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**D E C I S I O N**  
**of 5 July 2005**

**Case Number:** T 0455/03 - 3.3.01

**Application Number:** 93923207.0

**Publication Number:** 0670870

**IPC:** C09K 3/18

**Language of the proceedings:** EN

**Title of invention:**  
Polysiloxane coating

**Patentee:**  
Ameron International Corporation

**Opponent:**  
J. C. Hempel's Skibsfarve-Fabrik A/S

**Headword:**  
Polysiloxane/AMERON

**Relevant legal provisions:**  
EPC Art. 113(2), 123(2)

**Keyword:**  
"Late filed requests (not admitted) - clearly not allowable"  
"Intention of submitting fresh requests after closure of the  
debate (not allowed) - debate not reopened - amorphous request  
- no procedural assistance for a party provided by the Board -  
tactical abuse"

**Decisions cited:**  
G 0009/91, T 0153/85, T 0206/93, T 0840/93, T 0382/96,  
T 0396/97, T 0427/99, T 0196/00

**Headnote:**

1. An amorphous request not specifying the wording of the claims sought but leaving it to the Board to identify and to speculate on the intended text of the claims is not consistent with the requirements of the EPC.

2. No party can expect, in particular in inter partes proceedings, that the Board provides procedural assistance by, in effect, taking on the role of a party and choosing the appropriate moment in the proceedings for the submission of a further request striving to overcome the deficiencies and, by indicating this moment to that party.



Case Number: T 0455/03 - 3.3.01

**D E C I S I O N**  
of the Technical Board of Appeal 3.3.01  
of 5 July 2005

**Appellant:** Ameron International Corporation  
(Proprietor of the patent) 245 S. Los Robles Avenue  
Pasadena  
California 91101 (US)

**Representative:** Griffin, Kenneth David  
Saunders & Dolleymore  
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Watford  
Hertfordshire WD18 0JU (GB)

**Respondent(s):** J. C. Hempel's Skibsfarve-Fabrik A/S  
(Opponent) Lundtofeves 150  
DK-2800 Lyngby (DK)

**Representative:** Plougmann & Vingtoft A/S  
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**Decision under appeal:** Decision of the Opposition Division of the  
European Patent Office posted 18 February 2003  
revoking European patent No. 0670870 pursuant  
to Article 102(1) EPC.

**Composition of the Board:**

**Chairman:** A. Nuss  
**Members:** R. Freimuth  
R. Menapace

## Summary of Facts and Submissions

I. The Appellant (Proprietor of the patent) lodged an appeal against the decision of the Opposition Division posted on 18 February 2003 revoking European patent No. 670 870 and filed a written statement setting out the grounds of appeal on 18 June 2003.

II. Notice of Opposition had been filed by the Respondent (Opponent) requesting revocation of the patent in suit in its entirety for lack of novelty and of inventive step based *inter alia* on the document

(2) US-A-4 851 481.

The decision under appeal was based on amended sets of claims according to the main and the auxiliary request submitted on 5 and 12 December 2002, respectively, which amended sets replaced the amended set of claims filed on 19 April 2001.

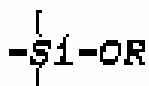
The Opposition Division held that the amendments made to the patent according to the then pending main request were not occasioned by a ground for opposition as required by Rule 57a EPC and that the patent according to the then pending auxiliary request lacked novelty vis-à-vis document (2).

III. The Appellant, annexed to the Statement of the Grounds of Appeal, submitted a fresh set of claims replacing the previous requests. On 10 June 2005 the Appellant submitted two new sets of claims as main and auxiliary request as a substitute for the requests so far submitted during the proceedings. At the oral

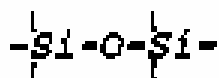
proceedings before the Board the Appellant, again, filed two sets of three claims each as main and auxiliary request superseding any previous request. Independent claim 1 according to that main request read as follows:

"1. A method for forming a protective coating composition comprising:

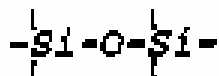
(A) polymerizing at ambient temperatures



groups for producing

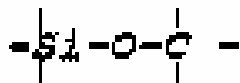


polymer groups and



groups using an amine catalyst and an organometallic catalyst; and

(B) copolymerizing **at ambient temperatures** a carbinol ingredient with such -Si- containing groups to form



polymer groups, the carbinol having at least two hydroxyl groups." (emphasis added).

Claim 1 according to the auxiliary request differed from claim 1 according to the main request exclusively in adding at the end of the claim the feature "wherein the said protective coating is a crosslinked structure of Si-O-Si and Si-O-C bonds".

