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Datasheet for the decision of 6 October 2011

Case Number: T 1238/08 - 3.3.01

Application Number: 97116415.7

Publication Number: 832947

IPC: C09D 7/12, B05D 7/14

Language of the proceedings: EN

Title of invention:
Scratch resistant clearcoats containing surface reactive microparticles and method therefor

Patentee:
BASF Corporation

Opponents:
Akzo Noble N.V.
PPG Industries, Inc.
INSTITUT FÜR NEUE MATERIALIEN gem. GmbH

Headword:
Clearcoats/BASF

Relevant legal provisions:
EPC Art. 123(2), 84

Relevant legal provisions (EPC 1973):
-

Keyword:
"Main request, auxiliary request 1: added matter (yes)"
"Auxiliary request 2: clarity (no), meaning of "non-reactive" unclear"
"Auxiliary request 3: remittal after amendment"

Decisions cited:
-

Catchword:
-

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Beschwerdekammern | Boards of Appeal | Chambres de recours

Case Number: T 1238/08 - 3.3.01

D E C I S I O N
of the Technical Board of Appeal 3.3.01
of 6 October 2011

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Decision under appeal: **Decision of the Opposition Division of the European Patent Office posted 29 April 2008 revoking European patent No. 832947 pursuant to Article 101(3)(b) EPC.**

Composition of the Board:

Chairman: P. Ranguis
Members: L. Seymour
L. Bühler

Summary of Facts and Submissions

I. European patent No. 0 832 947, based on application No. 97 116 415.7, was granted on the basis of nineteen claims, including two independent product claims 1 and 10, and two independent method claims 11 and 19. Independent claims 10 and 19 as granted read as follows (note: the definitions under parts (A) and (B) are identical in these two claims and have been omitted by the board in claim 19 for the sake of conciseness):

"10. An automotive clearcoat coating composition comprising

(A) a film forming binder system containing a crosslinkable resin, and optionally a crosslinking agent for the crosslinkable resin;

(B) colorless carbide or inorganic microparticles wherein the microparticles range in size from 1 to 1000 nanometers, and prior to incorporation in the coating composition, the microparticles are reacted with a coupling agent, wherein the coupling agent comprises a backbone portion which is a polyvalent linking group having thereon a first functionality reactive with the inorganic particles, and a second functionality reactive with the crosslinkable portion of the film forming binder system;

(C) a solvent system for the crosslinkable resin, optional crosslinking agent; whererein the crosslinkable resin is in an amount from 10 to 80% by weight and the inorganic microparticles are

present in an amount from 0.1 to 60.0% by weight based on the sum of the weights of the crosslinkable resin, the optional crosslinking agent, and the inorganic microparticles.

...

19. A method for improving the scratch resistance of an automotive clearcoat coating composition comprising

I. applying to a substrate a pigmented coating composition;

II. forming a film of the coating composition applied in I);

III. applying to the film formed from I) a clearcoat coating composition, wherein the clearcoat coating composition comprises

(A) ...;

(B) ...;

(C) a solvent system for the crosslinkable resin, optional crosslinking agent, and microparticles,

wherein the crosslinkable resin is present in an amount from 10 to 80% by weight and the inorganic microparticles are present in an amount from 0.1 to 60.0% by weight based on the sum of the weights of the crosslinkable resin, the optional crosslinking agent, and the inorganic microparticles; and

IV. baking the basecoat and clearcoat either separately or together to form a cured film on the substrate."

II. The patent was opposed by three opponents and revocation of the patent in its entirety requested pursuant to Articles 100(c), 100(b) and 100(a) EPC (lack of novelty and inventive step).

III. The appeal lies from the decision of the opposition division revoking the patent under Article 101(3)(b) EPC.

The decision was based on a main request and three auxiliary requests filed during oral proceedings before the opposition division. The opposition division considered that the subject-matter of claim 1 of each of these requests extended beyond the content of the application as originally filed, contrary to Article 123(2) EPC, since the definitions introduced for the backbone linking group had only been disclosed in the application as originally filed in connection with specific silica particles, namely, whose "surface is non-reactive with the crosslinkable resin or crosslinking agent".

