragraph [0080] further describes the step of mixing Parts A and B prior to application of the coating. Thus, this paragraph also discloses a composition comprising a mixture of the components respectively contained in Parts A and B. This is further confirmed in paragraph [0085] of the patent which discloses that the components pertaining to Parts A and B were added to a mixing vessel. After mixing, the coating compositions "*remained in a useable state for around 50 hours*". This statement reveals that the two components do not

immediately react upon mixing. Therefore, mixtures of the claimed first and second components are also disclosed in the patent. There is also no evidence available demonstrating that a two-component coating composition as defined in claim 1 would necessarily have been understood by the skilled person to be a composition of two discrete components kept separated from each other. Therefore, mixtures of the claimed first and second components are also encompassed by the subject-matter of claim 1 (T 0261/19, reasons, point 3.1.2).

Main request - claim 1 - novelty under Article 54 EPC

5. Document D17

5.1 At the oral proceedings, the appellant referred to the board's preliminary opinion (point VII above) and submitted that document D17 was novelty-destroying for the subject-matter of claim 1.

5.2 Document D17 (column 1, lines 6 to 19) discloses coating compositions comprising an aqueous acrylic latex in a core/shell arrangement to be used as a binder or primer for coatings and adhesives. Example 10(a)-(b) in column 12 of D17 describes the preparation of such a core/shell acrylic latex with a core to shell ratio of 80:20. Additionally, D17 discloses in column 6, lines 4 to 20 that various additives may be added to the latex formulation. A particularly useful additive comprises a non-copolymerisable silane coupling agent, said to increase bonding of the core/shell latex with the substrate on which it is coated. Among the silane coupling agents mentioned, γ -glycidyoxypropyl trimethoxysilane ("Glymo") is especially preferred, i.e. an epoxy functional silane.

- 5.3 On the basis of the above disclosure, a selection from a single list, i.e. the list of non-copolymerisable silane coupling agents in column 6 of D17, leads the skilled person to a coating composition comprising an acrylic latex material in a core/shell arrangement and Glymo mixed to each other. In view of the board's interpretation of claim 1 set out above, this composition comprises all the features mentioned in claim 1 and thus anticipates the subject-matter of claim 1.
- 5.4 In line with the appealed decision (page 12, point 5.3.2 and page 14, point 7.2.8), the respondent argued that the claimed subject-matter was novel over D17 in view of its interpretation of claim 1, restricted to compositions where the first and second components were separated from each other. However, for the reasons given above, this argument must fail.
- 5.5 The respondent further argued that D17 did not disclose a composition in which both an acrylic latex material and a functional silane material were present as discrete components mixed together. In D17, any silane material was part of the acrylic latex (core/shell) particles and was not a second component of a coating composition. This resulted from the passage at column 1, lines 5 to 11 where it was stated that the outer shell comprised an optional silane coupling agent. Similar language was used in column 2, lines 42 to 60. The passage in column 6, lines 4 to 20 also stated that the silane coupling agent was part of the latex. This disclosure was confirmed by example 10(a)-(b), where the silane coupling agent was part of the shell of the core-shell latex.
- 5.6 The board disagrees. It is acknowledged that D17 (column 2, lines 42 to 60 and column 5, lines 28 to 46) also discloses that the latex shell can comprise a

copolymerisable silane coupling agent. A latex comprising such an agent is produced according to example 10(a)-(b) of D17 (column 12). However, as set out above, D17 also discloses in column 6, lines 4 to 20 that a non-copolymerisable silane compound, especially Glymo, can be included as an additive in the latex formulation. It is this disclosure that, together with the disclosure of an acrylic latex in a core/shell arrangement, leads to D17 anticipating the subject-matter of claim 1.

- 5.7 For these reasons, the board concludes that the subject-matter of claim 1 lacks novelty over D17. Therefore, the main request is not allowable (Articles 52(1) and 54 EPC).

