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**Datasheet for the decision
of 10 January 2020**

Case Number: T 1533/15 - 3.3.02

Application Number: 05825629.8

Publication Number: 1819789

IPC: C09D151/08, B65D17/00

Language of the proceedings: EN

Title of invention:

COATING COMPOSITIONS FOR CANS AND METHODS OF COATING

Patent Proprietor:

SWIMC LLC

Opponent:

PPG Industries, Inc.

Headword:

COATING OF FOOD AND BEVERAGE CANS

Relevant legal provisions:

EPC Art. 106, 107, 108, 52(1), 54, 100(a), 123(2)

EPC R. 99(2)

RPBA Art. 13(1), 13(3), 12(3)

Keyword:

Admissibility of appeal - (yes)

Novelty - main request (no)

Amendments - added subject-matter (yes)

Late-filed items of evidence - admitted (no)

Late-filed auxiliary requests - admitted (no)

Decisions cited:

R 0016/09, T 0253/10, T 0248/13

Catchword:



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Case Number: T 1533/15 - 3.3.02

D E C I S I O N
of Technical Board of Appeal 3.3.02
of 10 January 2020

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Decision under appeal: **Interlocutory decision of the Opposition
Division of the European Patent Office posted on
16 June 2015 concerning maintenance of the
European Patent No. 1819789 in amended form.**

Composition of the Board:

Chairman M. O. Müller
Members: M. Maremonti
L. Bühler

Summary of Facts and Submissions

I. The appeals by the opponent and the patentee lie from the interlocutory decision of the opposition division, according to which European patent No. 1 819 789 in its form modified on the basis of the then pending third auxiliary request and the invention to which it relates meets the requirements of the EPC.

II. The contested patent in its granted form contains 20 claims, independent claims 1, 14 and 20 of which read as follows:

"1. A method of coating a food or beverage can, the method comprising:

forming a composition comprising an emulsion polymerized latex polymer and being substantially free of bound bisphenol A and aromatic glycidyl ether compounds, comprising:

forming a salt of an acid- or anhydride-functional polymer and an amine in a carrier comprising water to form an aqueous dispersion;

combining an ethylenically unsaturated monomer component with the aqueous dispersion; and

polymerizing the ethylenically unsaturated monomer component in the presence of the aqueous dispersion to form an emulsion polymerized latex polymer, and

applying the composition comprising the emulsion polymerized latex polymer to a metal substrate prior to or after forming the metal substrate into a food or beverage can or portion thereof."

"14. A method of coating a food or beverage can, the method comprising:

forming a composition comprising an emulsion polymerized latex polymer, comprising:

forming a salt of an acid- or anhydride-functional polymer and a tertiary amine in a carrier comprising water to form an aqueous dispersion;
combining an ethylenically unsaturated monomer component comprising 0.1 wt-% to 30 wt-% of an oxirane-functional alpha; beta-ethylenically unsaturated monomer with the aqueous dispersion, based on the weight of the monomer component: and
polymerizing the ethylenically unsaturated monomer component in the presence of the aqueous dispersion to form an emulsion polymerized latex polymer, and
applying the composition comprising the emulsion polymerized latex polymer to a metal substrate prior to or after forming the metal substrate into a food or beverage can or portion thereof."

"20. A composition for use in coating a food or beverage can, the composition comprising an emulsion polymerized latex polymer, wherein the emulsion polymerized latex polymer is prepared from a salt or an acid- or anhydride-functional polymer and a tertiary amine, an ethylenically unsaturated monomer component including a mixture of monomers including at least one oxirane functional group-containing alpha, beta-ethylenically unsaturated monomer in an amount of at least 0.1 wt-% and no greater than 30 wt-%, based on the weight of the monomer mixture, and water."

Claims 2 to 13 define specific embodiments of the method of claim 1, while claims 15 to 19 are directed to a food or beverage can.

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

D1: EP 0 389 915 A

D5: US 5,714,539

D9: Declaration of Dr Brandenburger dated 23 August
2012

D15: US 7,745,508 B2

The opposition division came to, *inter alia*, the following conclusions on the then pending main request (patent as granted) and auxiliary requests 1 to 3:

- The subject-matter of claim 1 as granted was novel over the disclosures of D1 and D5.
- The subject-matter of claim 20 as granted was, however, not novel over D1 and D5.
- The subject-matter of auxiliary requests 1 and 2 met the requirements of Articles 84 and 123(2) EPC.
- The subject-matter of claim 18 of auxiliary requests 1 and 2 was, however, not novel over D5.
- Auxiliary request 3 met the requirements of the EPC. In particular, the claimed subject-matter involved an inventive step in view of either D1 or D3 taken as the closest prior art.

IV. In its statement of grounds of appeal and in its reply to the opponent's statement of grounds of appeal, the patentee contested the reasoning of the opposition division and maintained, *inter alia*, that the subject-matter of claim 20 was novel over document D5. It re-filed auxiliary requests 1 to 14 as already filed before the opposition division. It argued that the subject-matter of the patent as granted and of all auxiliary requests met all requirements of the EPC.

The patentee also filed the following new documents (renumbered by the board):

D24: EP 0 992 548 A2

D25: US 5,578,669

D26: US 8,871,888 B2

However, since they were not addressed during oral proceedings nor relied upon by the patentee for the questions leading to the present decision, these documents will not be discussed further in the present decision.

- V. In its statement of grounds of appeal and reply to the patentee's statement of grounds of appeal, the opponent argued that the subject-matter of claim 20 as granted lacked novelty over *inter alia* the disclosure of D5. Furthermore, the subject-matter of auxiliary requests 1 to 4 extended beyond the content of the application as filed. It also argued that auxiliary requests 5 to 14 should not be admitted into the proceedings.

The opponent corroborated its arguments by filing *inter alia* the following new items of evidence:

D21: Declaration of Mr R.H. Good, dated 11 September 2012

D23: Test report on example 18 of D5

- VI. The parties were summoned to oral proceedings following their respective requests.

In preparation for the oral proceedings, the board issued a communication in which it expressed *inter alia* the preliminary opinion that document D5 anticipated the subject-matter of claim 20 as granted and that none of the auxiliary requests of the patentee appeared to comply with Article 123(2) EPC.

VII. In its response dated 10 December 2019, the patentee filed new auxiliary requests 1, 1A, 2, 2A to 2C and 3A to 14A. Moreover, it submitted new items of evidence, *inter alia*:

D32a: Cover page of US serial application 2015/0017359 submitted to the US Patent and Trademark Office in the name of the opponent

D32b: Declaration submitted by the opponent in the US proceedings relating to D32a

D32c: US 6,423,769 discussed in D32b

D33: Repetition of D5's example 18 using higher amounts of crosslinker

The patentee also filed other items of evidence with this response, named D27 to D31 and D34a-d. However, since they were not addressed during oral proceedings nor relied upon by the patentee for the questions leading to the present decision, these items of evidence will not be discussed further in the present decision.

