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**D E C I S I O N**  
of 12 November 1996

**Case Number:** T 0399/95 - 3.2.3  
**Application Number:** 87103836.0  
**Publication Number:** 0238037  
**IPC:** B05D 1/38, B05D 3/02, C09D 5/38,  
B05D 7/14

**Language of the proceedings:** EN

**Title of invention:**  
Method for forming a metallic coat

**Patentee:**  
NIPPON PAINT CO., LTD.

**Opponent:**  
BASF Lacke + Farben AG

**Headword:**  
-

**Relevant legal provisions:**  
EPC Art. 54

**Keyword:**  
"Novelty (no)"  
"New claims submitted at oral proceedings (disregarded)"

**Decisions cited:**  
T 0095/83, T 0153/85, T 0170/87

**Catchword:**  
-



Case Number: T 0399/95 - 3.2.3

**D E C I S I O N**  
of the Technical Board of Appeal 3.2.3  
of 12 November 1996

**Appellant:**  
(Opponent)

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**Respondent:**  
(Proprietor of the patent)

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**Representative:**

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**Decision under appeal:**

Decision of the Opposition Division of the  
European Patent Office dated 14 March 1995,  
posted on 24 March 1995, rejecting the opposition  
filed against European patent No. 0 238 037  
pursuant to Article 102(2) EPC.

**Composition of the Board:**

**Chairman:** C. T. Wilson  
**Members:** F. Brösamle  
L. C. Mancini

## Summary of Facts and Submissions

- I. European patent No. 0 238 037 was granted on 30 September 1992 with claims 1 to 14.
- II. Claim 1 thereof reads as follows:
- "1. A coating method for forming a metallic coat comprising the successive steps of:
- (a) coating an article with an electrocoating composition and baking it,
  - (b) coating the thus-baked article with a sealer coating composition,
  - (c) coating the sealer coated article with an aqueous metallic base coating resinous composition without curing the sealer coating composition,
  - (d) flashing and/or baking the article obtained in Step (c),
  - (e) coating the article obtained in Step (d) with a thermosetting clear coating resinous composition, and
  - (f) baking the coated article."
- III. An opposition filed against the patent in suit was rejected by the Opposition Division on 14 March 1995, whereby the written decision was posted on 24 March 1995.
- IV. The Opposition Division came in its decision pursuant to Article 102(2) EPC to the result that even in the light of the documents
- (D1) JP-A-57-156 069 and its English translation and
  - (D2) FR-A-2 511 617

the subject-matter of granted claim 1 was novel and inventive so that the attacked patent was upheld unamended.

- V. The Appellant (Opponent) with letter of 8 May 1995, received on 10 May 1995, lodged an appeal against the decision of the Opposition Division and paid the appropriate fee on the same day. The Statement of Grounds of Appeal was received on 18 July 1995. It was argued that the subject-matter of granted claim 1 was not novel with respect to (D2).
- VI. The Respondent (Proprietor) with letter of 10 November 1995 defended the patent as granted as his main request and filed two sets of claims 1 to 10 as the basis for his first and second auxiliary requests.
- VII. Claims 1 of the first and second auxiliary requests read as follows:
- a) first auxiliary request
- "1. A coating method for forming a metallic coat comprising the successive steps of:
- (a) coating an article with an electrocoating composition and baking it,
  - (b) coating the thus-baked article with a sealer coating composition which contains an organic solvent,
  - (c) coating the sealer coated article with an aqueous metallic base coating resinous composition by a Wet-On-Wet method without curing the sealer coating composition,
  - (d) flashing and/or baking the article obtained in Step (c)

- (e) coating the article obtained in Step (d) with a thermosetting clear coating resinous composition, and
- (f) baking the coated article."

(b) second auxiliary request

"1. A coating method for forming a metallic coat comprising the successive steps of:

- (a) coating an article with an electrocoating composition and baking it,
- (b) coating the thus-baked article with a sealer coating composition which contains an organic solvent,
- (c) coating the sealer coated article with an aqueous metallic base coating resinous composition by a Wet-On-Wet method without curing the sealer coating composition,
- (d) drying, without baking, the article obtained in Step (c)
- (e) coating the article obtained in Step (d) with a thermosetting clear coating resinous composition, and
- (f) baking the coated article."

VIII. Following a communication of the Board of 18 March 1996 in which the Board raised objections under Article 54 EPC oral proceedings were held on 12 November 1996.

