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**Datasheet for the decision  
of 4 November 2019**

**Case Number:** T 0967/15 - 3.3.02

**Application Number:** 07748204.0

**Publication Number:** 2064295

**IPC:** C09D7/12, C08K5/103, C09D5/02,  
C09J11/06, C09K3/10

**Language of the proceedings:** EN

**Title of invention:**

A WATERBORNE BINDER COMPOSITION AND USE THEREOF

**Applicant:**

Perstorp Specialty Chemicals AB

**Headword:**

**Relevant legal provisions:**

EPC Art. 52(1), 54, 111(1), 113(1)  
EPC R. 103(1)(a)

**Keyword:**

Novelty - (yes)  
Right to be heard - substantial procedural violation (yes)  
Reimbursement of appeal fee - (yes)

**Decisions cited:**

**Catchword:**



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Case Number: T 0967/15 - 3.3.02

**D E C I S I O N**  
**of Technical Board of Appeal 3.3.02**  
**of 4 November 2019**

**Appellant:** Perstorp Specialty Chemicals AB  
(Applicant) 284 80 Perstorp (SE)

**Representative:** Hoffmann Eitle  
Patent- und Rechtsanwälte PartmbB  
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**Decision under appeal:** **Decision of the Examining Division of the  
European Patent Office posted on  
17 November 2014 refusing European patent  
application No. 07748204.0 pursuant to  
Article 97(2) EPC**

**Composition of the Board:**

**Chairman** M. O. Müller  
**Members:** M. Maremonti  
M. Blasi

## Summary of Facts and Submissions

I. The appeal by the applicant (hereinafter "appellant") lies from the decision of the examining division to refuse European patent application No. 07 748 204.0.

II. The claim request refused by the examining division contained ten claims, independent claim 1 of which reads as follows:

*"1. Use of a waterborne binder composition in a waterborne paint, wherein the waterborne binder composition comprises a water dispersible polymer binder and a coalescing agent, characterized in that said coalescing agent comprises triesters selected from the group consisting of triester of glycerol and propionic acid, triester of glycerol and butyric acid, triester of glycerol and isobutyric acid or triester of glycerol and valeric acid or combinations of two or more of these, wherein the binder is a homo- or copolymer comprising monomer units of acrylates, methacrylate, vinyl acetate and/or units of urethane or urethane/urea."*

III. The following were among the documents cited during the examination proceedings:

D1: CH 478 856

D2: US 3 524 828

D3: CN 1 216 774 A

with its certified translation D3' into English (numeration by the board) as provided by the appellant

D13: US 5 445 754

D17: [http://en.wikipedia.org/wiki/vinyl\\_acetate](http://en.wikipedia.org/wiki/vinyl_acetate)

D18: GB 567 879 A

D19: GB 567 464 A

D20: US 3 074 912 A

D21: POLYMERIC MATERIALS ENCYCLOPEDIA, Editor Joseph C. Salamone, CRC Press, Boca Raton, US, 1996, pages 6992 and 6993

In the impugned decision, the examining division referred to its previous communications dated 15 March 2013, 3 September 2013 and 14 January 2014 containing, *inter alia*, the following objection to the above claim request:

- The subject-matter of claim 1 lacked novelty over the disclosure of D3.

IV. In the statement of grounds of appeal, the appellant explained why the reasons of the impugned decision and the proceedings before the examining division were defective and contested the reasoning of the examining division in substance. The appellant submitted, *inter alia*, that the claimed subject-matter was novel over D3. It further relied on the following item of evidence (enumeration by the board):

D22: Kirk-Othmer, *Encyclopedia of Chemical Technology*, Third Edition, 1983, Volume 23, page 817.

V. The appellant was summoned to oral proceedings. In preparation therefor, the board issued a communication dated 28 May 2019, in which it expressed the preliminary opinion that a violation of the right to be heard amounting to a fundamental deficiency appeared to

have occurred in the proceedings before the examining division and its intention not to remit the case under Article 11 RPBA but to deal with it as to its merits. The subject-matter of claim 1 (II, *supra*) appeared to be novel over the disclosure of D3 but, in view of the adopted wording, it appeared to lack novelty over the disclosure of D2. The board also expressed its intention to remit the case to the examining division for further prosecution in case the novelty objection over D2 was overcome.