VIII. Oral proceedings before the board were held on 10 January 2020. During oral proceedings, the opponent contested the admissibility of the appeal of the patentee. The patentee withdrew its request not to admit D21.

IX. The parties' requests

The patentee requested that the decision under appeal be set aside and that the patent be maintained as granted (main request). Alternatively, it requested that the patent be maintained on the basis of the claims of one of auxiliary requests 1, 1A, 2, 2A, 2B,

and 2C filed by letter dated 10 December 2019. Alternatively, it requested that the opponent's appeal be dismissed (auxiliary request 3), or, alternatively, that the patent be maintained on the basis of the claims of one of the auxiliary requests 3A, 4, 4A, 5, 5A, 6, 6A, 7, 7A, 8, 8A, 9, 9A, 10, 10A, 11, 11A, 12, 12A, 13, 13A, 14 and 14A (the auxiliary requests with the letter A having been filed by letter dated 10 December 2019; the other auxiliary requests having been filed with the patentee's statement of grounds of appeal).

The opponent requested that the patentee's appeal be rejected as inadmissible. It further requested that the decision under appeal be set aside and that the patent be revoked. The opponent also requested that all auxiliary requests except for auxiliary requests 2, 2B, 3 and 4 not be admitted into the proceedings. It further requested that documents D29 to D31, D32a to D32c, D33 and D34a to D34d filed by the patent proprietor with its letter dated 10 December 2019 not be admitted into the appeal proceedings.

X. The arguments of the patentee, where relevant to the present decision, may be summarised as follows:

Admissibility of the patentee's appeal:

- Page 2 of the statement of grounds of appeal contained the reasoning why the subject-matter of claim 20 as granted was novel over D1 and D5, contrary to what was decided by the opposition division.
- For this reason alone, the appeal should be regarded as admissible.

Novelty of claim 20 over D5:

- The wording of claim 20 made clear that the defined composition had to be suitable for coating food and beverage cans.
- The compositions disclosed in D5 did not meet this requirement for several reasons.
- Food and beverage can coatings were a demanding end use of compositions and thus rewarding. The fact that a certain composition was suitable for this demanding application would have never been hidden. However, D5 was silent to the application of the disclosed composition for food and beverage cans. This alone demonstrated that the disclosed compositions were not suitable.
- A coating composition to be used for food and beverage cans had to meet very stringent requirements, in particular in terms of flexibility. D5, especially in its example 18, disclosed an acrylic latex polymeric composition. D15, in the name of the opponent, disclosed in column 1, lines 62 to 64, that acrylics were too inflexible for a food and beverage can coating end use. D15 had a filing date nine years after D5. If D5 had already solved the flexibility issue of acrylics, this would have been known to the opponent when drafting D15. However, this was not the case.
- D5 focused on room temperature coalescence and ultra-low VOC. These goals were totally different from food and beverage can coatings, which were baked at high temperatures.

- The compositions of D5 were applied to simple flat aluminium panels and tested for blistering, detergent and acid resistance. These tests were not specific to food and beverage can coatings but rather used to test coating properties in a variety of industrial fields.
- D5 focused on latex polymers having high glass transition temperature (hereinafter "Tg"), typically above 40°C. The latex polymer of example 18 had a Tg of 95°C. It was known that coatings were hard and brittle at a temperature below Tg. This meant that a coating made of the latex of example 18 could not withstand the manufacture of a can or a routine drop damage event at room temperature. In other words, it was not suitable for use in coating food and beverage cans.
- This brittleness was confirmed by D9, where example 18 of D5 was run with 0%, 2.5% and 5% concentration of the crosslinker Cymel 303. The latter was used in D5 to formulate the latex polymer of, *inter alia*, example 18 into a coating composition. The data reported in D9 confirmed that none of the coatings withstood the 4T bend test, a common test used to assess the coating's flexibility.
- According to column 11, lines 4 to 17 of D5, the latex polymer of, *inter alia*, example 18 was formulated into a coating composition by adding not only said crosslinker Cymel 303 but also several not further specified agents, like a surfactant, a defoamer and an organic solvent. This lack of precise information already demonstrated that the composition of claim 20 could not be regarded as being directly and unambiguously disclosed in D5.

- Also D23, the test report of the opponent, showed that the latex polymer of example 18 as such, i.e. without the crosslinker, was completely crazed after a reverse impact test and thus not suitable for use in coating food and beverage cans.
- Finally, example 18 of D5 was not among the preferred embodiments. Rather D5 pointed to examples 13 and 14 as preferred latex polymers for coating, which, however, did not comprise the components required by claim 20 as granted.
- Thus, it had to be concluded that claim 20 as granted was novel over the disclosure of D5.

Admittance of D32a-c and D33 and the related submissions contained in the patentee's brief dated 10 December 2019:

- D32a-c were very relevant for the question of novelty of claim 20 over example 18 of D5.
- In particular, point 14 of D32b contained the statement made by the opponent that surfactants like AOT-75, used in example 18 of D5, were highly undesirable for coating food and beverage cans.
- D32a-c were filed as soon as they became available to the patentee.
- As documents of the opponent, the latter knew these documents very well. Thus, it could not have been surprised by them.
- These documents were not complex and did not raise new issues. Thus, they should be admitted into the proceedings.

- D33 was a test report filed in direct response to D23 of the opponent. It thus should also be admitted.

Admittance of auxiliary requests 1 and 1A:

- These auxiliary requests were filed in an attempt to overcome the objections raised by the board in its preliminary opinion.
- They only contained granted claims so that no new issues were raised. The opponent was aware of the subject-matter of independent claims 1 and 14 from the early beginning of opposition proceedings.
- The impugned decision contained a reasoning why the subject-matter of claim 1 was novel. Therefore, the patentee did not avoid a decision by not filing these requests earlier.
- Moreover, if the board had acknowledged the novelty of claim 20, it would have continued the proceedings by examining claims 1 and 14. It could not be the case that the decision of the board on the admittance of these auxiliary requests depended on the outcome of the discussion on the novelty of claim 20 as granted.
- Thus, auxiliary requests 1 and 1A should be admitted.

Compliance with Article 123(2) EPC of the subject-matter of auxiliary requests 2, 2B and 3 to 14:

- Claim 1 of auxiliary request 2 defined a combination of preferred embodiments disclosed in the application as filed.

- This combination resulted from claim 10 as filed together with the passages on page 11, lines 21 to 25, and page 12, line 30 to page 13 line 2, of the application as filed.
- The disclaimer expressing that the claimed composition was substantially free of bound bisphenol A (hereinafter "BPA") and aromatic glycidyl ether compounds was a preferred state which applied to the entire patent specification. As such, it did not require any selection. This was also confirmed by D21 of the opponent (point 8). Moreover, this disclaimer was disclosed *verbatim* on page 4, lines 14 to 15.
- The amendments carried out merely made claim 1 as filed more precise, without creating any new matter. This was confirmed by all examples, which all fell under claim 1 of auxiliary request 2.
- It had to be concluded that auxiliary request 2 complied with Article 123(2) EPC.
- The same arguments applied to auxiliary requests 2B and 3 to 14 which all met the requirements of Article 123(2) EPC.

