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D E C I S I O N
of 20 December 2000

Case Number: T 0547/96 - 3.3.1

Application Number: 88202206.4

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Language of the proceedings: EN

Title of invention:

Paint colourizing system based on base paint and pigment paste

Patentee:

VAN WIJHE BEHEER B.V.

Opponent:

CREANOVA INC.
FINA RESEARCH S.A. / SIGMA Coatings B.V.
Jotun Fabrikker A/S
TIKKURILA OY
Akzo Nobel N.V.

Headword:

Paint System /VAN WIJHE

Relevant legal provisions:

EPC Art. 123(2) and (3)
EPC R. 67

Keyword:

"Amendments - added subject-matter (yes) - extension of
protection conferred (yes)"
"Reimbursement of appeal fee (no)"

Decisions cited:

-

Catchword:

-



Case Number: T 0547/96 - 3.3.1

D E C I S I O N
of the Technical Board of Appeal 3.3.1
of 20 December 2000

Appellant: VAN WIJHE BEHEER B.V.
(Proprietor of the patent) Russenweg 2-4
NL-8041 AL Zwolle (NL)

Representative: Jorritsma Ruurd
Nederlandsch Octrooibureau
Scheveningseweg 82
P.O. Box 29720
NL-2502 LS 's-Gravenhage (NL)

Respondents: CREANOVA INC.
(Opponent 0I) 80 Centennial Avenue
PO Box 456
Piscataway
New Jersey 08855-0456 (US)

Representative: W. P. THOMPSON & CO.
Eastcheap House
Central Approach
Letchworth
Hertfordshire SG6 3DS (GB)

(Opponent 0II) FINA RESEARCH S.A. / SIGMA Coatings B.V.
Zone Industrielle C / Amsterdamseweg 14
BE-7181 SENEFFE (Feluy) / NL-1422 AD
Uithoorn (BE)/(NL)

Representative: Leyder, Francis
c/o Fina Research S.A.
Dépt. Brevets
Zone Industrielle C
BE-7181 Seneffe (Feluy) (BE)

(Opponent 0III) Jotun Fabrikker A/S
P.O. Box 2021 Hasle
NO-3201 Sandefjord (NO)

Representative: Reinhard, Skuhra, Weise & Partner
Postfach 44 01 51
DE-80750 München (DE)

(Opponent 0IV)

TIKKURILA OY
PL 53
FI-01301 VANTAA (FI)

Representative:

Sexton, Jane Helen
J.A. KEMP & CO.
14 South Square
Gray's Inn
London WC1R 5LX (GB)

(Opponent 0V)

Akzo Nobel N.V.
Velperweg 76
NL-6824 BM Arnhem (NL)

Representative:

Zonneweld, Hendrik Jan
Akzo Nobel N.V.
Velperweg 76
NL-6824 BM Arnhem (NL)

Decision under appeal:

**Decision of the Opposition Division of the
European Patent Office posted 25 April 1996
revoking European patent No. 0 311 209 pursuant
to Article 102(1) EPC.**

Composition of the Board:

Chairman: A. J. Nuss
Members: P. P. Bracke
S. C. Perryman

Summary of Facts and Submissions

I. The appeal lies from the Opposition Division's decision, announced orally on 19 March 1996, with the reasoned decision being issued on 25 April 1996, to revoke European patent No. 0 311 209 because the then pending sets of claims according to the main request and the first to seventh auxiliary requests did not meet the requirement of Article 123(2) and/or (3) EPC or because they were not novel or inventive. None of these requests was identical to any of the requests before the Board.

II. The sets of claims underlying the present decision are those filed by the Appellant (Proprietor) with telefax of 8 December 2000 entitled "main request" and "first auxiliary request" and those filed at the oral proceedings before the Board on 20 December 2000 as second to fourth auxiliary requests.