- IV. The Appellant submitted that the amendment made to claim 1 according to both the main and the auxiliary request, namely the addition of the feature "at ambient temperatures" in copolymerizing step (B), was supported by the application as filed and thus satisfied the requirements of Article 123(2) EPC. That feature was said to be found at page 2, line 25 and page 4, line 7 of the original application.

The Appellant argued that the fresh claims according to the main and the auxiliary request were restricted to mere process claims thereby overcoming the novelty objection raised in the decision under appeal against the then pending product claim 1. The subject-matter claimed was delimited from document (2) since the process of the present invention as amended operated at ambient temperature in both steps (A) and (B), while there was only one single example in document (2) operating at ambient temperature. That example, i.e. example 4, however, used an epoxy resin which did not satisfy the definition given for the carbinol in present claim 1. That epoxy resin was Epikote 807 which was identical to Epikote 862 as shown in appendix

- (A) Product data sheets of Epikote 807 and 862.

Calculated on the basis of the product data given in the data sheets (A), the concentration of OH-groups was merely about 0.1 equivalents per epoxy resin molecule as shown in appendix

(B) Letter dated 18 December 2002 from the company  
Resolution Performance Products

which company was the supplier of the epoxy resins Epikote 807. However, present claim 1 provided for at least 2 equivalents OH-groups in the carbinol per resin molecule. Therefore the claimed invention as amended was novel over document (2).

The Appellant submitted as appendix

(C) an Affidavit of Mr Fernando dated 5 June 2005

for the purpose of evaluating document (2).

V. The Respondent did not comment on the eventual main and auxiliary request.

VI. The Appellant requested that the decision under appeal be set aside and the patent be maintained on the basis of the two sets of claims filed during the oral proceedings before the Board as main and auxiliary request.

The Respondent requested in writing that the appeal be dismissed.

VII. Oral proceedings were held on 5 July 2005 in the absence of the Respondent who, after having been duly summoned, had informed the Board in his letter dated 28 June 2005 that he would not attend. At the end of the oral proceedings, after a negative answer from the Appellant to the question whether he wanted the floor for any further submission or request, the Board closed the debate and adjourned the proceedings for deliberation. Having done so, the Appellant, after a while, asked whether the Board would be prepared to accept a fresh additional (second) auxiliary request. On enquiry by the Board, the Appellant revealed that he had neither a copy of the intended additional request ready nor could he indicate the precise wording thereof. The Board did not reopen the debate and, after deliberation, announced its final decision.

### **Reasons for the Decision**

1. The appeal is admissible.
2. *Admissibility of main and auxiliary request*

The Appellant submitted the present main and auxiliary request for the first time at the very last stage of the appeal proceedings, namely towards the end of the oral proceedings before the Board. Both requests comprised substantial amendments: the claims were restricted to process claims, any product claim, which were included in any previous request up to then, having been dropped, and claim 1 according to either request comprised the additional feature that



copolymerizing step (B) operates "at ambient temperatures".

Therefore the issue arises whether or not these late filed requests are to be admitted into the proceedings.

- 2.1 As has been stated in the decision G 9/91 (OJ EPO 1993, 408, point 18 of the reasons) the purpose of the appeal procedure in *inter partes* proceedings is mainly to give the losing party the possibility of challenging the decision of the first instance. The appealing Proprietor of the patent, unsuccessful before the Opposition Division, thus has the right to have the rejected requests reviewed by the Board of Appeal. However, if he wants other requests to be considered, admission of these requests into the proceedings is a matter of discretion of the Board of Appeal, and is not a matter of right of the appealing Proprietor of the patent (see decision T 840/93, OJ EPO 1996, 335, point 3.1 of the reasons; T 427/99, point 3 of the reasons, not published in OJ EPO). For exercising due discretion in respect of the admission of requests by the appealing Proprietor that were not before the Opposition Division, it is established case law of the Boards of Appeal that crucial criteria to be taken into account are whether or not the amended claims of those requests are clearly allowable and whether or not there is proper justification for their late filing to forestall tactical abuse (e.g. decisions T 153/85, OJ EPO, 1988, 1, points 2.1 and 2.2 of the reasons; T 206/93, point 2.4 of the reasons, T 396/97, point 6 of the reasons and T 196/00, point 3.2 of the reasons , none published in OJ EPO).

2.2 The fresh amendment of claim 1 according to either request specifies that the copolymerizing step (B) operates "at ambient temperatures". In order to support that amendment in view of the provisions of Article 123(2) EPC, the Appellant referred to two paragraphs of the application as filed, namely page 2, line 25 and page 4, line 7. However, the first paragraph addressed by the Appellant is not directed to the invention under consideration, it rather acknowledges the state of the art and the aims to be achieved in view of the drawbacks of the art; the second paragraph does not deal with the operation of copolymerizing step (B), but rather addresses the curing of the coatings.