Admittance of auxiliary requests 2A, 2C and 3A to 14A:

- These auxiliary requests were filed in response to the objections under Article 123(2) EPC raised by the board in its preliminary opinion.
- These requests differed from previously filed requests merely in that claims were deleted. Claim 1 of e.g. auxiliary request 2A had been fully examined by the opposition division. The situation was thus totally different to the issue of

admittance of auxiliary requests 1 and 1A. Thus, auxiliary request 2A should be admitted into the proceedings.

- The same applied to auxiliary requests 2C and 3A to 14A. Auxiliary request 3A merely represented a shortened version of auxiliary request 3 found allowable by the opposition division. During oral proceedings before the opposition division, the opponent refrained from presenting objections under Article 123(2) EPC against claim 1 of said auxiliary request 3 (minutes of oral proceedings before the opposition division, page 3, point 5, first paragraph). Thus, the deletion of this claim 1 in auxiliary request 3A did not lead to any modification of the opponent's case.

XI. The arguments of the opponent, where relevant to the present decision, may be summarised as follows:

Admissibility of the patentee's appeal:

- Article 12(2) RPBA 2007 stipulated that the statement of grounds of appeal should contain the party's complete case. As mentioned by the board in its preliminary opinion, the mere reference to arguments provided in previously filed letters as made by the patentee in its statement of grounds of appeal did not comply with this requirement.
- The short arguments contained on page 2 of the statement of grounds did not address the reasoning of the opposition division leading to the decision that claim 20 lacked novelty.
- Therefore, the appeal of the patentee should be regarded as inadmissible.

Novelty of claim 20 over D5:

- It had never been disputed that example 18 of D5 disclosed a latex polymer comprising all components of the composition defined in claim 20 as granted.
- The composition of claim 20 did not have to be suitable for internal coating. Nor was the food or beverage to be put into the can limited to any extent.
- Claim 20 did not specify any requirement to be fulfilled by the coating, let alone a flexibility requirement. The only requirement imposed by claim 20 was that the composition had to be suitable to be applied in a coating and that this coating had to be applicable to a metal surface which could be formed into a can.
- This requirement was clearly met by the composition of example 18. In fact, the latter was formulated into a coating composition that was applied to an aluminium panel (column 11 of D5).
- Claim 20 merely defined a latex polymer. As in D5, also according to the contested patent, paragraphs [0099] to [0103] and [0113], crosslinking agents and surfactants could be added to such a latex polymer to formulate a coating composition.
- Claim 20 did not require any specific Tg of the latex polymer. The flexibility of the final coating composition could be improved by the addition of several components. The Tg of the latex polymer as such did not have any influence on the flexibility of the final coating.

- According to the contested patent, the fact that a coating might show crazing after a reverse impact test did not mean that the coating was unsuitable for food and beverage cans. This was demonstrated by the results reported in table 10 on page 28 of the contested patent. Here the coatings of examples 29 to 33, all according to the invention, showed craze when subjected to the crazing reverse impact test described in paragraph [0135] of the patent in suit.
- Test report D23 demonstrated that the coating formulated from the latex polymer of D5's example 18 with at least 7.5% crosslinker did not show any crazing when subjected to the same reverse impact test.
- The criteria used to assess suitability of a coating for food and beverage cans had to be the same for the coatings described in the contested patent as well as for the coatings disclosed in the prior art.
- It had to be concluded that the subject-matter of claim 20 lacked novelty over the composition disclosed in example 18 of D5.

Admittance of D32a-c and D33 and the related submissions contained in the patentee's brief dated 10 December 2019:

- D32a-c were known to the patentee at least since 9 August 2019, date on which they were filed by the patentee with the EPO in the case concerning European patent EP 2 420 541, i.e. the divisional patent of the patent in suit.

- The patentee deliberately withheld the documents until the last possible day for making submissions in the present proceedings. For this reason alone, these documents should not be admitted.
- The fact that this evidence might be known to the opponent did not mean that the opponent could deal with it at such a late stage of the proceedings. Considering that the evidence was filed only one month prior to oral proceedings before the board and over the Christmas period, it was practically impossible for the opponent to deal with this evidence appropriately.
- Moreover, D32a-c represented evidence filed with the US Patent Office, i.e. under a different legislation. This made the statements contained in D32b totally irrelevant to the present proceedings.
- Point 14 of D32b, referred to by the patentee, merely contained the statement that external surfactants worsened the water resistance of the container coating. However, the water resistance of the coating obtained with the composition of example 18 of D5 was rated excellent, see table I in column 12 of D5, last line. Therefore, the above statement did not change the fact that the composition of example 18 of D5 was suitable in coating food and beverage cans.
- As regards D33, this was late-filed and reported that a coating containing 15% Cymel 303 failed the 4T bend test. However, no numerical values nor photographs were reported. It was obscure what the term "*failed*" meant in practice.

- Therefore, documents D32a-c and D33 and the related patentee's submissions should not be admitted into the proceedings.

Admittance of auxiliary requests 1 and 1A:

- The patentee's argument that it was surprised by the board's preliminary opinion and thus it filed these auxiliary requests as a reaction to this opinion could not be accepted.
- There could not be any surprise because the board did not raise any new issues in the preliminary opinion. The board merely tended to follow a line of argumentation presented by the opponent. This resided in the nature of *inter-partes* proceedings.
- Since the patentee had already been aware of all objections presented in the board's preliminary opinion, it might have presented auxiliary requests trying to overcome such objections at an earlier stage of the proceedings.
- The patentee avoided a discussion of claims 1 and 14 as granted in which the suitability of the claimed latex polymer for food and beverage cans did not play any role.
- Inventive step was only discussed in relation to a restricted version of claim 1, limiting the latex polymer to acrylates and methacrylates. All experimental tests of the opponent concentrated on such polymers. The closest prior art was selected accordingly.
- Therefore, the admittance of these auxiliary requests would render necessary a remittal to the department of first instance.

Compliance with Article 123(2) EPC of the subject-matter of auxiliary requests 2, 2B and 3 to 14:

- The combination of features defined in claim 1 of auxiliary request 2 resulted from cherry picking from preferred and not preferred embodiments in the application as filed, pages 11 to 13. Moreover, the amount of oxirane functional group-containing monomer also disclosed in these pages was not included in claim 1.
- No direct and unambiguous disclosure of such a combination was present in the application as filed.
- If the examples had to represent the basis for the claimed subject-matter, this subject-matter was a non allowable intermediate generalisation of the examples because not all features of the examples were included.
- The application as filed only disclosed the exclusion of both mobile and bound BPA. Thus, the disclaimer present in claim 1 of auxiliary request 2, only excluding bound BPA, did not have basis in the application as filed.
- Even assuming that a basis for the claimed disclaimer was present, this was clearly a non-preferred embodiment since mobile BPA was not excluded.
- It had to be concluded that the subject-matter of auxiliary request 2 and, for the same reasons, auxiliary requests 2B and 3 to 14, infringed Article 123(2) EPC.