The Respondent filed a third auxiliary request in form of a disclaimer which reads as follows:

"but not including methods in which the sealer coating composition contains a blocked isocyanate group and the aqueous metallic base coat composition contains a 1,2-epoxy group."

IX. The Appellant requests to set aside the impugned decision and to revoke the patent.

The Respondent requests to dismiss the appeal i.e. to maintain the patent in its granted form as main request or to set aside the impugned decision and to maintain the patent in amended form according to the first, second or third auxiliary request.

X. The essential arguments of the Appellant and of the Respondent can be summarized as follows:

(a) Appellant

- (D2) is seen as a novelty destroying document with respect to claims 1 of the main request and first and second auxiliary request since its pages 20 to 24 inter alia disclose a Wet-on-Wet application of coatings, drying without baking, an aqueous base coat and a metallic character thereof;
- though in (D2) the actual wording might be different its disclosure has to be seen as that understood by a skilled person for coating methods so that the above interpretation of (D2) as a novelty destroying document is justified;
- the disclaimer according to the third auxiliary request is not helpful for the issue of novelty since (D2) is not restricted to a specific binder combination, see page 23, lines 21 to 22 and line 34 thereof.

(b) Respondent

- If (D2) has to be seen as having any relevance at all, it must be seen as a document which accidentally destroys novelty of the

subject-matter of claims 1 according to the main request and to the first and second auxiliary request; the third auxiliary request is therefore cast as a disclaimer to clearly overcome any novelty objection;

- in contrast to (D2) the claimed solvent is water and not a resin;
- a disclosure of the combination of the features metallic coating based on water as solvent is not derivable from (D2);
- the essence of the claimed coating method is the possibility that the metallic particles are orientable to achieve a good appearance of the coatings;
- it is offered to insert the word "orientable" in the independent claims;
- as to the third auxiliary request it is felt that the communication dated 18 March 1996 only expresses the provisional opinion of the Rapporteur and not the Board's opinion since only one signature can be seen on it;
- the third auxiliary request can therefore not be seen as late filed since it overcomes the novelty objection and enables the Board to carry out the assessment of the issue of inventive step.

XI. At the end of the oral proceedings before the Board the Chairman of the Board announced the final decision of the appeal case in suit.

## Reasons for the Decision

1. The appeal is admissible.

2. *Main request*

2.1 The crucial issue to be decided is novelty of the subject-matter of claim 1 in the light of (D2) since the parties shared contradictory opinions as to the relevance of (D2) in this respect.

2.2 From (D2) a coating method for forming a metallic coat can be seen which comprises the successive steps of applying coatings (1) to (4) on an article, whereby coating (1) is carried out by electrocoating and the coating is hardened thereafter, coating (2) is applied on a hardened coating (1) whereas coating (3) is applied on an uncured coating (2), coating (3) is flashed and/or baked thereafter and coated with coating (4); finally the article with all four coatings is baked.

In (D2) the following technical terms are used:

"couche primaire" for coating (1), "couche intermédiaire" for coating (2), "couche de finition" for coating (3) and "couche supérieure transparente" for coating (4).

From (D2) it is furthermore known that coating (3) can be aqueous, see page 22, lines 4 and 5 or 25 and 26 of (D2), where it is set out that this coating can be based on water (or on solvents); in page 22, lines 18 to 22 of (D2) reference is made firstly to pigments and secondly to metallic pigments such as aluminium, copper and bronze.



2.3 The Appellant argued that the sealer coating (2) according to above remark 2.2 of (D2) is restricted to a blocked isocyanate and that the aqueous metallic base coat contains a 1,2-epoxy group and that this specific disclosure cannot be novelty destroying to the subject-matter of claim 1.

2.4 The Board cannot accept this argument since claim 1, see its features (b) and (c), does not exclude that coatings (2) and (3) according to above remark 2,2 are of blocked isocyanate or contain a 1,2-epoxy group. Generally speaking (D2) discloses **specific** features which are novelty destroying to the claimed **general** features i.e. copper would be novelty destroying to metal.

Under these circumstances it is irrelevant whether (D2) is an "accidental" document or not since in combination with the assessment of the issue of novelty the question to be answered is whether the claimed features according to the wording of the claim in suit in combination are known from a document or not.

It is moreover irrelevant whether a known feature is an alternative of another feature or even an alternative of an alternative; what counts in this respect is the disclosure of a document to a skilled reader.

Since the orientation of the metallic particles is moreover not defined in claim 1 this feature cannot be considered when dealing with the issue of novelty.