Auxiliary request 1 - admittance into the proceedings

6. The set of claims according to auxiliary request 1 was filed by the respondent with its reply to the statement of grounds of appeal. Claim 1 of auxiliary request 1 was amended as compared to claim 1 of the main request by adding the following feature at the end of the claim:

"wherein the shell mixture comprises one or more $\alpha\beta$ ethylenically unsaturated carboxylic acid and the shell polymer has pendant carboxylic acid functional groups."

- 6.1 The appellant submitted that the amendment to claim 1 had not been substantiated and requested that auxiliary request 1 not be admitted into the proceedings.
- 6.2 The respondent argued that auxiliary request 1 had been filed as auxiliary request 3 before the opposition division. The basis for the amendments had been provided in the annex to the reply to the appeal. Furthermore, on page 10 of this reply, it was indicated that the auxiliary requests were filed to further

distance the claimed subject-matter from the cited prior art or to address allegations of lack of sufficiency. Moreover, the appellant had not raised any objections against the auxiliary requests, and thus there were no arguments on file for the respondent to respond to.

- 6.3 The board notes that the mere fact that auxiliary request 1 was formally filed during the opposition proceedings does not render it automatically part of the appeal case since its admittance had not been examined by the opposition division (T 0319/18, reasons, point 2.2).
- 6.4 The very general statement on page 10 of the reply to the appeal expressing that the auxiliary requests aimed to "*further distance the claimed subject matter from the cited prior art in order to address allegations of lack of novelty and lack of inventive step*" cannot be seen as an explanation of the technical significance of the amendment carried out in claim 1 of auxiliary request 1. Neither the board nor the appellant are put in a position to understand why the feature added to claim 1 would overcome the objections raised against claim 1 of the main request. Thus, auxiliary request 1 has not been substantiated.
- 6.5 Under Article 12(2) RPBA 2007, the reply to the appeal shall contain the respondent's complete case. It shall set out clearly and concisely the reasons why it is requested that the decision under appeal be reversed, amended or upheld and should expressly specify all the facts, arguments and evidence relied on. The fact that the appellant had not raised any objection against the (not yet filed) auxiliary requests has no bearing on this requirement. Thus, the statement on page 10 of the reply referred to above does not comply with the

requirement for the respondent to present its complete case.

- 6.6 In accordance with the case law of the Boards of appeal (see e.g. T 0568/14, reasons, point 8.4), a substantiation why amendments are filed may exceptionally not be needed if the amendments are self-explanatory in the sense that the board and the other party are put in a position to understand, without any further explanation, which outstanding objections are meant to be overcome.

However, this condition is not met for auxiliary request 1. Indeed, it is not immediately apparent which technical contribution the feature added to claim 1 of auxiliary request 1 would have brought over, *inter alia*, the disclosure of document D17. Requests which are not self-explanatory are considered to be submitted only on the date of their substantiation (see T 0217/10, reasons, point 5).

- 6.7 In the case underlying T 0217/10, substantiation was provided shortly before the oral proceedings, and the claim requests were deemed to have been validly filed at that point in time. In the current case, no substantiation of auxiliary request 1 was provided at any time during the appeal proceedings, not even at the oral proceedings.

- 6.8 As a consequence, the board concluded that auxiliary request 1 was not validly filed and was not part of the current appeal proceedings (T 1732/10, reasons, point 1.5; T 1784/14, reasons, point 3; T 0319/18, reasons, point 2).

Auxiliary request 2 - claim 11 - inventive step under Article 56 EPC

7. Auxiliary request 2 differs from the main request only in that claim 1 of the main request was deleted. The remaining claims were renumbered accordingly.

7.1 In its statement of grounds of appeal (pages 36 and 37), the appellant objected to the inventive step of the subject-matter of use claim 12 of the main request (wrongly indicated by the appellant as claim 11) in view of, *inter alia*, document D7 taken as the closest prior art. It also stated that the same objection applied to the subject-matter of the use claims in any auxiliary request, i.e. also to the subject-matter of claim 11 of auxiliary request 2.

7.2 Claim 11 of auxiliary request 2 recites:

"11. Use of a functional silane material for reducing the curing temperature in a two component coating composition as defined in claim 1."