Admittance of auxiliary requests 2A, 2C and 3A to 14A:

- The patentee's argument that these auxiliary requests were a reaction to the surprising negative preliminary opinion of the board could not be accepted.
- There could not have been any surprise because the board did not raise any new issues in the preliminary opinion. In fact, the opponent's objection under Article 123(2) EPC had already been raised before the opposition division and repeated in the opponent's statement of grounds of appeal.
- Therefore, the patentee could have filed these auxiliary requests much earlier in the proceedings. On the contrary, it waited until only one month prior to oral proceedings before the board and over the Christmas period. It was practically impossible for the opponent to deal with these auxiliary requests appropriately.
- As regards auxiliary request 3A, the passage of the minutes of the oral proceedings before the opposition division referred to by the patentee clearly stated that the opponent maintained its objections under Articles 84 and 123(2) EPC against the then pending auxiliary request 3, in particular against claim 1 of that request. However, since the opposition division had already decided on that matter, no further arguments had been presented. This did not mean that the objections had been withdrawn.
- Therefore, these auxiliary requests should not be admitted into the proceedings.

Reasons for the Decision

Applicable Rules of Procedure of the Boards of appeal

1. On 1 January 2020, the previously applicable Rules of Procedure of the Boards of appeal were replaced by new Rules of Procedure. The present decision has been issued after the new Rules of Procedure entered into force.
 - 1.1 Hereinafter, the requirement that the statement of grounds of appeal and the reply thereto should contain the party's complete case will be addressed. This requirement is present in Article 12(2) of the previous Rules of Procedure (hereinafter Article 12(2) RPBA 2007) and Article 12(3) of the new Rules of Procedure (hereinafter Article 12(3) RPBA 2020) and is expressed with a substantially identical wording. According to Article 25(1) of the transitional provisions of the new Rules of Procedure, for any appeal pending on the date of entry into force like the present one, the new Rules of Procedure shall apply subject to certain exceptions dealt with in paragraph 25(2) and (3) RPBA 2020. Article 12(3) RPBA 2020 is not among those exceptions. Hence, Article 12(3) RPBA 2020 rather than Article 12(2) RPBA 2007 applies and will be referred to in the following.
 - 1.2 In subsequent sections of the present decision, admittance of several submissions under the Rules of Procedure will be discussed, with these submissions having been filed after the summons to oral proceedings had been issued and before the entry into force of the new Rules of Procedure. For such a situation, Article 25(3) of the transitional provisions of the new Rules

of Procedure applies. According to this provision, Article 13(2) of the new Rules of Procedure shall not apply and instead Article 13 of the previous Rules of Procedure shall continue to apply. This means that at least Article 13(1) and (3) of the previous Rules of Procedure (hereinafter Article 13(1) and (3) RPBA 2007) applies and will be relied upon by the board in the following sections addressing admittance.

Admissibility of the appeal by the patentee

2. The opponent (XI *supra*) objected to the admissibility of the patentee's appeal.

The board disagrees for the following reasons.

- 2.1 Under Rule 101(1) EPC, the board shall reject an appeal as inadmissible, if it does not comply *inter alia* with Rule 99(2) EPC. This rule stipulates *inter alia* that in the statement of grounds of appeal, "*the appellant shall indicate the reasons for setting aside the decision impugned*".

- 2.2 In the present case, the opposition division came to, *inter alia*, the conclusion that the subject-matter of claim 20 as granted lacked novelty over documents D1 and D5 (impugned decision, page 10, points 2.5 to 2.7).

The reasons for this conclusion are given in point 2.6 of the impugned decision, which recites: "*The wording "for use in coating a food or beverage can" in the composition claim 20 has no limiting effect, said wording merely meaning that **the composition claimed is in fact suitable for the stated use**. The compositions known from D1 and D5 are in a form of latex **which renders them also suitable** for said use*" (emphasis added by the board).

This very short statement of the opposition division is more in the form of an assertion than of a reasoning. No explanation is given as to why the arguments submitted by the patentee had not been accepted.

- 2.3 The patentee's statement of grounds of appeal contains on page 2, second paragraph, the statement that documents D1 and D5 were "*not concerned with the coating of food or beverage cans*", so that it could not "*be unambiguously taken from these documents that the coating compositions described therein are suitable for coating food or beverage cans. Thus, novelty of claim 20 should be acknowledged*".

Moreover, in the third paragraph on page 2, the patentee made reference to the reproduction of D5's example 18, giving reasons why, presumably due to the high Tg, the compositions produced according to this example were not suitable for coating food or beverage cans.

- 2.4 The board did not share the patentee's view that the coating compositions of D1 and D5 could be considered unsuitable for coating food or beverage cans merely on the ground that the two documents were not concerned with that purpose. Nevertheless, the patentee's statement made it clear why it thought the opposition division's reasoning was wrong. This is all the more true since in view of the extremely short statement given by the opposition division to explain its conclusion about lack of novelty of claim 20 as granted (2.2 *supra*), the patentee could have only speculated what the reasoning behind this conclusion was. The reasons provided by the patentee in its statement of grounds of appeal were therefore considered sufficient

by the board to meet the requirements of Rule 99(2) EPC.

- 2.5 Since it was not disputed that the patentee's appeal also met the requirements of Articles 106 to 108 EPC as well as of Rule 99(1), sub-paragraphs (a) to (c), the board decided that the appeal by the patentee was admissible.

Main request - patent as granted - reading of claim 20

3. Claim 20 as granted defines (complete wording under II *supra*) a "*composition **for use in coating** a food or beverage can*" (emphasis added by the board).
- 3.1 Contrary to a formulation like "*composition for use **as a coating** of a food or beverage can*", the wording of claim 20 does not mean that the composition defined must be *as such* suitable for coating food and beverage cans. Rather, the composition of claim 20 can be rendered suitable for coating food and beverage cans by adding any further component.
- 3.2 This reading of claim 20 is confirmed by the contested patent itself, which in paragraphs [0038] and [0099] to [0113] teaches that a number of additional components may be added to the latex polymer defined in claim 20 to prepare a coating composition for food and beverage cans.

Main request - patent as granted - novelty of claim 20 under Article 54 EPC

4. The opponent objected to the novelty of the subject-matter of claim 20 as granted, *inter alia*, in view of example 18 of document D5.

4.1 Example 18 of D5 discloses (column 10, bottom) an emulsion polymerised latex polymer prepared as described in examples 5, 6 and 13 of D5. This emulsion polymerized latex polymer is prepared from acrylic acid functional polymer and dimethylethanolamine, which is a tertiary amine, a mixture of monomers including 0.97 wt-% glycidyl methacrylate, an oxirane-group-containing alpha, beta-ethylenically unsaturated monomer, based on the weight of the monomer mixture, and water (D5: column 8, table in example 6).

As not disputed by the patentee, this latex polymer of example 18 comprises all components defined in claim 20 as granted.

