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**Datasheet for the decision
of 22 January 2013**

Case Number: T 1106/10 - 3.3.09
Application Number: 98904827.7
Publication Number: 963291
IPC: B32B 27/18, C09D 5/14,
A01N 43/40
Language of the proceedings: EN

Title of invention:

Discoloration prevention in pyrithione-containing coating compositions

Patent Proprietor:

Arch Chemicals, Inc.

Opponent:

Thor GmbH

Headword:

-

Relevant legal provisions:

EPC Art. 100(c), 111(1)(2), 114(2)

Keyword:

"Late submitted ground of opposition - considered"
"Granted claim 3 - added subject-matter (yes)"
"Remittal (yes)"

Decisions cited:

G 0016/91, T 0986/93

Catchword:

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Case Number: T 1106/10 - 3.3.09

DECISION
of the Technical Board of Appeal 3.3.09
of 22 January 2013

Appellant: Arch Chemicals, Inc.
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Decision under appeal: Decision of the Opposition Division of the
European Patent Office posted 25 May 2010
revoking European patent No. 963291 pursuant to
Article 101(3) (b) EPC.

Composition of the Board:

Chairman: W. Sieber
Members: W. Ehrenreich
K. Garnett

Summary of Facts and Submissions

I. Mention of the grant of European patent No. 0 963 291 in respect of European patent application 98 904 827.7, filed as International application PCT/US1998/001935 on 3 February 1998 in the name of Olin Corporation, now Arch Chemicals, Inc., was announced on 27 April 2005 in Bulletin 2005/17.

The patent was granted with 4 claims. Claims 1 to 3 read as follows:

"1. An aqueous coating composition being a paint containing a single pyrithione salt, that being zinc pyrithione, wherein the paint is characterised by:

- (a) water,
- (b) a base medium being a resin selected from vinyl, alkyd, epoxy, acrylic, polyurethane and polyester resins, and combinations thereof,
- (c) zinc pyrithione, in an amount of from 0.01% to 2.0% based upon the weight of the composition, and
- (d) a zinc oxide compound selected from the many grades suitable for paint manufacture at a concentration of from 0.02% to 0.5% based upon the weight of the coating composition."

"2. The coating composition of claim 1 characterized in that said zinc oxide is present in an amount of from 0.02% to 0.2%, based upon the weight of the coating composition."

"3. The coating composition of claim 1 characterised in that said coating composition comprises a polymer latex."

Dependent claim 4 relates to a list of certain co-biocides additionally contained in the composition of claim 1.

II. On 27 January 2006 an opposition was filed by Thor GmbH. The opponent requested revocation of the patent in its entirety on the grounds of Article 100(a) EPC in that the claimed subject-matter was neither novel nor based on an inventive step. The opponent based its objections on several documents.

After expiry of the opposition period the opponent, with its letter dated 29 August 2007, cited a new document, namely:

D8 EP-A 0 345 955.

The opponent argued that the subject-matter of claims 1, 2 and 3 as granted was not novel over comparative paints AJ, AK and AL disclosed in D8.

With its letter dated 18 September 2009 the opponent raised an objection for the first time that the subject-matter of dependent claims 2 and 3 was not disclosed in the application as filed (Article 100(c) EPC; points 7(b) and (c) of the letter).

III. Counterarguments were provided by the patent proprietor by letters dated 18 September 2006, 16 September 2008 and 4 November 2009.

With its letter dated 16 September 2008 the patent proprietor *inter alia* requested that D8 be not admitted into the proceedings because it was late-filed and not more relevant than the documents filed with the notice of opposition.

Enclosed with the letter dated 4 November 2009 was a set of claims as the basis for a first auxiliary request, consisting of independent claims 1, 2 and 3, and dependent claims 4 and 5.

- IV. With its decision announced orally on 20 November 2009 and issued in writing on 25 May 2010 the opposition division revoked the patent.

The opposition division admitted D8 into the proceedings, *inter alia* in view of the proprietor's announcement in the oral proceedings that it no longer challenged its admissibility (point 5.3 of the decision).