Claim 1, corresponding to claim 2 of the main request (complete wording under point II above), is directed to a food or beverage can having a coating formed from a coating composition. The latter is defined as a *"composition comprising a first component comprising an acrylic latex material; and a second component comprising a functional silane material."*

Contrary to claim 1 of the main request (point II above), no further characterisation of the two components is contained in claim 1 of auxiliary request 2.

7.3 The appellant requested that auxiliary request 2 not be admitted into the proceedings. The board concluded that auxiliary request 2 had been validly filed with the reply to the appeal and formed part of the proceedings.

However, since auxiliary request 2 was found not to be allowable (see below), no reasoning on this conclusion of the board is needed.

7.4 Document D7 (abstract, figure 3, paragraph 6.2) discloses coating compositions comprising an acrylic latex material and an epoxy-alkoxy silane, *inter alia*, Glymo or γ -glycidylloxypropyl triethoxysilane. It was not disputed by the respondent that such compositions fall under the definition in claim 1 of auxiliary request 2 for the coating composition. As pointed out by the appellant, D7 (point 6.2 on page 534) discloses that two-component compositions comprising the above-mentioned silanes also cure at room temperature. Moreover, table 13 of D7 (page 537) discloses a composition including acrylic latex and an epoxy-alkoxy silane ("silane 4", figure 3), i.e. a functional silane, cured at 66 °C.

7.5 Distinguishing features

7.5.1 The respondent argued that the subject-matter of claim 11 had to be understood to mean that the functional silane material allowed reducing the curing temperature compared to compositions without any silane. This was confirmed by the results reported in table 4 of the patent, on page 11, showing improved performance of coating compositions according to the invention over a standard composition. D7 did not disclose that the functional silane was used with the intent to reduce the curing temperature within the meaning of claim 11. According to paragraph 6.2 on page 534 of D7, curing at room temperature was possible provided that the recommended catalysts were used. As regards the composition disclosed in table 13, it was acknowledged that no catalyst was present. However, no comparison with compositions not including any silane had been reported. Thus, a reduction of the curing temperature

deriving from the silane material was not disclosed in D7 and represented a distinguishing feature of the claimed subject-matter.

- 7.5.2 The board disagrees. Claim 11 does not mention any reference composition, in comparison to which the curing temperature should be *reduced*. Also, the patent, when mentioning a reduction of the curing temperature (paragraph [0067]), does not indicate any composition over which this reduction should be achieved. Table 4 on page 11 of the patent, referred to by the respondent, reports the same curing temperatures of 105 °C, 120 °C and 150 °C for both compositions according to the invention and a standard from the prior art, the composition of which is not specified. The fact that coatings according to the invention are reported to perform better than this standard as regards, e.g. blush or yellowing, does not allow drawing any conclusion concerning a reduction of the curing temperature.
- 7.5.3 Therefore, the feature of "*reducing the curing temperature*" mentioned in claim 1, in the absence of a reference composition, does not allow the subject-matter of the claim to be distinguished from D7.
- 7.5.4 Moreover, the above-cited passages of D7 disclose that the inclusion of functional silanes allows the curing of the coating compositions to be carried out at room temperature or 66 °C, i.e. at temperatures much lower than those reported in the patent. The fact that catalysts might possibly also be added does not have any bearing on this disclosure. Therefore, the use of functional silanes for reducing the curing temperature, within the meaning of claim 11, is considered to be also disclosed in D7.

7.6 No other distinguishing features were mentioned by the respondent. As a consequence, the board concludes that no distinguishing features exist between the subject-matter of claim 11 and the disclosure of D7. Lacking any distinguishing feature, there is no technical problem to be solved, and thus the subject-matter of claim 11 cannot involve any inventive step within the meaning of Article 56 EPC.

7.7 At the oral proceedings, the appellant argued that since no distinguishing feature was present in view of D7, the subject-matter of claim 11 lacked novelty over D7. The respondent requested that this novelty objection not be admitted into the proceedings because it had been filed late.

7.8 However, in view of the above-mentioned conclusion of the board on lack of inventive step of the subject-matter of claim 11, there was no need for the board to take a decision on the admittance of this novelty objection of the appellant.