4.2 However, according to the patentee (*X supra*), this latex polymer of D5's example 18 was not suitable for coating food and beverage cans and therefore it did not anticipate the subject-matter of claim 20.

4.3 The board disagrees for the following reasons.

4.3.1 As mentioned under 3.1 and 3.2 above, claim 20 does not require that the latex polymer defined be suitable as *such* for coating food and beverage cans. In the same way, to anticipate the subject-matter of claim 20, the latex polymer of D5's example 18 does not have to be suitable as *such* for coating food and beverage cans. It suffices that it is demonstrated that it can be formulated into a suitable coating composition by adding any kind of component.

4.3.2 The opponent demonstrated by means of test report D23 that by adding a sufficient amount of the crosslinking agent Cymel 303 to the latex polymer of said example 18, a coating can be obtained showing optimal performances in a reverse impact test. In fact, D23

reports that already for a Cymel 303 concentration of 7.5 wt-%, the resulting coating showed no craze. The same result was obtained for Cymel 303 concentrations of 10, 20 and 30 wt-%.

- 4.3.3 Cymel 303 is also the crosslinking agent used in D5 itself to formulate, *inter alia*, the latex polymer of example 18 in a coating composition applied to aluminium panels (D5: column 11, lines 4 to 47). Cymel 303 is also a preferred crosslinking agent according to the contested patent, to be added to the latex polymer in an amount up to 50 wt-% (paragraphs [0103] and [0105]).
- 4.3.4 The reverse impact test used in D23 is the same test used in the contested patent (paragraph [0135]) to assess crazing of the coating. The coatings according to examples 29 to 33 of the contested patent (table 10 on page 28) showed crazing when subjected to said reverse impact test. Nevertheless, they represent coatings according to the invention. Therefore even coatings not meeting the reverse impact test are suitable for coating food and beverage cans.
- 4.3.5 This must be all the more true for the latex polymer of D5's example 18, which can be formulated into a coating composition showing optimal performances in terms of crazing in a reverse impact test. The board thus concludes that the latex polymer of said example 18 not only fulfils all compositional requirements of claim 20 but it is also suitable for use in coating food and beverage cans within the meaning of claim 20 at issue (3.1 and 3.2 *supra*). The latex polymer of D5's example 18 thus anticipates the subject-matter of claim 20.
- 4.4 The patentee argued (X *supra*), that food and beverage can coatings had to fulfil very stringent requirements.

However, no such requirement is mentioned in claim 20 for the composition it defines or any coating resulting from it. No limitation is present in claim 20 in this respect. In fact, as set out above, in the opposed patent compositions are considered suitable in coating food or beverage cans even though the resulting coatings show crazing.

- 4.5 The patentee's arguments (*X supra*) that D5 did not mention that the disclosed compositions might be used for coating food and beverage cans and that D5's compositions focused on different goals are totally irrelevant to the question of novelty of claim 20 as granted and could only play a role for the issue of inventive step. What counts for novelty is that the latex polymer of D5's example 18 meets the compositional requirements of claim 20 and that suitability for use in coating food and beverage cans was demonstrated.
- 4.6 For the same reasons, also the arguments (*X supra*) that the tests used in D5 to assess coating performances were not specific to food and beverage can coatings and that example 18 was not among the preferred embodiments of D5 are totally irrelevant to the question of novelty.
- 4.7 Furthermore, the patentee's argument (*X supra*) that in D15 the opponent stated that acrylics were too rigid for a food and beverage can coating is not relevant. On the one hand, D15 in the passage cited by the patentee (column 1, lines 62 to 64) refers to acrylic copolymers in general and not to the specific latex polymer of D5's example 18. On the other hand, the suitability of the latex polymer of D5's example 18 has been proven as set out above.

- 4.8 The argument (*X supra*) that the Tg of the latex polymer of D5's example 18 and the brittleness resulting from it was too high for a food and beverage can coating can also not be accepted. As set out under 3.1 and 3.2 above, the latex polymer of example 18 does not have to be suitable *as such* for coating food and beverage cans. During oral proceedings, the patentee did not contest that different agents could be added to the latex polymer of example 18 to increase its flexibility. The Tg of the latex polymer *as such* is not necessarily decisive for the brittleness of a coating deriving from such latex polymer by inclusion of additional substances, e.g. crosslinkers. Furthermore, no flexibility or Tg requirement is mentioned in claim 20 to be met by the composition defined or by any coating resulting from it.
- 4.9 The patentee (*X supra*) also referred to test report D9 showing that coatings obtained by adding 0%, 2.5% and 5% Cymel 303 to the latex polymer of D5's example 18 did not withstand the 4T bend test. However, this argument can also not change the above conclusion of lack of novelty. On the one hand, no resistance to said 4T bend test is required in claim 20, nor is this test mentioned in the contested patent. On the other hand, as set out above, test report D23 demonstrated that higher amounts of Cymel 303 resulted in coatings showing no crazing when subjected to the reversed impact test described in the contested patent.
- 4.10 The patentee (*X supra*) also pointed to a lack of precise information about the coating formulation disclosed in column 11, lines 4 to 17 of D5 to be prepared from the latex polymer of example 18 of this document. Due to this lack of precise information, it could not be argued that the coating formulation of D5

was suitable as coating for food or beverage cans. However, this lack of information, if any, is irrelevant since the latex polymer of example 18 as *such* has been shown to be suitable for use in coating food or beverage cans and thus anticipates the subject-matter of claim 20.

- 4.11 The further submissions of the patentee based on documents D32a-c and D33 do not need to be considered for the question of novelty over D5's example 18 since these were not admitted into the proceedings (see the section below).
- 4.12 Therefore, the board concludes that the subject-matter of claim 20 lacks novelty over example 18 of D5 (Articles 52(1) and 54 EPC). The ground for opposition under Article 100(a) EPC prejudices the maintenance of the patent as granted. As a consequence, the main request of the patentee is not allowable.

Admittance of D32a-c and D33 and the related submissions contained in the patentee's brief dated 10 December 2019

5. The patentee requested to admit the items of evidence D32a-c and D33 into the proceedings. The opponent requested that these items of evidence not to be admitted.

The board rejected the patentee's request for the following reasons.

Documents D32a-c

- 5.1 D32a-c were filed on 10 December 2019, i.e. only one month prior to oral proceedings. On the basis of these new items of evidence, the patentee alleged a new fact (*X supra*), namely, that the surfactant AOT-75 as contained in the latex polymer of D5's example 18,

would render this latex polymer unsuitable for coating food and beverage cans.

- 5.2 Therefore, the patentee's submission amounted to a new allegation of fact, based on new evidence, late-filed in appeal proceedings. It thus represented an amendment of the patentee's case, which can only be admitted at the board's discretion pursuant to Article 13(1) and (3) RPBA 2007.

Under Article 13(1) RPBA 2007, the board exercises its discretion in view of, *inter alia*, the complexity of the new subject-matter submitted, the state of the proceedings and the need for procedural economy.