The fresh opposition ground of Article 100(c) EPC was not admitted into the proceedings. In the opposition division's view the alleged violation of Article 123(2) EPC was not *prima facie* relevant for the granted claims 2 and 3 of the main request (points 3.1 to 3.3 of the decision).

As regards the main request it was the opposition division's position that the subject-matter of claim 1 was anticipated by the compositions AJ, AK and AL disclosed as comparative paints in document D8.

Concerning the auxiliary request, the opposition division held that its subject-matter did not meet the requirements of Articles 84, 123(2), 54 and Rule 80 EPC (points 7.2 to 7.5 of the decision).

- V. On 26 November 2009 (i.e. 6 months before the issuance of the written reasoned decision dated 25 May 2010) the proprietor (hereinafter: the appellant) filed a notice of appeal and paid the appeal fee on the same day. The grounds of appeal were received on 1 October 2010.

The appellant requested maintenance of the patent as granted (main request) and submitted three sets of claims as bases for first to third auxiliary requests. As regards the new ground of opposition according to Article 100(c) EPC, it agreed with the statements made by the opposition division and maintained its position that it should not be admitted into the appeal proceedings.

With the letter dated 11 January 2011 the appellant filed a further set of claims as basis for a fourth auxiliary request.

- VI. In its letter of response dated 14 February 2011 the opponent (hereinafter: the respondent) reiterated its objections of lack of novelty and inventive step of the subject-matter of the main request and raised objections under Articles 84, 123(2)/(3) 54, 56 and Rule 80 EPC against the first to fourth auxiliary requests. Further new documents were filed.

- VII. With a letter bearing no date but received by the EPO on 19 July 2012, and a further letter dated 2 August

2012, received at the EPO on 8 August 2012, anonymous third party observations under Article 115 EPC were filed. These observations related to the opposition grounds of Articles 100(b) and 100(c) EPC. In respect of Article 100(c) EPC it was argued that claims 1 and 4 of the main request did not meet the requirements of Article 123(2) EPC. Further objections under Article 123(2) EPC were raised against some of the auxiliary requests.

VIII. The third party observations, together with a communication of the board, were sent to the appellant and respondent as annexes to the official letter dated 13 August 2012.

In its communication the board stated that Articles 100(b) and 100(c) EPC were not mentioned as opposition grounds in the notice of opposition and that the ground of Article 100(c) EPC had not been admitted by the opposition division. The board further pointed out that the amendments to the claims of the first to fourth auxiliary requests filed by the appellant in the appeal proceedings would have to be examined as to their compatibility with the provisions of Article 123(2) EPC.

IX. With the summons dated 27 September 2012 oral proceedings were arranged to take place on 22 January 2013. A further communication of the board dated 5 November 2012 was issued, which *inter alia* dealt with the issue of novelty of the subject-matter of the main request (claims as granted) over D8.

X. Further observations were provided by the respondent with its letter dated 18 December 2012, wherein, in point 3, the respondent referred to its objections under Article 100(c) EPC against claims 2 and 3 as granted, which were already raised in the opposition proceedings in its letter dated 18 September 2009.

In the respondent's view its objection under Article 100(c) EPC was no longer a fresh opposition ground in the sense of G 10/91 point 3, but constituted an opposition ground which was an essential part of the opposition division's decision because the opposition division had already considered Article 100(c) EPC and had come to the conclusion that neither claim 2 nor claim 3 violated Article 100(c) EPC. The opposition division's discretion not to admit the objection under Article 100(c) into the proceedings was, however, exercised on the wrong basis. Reference was made to decision T 986/93, points 2.1 to 2.5.

With reference to the third party observations dated 2 August 2012, the respondent adopted the view that also claim 4 as granted contained added subject-matter.