The set of claims according to the *main request* consisted of five claims with the only independent claims reading:

"1. Process for producing a paint having a desired colour, characterised by providing a paint system consisting of:

(a) a series of pigment pastes containing organic solvent and 23-62 % by weight of binder if the paint is a synthetic paint, or containing 15-45 % by weight of water-miscible glycols if the paint is a water-reducible paint, and further containing 10-65 % by weight of pigment and optional further standard additives;

(b) one white base paint containing 20-60 % by weight of a binder, a white pigment, and further standard constituents; and

(c) one clear base paint containing 20-60 % by weight of a binder and further standard constituents and not containing a pigment;

followed by adding one or more of said pigment pastes (a) either to said white base paint (b), or to said clear base paint (c), and mixing, the proportion of the pigment pastes with respect to the total volume of the paint being up to 7.5 % by volume in case of the white base paint and being 10-45 % by volume in case of the clear base paint."

"5. Paint producing system consisting of:

(a) a series of pigment pastes containing 23-62 % by weight of a binder, organic solvent, 10-65 % by weight of pigment and optional further standard additives;

(b) one white base paint containing 20-60 % by weight of a binder, a white pigment, and further standard constituents; and

(c) one clear base paint containing 20-60 % by weight of a binder and further standard constituents and not containing a pigment."

The set of claims according to the *first auxiliary request* consisted of four claims, which were identical with Claims 1 to 4 of the main request.

The set of claims according to the *second auxiliary*

request consisted of four claims with the only independent claim reading:

"1. Process for producing a paint having a desired colour, characterised by providing:

(a) more than one pigment pastes containing organic solvent and 23-62 % by weight of binder if the paint is a synthetic paint, or containing 15-45 % by weight of water-miscible glycols if the paint is a water-reducible paint, and further containing 10-65 % by weight of pigment and optional further standard additives;

(b) one white base paint containing 20-60 % by weight of a binder, a white pigment, and further standard constituents; and

(c) one clear base paint containing 20-60 % by weight of a binder and further standard constituents and not containing a pigment;

followed by mixing one or more of said pigment pastes (a) either with said white base paint (b), or with said clear base paint (c), the proportion of the pigment pastes with respect to the total volume of the paint being up to 7.5 % by volume in case of the white base paint and being 10-45 % by volume in case of the clear base paint."

The set of claims according to the *third auxiliary request* consisted of four claims with the only independent claim reading:

"1. Process for producing a paint having a desired

colour, characterised by providing:

(a) more than one pigment pastes containing organic solvent and 23-62 % by weight of binder if the paint is a synthetic paint, or containing 15-45 % by weight of water-miscible glycols if the paint is a water-reducible paint, and further containing 10-65 % by weight of pigment and optional further standard additives;

(b) one prepacked white base paint containing 20-60 % by weight of a binder, a white pigment, and further standard constituents; and

(c) one prepacked clear base paint containing 20-60 % by weight of a binder and further standard constituents and not containing a pigment;

followed by adding one or more of said pigment pastes (a) either with said prepacked white base paint (b), or with said prepacked clear base paint (c), using a colour mixing machine, the proportion of the pigment pastes with respect to the total volume of the paint being up to 7.5 % by volume in case of the white base paint and being 10-45 % by volume in case of the clear base paint."

The set of claims according to the *fourth auxiliary request* consisted of four claims with the only independent claim reading:

"1. Process for producing a paint having a desired colour, characterised by mixing one or more pigment pastes taken from more than one pigment pastes provided together, said pigment pastes containing organic

solvent and 23-62 % by weight of binder if the paint is a synthetic paint, or containing 15-45 % by weight of water-miscible glycols if the paint is a water-reducible paint, and further containing 10-65 % by weight of pigment and optional further standard additives; either with

(b) one white base paint containing 20-60 % by weight of a binder, a white pigment, and further standard constituents; or with

(c) one clear base paint containing 20-60 % by weight of a binder and further standard constituents and not containing a pigment; said two base paints being provided together with said more than one pigment pastes, the proportion of the pigment pastes with respect to the total volume of the paint being up to 7.5 % by volume in case of the white base paint and being 10-45 % by volume in case of the clear base paint."