Under Article 13(3) RPBA 2007, late-filed amendments of a party's case shall not be admitted if they raise issues which the board or the other party cannot reasonably be expected to deal with without adjournment of the oral proceedings.

- 5.3 Contrary to the patentee's view (X *supra*), the board considered that the new submission raised complex issues at a very late stage of the proceedings. In fact, admitting this new submission and related documents D32a-c would have required to assess what influence, if any, the presence of the surfactant AOT-75 in the latex polymer of D5's example 18 might have on the suitability of such latex polymer for use in coating food and beverage cans. Furthermore, D32b was a declaration filed by the opponent under the legislation of the United States. The implications that such a declaration could have under the EPC, the circumstances under which this declaration had been filed and the relevance to the present case would also have needed to be assessed. This completely new

assessment at such a late stage of the proceedings would also have been contrary to procedural economy.

5.4 Moreover, the patentee did not dispute that D32a-c were already known to it on 9 August 2019. The patentee could give no reasons why it waited until one month prior to oral proceedings to file these documents.

5.5 The opponent could also not reasonably be expected to deal with D32a-c and the related patentee's submission without adjournment of the oral proceedings. The opponent would have needed time to check the issue of the presence of AOT-75 in the latex polymer of example 18 of D5 with its technical experts and possibly provide counter-evidence. The board regards one month as not sufficient time to appropriately respond to these complex issues raised by the patentee.

5.6 In exercising its discretion under Article 13(1) and (3) RPBA 2007, the board thus decided not to admit D32a-c and the related submission of the patentee into the proceedings.

Test report D33

6. Like D32a-c, also D33 was also filed with the letter dated 10 December 2019. On the basis of the data contained in this document, the patentee argued that the opponent's data filed with D23 were not correct. This document had to be admitted since it was a reaction to the opponent's filing of D23.

6.1 The board did not agree. The board considered that D33 did not represent a timely reaction to test report D23 filed by the opponent. In fact, D23 had been filed on 14 March 2016 with the opponent's response to the patentee's statement of grounds of appeal. The patentee

thus waited almost four years before submitting D33 only one month prior to oral proceedings.

6.2 In addition to this extremely late-filing, for which no justification was provided, D33 raised complex issues at a very late stage of the proceedings. In fact, admitting this test report would have required assessing what the term "*failed*" had meant in the following sentence of D33: "*the coating containing 15% Cymel 303 crosslinker showed a lack of flexibility and **failed** the 4T bend testing*" (emphasis added by the board). In fact, no numerical values or photographs of the coating were included in D33. An assessment would also have had to be made of what influence such a *failing* of the 4T bend testing might have on the suitability of the tested composition for use in coating food and beverage cans, especially in view of the positive results showed by the opponent (D23) by the crazing reverse impact test. Furthermore, while the crazing reverse impact test was used in the contested patent (paragraph [0135]) to assess coating performance, the 4T bend test used in D33 was not mentioned in the contested patent. These completely new assessments at such a late stage of the proceedings would also have been contrary to procedural economy.

6.3 Moreover, the opponent could also not reasonably be expected to deal with D33 and the related patentee's submission without adjournment of the oral proceedings. The opponent would have needed time to check the statements made in D33 with its technical experts and possibly provide experimental counter-evidence. The board regards one month as a not sufficient time to appropriately respond to these complex issues raised by the patentee.

6.4 In exercising its discretion under Article 13(1) and (3) RPBA 2007, the board thus decided not to admit D33 and the related patentee's submissions into the proceedings.

Auxiliary requests 1, 1A, 2A, 2C and 3A to 14A - admittance into the proceedings

7. Auxiliary requests 1, 1A, 2A, 2C and 3A to 14A were filed by the patentee on 10 December 2019, i.e. one month prior to oral proceedings before the board. The set of claims of auxiliary request 1 differs from the claims as granted in that granted claim 20 was deleted. The set of claims of auxiliary request 1A differs from the claims as granted in that granted claims 1 to 13, 16, 17, 19 and 20 were deleted. Auxiliary requests 2A, 2C and 3A to 14A contain various restrictions of independent claim 14 as granted. Moreover, all claims corresponding to granted claims 1 to 13 have been deleted.

The patentee requested that these auxiliary requests be admitted into the proceedings. The opponent requested that these auxiliary requests not be admitted.

The board rejected the patentee's request for the following reasons.

7.1 It was undisputed that the filing of auxiliary requests 1, 1A, 2A, 2C and 3A to 14A represented an amendment of the patentee's case presented only one month prior to oral proceedings before the board. In the same way as for D32a-c and D33, *inter alia* Article 13(1) RPBA 2007 applied. Under Article 13(1) RPBA 2007, such an amendment might only be admitted and considered at the board's discretion. This discretion should be exercised in view of *inter alia* the complexity of the new

subject-matter submitted, the current state of the proceedings and the need for procedural economy.

7.2 As stated by the Enlarged Board of Appeal (R 16/09, reasons, 2.2.4), lateness alone can outbalance the further criteria mentioned in Article 13(1) RPBA 2007 and become decisive when exercising the discretion to admit or not, *inter alia*, late-filed claim requests (R 16/09, reasons, 2.2.12; see also T 0253/10, reasons, 2.3). Hence, the very fact that auxiliary requests 1, 1A, 2A, 2C and 3A to 14A have been filed extremely late in the present appeal proceedings was sufficient reason alone not to admit these requests.

7.3 Moreover, during opposition proceedings, the patentee had filed 14 claim requests before the opposition division that were re-filed with its statement of grounds of appeal. All these requests contained a restriction of both independent claims 1 and 14. This led the opponent and the board to believe that those requests contained all the amendments the patentee considered to be necessary (T 0248/13, reasons, 4.3).

This belief was reinforced by the fact that until one month prior to oral proceedings before the board, the patentee never manifested any intention to go in a different direction, namely, to delete granted claim 20 while leaving claims 1 and/or 14 unamended (auxiliary requests 1 and 1A) or to delete all claims corresponding to granted claims 1 to 13 and focus only on the restrictions of granted claim 14 (auxiliary requests 2A, 2C and 3A to 14A). This direction was chosen only one month before the oral proceedings by filing auxiliary requests 1, 1A, 2A, 2C and 3A to 14A.

This change of direction was further aggravated by the fact that the newly filed auxiliary requests were not

convergent. For example auxiliary requests 1, 1A, 3A, 4A, 7A, 8A and 11A to 14A did not contain any composition claim whereas the latter was reinserted into auxiliary requests 2A, 2C, 5A, 6A, 9A and 10A. Moreover, while auxiliary requests 2C, 4A, 6A, 8A, 10A and 12A to 14A were restricted to the coating of an inside surface of a food and beverage can, this restriction was not present in auxiliary requests 1, 1A, 2A, 3A, 5A, 7A, 9A and 11A.

The opponent (and the board) was thus confronted with a target that was moved almost at the end of the appeal proceedings. This implied high complexity both in procedural and technical terms which was a further reason for not admitting auxiliary requests 1, 1A, 2A, 2C and 3A to 14A into the proceedings.