XI. With the letter dated 20 December 2012 the appellant filed revised sets of claims as bases for new first to sixth auxiliary requests. In the event that the board did not allow these requests the appellant requested the board to proceed with the first to fourth auxiliary requests previously on file (i.e. the old auxiliary requests). In the oral proceedings the appellant withdrew the new first and third auxiliary requests and the old first and second auxiliary requests.

XII. During the oral proceedings the discussion focused on opposition ground of Article 100(c) EPC, late-filed in the opposition proceedings and relating to claims 2 and 3 as granted, and the opposition ground of Article 100(c) EPC filed for the first time in the appeal proceedings in relation to claims 1 and 4 as granted. The parties' written and oral arguments concerning this issue are summarized in the following.

XIII. Arguments of the respondent

- (a) The objections under Article 100(c) EPC relating to claims 2 and 3 as granted were already considered by the opposition division, who had decided that they were not *prima facie* relevant. The respective objections thus did not constitute a fresh opposition ground in the sense of point 3 of the decision G 10/91 and had therefore to be considered in the appeal proceedings.

The opposition division's discretion not to admit the Article 100(c) EPC objections into the proceedings was exercised wrongly, for the following reasons:

Claim 2 has no basis in the application as filed because no disclosure is found relating to zinc pyrithione as single pyrithione salt and zinc oxide in a concentration of 0.02 to 0.2 wt.-%.

Claim 3 embraces the presence of a combination of a resin according to feature (b) of claim 1 and a polymer latex. Such a combination is not disclosed in the application as filed.

Therefore the board was not barred from considering this belatedly submitted ground of opposition which had been disregarded by the opposition division.

- (b) The feature of claim 1 that zinc pyrithione is present as the single pyrithione salt in the claimed paint composition cannot be derived from the application as filed (Article 100(c) EPC) because there is no disclosure of how the formation of other pyrithione salts, e.g. sodium or potassium pyrithione, induced by the presence of sodium or potassium hydroxide for adjusting the pH-value to 9 - 9.5 of the claimed paints, can be avoided.

The third party observation relating to claim 4 was also adopted. The presence of co-biocides according to claim 4 is disclosed in the application as filed only in combination with paints which are rich in hydrophilic ingredients.

XIV. Arguments of the appellant

The opposition ground of Article 100(c) EPC relating to claims 2 and 3 as granted was late-filed in the opposition proceedings and no consent was given to admit this opposition ground. Also no consent was given to this opposition ground being considered in the appeal proceedings in respect of granted claims 1 or 4.

- XV. The appellant requested that the decision under appeal be set aside and the patent be maintained as granted,

alternatively, that if the board were to decide that the opposition division had exercised its discretion not to admit the ground of opposition under Article 100(c) EPC on the wrong basis, the case be remitted to the opposition division.

XVI. The respondent requested that the appeal be dismissed.

Reasons for the Decision

1. The appeal is admissible.
2. Admission of the opposition ground of Article 100(c) EPC
 - 2.1 An objection under Article 100(c) EPC was raised for the first time by the opponent after expiry of the opposition period with its letter dated 18 September 2009. This objection exclusively related to claims 2 and 3 as granted (points 7(b) and (c) of the letter). In its decision (points 3.1 to 3.3) the opposition division considered this opposition ground and came to the conclusion that the requirements of Article 123(2) EPC were met for granted claims 2 and 3. It was thus decided not to admit the opposition ground of Article 100(c) EPC into the opposition proceedings.

In contrast, the objections under Article 100(c) EPC relating to claims 1 and 4 as granted were first raised in the appeal proceedings by way of the anonymous third party observations (point VIII above).

Because the appellant did not give its consent to the admission of the late-filed opposition ground according to Article 100(c) EPC, the question arises if and to what extent the board can consider this opposition ground without the approval of the appellant.

- 2.2 According to the "Headnote" of the decision T 986/93 a board of appeal is not barred from considering a belatedly submitted ground of opposition which had been disregarded by the opposition division pursuant to Article 114(2) EPC if the board is of the opinion that the opposition division exercised its discretion in this respect wrongly. Point 2.5 of the decision refers to G 10/91, reasons point 16, and concludes that a board of appeal in considering whether an opposition division exercised its discretion properly with respect to disregarding such a ground is limited in the extent of its investigations in the same way as the opposition division, as follows from Article 111(1) EPC.