IV. The appellant (patentee) lodged an appeal against this decision, and filed a main request and an auxiliary request with the grounds of appeal, each consisting of two claims.

Claims 1 and 2 of the main request are based on claims 10 and 19 as granted, respectively (see point I above). In claim 1, the following definition has been

introduced at the end of part (B): "and wherein the polyvalent linking group is selected from the group consisting of oligomers and polymers selected from the group consisting of acrylic, urethane, polyester, polyamide, epoxy, urea and alkyd oligomers and polymers". Claim 2 also contains the same list of definitions, but with "silicone radicals" as an additional option.

The claims of the auxiliary request, which was subsequently resubmitted as auxiliary request 2 (see point VI below), differs from the claims of the main request in the replacement in the first line of part (B) of the feature "colorless carbide or inorganic microparticles" by "colorless silica microparticles where the silica surface is non-reactive with the crosslinkable resin or crosslinking agent".

V. Respondent 1 (opponent 1) took no active part in the appeal proceedings.

Respondents 2 and 3 (opponents 2 and 3) each filed a letter of reply, dated 13 January 2009 and 12 February 2009, respectively, raising objections to the main request under Article 123(2) EPC and to the auxiliary request under Article 84 EPC.

VI. With its letter of 29 August 2011, the appellant filed three auxiliary requests to replace the auxiliary request previously on file (cf. point IV above).

Auxiliary request 1 differs from the main request filed with the statement of grounds of appeal (cf. point IV above) in the deletion of the option "carbide" in the

feature "colorless carbide or inorganic microparticles" in the first line of part (B).

Auxiliary request 2 is identical to the auxiliary request filed with the statement of grounds of appeal (cf. point IV above).

Auxiliary request 3 consists of a single method claim based on claim 19 as granted (see point I above), amended by deletion of the option "carbide" in the feature "colorless carbide or inorganic microparticles" in the first line of part (B).

VII. With letters dated 21 September 2011 and 26 September 2011, respectively, respondents 1 and 3 announced that they would not be attending oral proceedings. Respondent 3 referred to its written submissions filed with letter of 12 February 2009 (cf. point V above).

VIII. Oral proceedings were held before the board on 6 October 2011.

IX. The appellant's arguments, insofar as they are relevant to the present decision, may be summarised as follows:

As regards the basis in the application as originally filed for subject-matter of the main request (Article 123(2) EPC), the appellant pointed to claims 11 and 20 in combination with the paragraph of the description on page 15, lines 5 to 17, which contained the list of definitions for the backbone (polyvalent linking group) now introduced into the main request. The appellant acknowledged that this paragraph contained a qualification with respect to the

definition of the microparticle, namely, "where the silica surface is non-reactive with the crosslinkable resin or crosslinking agent" (page 15, lines 5, 6). However, the appellant argued that the skilled person would recognise that the specific definitions of the backbone further down in the same paragraph were not restricted to this context but could be applied more generally to "colorless carbide or inorganic microparticles". This became clear from the fact that the application as originally filed strictly distinguished between three different structural features of the coupling agent, namely, a first functionality reactive with the inorganic particles, a second functionality reactive with the crosslinkable resin or crosslinking agent, and a backbone portion. Since the microparticle and backbone were not directly attached to each other, the skilled person would understand that there was no structural relationship between these two elements, although the nature of the backbone did indeed contribute to improving the properties of the coating composition.

It was in line with the case law of the boards of appeal, as reflected, for example, in decisions T 879/09 and T 1408/04, that a specific feature could be applied to a more general context without contravening Article 123(2) EPC, provided that it was not inextricably linked to the further features of the combination in which it appeared.

Moreover, additional support for the combination of features now claimed could be derived from the claims as originally filed, specifically, from claims 11 and 20 in combination with claim 6, which also contained

the same list of definitions for the backbone as disclosed in said paragraph on page 15. Claim 6 referred back to claim 5, which in turn depended on claim 1. The latter generally related to "colorless carbide or inorganic microparticles" rather than to any specific silica microparticles. The appellant acknowledged that, as originally filed, claims 1, 5 and 6 were formulated as being independent of claims 11 and 20, but argued that they would be read by the skilled person in combination as relating to a single invention. In this context, the appellant stressed that there was no contradiction in the terminology used in these two groups of claims, since the feature "the crosslinkable portion of the film forming binder system", appearing under part (B) of claim 11 and 20, also encompassed "the crosslinking agent" as disclosed in the corresponding expression in claims 5 and 6.