7.9 It follows that auxiliary request 2 is not allowable (Articles 52(1) and 56 EPC).

Auxiliary requests 2a and 2b - admittance into the proceedings

8. Auxiliary request 2a differs from the main request in that independent claims 1 and 12 have been deleted. Auxiliary request 2b differs from the main request in that claims 1, 5, 6 and 12 have been deleted. The respondent filed these auxiliary requests by letter dated 1 April 2022, after notification of the summons to oral proceedings.

8.1 The appellant requested that auxiliary requests 2a and 2b not be admitted into the proceedings.

8.2 Under Article 13(2) RPBA 2020, amendments 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 justified with cogent reasons by the party concerned. Therefore, under these provisions, it has first to be assessed whether the respondent's case has been amended by the filing of auxiliary requests 2a and 2b. If this is the case, it then has to be determined whether exceptional circumstances for the filing of auxiliary requests 2a and 2b existed which were justified with cogent reasons.

8.3 Has the respondent's case been amended?

8.3.1 The respondent argued that the amendments to the main request in auxiliary requests 2a and 2b consisted only in the deletion of claims. This deletion did not raise any new issues. Thus, the filing of auxiliary requests 2a and 2b should not be seen as an amendment of the respondent's case. Reference was made to T 1480/16, T 0995/18 and T 1597/16.

8.3.2 The board disagrees. During opposition proceedings, the respondent had filed 19 auxiliary requests before the opposition division in reply to the notice of opposition. Seventeen of those requests were re-filed with the reply to the appeal. All these requests contained either an independent claim 1 directed to a "*two component coating composition*" or an independent claim directed to the "*use of a functional silane material for reducing the curing temperature in a two component coating composition*" or both. This led the appellant and the board to believe that those requests contained all the amendments the respondent considered necessary to make its case (T 0248/13, reasons, 4.3). In fact, in its statement of grounds of appeal, the appellant raised objections against independent claims

1 and 12 of the main request and claims dependent on claim 1. No objection against independent claim 2 or 3 was raised.

8.3.3 During oral proceedings before the board, the respondent pointed to page 4 of the annex to its reply to the appeal. In this annex, the possibility that it might file further auxiliary requests containing the deletion of the independent use claim together with the independent claim directed to a coating composition was foreshadowed. Thus, the appellant could not have been taken by surprise by the deletion of both independent claims in auxiliary requests 2a and 2b.

8.3.4 This argument is not convincing. Firstly, the annex to the reply to the appeal referred to by the respondent is a copy of a document filed before the opposition division. Therefore, intentions mentioned in it do not concern the appeal proceedings. The annex was instead provided with the reply to indicate the basis for the amendments carried out (see the reply to the appeal, page 1, last paragraph). Secondly, no corresponding auxiliary request was filed by the respondent until 1 April 2022, i.e. shortly before the oral proceedings before the board, when auxiliary requests 2a and 2b were filed.

8.3.5 Therefore, contrary to the respondent's view, the deletion of both independent claims 1 and 12 of the main request did change the respondent's case to such an extent that new issues had to be discussed which the opponent could not be expected to be familiar with. It is not the task of an opponent to speculate about what amendments a patentee might make at a very late stage of the proceedings and to prepare pre-emptively for all of them (T 0248/13, reasons, point 4.5).

8.3.6 The case law referred to by the respondent cannot change the above assessment for two reasons.

Firstly, the board is of the view that the deletion of claims inevitably results in an amendment of the respondent's case. In fact, this deletion implies that it is requested that the patent be maintained in a form different than previously requested, with legal consequences for the patent's validity and scope. The board cannot see how this deletion could not be regarded as an amendment of the requests filed at the outset of the appeal proceedings. In the board's view, the respondent's case is amended if the claims are changed; it is not necessary that in consequence of these changes also the subject of the proceedings is changed. If the amendment of the claims does not lead to a different discussion on the merits, this will be a circumstance which the competent board may consider when, *inter alia*, exercising the discretion under Article 13(2) RPBA 2020. The board's view is supported at least by part of the case law. In decision T 2091/18 (reasons, point 4.1), the entrusted board considered the filing of an amended set of claims to represent an amendment of the patentee's case, the admittance of which was subject to the discretion of the board. The entrusted board noted that in accordance with Article 12(2) RPBA 2020, the appeal case must be directed to the requests, facts, objections, arguments and evidence on which the contested decision is based. The board referred to J 14/19 (reasons, points 1.4 and 1.5), where the Legal Board of Appeal stated that in view of this provision, it followed that submissions not directed to the requests, facts, objections, arguments or evidence contained in the statement of grounds of appeal or reply have the effect of amending the appeal's case. As an example, J 14/19 cited an amendment of the patent. The board in T 2091/18 noted