From the above it follows that the board is limited in the present case to examine whether or not the opposition division has exercised its discretion on a correct basis in considering the opposition ground of Article 100(c) EPC to be *prima facie* not relevant only in relation to granted claims 2 and 3.

Concerning the opposition ground of Article 100(c) EPC against granted claims 1 and 4, mentioned for the first time in the appeal proceedings, point 18 of the reasons of G 10/91, however, applies. It is stated therein that fresh grounds for opposition may in principle not be introduced at the appeal stage. In relation to granted claims 1 and 4 the ground of opposition according to

Article 100(c) EPC is a fresh ground of opposition and thus, given the appellant's refusal to agree to it being admitted, inadmissible.

3. The discretionary decision of the opposition division in respect of granted claims 2 and 3

3.1 Concerning claim 2 as granted the opposition division found that the feature of the zinc oxide concentration of 0.02% to 0.2% based on the weight of the coating composition has a basis in claim 3 and page 10, lines 8 to 10 of the application as filed because this range falls within the larger range of granted claim 1 and is a combination of end ranges, which are allowable in view of T 925/98 (point 3.2 (i) of the decision). The board follows this conclusion of the opposition division. Thus, the opposition division's discretion not to admit the opposition ground of Article 100(c) EPC in respect of granted claim 2 was exercised correctly.

3.2 According to granted claim 3, referring back to claim 2, the paint composition comprises a polymer latex. Because the paint composition according to claim 1 is already characterised in feature (b) by a base medium being a resin selected from certain polymer resins, claim 3 embraces a paint composition which comprises a polymer latex in addition to the polymeric base medium as defined in feature (b) of claim 1. The opposition division found a basis for this embodiment on page 5, lines 21 to 23 of the WO-A 98/36904 indicating that "Typical coating compositions include ... latex emulsion ...".

This disclosure, however, when reading it in context with the whole passage beginning at line 10 of page 5, implies that the aqueous coating composition can exist in the form of a latex emulsion, rather than that a latex is an additional ingredient of an aqueous paint composition already including a polymeric base medium (b). Also, the other passages in the WO publication referred to by the opposition division, i.e. page 15, lines 24 to 28 and page 19, lines 20 to 23 cannot provide sufficient basis for claim 3 because these passages do not unambiguously disclose that the polymer latex is an additional ingredient of an aqueous paint composition including a polymeric base medium as specified in feature (b) of claim 1.

The board thus comes to the conclusion that the opposition division erred in deciding that the ground of opposition according to Article 100(c) EPC is not *prima facie* relevant for this claim. The opposition division therefore exercised its discretion on a wrong basis in relation to claim 3 as granted.

4. Remittal

The board thus reaches the conclusion that the opposition division did not exercise its discretion correctly in deciding in relation to the appellant's main request not to admit the opposition ground according to Article 100(c) EPC in respect of granted claim 3. This gives rise to a new situation, as a result of which the board considers it appropriate to grant the appellant's request to remit the case. The future conduct of the opposition proceedings will obviously depend on the future requests of the parties.

In so far as (a) the appellant's requests include a request to reject the opposition (ie maintain the patent as granted) and (b) the respondent maintains its request to admit an objection under Article 100(c) EPC against granted claim 3, the division will be required to exercise its discretion again. In doing so, however, the conclusions of the board set out in point 3.2, above, about what was originally disclosed form part of the *ratio decidendi* of this decision and (so the board considers) will be binding on the division. See Article 111(2) EPC. In the same way the board's conclusion that the division correctly exercised its discretion not to admit the opposition ground of Article 100(c) EPC in respect of granted claim 2 (point 3.1, above) will (the board considers) be binding.

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 for further prosecution.

The Registrar

The Chairman

M. Cañueto Carbajo

W. Sieber