- VI. By letter dated 26 July 2019, the appellant replied to the board's communication and filed a new set of ten claims, independent claim 1 of which differs from previous claim 1 (II, *supra*) only in that it defines (amendment in bold) the:

*"1. Use of a waterborne binder composition **as** a waterborne paint".*

The appellant withdrew its request for oral proceedings and agreed on the case being remitted to the examining division.

- VII. By communication dated 9 September 2019, oral proceedings were cancelled.

- VIII. Final requests

The appellant requests that the decision under appeal be set aside and the case be remitted to the examining division for further prosecution on the basis of the set of claims filed by letter dated 26 July 2019.

The appellant further requests that the appeal fee be reimbursed.

- IX. The arguments of the appellant, where relevant for the present decision, can be summarised as follows:

- Notwithstanding the position taken by the examining division that the "*applicant filed no comments or amendments in reply to the latest communication*", the applicant, by its letter dated 13 October 2014, did file observations in reply to the assumptions provided by the examining division.
- The appellant's right to be heard was fundamentally violated and a reimbursement of the appeal fee was appropriate.
- The certified full translation of document D3 (D3') confirmed that this document disclosed a roofing composition comprising plastic cement, titanium dioxide, vinyl acetate, polyvinyl alcohol, tributyl ester and formaldehyde.
- Vinyl acetate did not polymerise under the conditions described in D3. In particular, oxygen and sulfur present in the environment acted as polymerisation inhibitors, as confirmed by D22.
- Additionally, titanium dioxide was employed in significant proportion in the composition of D3 and was known as an ultraviolet light absorber. The presence of titanium dioxide as well as of plastic cement did not allow UV light to initiate any polymerisation of vinyl acetate.
- D17 merely disclosed that vinyl acetate could polymerise due to instability of its radical. No vinyl radical was present in the composition of D3.
- None of D18 to D21 described a composition coming close to the composition of D3. D18 to D20 concerned the spontaneous polymerisation of bulk

materials, i.e. wherein vinyl acetate was nearly the sole component of the tested compositions.

- D21 disclosed the photo-polymerisation of vinyl acetate in water under exposure to a high-pressure mercury lamp for ten hours. Such experimental conditions had nothing in common with the disclosure of D3.
- It thus had to be concluded that the claimed subject-matter was novel over D3.

### **Reasons for the Decision**

Fundamental deficiency in the first instance proceedings -  
Article 11 RPBA

1. Pursuant to Article 11 RPBA, the board remits a case to the department of first instance if fundamental deficiencies are apparent in the first instance proceedings, unless special reasons present themselves for doing otherwise.
- 1.1 The board considers the decision under appeal deficient in view of a substantial violation of the right to be heard under Article 113(1) EPC. According to the latter provision, the decisions of the EPO must be based on grounds or evidence on which the parties concerned have had an opportunity to present their comments. In accordance with established case law of the boards of appeal, this means that in the present case the appellant must have been given an opportunity to not only present comments on the facts and considerations pertinent to the decision but also have those comments considered, that is, reviewed with respect to their relevance for the decision on the matter (see e.g. Case



Law of the Boards of Appeal, 9th edition 2019, III.B.2.4.1).

- 1.2 The impugned decision refers as a reasoning for the refusal to three different communications of the examining division (dated 15 March 2013, 3 September 2013 and 14 January 2014) and contains the statement of the examining division that the "*applicant filed no comments or amendments in reply to the latest communication*" (see decision of the examining division using EPO Form 2061).
- 1.3 However, in fact, the latest communication of the examining division was dated 4 June 2014 and included, *inter alia*, new documents D18 to D21 introduced by the examining division to substantiate its novelty objection in view of document D3. Subsequently, the appellant filed a letter dated 13 October 2014, containing arguments relating to the objection based on document D3 and contesting the findings of the examining division, particularly based on D18 to D21. The latter documents had been used by the examining division to support the teaching of document D17, which it had introduced with its communication dated 14 January 2014 for interpreting document D3.
- 1.4 It cannot be established from the file that the appellant's submissions dated 13 October 2014 were taken into account by the examining division.
- 1.5 Furthermore, the content of the appellant's letter dated 13 May 2014 filed in reply to the examining division's communication dated 14 January 2014, i.e. the latest of the three communications cited in the impugned decision, was not taken into account in the decision either. In that letter dated 13 May 2014, the appellant had presented counter-arguments in relation

to documents D3 and D17. The subsequent communication of the examining division dated 4 June 2014, which could possibly have taken into account the appellant's arguments dated 13 May 2014, does not, however, form part of the examining division's decision.