III. The Appellant in particular submitted that Article 123(2) and (3) EPC was not contravened by the amendments in the sets of claims underlying the present decision, which was contested by the Respondents (Opponents).

IV. The Appellant requested that the decision under appeal be set aside and that the patent be maintained on the basis of the main request or the 1st auxiliary request, both filed on 8 December 2000, or of the 2nd, 3rd or 4th auxiliary request filed at the oral proceedings on 20 December 2000, and that the appeal fee be reimbursed.

The Respondents requested that the appeal be dismissed.

Reasons for the Decision

1. The appeal is admissible.
2. *Main request*
 - 2.1 Article 123(2) EPC

In accordance with the established jurisprudence, the relevant question to be decided in assessing whether by an amendment subject-matter was added extending beyond the content of the application as filed, is whether the proposed amendment was directly and unambiguously derivable from the application as filed.

Whereas Claims 1 to 3 as originally filed were related to paint colourising systems characterised by a pigment paste and a base paint, present Claims 1 to 4 are related to a process of producing a paint characterised by **providing (a)** a series of pigment pastes, **(b)** one white base paint **and (c)** one clear base paint, followed by the steps of adding one or more of said pigment pastes to said white base paint or said clear base paint and mixing.

Therefore, the first question arises whether **providing (a)** a series of pigment pastes, **(b)** one white base paint **and (c)** one clear base paint was directly and unambiguously derivable from the application as filed.

Although in the application as originally filed the

words "providing" or "provision" or "provided" were not used, the Appellant submitted that this provision was implicitly disclosed by the passage on page 2, lines 5 to 13, of the application as filed, saying that in a paint system of the type described in the introduction two base paints may be sufficient, in particular, one base white for pastel shades and one clear base paint for deep tones by using a base paint and adding thereto one or more pigment pastes.

This passage, however, which concerns only adding one or more pigment pastes to a base paint, is completely silent about providing (a) a series of pigment pastes, (b) one white base paint and (c) one clear base paint.

Moreover, also the passage on page 4, lines 17 to 21, of the application as filed, saying that "any colour can be obtained by means of two base paints per type of product by means of a colour mixing machine making use of prepacked quantities of base paint and adding to the prepacked base paint both volumetrically and gravimetrically" is concerned with adding and mixing the pigment pastes and the base paint together, without mentioning that (a) a series of pigment pastes may be provided together with (b) one white base paint and (c) one clear base paint.

The Appellant submitted that the provision of (a), (b) and (c) was implicitly disclosed by the passage on page 2, lines 5 to 13, of the application as filed, since **a paint system** wherein one or more pigment pastes are added to a base paint is described therein.

However, the said passage explicitly refers to a paint system **of the type described in the introduction** and in

the introductory part on page 1, lines 5 to 10, it is set out that by paint "systems" paint colourising systems are meant, the equipment, pigment paste and base paints of which can be found in distribution centres and shops. Since the term paint colourising systems in the concerned passage is thus clearly not related to paint systems consisting of (a) a series of pigment pastes, (b) one white base paint and (c) one clear base paint, it follows that providing such paint systems is not implicitly disclosed in the passages referred to by the Appellant.

In the absence of any direct and unambiguous disclosure in the application as filed to provide a paint system consisting of (a) a series of pigment pastes, (b) one white base paint and (c) one clear base paint, the Board comes to the conclusion that by the feature of providing such a paint system subject-matter has been added extending beyond the application as filed, contrary to the requirement of Article 123(2) EPC.

2.2 Article 123(3) EPC

In assessing whether an amendment to the claims is such as to extend the protection conferred, it is necessary to determine the protection conferred by the claims as granted before deciding whether a proposed amendment is such as to extend it.