7.4 The patentee has not argued, and the board did not see any reason to assume, that the high number of differently amended requests was occasioned by a high number of objections from the opponent. On the contrary the number of objections was relatively small and the high number of requests and related amended independent claims not commensurate with that number of objections.

7.5 The patentee argued (*X supra*) that the independent claims of auxiliary requests 1 and 1A corresponded to granted independent claims and that the opposition division had decided that these claims were novel. Therefore, the opponent should have been prepared to discuss these claims. Moreover, the board would have had to deal with these claims in respect of the main request, if granted claim 20 had been found novel.

This argument is not convincing. It is not the task of the opponent (or the board) to speculate about what amendments the patentee might make at a very late stage

of the proceedings and to prepare pre-emptively for all of them (T 0248/13, reasons, 4.5).

- 7.6 Moreover, the notice of opposition (page 11, point 2.16.2) already contained the opponent's novelty objection against granted claim 20 in view of D5's example 18. This objection was accepted by the opposition division, which also found the subject-matter of claim 20 to be not novel over said example 18. Consequently, the patentee could and should have filed auxiliary requests 1 and 1A already before the department of first instance. This was even more true when considering that during oral proceedings before the opposition division, the patentee was informed (minutes of oral proceedings before the opposition division, page 1, point 2, last paragraph) that remaining independent claims, i.e. *inter alia* claims 1 and 14, were found to be novel by the opposition division. At that point in time, the patentee could and should have filed requests not containing claim 20 anymore.
- 7.7 Furthermore, the patentee appealed the opposition division's decision, and it would thus have been on it to show that this decision was wrong and to present its complete case - including present auxiliary requests 1 and 1A - with its statement of grounds of appeal at the latest (Article 12(3) RPBA 2020). Instead, the patentee waited until one month prior to oral proceedings before the board to file auxiliary requests 1 and 1A.
- 7.8 The patentee also argued (X *supra*) that auxiliary requests 1 and 1A were filed to overcome *inter alia* the novelty objection raised by the board in its preliminary opinion. However, as mentioned above, this objection was already contained in the notice of

opposition and was furthermore reiterated by the opponent in its response to the patentee's statement of grounds of appeal. The board did not raise any new novelty issue in its preliminary opinion. The mere fact that the board tended to concur with the opponent's objection and with the decision of the opposition division resided in the very nature of *inter-partes* proceedings and could not justify the filing of auxiliary requests at an extremely late stage of the proceedings.

7.9 In a similar way as for auxiliary requests 1 and 1A, the patentee also argued (*X supra*) that auxiliary requests 2A, 2C and 3A to 14A were filed to overcome the objection under Article 123(2) EPC as raised by the board in its preliminary opinion against the subject-matter of auxiliary requests 2, 2B and 3 to 14. However, this objection was already contained in the opponent's statement of grounds of appeal (section 4 on pages 2 to 4). The board did not raise any new added matter issue in its preliminary opinion. The mere fact that the board tended to concur with the opponent's objection resided in the very nature of *inter-partes* proceedings and could not justify the filing of auxiliary requests at an extremely late stage of the proceedings. Consequently, the patentee could and should have filed its complete case, namely auxiliary requests aiming at overcoming such an objection with its reply to the opponent's statement of grounds of appeal at the latest (Article 12(3) RPBA 2020). Instead, the patentee waited until one month prior to oral proceedings before the board to file auxiliary requests 2A, 2C and 3A to 14A.

7.10 At the oral proceedings before the board, the patentee also argued (*X supra*) that the admittance of auxiliary

requests 2A, 2C and 3A to 14A would not lead to a modification of the opponent's case. The patentee referred to the minutes of oral proceedings before the opposition division (page 3, point 5, first paragraph), according to which the opponent refrained from presenting objections under Article 123(2) EPC against claim 1 of the then pending third auxiliary request, which was now deleted in auxiliary requests 2A, 2C and 3A to 14A.

The board could not accept this argument, either. The passage of the minutes referred to by the patentee recited that the "*Opponents were of the opinion that the claims of the Third Auxiliary Request **would not satisfy** the requirements of Articles 84 **and 123(2) EPC***" (emphasis added by the board). However, since the opposition division had already concluded as regards the then pending first auxiliary request, that the requirements of Article 123(2) EPC had been met and that the same reasoning also applied to said pending third auxiliary request (impugned decision, page 12, points 6.1 and 6.2), the opponent did not repeat its arguments. However, the above passage of the minutes clearly showed that the objection under Article 123(2) EPC was maintained by the opponent.

- 7.11 The patentee also argued (X *supra*) that claim 1 of e.g. auxiliary request 2A had been fully examined by the opposition division because it was identical to claim 13 of the then pending third auxiliary request found allowable by the opposition division. The situation was thus totally different to that with auxiliary requests 1 and 1A. The opponent should have been prepared to discuss this claimed subject-matter.

However, as set out above, for both auxiliary requests 1 and 1A on the one hand, and *inter alia* auxiliary request 2A on the other hand, the lateness of their filing and the complexity linked with them spoke against admittance. There was thus no fundamental difference justifying the admittance of e.g. auxiliary request 2A.

7.12 In exercising its discretion under Article 13(1) RPBA 2007, the board thus decided not to admit auxiliary requests 1, 1A, 2A, 2C and 3A-14A into the proceedings.

Auxiliary requests 2, 2B and 3 to 14 - compliance with Article 123(2) EPC

8. Claim 1 of auxiliary request 2 recites as follows, whereby the amendments as compared to claim 1 as granted are highlighted by the board:

"1. A method of coating a food or beverage can, the method comprising:

forming a composition comprising an emulsion polymerized latex polymer and being substantially free of bound bisphenol A and aromatic glycidyl ether compounds, comprising:

forming a salt of an acid- or anhydride-functional polymer and an amine in a carrier comprising water to form an aqueous dispersion;

combining an ethylenically unsaturated monomer component with the aqueous dispersion; and

*polymerizing the ethylenically unsaturated monomer component in the presence of the aqueous dispersion to form an emulsion polymerized latex polymer, **wherein the ethylenically unsaturated monomer component comprises a***

mixture of monomers comprising at least one oxirane functional group-containing monomer, wherein at least 40 wt-% of the ethylenically unsaturated monomer component are selected from alkyl acrylates and methacrylates, and

applying the composition comprising the emulsion polymerized latex polymer to a metal substrate prior to or after forming the metal substrate into a food or beverage can or portion thereof."

8.1 Claim 1 was amended when compared to claim 1 as filed, by adding the following features:

- (a) The composition is substantially free of BPA and aromatic glycidyl ether compounds.
- (b) The ethylenically unsaturated monomer component comprises a mixture of monomers.
- (c) The mixture of monomers comprises at least one oxirane functional group-containing monomer.
- (d) At least 40 wt-% of the ethylenically unsaturated monomer component are selected from alkyl acrylates and methacrylates.