that there was no doubt that the deletion of one or more independent claims, including any dependent claims, constituted an amendment of the patent and thus, in line with J 14/19, of the patentee's appeal case.

Secondly, even when taking the decisions invoked by the respondent into account, the factual scenarios underlying these decisions substantially differ from the factual scenario underlying the current case, meaning that these decisions are not applicable.

In T 1480/16 (reasons, point 2), the entrusted board decided that the deletion of the process claims in auxiliary request 5 did not lead to any amendment of the patentee's case. This was because the novelty and inventive step of the remaining claims had been extensively discussed by both parties so that no new issues arose. The situation is different in the current case: the appellant concentrated its objections precisely on the independent claims that were deleted in new auxiliary requests 2a and 2b.

In T 0995/18 (reasons, point 2), the amendment of auxiliary request 1 concerned the deletion of a single dependent claim. The entrusted board decided that this deletion did not change the subject of the proceedings and thus did not represent an amendment of the patentee's case. For the reasons given above, the situation is totally different in the case at hand, where the deletion concerns independent claims.

In T 1597/16 (reasons, point 4), the amendment carried out in the new main request concerned the deletion of one of three variants within claim 1. The entrusted board decided that this deletion did not change the subject of the proceedings and thus did not represent an amendment of the patentee's case since objections

against the remaining subject-matter had been raised by the opponent. As explained above, the situation is different in the current case: the objections of the appellant concern the independent claims having been deleted.

Therefore, none of the decisions invoked by the respondent is applicable to the case at hand.

8.3.7 For these reasons, the deletions carried out in auxiliary requests 2a and 2b do represent an amendment of the respondent's case filed after the summons to oral proceedings.

8.4 Did exceptional circumstances exist?

8.4.1 The respondent argued that the filing of auxiliary requests 2a and 2b was a direct reaction to the new interpretation by the board of the subject-matter of claim 1 of the main request given in its provisional opinion. This interpretation that claim 1 also covered compositions in which first and second components were mixed to each other deviated from the interpretation accepted by the opposition division and all the parties during opposition proceedings and was thus surprising to the respondent. Moreover, based on this interpretation, the board had raised in its preliminary opinion a new novelty objection against the subject-matter of claim 1 in view of document D17. This objection had not been raised by the appellant. Therefore, exceptional circumstances existed, justifying the admittance of new auxiliary requests 2a and 2b. Moreover, the claims of these requests were restricted to subject-matter not objected to in the statement of grounds of appeal. Therefore, these auxiliary requests were clearly allowable and should have been allowed in the proceedings to provide procedural economy.

- 8.4.2 The respondent's arguments are not convincing. The interpretation that claim 1 of the main request also covered compositions in which first and second components are mixed to each other was put forward by the appellant in its statement of grounds of appeal (page 7, last paragraph). In its provisional opinion (point 7.2), the board merely reiterated this interpretation given by the appellant. Thus, this interpretation cannot be surprising to the respondent. Moreover, while it is acknowledged that the board had raised a new novelty objection in its communication issued in preparation for the oral proceedings (points 8.2 and 8.3), this objection only concerned claim 1 of the main request. In auxiliary requests 2a and 2b, not only was claim 1 deleted but also independent use claim 12, against which no new objections had been raised by the board. Therefore, no causal link exists between the new novelty objection raised by the board and the deletion of the independent use claim. It is further noted that auxiliary requests in which claim 1 of the main request had been deleted had been filed by the respondent already with its reply to the appeal (see e.g. auxiliary requests 2, 3 and 4).
- 8.4.3 Therefore, the board concludes that no exceptional circumstances exist justifying the filing of auxiliary requests 2a and 2b only shortly before the oral proceedings. Whether auxiliary requests 2a and 2b might be clearly allowable has no bearing on this conclusion.
- 8.5 In exercising its discretion under Article 13(2) RPBA 2020, the board thus decided not to admit auxiliary requests 2a and 2b into the proceedings.