1.6 The violation of the right to be heard under Article 113(1) EPC affected the proceedings before the examining division as a whole because it was linked to the sole reason for which the application was refused, namely lack of novelty over the disclosure of document D3. It therefore amounted to a fundamental deficiency within the meaning of Article 11 RPBA, requiring, as a rule, that the case be directly remitted to the examining division without consideration of the appeal case as to its merits.

1.7 However, special reasons present themselves for the board to decide on the appeal in its substance. Firstly, the appellant did not request remittal due to this deficiency but, in the statement of grounds of appeal, comprehensively dealt in substance with the reason for the refusal of the application, namely lack of novelty based on document D3. Secondly, all the examining division's arguments in relation to the reason on which the decision under appeal was based, i.e. the afore-mentioned objection of lack of novelty, are clear to the board and also to the appellant, as derivable from the statement of grounds of appeal. This was not contested by the appellant in its reply to the board's communication dated 28 May 2019 either. Accordingly, the appeal case is considered as to its merits.

Claim 1 - clarity - Article 84 - added subject-matter -  
Article 123(2) EPC

2. Claim 1 at issue (VI, *supra*) is based on claim 13 as filed reciting the use of the defined waterborne binder composition in a waterborne paint. The replacement of the wording "*in a waterborne paint*" with "*as a waterborne paint*" clarifies that it is the binder composition itself that is used as a paint and finds its basis, *inter alia*, on page 3, line 6 and lines 14 to 16 and examples 21 to 23 of the application as filed.

The claimed subject-matter thus meets the requirements of Articles 84 and 123(2) EPC.

Claim 1 - novelty - Article 54 EPC

3. Claim 1 at issue (II and VI, *supra*) requires the use of a waterborne composition comprising, *inter alia*, polyvinyl acetate as a waterborne paint.

Document D3 discloses (claim 1) a waterborne composition, comprising, *inter alia*, 32 % to 37 % vinyl acetate.

- 3.1 The examining division held (point 1 of the communication dated 3 September 2013 referred to in the impugned decision) that "*since the composition [of D3] **is placed in a roof**, the vinyl acetate component will inadvertently polymerise in the presence of the ultraviolet rays of daylight and form polyvinyl acetate*" (emphasis added by the board). It concluded hence that the claimed use lacked novelty over D3.
- 3.2 The board notes, however, that contrary to the above statement of the examining division, D3 does not disclose that the composition disclosed therein is

"placed in a roof". D3 merely discloses (D3': last two lines of the first description page) that the described composition "**may be extensively applied onto roofs, floors, walls and water tanks**" (emphasis added by the board). The actual application on roofs is not disclosed in D3. For this reason alone, the claimed subject-matter is novel over the disclosure of D3.

3.3 The board is further convinced that even assuming that the composition of D3 had been used as roof covering, it could not be directly and unambiguously derived that the vinyl acetate comprised therein would have inevitably polymerised to form polyvinyl acetate. In fact, the behaviour of the vinyl acetate molecules in the presence of the other components of the composition of D3, particularly polyvinyl alcohol, titanium oxide and plastic cement, cannot be predicted *a priori*. The above statement of the examining division as included by reference in the decision under appeal was not substantiated by verifiable facts and thus amounts to mere speculation.