Claim 1 of the patent in suit as granted read:

"Process for producing a paint having a desired colour, characterised by mixing

(a) one or more pigment pastes containing organic

solvent and 23-62 % by weight of binder if the paint is a synthetic paint, or containing 15-45 % by weight of water-miscible glycols if the paint is a water-reducible paint, and further containing 10-65 % by weight of pigment and optional further standard additives; and

(b) a base paint containing 20-60 % by weight of a binder and further standard constituents;

the proportion of the pigment pastes with respect to the total volume of the paint being up to 7.5 % by volume in case of the white base paint and being 10-45 % by volume in case of the clear base paint."

That claim was confined to a process for producing a paint characterised only by mixing one or more pigment pastes and a base paint, whereas present Claim 1 is no longer claiming the mere activity of producing a paint by mixing one or more pigment pastes and a base paint but is now concerned with a process for producing a paint by **providing** a paint system consisting of (a) a series of pigment pastes, (b) one white base and (c) one clear base before producing a paint in the way set out in Claim 1 as granted.

The protection conferred by Claim 1 as granted was thus restricted to the handling of mixing a pigment paste with a base paste, whereas the protection conferred by present Claim 1 clearly extends beyond that to the step of providing a paint system consisting of (a) a series of pigment pastes, (b) one white base and (c) one clear base. The Appellant's view that the amendment amounts to no more than further specifying the process of granted Claim 1, thereby restricting the scope of

protection, is thus clearly at variance with the facts.

Thus the scope of Claim 1 has been extended compared to the Claim 1 as granted by covering also pigment pastes or base paints which have been provided but not mixed. This is contrary to the provisions of Article 123(3) EPC.

- 2.3 The main request must thus be refused as independent Claim 1 fails to meet the requirements of Article 123(2) and (3) EPC.

3. *First auxiliary request*

Since Claim 1 is identical with Claim 1 of the main request, both Article 123(2) and (3) EPC is contravened for the same reasons as for Claim 1 of the main request given above, so the first auxiliary request must be refused.

4. *Second and third auxiliary request*

Claim 1 of each of these requests still give rise to the objections under Article 123(2) and (3) EPC in relation to Claim 1 of the main request, since Claim 1 still contains in a similar way the objectionable feature of providing (a) more than one pigment pastes, (b) one white base paint and (c) one clear base paint.

The second and third auxiliary request must thus be refused.

5. *Fourth auxiliary request*

Due to the feature "said two base paints being provided

together with said more than one pigment pastes"
Claim 1 also contravenes Article 123(2) and (3) EPC for the same reasons as for Claim 1 of the second auxiliary request.

6. Thus, the Board comes to the conclusion that none of the sets of claims according to the main and the first to fourth auxiliary request underlying the present invention meets the requirement of Article 123(2) and (3) EPC.
7. At the oral proceedings the Appellant finally also asked the Board to indicate what claims, if any, it would consider allowable. In inter partes proceedings the Board must be, and must be seen to be neutral between the Parties. For the Board to indicate possible claims would prejudice this neutrality, even if, which was not the case here, the Board had formed an opinion that some form of amended claims would meet all the objections here raised by the Respondents. Accordingly the Board had of necessity to refuse to make any such indication: it is for to the patent proprietor to put amended claims up for consideration by the Board.
8. *Reimbursement of the appeal fee*

As it is a prerequisite of Rule 67 EPC that the appeal be allowable in order that reimbursement of the appeal can be ordered by the Board, the question whether a substantial procedural violation was committed by the Opposition Division is only relevant if the appeal is successful. Since in the present case the Board comes to the conclusion that the appeal is not allowable, already for this reason alone the reimbursement of the appeal fee cannot be ordered.

Order

For these reasons it is decided that:

1. The appeal is dismissed.
2. The request for reimbursement of the appeal fee is refused.

The Registrar:

The Chairman:

N. Maslin

A. Nuss