Auxiliary request 3 - objection of the appellant based on document D7 against claim 11 of auxiliary request 3 when referring to compositions according to alternative (iii) of claim 1 - admittance into the proceedings

9. In auxiliary request 3, claim 1 of the main request was deleted and claim 2 became the new claim 1. Moreover, claim 1 of auxiliary request 3 differs from claim 2 of the main request in that the claim is restricted to cover three alternatives (i) to (iii) for the silane material (see below).

9.1 Claim 11 of auxiliary request 3 recites:

"11. Use of a functional silane material for reducing the curing temperature in a two component coating composition as defined in claim 1."

Claim 1 is directed to a food or beverage can having a coating formed from a coating composition. The latter is defined as a *"composition comprising a first component comprising an acrylic latex material; and a second component comprising a functional silane material, wherein:*

- (i) the functional silane material comprises an epoxy functional silane and the acrylic latex material comprises an aqueous dispersion of an acrylic material in a core/shell arrangement; or*
- (ii) the functional silane material comprises an amino functional silane; or*
- (iii) the functional silane material comprises a hydroxyl or alkoxy functional silane."*

9.2 The appellant requested that auxiliary request 3 not be admitted into the proceedings. The board concluded that auxiliary request 3 had been validly filed with the

reply to the appeal and formed part of the proceedings. However, since auxiliary request 3 was found not to be allowable (see below), a reasoning on this conclusion of the board is not needed.

- 9.3 The appellant objected to the inventive step of the subject-matter of claim 11 when referring to a coating composition as defined in alternative (iii) of claim 1 in view of document D7.
- 9.4 The respondent requested that this objection not be admitted into the proceedings. It argued that this objection was late filed since it had been raised only at the oral proceedings before the board. Therefore, it represented an amendment of the appellant's case, for the admittance of which no exceptional circumstances existed.
- 9.5 The board disagrees. On pages 36 and 37 of its statement of grounds of appeal (point 3.3), the appellant objected to inventive step of use claim 12 of the main request (wrongly indicated by the appellant as claim 11). It argued that the claimed use was not inventive in view of document D7, which disclosed (table 1, figure 3, paragraph 6.2), *inter alia*, acrylic latex dispersions of epoxy-alkoxy silanes cured at room temperature. The appellant stated that the same objection applied to all use claims included in the auxiliary requests, i.e. also to claim 11 of auxiliary request 3. Since coating compositions comprising acrylic latex dispersions of epoxy-alkoxy silanes fall under alternative (iii) of claim 1 of auxiliary request 3, it follows that an inventive-step objection against claim 11 of auxiliary request 3 when referring to compositions according to alternative (iii) of claim 1 had been raised by the appellant in the statement of grounds of appeal.

9.6 For these reasons, the board concludes that the above objection does not represent an amendment of the appellant's case. Therefore, the objection was admitted into the proceedings.

Auxiliary request 3 - claim 11 - inventive step under Article 56 EPC

10. The respondent argued that the subject-matter of claim 11 of auxiliary request 3 was inventive for the same reasons as for claim 11 of auxiliary request 2 (see above). Document D7 did not disclose the use of the claimed silanes for reducing the curing temperature. However, as mentioned above for claim 11 of auxiliary request 2, the board holds that D7 does disclose the use of epoxy-alkoxy silanes, *inter alia*, Glymo or γ -glycidylloxypropyl triethoxysilane, for reducing the curing temperature of coating compositions comprising an acrylic latex within the meaning of claim 11. These epoxy-alkoxy silanes belong to the generic class of alkoxy functional silanes and correspond to functional silanes used according to claim 11 of auxiliary request 3 when referring to compositions according to alternative (iii) of claim 1 (point 9.1 above).