The combination of all these features was not included in claim 1 as granted. Thus, the board has to examine whether or not the claimed combination has a basis in the application as filed (Article 123(2) EPC).

8.2 Contrary to the patentee's view (X *supra*), the board considers that the above combination of features extends beyond the content of the application as filed, and this for the following reasons.

8.2.1 Feature (a) is disclosed in the application as filed in the second sentence of the passage on page 4, lines 13 to 15. This passage reading as follows:

"In certain embodiments, the composition is substantially free of mobile BPA and aromatic glycidyl ether compounds. Preferably, the composition is substantially free of bound BPA and aromatic glycidyl ether compounds".

Contrary to the patentee's opinion, the board regards the second sentence in the above-quoted passage to be linked to the previous one, reciting that *"In certain embodiments, the composition is substantially free of **mobile BPA** and aromatic glycidyl ether compounds"* (emphasis added by the board). In other words, the whole paragraph on page 4, lines 13 to 15, requires that the composition not only be free of bound BPA but also of mobile BPA. This reading is confirmed by the fact that the preceding and subsequent paragraphs all have the same structure as the above-quoted paragraph, i.e. they all start with "In certain embodiments" and all contain in their second sentence (if present) preferred forms of these certain embodiments. Moreover, the application as filed on page 10, lines 3 to 11, states that *"Preferred compositions are substantially free of **mobile** bisphenol A (BPA) and aromatic glycidyl ether compounds [...]. The coating composition is **also** preferably substantially free of bound BPA and aromatic glycidyl ether compounds"* (emphasis and square brackets added by the board), which also confirms the above reading. The same is further confirmed by claims 16 and 17 as filed, which also require that the composition be free of mobile **and** bound BPA and aromatic glycidyl ether compounds. Consequently, the application as filed

cannot provide a basis for feature (a) as recited in claim 1 at issue. Even assuming that the application as filed disclosed feature (a), a selection from the application as filed would still be required to include feature (a) in claim 1 of auxiliary request 2. Such a selection would definitely not be preferred since the presence of mobile BPA is not excluded from claim 1 at issue contrary to the preferred embodiments disclosed in the passages referred to above and to the general statement on page 1, lines 26 to 32, of the application as filed, which expresses the *strong desire* to eliminate *inter alia* mobile BPA from food contact coatings.

The patentee also referred to D21, point 8, to argue that feature (a) was disclosed in the application as filed. D21 is a declaration filed by the opponent, which, at point 8 referred to by the patentee, recites that "*one of ordinary skill would understand that the way to ensure that the latex polymer is substantially free of the undesired compounds is not to use materials containing them in the first place*". The board acknowledges that this is in line with what is disclosed in the application as filed, namely that both mobile and bound BPA must be absent. However, such a statement does not support the patentee's allegation that there was basis for the absence of bound BPA only, i.e. without the contemporary exclusion of mobile BPA.

- 8.2.2 As regards features (b) and (c), the patentee invoked claim 10 as filed as the basis in the application as filed. Indeed, claim 10, in combination with claim 9, recites the inclusion of features (b) and (c). However, as claim 10 is a dependent claim, its subject-matter represents a second selection to be made within the

application as filed in order to arrive at claim 1 of auxiliary request 2.

- 8.2.3 As regards feature (d), the patentee referred to page 11, lines 21 to 25, and page 12, line 30, to page 13, line 1, of the application as filed.

The type of monomer component included in feature (d) is disclosed on page 11, lines 21 to 25, of the application as filed. More specifically, page 11 recites that the "*oxirane-functional monomer is preferably reacted with suitable other monomers within the monomer mixture. These can be ethylenically unsaturated monomer and hydroxy-functional monomers*". Among the ethylenically unsaturated monomers, alkyl (meth)acrylates are then mentioned within a list of several other possible monomers. However, the concentration (second part of feature (d)) is not stated, nor is a preference for alkyl (meth)acrylates over the other listed ethylenically unsaturated monomers and hydroxy-functional monomers expressed. Therefore, the inclusion alone of alkyl acrylates and methacrylates *as such* represents a further selection to be made within the application as filed for which no preference is expressed.

As regards the concentration of at least 40 wt-% included in feature (d), the passage from page 12, line 25, to page 13, line 2, recites that the "*oxirane group-containing monomer preferably constitutes 0.1 wt-% to 30 wt-% [...] of the ethylenically unsaturated monomer component. The other monomer or monomers in the mixture constitute the **remainder** of the monomer component, that is, **70 wt-%** to 99.9 wt-% [...] based on total weight of the monomer mixture. Preferably, at least **40 wt-%** of the ethylenically unsaturated monomer*

component, more preferably at least 50 wt-%, will be selected from alkyl acrylates and methacrylates. Preferably, at least 20 wt-%, more preferably at least 30 wt-%, will be selected from vinyl aromatic compounds" (emphasis and square brackets added by the board).

From the above passage, it can be concluded that the concentration of at least 40 wt-% alkyl acrylates and methacrylates is not directly and unambiguously disclosed in the application as filed separately from a concentration of the oxirane group-containing monomer of 0.1 wt-% to 30 wt-%. This also in view of the amounts of alkyl acrylates and methacrylates and vinyl aromatic compounds, which, according to the cited passage, add up to at least 70 wt-%, corresponding to the maximum value of 30 wt-% of the oxirane group-containing monomer as disclosed in the cited passage on page 12.

However, this amount of the oxirane group-containing monomer from 0.1 wt-% to 30 wt-% was not included in feature (d). Therefore, the concentration included in feature (d) as such represents an intermediate generalisation of the above embodiment disclosed from page 12, line 25, to page 13, line 2, of the application as filed, for which no direct and unambiguous disclosure exists in the application as filed.

- 8.2.4 The patentee's observation (X *supra*) that all examples of the contested patent fall under claim 1 of auxiliary request 2 can also not constitute a reason why the subject-matter of claim 1 of auxiliary request 2 would have basis in the application as filed. In fact, the examples disclose compositions that are much more

specific than the one defined in claim 1 at issue, which must have a basis as *such*, i.e. in its broadest form, in the application as filed.

8.3 In view of the above, the board concludes that the combination of above mentioned features (a) to (d) included in claim 1 of auxiliary request 2 is not directly and unambiguously disclosed in the application as filed. Consequently, auxiliary request 2 does not meet the requirements of Article 123(2) EPC and is not allowable.

8.4 Since the combination of above features (a) to (d) is contained at least in claim 1 according to all auxiliary requests 2B and 3 to 14, the above considerations under Article 123(2) EPC made for auxiliary request 2 apply *mutatis mutandis* also to all these auxiliary requests.

The board thus concludes that none of auxiliary requests 2B and 3 to 14 complies with Article 123(2) EPC. These auxiliary requests are also not allowable.

Conclusions

9. None of the patentee's requests is both admissible and allowable.

Order

For these reasons it is decided that:

1. The appealed decision is set aside.
2. The patent is revoked.

The Registrar:

The Chairman:



N. Maslin

M. O. Müller

Decision electronically authenticated