3.4 Also, neither document D17 nor documents D18 to D21, which were introduced by the examining division with its communication dated 4 June 2014, which does not form part of the impugned decision, provide sufficient evidence leading to any direct and unambiguous conclusion that the vinyl acetate comprised in the composition of D3 would inevitably polymerise upon exposure to daylight. Actually, D17 (paragraph "Polymerization") merely mentions that vinyl acetate "can be polymerized" and that due to the instability of the radical, control of the polymerisation is problematic. D18 to D20 concern the stabilisation of vinyl acetate in order to avoid its spontaneous polymerisation. That the latter would inevitably occur

in the presence of the other above-mentioned components of the composition of D3 upon exposure to daylight cannot be concluded from these documents. Finally, D21 discloses (figure 1 and page 6993) the photo-polymerisation of an aqueous solution of vinyl acetate upon exposure to a UV-lamp for ten hours. These experimental conditions are totally different from those that the composition of D3 would experience when placed on a roof.

- 3.5 For the reasons given above, the board concludes that D3 merely discloses vinyl acetate as part of a roof's covering.
- 3.6 Irrespective of the above, if anything, the polyvinyl acetate is formed in D3 only after the composition disclosed therein has been put on the roof and has been exposed to sunlight. Hence, the polyvinyl acetate is not yet present in the waterborne binder composition to be applied to the roof, or, in the words of claim 1, to be used as waterborne paint.
- 3.7 The subject-matter of claim 1 is therefore novel over the disclosure of D3 (Article 54 EPC).
4. The board further observes that the other documents cited during prosecution of the present application do not anticipate the claimed subject-matter either.
  - 4.1 In particular, document D1 discloses (column 1, lines 1 to 7 and claims) a floor covering made of a polyvinyl resin, comprising polyvinyl acetate and tri-isobutyrate. Although the floor covering of D1 may be regarded as a *paint*, it does not contain water as required by claim 1 at issue.

4.2 Document D2 discloses (abstract, column 1, line 54 to column 2, line 21) an aqueous composition, comprising a vinyl acetate-ethyl acrylate copolymer and tributyrin. However, the composition is used as an adhesive and not as a paint.

4.3 Document D13 discloses (column 3, lines 12 to 20 and column 4, lines 37 to 60) a composition comprising a vinyl acetate-dibutyl maleate copolymer and a coalescing agent and its use as a waterborne paint. The adopted coalescing agent is, however, different from those listed in claim 1 at issue.

The remaining documents cited by the examining division are less relevant and, thus, do not need to be addressed here in more detail.

4.4 The board, therefore, concludes that the subject-matter of claim 1 and of claims 2 to 10 dependent thereof as filed by letter dated 26 July 2019, is novel over the state of the art cited by the examining division (Articles 52(1) and 54 EPC).

Remittal - Article 111(1), second sentence, EPC

5. The application was refused on the ground of lack of novelty only. The compliance of the claimed subject-matter with the other requirements of the EPC, e.g. inventive step, has not been assessed yet.

Since the main purpose of appeal proceedings is to review the decision under appeal, the board, exercising its discretion under Article 111(1), second sentence, EPC decided to remit the case to the examining division for further prosecution, thus following the request of the appellant to this end.

Substantial procedural violation - reimbursement of the appeal fee - Rule 103(1)(a) EPC

6. According to Rule 103(1)(a) EPC the appeal fee is to be reimbursed in full in the event of interlocutory revision or where the board deems an appeal allowable, if such reimbursement is equitable by reason of a substantial procedural violation.  
As the board holds that the claimed subject-matter is novel (4.4, *supra*), the decision under appeal is to be set aside and the appeal is allowable. The examining division's finding of lack of novelty in view of the disclosure of document D3 is tainted with a violation of the right to be heard under Article 113(1) EPC (1.1 to 1.5, *supra*) and a causal link between the violation and the final decision exists, since this objection was the sole reason for the refusal of the application, amounting thus to a substantial procedural violation. Furthermore, the appellant was obliged to file an appeal in order to ensure that its arguments on novelty would be duly considered. Under these circumstances, the board considers it equitable that the appeal fee be reimbursed in full in accordance with Rule 103(1)(a) EPC.

## Order

### For these reasons it is decided that:

1. The appealed decision is set aside.
2. The case is remitted to the examining division for further prosecution.
3. The appeal fee is reimbursed in full.

The Registrar:

The Chairman:



N. Maslin

M. O. Müller

Decision electronically authenticated