It follows that no distinguishing features exist between the subject-matter of claim 11 when referring to compositions according to alternative (iii) of claim 1 and the disclosure of D7. Lacking any distinguishing feature, there is no technical problem to be solved, and thus the subject-matter of claim 11 cannot involve any inventive step within the meaning of Article 56 EPC.

Therefore, auxiliary request 3 is not allowable (Articles 52(1) and 56 EPC).

Auxiliary request 4 - admittance into the proceedings

11. The set of claims according to auxiliary request 4 was filed by the respondent with its reply to the statement of grounds of appeal. With respect to the main request (point II above), claim 1 was deleted and claim 2 became the new claim 1. Moreover, claim 1 of auxiliary request 4 differs from claim 2 of the main request in that the claim is restricted to cover two alternatives (i) and (ii) for the silane material (see below).
- 11.1 The appellant argued that the amendments carried out in the claims of auxiliary request 4 had been substantiated by the respondent neither in its reply to the appeal nor later in the proceedings. Thus, it requested that auxiliary request 4 not be admitted into the proceedings.
- 11.2 The board disagrees. As set out above with respect to auxiliary request 1, a substantiation why claim amendments are filed may not be needed if the amendments are self-explanatory in the sense that they put the board and the other party in a position to understand - without any further explanation - which outstanding objections are meant to be overcome.
- 11.2.1 In the statement of grounds of appeal (see pages 1 to 35), the appellant raised objections essentially against claim 1 of the main request and claims dependent on claim 1. On pages 36 and 37, objections against the independent use claim referring to the composition as defined in claim 1 had also been raised. However, no objections against independent claims 2 and 3 of the main request (point II above) had been made.
- 11.2.2 Therefore, the board holds that the deletion of claim 1 and the renumbering of previous claims 2 and 3 as claims 1 and 2 in auxiliary request 4 was meant to overcome the above-mentioned objections raised by the

appellant in its statement of grounds of appeal. As such, the amendments carried out in auxiliary request 4 are considered to be self-explanatory and do not need any explicit substantiation.

11.3 For these reasons, the board decides that auxiliary request 4 was validly filed with the respondent's reply to the statement of grounds of appeal, and thus it forms part of the proceedings.

Auxiliary request 4 - claim 11 - appellant's objections to inventive step - admittance into the proceedings

12. Claim 11 of auxiliary request 4 recites:

"11. Use of a functional silane material for reducing the curing temperature in a two component coating composition as defined in claim 1."

Claim 1 is directed to a food or beverage can having a coating formed from a coating composition. The latter is defined as a *"composition comprising a first component comprising an acrylic latex material; and a second component comprising a functional silane material, wherein:*

- (i) the functional silane material comprises an epoxy functional silane and the acrylic latex material comprises an aqueous dispersion of an acrylic material in a core/shell arrangement; or*
- (ii) the functional silane material comprises an amino functional silane."*

12.1 On pages 36 and 37 of its statement of grounds of appeal (points 3.3 and 3.4), the appellant objected to inventive step of use claim 12 of the main request (wrongly indicated by the appellant as claim 11) in view of the combination of documents D7 and A027, documents D2 and D25, or documents D7 and D25. It

further stated that the same objections applied to all use claims in the auxiliary requests. Therefore, in view of the definition of the coating composition given in claim 1 of the main request (point II above), these objections of the appellant apply *mutatis mutandis* also to claim 11 of auxiliary request 4 when referring to coating compositions according to alternative (i) of claim 1 of auxiliary request 4.

However, for the reasons stated above, D25 and A027, and any objections based on them, have not been admitted into the proceedings. It follows that all objections based on these documents, *inter alia*, the above-mentioned inventive-step objections against claim 11 of auxiliary request 4, must remain unconsidered.