Hence, that amendment of claim 1 according to either request generates fresh subject-matter which extends beyond the content of the application as filed, contrary to the requirements of Article 123(2) EPC.

2.3 For these reasons, the Appellant's main and auxiliary request are clearly not allowable and the Board exercises its discretion not to admit these requests into the proceedings.

2.4 Article 113(2) EPC stipulates that the instances of the EPO shall consider and decide upon the European patent in suit only in the text submitted to it, or agreed, by the Proprietor of the patent. In the present case, the appealing Proprietor agreed only to the text of the patent in suit submitted as main and auxiliary request at the oral proceedings before the Board (see point III *supra*). However, that main and that auxiliary request are not admitted into the proceedings for the reasons

given in point 2.1 to 2.3 *supra*. The Appellant, during the debate of the oral proceedings before the Board, neither submitted nor agreed to any other text of the patent in suit. Thus, in the absence of any valid request in the proceedings, the patent in suit must stay revoked since there is no text qualifying under Article 113(2) EPC and, thus, no text on which the patent in suit may be maintained.

3. *Procedural matters*

3.1 The Appellant, before the Opposition Division, twice submitted fresh requests based on amended sets of claims (see point II *supra*). Annexed to the Statement of the Grounds of Appeal, the Appellant, for the third time, filed a fresh request and about three weeks before the oral proceedings before the Board he submitted, for the fourth time, again fresh requests (see point III *supra*).

3.2 At the oral proceedings before the Board, the discussion revealed that the Appellant's then pending requests still comprised multiple deficiencies, *inter alia* with respect to the provisions of Rule 57a and Article 123(2) EPC. However, the first instance already found in the decision under appeal that the main request pending before it was in conflict with the requirements of Rule 57a EPC (see point II *supra*). This Appellant's course of action generates considerable doubts as to whether he made a serious attempt and showed a *bona fide* approach to remove the objections raised in the decision under appeal. Notwithstanding those doubts, the Board, after discussion of the deficiencies in the oral proceedings, gave the

Appellant the opportunity to submit, now for the fifth time, fresh requests based on amended sets of claims. The Appellant did so, but did not succeed in removing the deficiencies (see point 2.2 *supra*).

3.3 At the end of the oral proceedings, after a negative answer of the Appellant to the question whether he wanted the floor for any further submission or request, the Board closed the debate and adjourned the proceedings for final deliberation. It was only some time after that closing that the Appellant asked whether the Board would be prepared to accept an intended fresh additional (second) auxiliary request. In answer to a relevant question from the Board, he was neither able to provide a copy of that intended additional request nor could he indicate the precise wording thereof, thus, asking in fact for *carte blanche* to submit any request.

3.3.1 The EPC, however, entrusts the Board only with the power to consider and to decide on a specific text of the claims submitted to it while it is up to the appealing Proprietor to formulate on its own any text of the claims he wishes a patent to be granted with. Such an amorphous request not specifying the wording of the claims sought but leaving it to the Board to identify and to speculate on the intended text of the claims is not consistent with the requirements of the EPC. Thus, the Appellant's course of action amounts to an abuse of the procedure (see decision T 382/96, points 5.1 to 5.3, not published in OJ EPO).

3.3.2 The Appellant did not provide any justification for the intended filing of a fresh request after closing the

debate at the oral proceedings and the Board is not aware of any. The Appellant, in opposition and appeal proceedings, had the benefit of multiple opportunities to submit fresh requests based on amended claims and he did so five times without, however, being successful in overcoming the deficiencies known to him.

As a matter of principle, no party can expect, in particular in *inter partes* proceedings, that the Board provide procedural assistance by, in effect, taking on the role of the Appellant and choosing the appropriate moment in the proceedings for the submission of a further request striving to overcome the deficiencies and, by indicating that moment to the Appellant.

In the absence of any justification for such a late filing, it would have been improper to give the Appellant a further opportunity to amend the claims since the intended submission of a fresh request after the debate was closed constituted a tactical abuse which the Board cannot sanction (see T 153/85 *loc. cit.*, T 196/00 *loc. cit.*).

- 3.4 The Appellant's course of action representing an abuse of procedure, the Board, at the oral proceedings, did not reopen the debate and, after deliberation, announced its final decision.

**Order**

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

The appeal is dismissed.

The Registrar:

The Chairman:

N. Maslin

A. Nuss