2.5 Summarizing the coating method of claim 1 lacks novelty with respect to (D2) so that granted claim 1 is not valid.

3. *First auxiliary request*

3.1 Claim 1 thereof differs from claim 1 of the main request in that it is prescribed that the sealer coating (2) contains an organic solvent and that the subsequent coating (3) is applied by a Wet-on-Wet method.

3.2 These features are, however, also known from (D2), see page 19, lines 5 and 6 and lines 15 to 21, where it is set out that the sealer coating can be based on water or on a solvent, and see page 23, line 21 to page 24, line 13, where it is set out that the coatings (2) and (3) can be applied Wet-on-Wet (mouillé/mouillé); on page 20, lines 18 to 27 of (D2) a definition of a process "Wet-on-Wet" is given.

3.3. Claim 1 of the first auxiliary request does therefore not add anything novel to the subject-matter of claim 1 of the main request so that this claim is not valid either.

4. *Second auxiliary request*

4.1 Claim 1 thereof differs from the first auxiliary request by its feature (d), namely "drying without baking "of the article coated with coating (3).

4.2 From page 20, lines 23/24 of (D2) this feature is, however, also known so that the subject-matter of claim 1 cannot be seen as novel either with respect to (D2).

4.3 As a consequence claim 1 of the second auxiliary request is not valid either.

5. *Third auxiliary request*

5.1 According to this request the teaching of (D2) should be disclaimed, see Summary of Facts and Submissions, remark VIII.

5.2 In accordance with the established jurisprudence of the Boards of Appeal amended claims may be admitted at a late stage in the procedure, e.g. during oral proceedings, if they are clearly allowable and if there is a good reason for their late submission. For the following reasons the Board found the third auxiliary request inadmissible:

5.2.1 While the Respondent filed the first and the second auxiliary requests with his reply to the Statement of Grounds of Appeal, namely on 10 November 1995, the third auxiliary request was only filed in the oral proceedings before the Board i.e. nearly eight months after the Board's communication of 18 March 1996.

5.2.2 It is true that this communication is only signed by one member of the Board, but it is also clear that it is an annex to the summons to oral proceedings dated 18 March 1996, see "Enclosure: Communication (Form 3008)".

5.2.3 The summons to oral proceedings is, however, under the responsibility of the Board and not only one member thereof so that the Respondent cannot argue that the communication under discussion was seen as a provisional opinion of

one member of the Board only, so that he saw a possibility of convincing the other members, thus avoiding a further auxiliary request.

- 5.2.4 In remark 7 of the communication under discussion the parties were informed that any observations should be filed at least **four weeks** before the oral proceedings, Rule 71(a) (1) EPC.
- 5.2.5 Under these circumstances the Board came to the conclusion that the third auxiliary request was **late filed** without good reason.
- 5.2.6 Moreover, the third auxiliary request is not prima facie allowable since the Board is convinced that the disclosure of (D2) has to be seen as much broader than admitted by the Respondent who interpreted (D2) as being linked to the features contained in the "Disclaimer" submitted in the oral proceedings.
- 5.2.7 The Appellant pointed in this context to page 23, lines 21 and 22 and line 34 of (D2); it is true that there the skilled reader is not limited to any specific binder for the coatings (2) and (3) so that there is a basis for not limiting the teaching of (D2) to a blocked isocyanate or to a 1,2-epoxy group.
- 5.2.8 This makes clear that a disclaimer is not helpful to overcome any novelty objection.
- 5.2.9 Even if, however, the novelty objection were met by the disclaimer submitted in the oral proceedings the issue of inventive step over (D2) would have to be considered.

5.2.10 According to the decision T 0170/87, OJ EPO 89, 441, a disclaimer can be used to make an inventive teaching which overlaps with the state of the art novel but it cannot make an obvious teaching inventive. This means that, since the Board is not convinced that (D2) can be considered to constitute an "accidental" disclosure the third auxiliary request is not clearly allowable, the Appellant also in his Statement of Grounds of Appeal objecting against the existence of an inventive step in the light of (D2) and (D1) should the Board come to the conclusion that the requirements of Article 54 EPC are met, see remark 2.2 of the above statement.

5.2.11 Following the principles laid down in T 0097/83, OJ EPO, 1985, 75 and T 0153/85, J EPO, 1988, 1 the third auxiliary request is not admissible.

**Order**

**For these reasons it is decided that:**

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

The Registrar:



N. Maslin

The Chairman:



C. T. Wilson