Consequently, the skilled person reading the application as originally filed as a whole would clearly recognise that the specific definitions for the backbone, as listed on page 15, lines 12 to 17, and in claim 6, were disclosed in relation to "colorless carbide or inorganic microparticles" in general and not restricted to any specific silica microparticles. These were, after all, the only specific definitions offered for the backbone in the application as originally filed, so that the skilled person would have no other choice but to refer to these passages.

Finally, the appellant referred to examples 4, 5, 6A and 6B as illustrating the subject-matter now claimed.

Therefore, the combination of features appearing in the main request did not contravene Article 123(2) EPC.

Regarding the basis in the application as originally filed for the subject-matter of auxiliary request 1, the appellant relied on the arguments already brought forward with regard to the main request.

Turning to the issue of clarity of auxiliary request 2, the appellant argued that, according to established case law of the boards of appeal, as illustrated in decisions T 860/93 and T 860/95, a relative term may be used in a claim provided that the skilled person was able to understand its meaning in context. This requirement was clearly fulfilled for the expression "colorless silica microparticles where the silica surface is non-reactive with the crosslinkable resin or crosslinking agent". Thus, the skilled person was aware of the fact that silica particles had inherent reactivity owing to the silanol groups (Si-OH) present at the surface of the particles. The skilled person would also be familiar with the standard curing conditions generally applied in the coating industry, and could therefore unambiguously establish whether or not "the silica microparticles" and "the crosslinkable resin or crosslinking agent" reacted under these conditions. Furthermore, even were these components to display a certain amount of reactivity under particular conditions, the skilled person would understand, within the context of the claims, that the modification of the microparticles with the coupling agent was aimed at achieving an enhancement of the reactivity of the microparticles. The appellant submitted in this context that the wording of the claims excluded further

modification of the surface of the silica particles, other than by means of the coupling agent. Consequently, the claims complied with Article 84 EPC.

Concerning auxiliary request 3, the appellant submitted that this request was based on claim 20 as originally filed, and claim 19 as granted. It was therefore formally allowable, and should be remitted to the first instance for further prosecution.

X. As already mentioned under point V above, respondent 1 did not make any submissions during the appeal proceedings. The arguments of respondents 2 and 3, insofar as they are relevant to the present decision, can be summarised as follows:

Respondents 2 and 3 raised objections against the main request and auxiliary request 1 under Article 123(2) EPC. The paragraph referred to by the appellant on page 15 of the description as originally filed related only to specific silica microparticles. The appellant had therefore generalised this specific disclosure in an unallowable manner. Moreover, the features of claims 1, 5 and 6 as originally filed could not be combined with those of claims 11 and 20 since these two groups of claims related to distinct embodiments.

Respondents 2 and 3 further objected to the lack of clarity introduced into the claims of auxiliary request 2 as a result of the relative and indefinite term "non-reactive".

With respect to auxiliary request 3, respondent 2 did not raise any objections to admissibility, or to the formal allowability under Articles 84 or 123 EPC. In addition, respondent 2 agreed with the appellant at oral proceedings that this request should be remitted to the opposition division for further prosecution. Respondent 3 did not file any comments in writing relating to this request.

XI. The appellant (patentee) requested that the decision under appeal be set aside and the patent be maintained on the basis of the main request filed with the statement of grounds of appeal or, alternatively, of one of auxiliary requests 1 to 3 filed with letter dated 29 August 2011. The appellant further requested remittal to the department of first instance for consideration of the outstanding grounds for opposition.

Respondent 2 (opponent 2) requested that the appeal be dismissed and that the case be remitted to the department of first instance for further prosecution in the event that a request was found to be allowable in view of Articles 84 and 123 EPC.

Respondent 3 (opponent 3) had requested in writing that the appeal be dismissed.