- 12.2 At the oral proceedings, the appellant also objected to inventive step of the subject-matter of claim 11 of auxiliary request 4 when referring to compositions according to alternative (i) of claim 1 in view of the combination of documents D7 and D17. It also argued that the feature "*core/shell arrangement*" as recited in alternative (i) did not have any limiting effect on the acrylic material. Additionally, it objected to inventive step of the subject-matter of claim 11 of auxiliary request 4 when referring to a composition according to alternative (ii) of claim 1 in view of document D2 taken alone or in combination with D7.

The respondent requested that all these objections raised at the oral proceedings not be admitted into the proceedings.

- 12.3 It was not disputed by the appellant that the above inventive-step objections had been raised at the oral proceedings before the board for the first time. As such, these objections represent an amendment of the

appellant's case filed at the latest possible stage of the appeal proceedings.

12.4 Under Article 13(2) RPBA 2020, amendments 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 justified with cogent reasons by the party concerned.

12.5 The appellant stated that the above-stated objections should be admitted in view of the high number of auxiliary requests.

This argument is not convincing. Auxiliary request 4 was filed with the reply to the statement of grounds of appeal. Therefore, the appellant could have raised the above-mentioned inventive-step objections much earlier in the appeal proceedings.

Furthermore, the board holds that in the current case, the number of auxiliary requests (17) filed with the reply to the appeal is not excessive, especially in view of the numerous inventive-step objections raised by the appellant in the statement of grounds of appeal. In fact, all D25, A027, D2, D7, D11, D12 and D19 had been indicated by the appellant as documents possibly representing the closest prior art for the claimed subject-matter.

12.6 As a consequence, the board concludes that no exceptional circumstances exist which would justify raising the above-mentioned inventive-step objections only at the oral proceedings. In exercising its discretion under Article 13(2) RPBA 2020, the board thus decided not to admit into the proceedings the appellant's objections to inventive step raised at the oral proceedings.

12.7 For the reasons set out above, none of the appellant's objections to inventive step of the subject-matter of claim 11 of auxiliary request 4 were admitted into the proceedings. Thus, there are no reasons on file that could challenge the inventive step of the subject-matter of claim 11 of auxiliary request 4.

Auxiliary request 4 - claim 4 - sufficiency of disclosure under Article 83 EPC

13. The appellant objected that the subject-matter of claim 5 of the main request was not sufficiently disclosed. Claim 5 of the main request corresponds to claim 4 of auxiliary request 4, so that the same objection is considered to apply to this claim *mutatis mutandis*.

13.1 The appellant argued in writing that since the claim referred to a composition comprising the mentioned first and second components mixed to each other, such a composition could not be used for coating. The reason was that the carboxylic acid groups (from the methacrylic acid monomer) of the shell polymer used to prepare the core/shell latex emulsion acted as a catalyst promoting the crosslinking of the epoxy silane component. In view of this crosslinking in the composition before its application to the substrate, no coating was possible.

13.2 The board finds this argument unconvincing. The patent (paragraphs [0080] to [0087]) contains detailed information allowing the skilled person to prepare coating compositions as claimed. Moreover, paragraph [0085] of the patent states that a composition comprising a first and second component according to the claims in a mixed state "*remained in a useable state for around 50 hours*". Thus, such a composition is suitable to be used for coating.

Under established case law, a successful objection of lack of sufficient disclosure presupposes that there are serious doubts, substantiated by verifiable facts, that the invention as claimed cannot be carried out by the skilled person without undue burden. This condition is not met by the appellant's objection set out above.

13.3 The board had expressed this provisional opinion in its communication issued in preparation for the oral proceedings (point 10). No reply was received by the appellant. Also, at the oral proceedings, the appellant merely relied on its submissions made in the statement of grounds of appeal.

13.4 As a consequence, the board concludes that the subject-matter of claim 4 of auxiliary request 4 is sufficiently disclosed, thus meeting the requirements of Article 83 EPC.

Conclusions

14. None of the appellant's objections against the claims of auxiliary request 4 is admissible and convincing.

Order

For these reasons it is decided that:

1. The decision under appeal is set aside.
2. The case is remitted to the opposition division with the order to maintain the patent on the basis of the claims of auxiliary request 4 and a description possibly to be adapted thereto.

The Registrar:

The Chairman:



N. Maslin

S. Bertrand

Decision electronically authenticated