XII. At the end of the oral proceedings, the decision of the board was announced.

Reasons for the Decision

1. The appeal is admissible.

2. The admissibility of the auxiliary requests filed with the letter of 29 August 2011 was not contested by any of the respondents, at oral proceedings or in writing, and the board sees no reason to differ.

3. *Main request - Article 123(2) EPC*

3.1 Claim 1 of the main request differs from claim 11 as originally filed mainly in the introduction of the following definition at the end of part (B): "and wherein the polyvalent linking group is selected from the group consisting of oligomers and polymers selected from the group consisting of acrylic, urethane, polyester, polyamide, epoxy, urea and alkyd oligomers and polymers". An analogous amendment has been made in claim 2 of the main request with respect to claim 20 as originally filed, except that "silicone radicals" is listed as an additional option.

The question therefore arises whether a direct and unambiguous basis can be found in the application as originally filed for the combination of features now claimed. The appellant has indicated two passages as a basis for the list of polyvalent linking groups introduced into claims 1 and 2 of the main request, namely, the claims and the paragraph of the description on page 15, lines 5 to 17.

3.2 The claim set as originally filed contains four independent claims and seventeen dependent claims (note:

two claims have been numbered as claim 16 on page 32 of the application as originally filed; the claim 16 referred to in this decision is that in lines 4 to 23).

These claims may be divided into two groups:

(i) independent product claim 1, and claims 2 to 10 dependent thereon, together with corresponding independent method claim 12, and claims 13 to 19 dependent thereon.

(ii) independent product claim 11 and corresponding independent method claim 20.

The board notes that claims that are formulated as being independent must *a priori* be assumed to relate to distinct embodiments. Indeed, in the present case, these two groups of claims differ in a number of features. Thus, "prior to incorporation in the coating composition" relates to the particle size in claims 1 and 12, and to the timing of coupling of the coupling agent to the particles in claims 11 and 20. Moreover, the "second functionality" of the coupling agent is defined as being "reactive with the crosslinking agent" in dependent claims 5, 6, 15 and 16, and "reactive with the crosslinkable portion of the film forming binder system" in claims 11 and 20. Regardless of whether the latter encompasses the former, which was a matter of dispute between the parties, the two features are not identical.

Consequently, the board is not convinced by the appellant's argument that the skilled person would read these two groups of claims in combination as relating

to a single invention. Rather, they are to be seen as representing two distinct embodiments, which cannot be combined without contravening Article 123(2) EPC. For this reason alone, the claims cannot provide a basis for the subject-matter claimed.

3.3 As regards the possibility of deriving the claimed subject-matter from the description as originally filed, the following should been considered:

The paragraph of the description on page 12, line 15 to page 14, line 15 generally discloses "the microparticles suitable for compositions of the present invention", whereby "a wide variety of small-particle, colloidal silicas" are particularly desirable (see page 13, lines 21 to 24), and various possible surface modifications thereof are disclosed in the paragraph on page 14, lines 16 to 25. There then follows two paragraphs disclosing various means by which the microparticles can be reacted with the binder or crosslinkable resin, which read as follows (page 14, line 26 to page 15, line 17; emphasis added):

"The microparticles can be reactive with the binder either by their inherent reactivity (e.g. presence of SiOH groups) or this reactivity can be converted using one of a wide range of alkoxy silane coupling agents (e.g. glycidyl alkoxy silanes, isocyanato alkoxy silanes, amino alkoxy silanes, and carbamyl alkoxy silanes). **The reactive groups on the silica** allow the silica to be reacted into the crosslinkable resin without additional treatment when an aminoplast or silane crosslinking agent is used.

Where the silica surface is non-reactive with the crosslinkable resin or crosslinking agent, the inorganic particles are reacted with a coupling agent which comprises a compound having a functionality capable of covalently bonding to the inorganic particles and having a functionality capable of crosslinking into the crosslinkable resin, where both functionalities are reacted onto a backbone of the coupling agent. The backbone of the coupling agent is a polyvalent linking group. Examples of the polyvalent linking group include polyvalent radicals such as silicone and phosphorus, alkyl groups, oligomers or polymers such as acrylic, urethane, polyester, polyamide, epoxy, urea and alkyd oligomers and polymers."

Thus, the first sentence of the cited passage discloses direct reaction of the microparticles, or the use of alkoxy silane coupling agents. The following sentence addresses a possibility for direct reaction where reactive groups are present on the silica. In direct contrast thereto, the second paragraph is dedicated to the case "where the silica surface is non-reactive with the crosslinkable resin or crosslinking agent". Consequently, the skilled person cannot but conclude that this is a compulsory structural requirement in relation to that which follows. Therefore, in order to arrive at the subject-matter now claimed in the main request, the skilled person has to omit this essential feature and apply some of the specific meanings listed for polyvalent radicals to a more general context. This amounts to an unallowable generalisation of a preferred

embodiment, which is not unambiguously disclosed in the application as originally filed.

Finally, it is noted that the examples referred to by the appellant also cannot provide a basis for the claimed subject-matter since they only disclose a particular combination of components and their use under specific conditions.

3.4 The arguments of the appellant that the skilled person would understand that the specific meanings listed for polyvalent radicals were not inextricably linked to the nature of the microparticles are relevant to the question of what might be rendered obvious by the content of the application as filed taking into account the general knowledge of the skilled person. This must be clearly distinguished from the question of what has been directly and unambiguously disclosed by the application as filed. The decisions cited by the appellant in this context are not considered to be pertinent. None of these decisions deal with a case such as the present, in which the various elements in question are literally linked to form a single chemical product having specific properties. It cannot therefore be accepted that the various elements of the coating composition can be arbitrarily and independently extracted from the specific context in which they were originally disclosed, and be combined with each other at will.

The board is also not convinced by the argument of the appellant based on the fact that the specific definitions introduced for the backbone were the only ones offered in the application as originally filed. It

would be contrary to the purpose of Article 123(2) EPC to allow undisclosed intermediate generalisations only because the application as originally filed had not been drafted to contain appropriate fall-back positions.

3.5 Hence, the subject-matter of claims 1 and 2 according to the main request contravenes the requirements of Article 123(2) EPC.

4. *Auxiliary request 1 - Article 123(2) EPC*

Auxiliary request 1 merely differs from the main request in the deletion of the option "carbide" in the feature "colorless carbide or inorganic microparticles" from claims 1 and 2. The assessment presented under point 3 above therefore applies to this request *mutatis mutandis*. The appellant did not advance any additional arguments in this respect.

Therefore, the subject-matter of auxiliary request 1 does not meet the requirements of Article 123(2) EPC.

5. *Auxiliary request 2 - Article 84 EPC*

5.1 According to claims 1 and 2 of auxiliary request 2, the microparticles present in component (B) of the coating composition are defined as "colorless silica microparticles where the silica surface is **non-reactive** with the crosslinkable resin or crosslinking agent" (emphasis added). This feature was not present in the set of claims as granted, and the amended claims must therefore be examined for compliance with the requirements of Article 84 EPC. This article stipulates that the claims shall define the matter for which

protection is sought. Thus, the question to be answered is whether it is possible to reliably determine whether particular silica microparticles fall within this definition.

5.2 It is firstly noted that the claims do not provide any definition of the types of silica particles that are embraced by said feature. Moreover, no evidence was provided by the appellant to establish that it had a well-recognised meaning in the art, in the sense that the skilled person reading the feature would know from the outset, on the basis of his common general knowledge, which silica particles were covered by this term.

The appellant is correct in stating that, according to the claims, reaction of the microparticles with the coupling agent enhances the reactivity of the former. However, this does not help to identify the types of microparticles that qualify as having a surface that is "non-reactive with the crosslinkable resin or crosslinking agent".

From his common general knowledge, the skilled person would be aware of the fact that the reactivity of the "silica microparticles" with "the crosslinkable resin or crosslinking agent" would depend not only on the nature of these components, but also on the conditions under which they were reacted. The board notes that the reaction conditions to be applied in order to establish non-reactivity are also not defined in the claims. The appellant argued in this context that skilled person would be familiar with standard curing conditions generally applied in the coating industry, but provided

no evidence that such standardised conditions exist. Therefore, the board concludes that the skilled person on reading the present claims would not know what method to apply in this respect and, depending on the particular reaction conditions selected, would obtain different results concerning reactivity or non-reactivity for the very same silica microparticles.

Consequently, the person skilled in the art on reading the present claims is not able to derive a clear definition of what is intended to be claimed.

5.3 Although the claims should be clear in themselves when read by the person skilled in the art, the board notes that reference to the description in the present case also does not help the skilled person in establishing a clear definition of the term in question.

Thus, it can be derived from paragraph [0030] of the patent is suit that "the microparticles can be reactive with the binder either by their inherent reactivity (e.g. presence of SiOH groups) or this reactivity can be converted using one of a wide range of alkoxy silane coupling agents". However, this does not provide any information on when the silica surface is to be classified as being "non-reactive".

In paragraph [0029], it is disclosed that the silica particles, at least prior to incorporation in the coating composition, may be surface-modified by means of "chemically bonded carbon-containing moieties, ... various ionic groups physically associated or chemically bonded within the surface of the silica, adsorbed organic groups **and combinations thereof,**

depending on the particular characteristics of the silica desired" (emphasis added). Therefore, contrary to the appellant's assertions, combinations of different types of surface modification are explicitly envisaged in this paragraph, and cannot be viewed as being excluded by the wording of the present claims. However, no information can be derived from paragraph [0029] as to how these modifications affect the reactivity of the silica surface.

Concerning the curing conditions to be applied, according to paragraph [0039] of the patent in suit, "the clearcoat composition used in the practice of the invention may include a catalyst to enhance the cure reaction". In addition, according to paragraph [0044], "various methods of curing may be used" and "curing temperatures will ... generally range between 93°C and 177°C". It is therefore derivable from these paragraphs that the reaction conditions used in curing reactions may vary widely. Therefore, the present description does not support the appellant's assertion that standardised curing conditions exist in the coating industry.

5.4 Consequently, auxiliary request 2 must be refused for lack of clarity (Article 84 EPC).

6. *Auxiliary request 3*

The single claim of this request finds its basis in claim 20 as originally filed, and has been restricted with respect to claim 19 of the granted version through the deletion of the option "carbide". The amended

request therefore meets the requirements of Article 123(2) and (3) EPC.

Since the features now claimed were already present in claim 19 as granted, they are not open to objection under Article 84 EPC, which does not constitute a ground of opposition under Article 100 EPC.

7. *Remittal*

The board has come to the conclusion that the subject-matter of the single method claim of auxiliary request 3 overcomes the objection of added subject-matter, which formed the basis of the decision under appeal (see point III above). However, the opposition division has not yet taken a decision on the patentability issues based on the grounds of opposition pursuant to Articles 100(c), 100(b) and 100(a) EPC (see point III above).

Given that the purpose of the appeal proceedings *inter partes* is mainly to give the losing party the possibility of challenging the decision of the opposition division on its merits (see G 9/91, OJ EPO 1993, 408, point 18), the board finds it appropriate to exercise its discretion under Article 111(1) EPC to remit the case to the first instance for further prosecution, as requested by the appellant and respondent 2 (see point XI above).

In considering any potential amendments to the single method claim of auxiliary request 3, the opposition division is bound, in accordance with Article 111(2) EPC, by the *ratio decidendi* of the board of appeal in

so far as the facts are the same (cf. in particular, conclusions on method claims 2 under points 3 to 5 above).

The board further notes that opponent 1 raised an objection under Article 100(c) EPC in its notice of opposition with respect to paragraph [0031] of the patent in suit, owing to the deletion of the phrase "where the silica surface is non-reactive with the crosslinkable resin or crosslinking agent" from the corresponding paragraph of the application as originally filed. This objection may become relevant should the adaptation of the description become an issue.

Order

For these reasons it is decided that:

1. The decision under appeal is set aside.

2. The case is remitted to the department of first instance for further prosecution on the basis of auxiliary request 3 filed with letter dated 29 August 2011.

The Registrar: The Chairman:

M. Schalow P. Ranguis