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**Datasheet for the decision  
of 28 November 2019**

**Case Number:** T 0384/16 - 3.3.02

**Application Number:** 01650041.5

**Publication Number:** 1162242

**IPC:** C09D7/00

**Language of the proceedings:** EN

**Title of invention:**

Rheological additives and paint and coating compositions containing such additives exhibiting improved intercoat adhesion

**Patent Proprietor:**

Elementis Specialties, Inc.

**Opponents:**

Kusumoto Chemicals, Ltd.  
ARKEMA France

**Headword:**

**Relevant legal provisions:**

EPC Art. 100(c), 123(2), 84  
EPC R. 80  
RPBA Art. 12(4), 13(1)

**Keyword:**

Amendments

Claims - clarity

Late-filed auxiliary requests

Late-filed facts

**Decisions cited:**

G 0003/14, T 0759/10

**Catchword:**



**Beschwerdekammern**

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Case Number: T 0384/16 - 3.3.02

**D E C I S I O N**  
**of Technical Board of Appeal 3.3.02**  
**of 28 November 2019**

**Appellant:** Elementis Specialties, Inc.  
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**Decision under appeal:** **Decision of the Opposition Division of the  
European Patent Office posted on 8 December 2015**

revoking European patent No. 1162242 pursuant to  
Article 101(3) (b) EPC.

**Composition of the Board:**

<b>Chairman</b>	M. O. Müller
<b>Members:</b>	S. Bertrand
	L. Bühler

## Summary of Facts and Submissions

I. The appeal by the patent proprietor (hereinafter "appellant") lies from the decision of the opposition division to revoke European patent EP 1 162 242.

II. The main request on which the decision of the opposition division was based contained a set of three claims, independent claim 1 of which reads as follows:

*"1. Use of a paint or coating composition with improved intercoat adhesion containing a rheological additive consisting essentially of the reaction product of:*

- a) ethylene diamine;*
- b) hexanoic acid; and*
- c) 12-hydroxystearic acid*

*for avoiding impairment of recoatability when the paint or coating composition is painted or coated over with a second paint or coating composition."*

III. The opposition division came *inter alia* to the following conclusions:

- The amendment of the term "comprising" in claim 1 as originally filed to the term "consisting essentially of" in claim 1 of each of the main request and the first auxiliary request and the omission of the drying step in claim 1 of each of these requests infringed Article 123(2) EPC.
- The effect of "avoiding impairment of recoatability" to be achieved according to use claim 1 of each of the second to fifth auxiliary requests was not clear within the meaning of Article 84 EPC.

- IV. In its statement setting out the grounds of appeal, the appellant submitted a main request and seven auxiliary requests. It contested the reasoning of the opposition division and submitted that the amendment of the term "comprising" to the term "consisting essentially of" in claim 1 of the main request did not infringe Article 123(2) EPC and that claim 1 of the main request did not introduce any lack of clarity.
- V. In its reply to the statement of grounds of appeal opponent 2 (hereinafter "respondent 2") rebutted the appellant's arguments and requested that the impugned decision be confirmed and the contested patent revoked.
- VI. Thereafter, the board summoned the parties to oral proceedings.
- VII. Both opponent 1 (hereinafter "respondent 1") and the appellant informed the board that they would not attend the oral proceedings and would not make any (further) submissions.
- VIII. The board issued a communication in preparation for the oral proceedings scheduled according to the requests of the parties.
- IX. In a subsequent letter dated 13 November 2019, respondent 2 filed further submissions against the patentability of the claims on file.
- X. Oral proceedings before the board were held on 28 November 2019.

XI. The appellant's case, where relevant to the present decision, may be summarised as follows.

Amendments in claim 1 of the main request:

- Independent claim 1 was based on claim 1 as granted; however, the claim category was changed by reformulating the granted product claim 1 into a use claim.
- Moreover, compared with claim 1 as granted, the rheological additive mentioned in claim 1 had been further restricted as regards the components a) and b). The diamine component a) had been specified as ethylene diamine and the straight chain monocarboxylic acid b) had been specified as hexanoic acid based on the disclosure in originally filed claim 3 as well as the disclosure on page 3, line 58 of the publication document EP 1 162 242 A1.
- A person skilled in the art would readily be aware of the fact that an embodiment, where the paint or coating composition as claimed contained a rheological additive that essentially consisted of the reaction product of components a) to c) as defined in claim 1, was indeed part of the disclosure of the original application and, as such, clearly and unambiguously derivable. The term "consisting essentially of" was clearly based on the description and the examples of the application as filed.

Clarity:

- Claim 1 of each of the requests was a reworded version of granted claim 1 from a product claim to a use claim and included only terms and expressions used in the granted claims. Thus, claim 1 did not introduce any lack of clarity which was not already present in granted claim 1. Claim 1 was not contestable under Article 84 EPC in accordance with G 3/14.

XII. The case of respondent 2, where relevant to the present decision, may be summarised as follows.

Amendment in claim 1 of the main request:

- The replacement of the term "comprising" by the term "consisting essentially of" violated Article 123(2) EPC. There was no clear and unambiguous basis in the application as filed for this replacement as required by T 759/10.

Admittance of the first to third auxiliary requests:

- The first to third auxiliary requests should have been filed during the opposition phase. The first auxiliary request also introduced new clarity objections.

Admittance of the objections under Articles 123(2), (3) and 84 EPC raised in the letter dated 13 November 2019:

- The clarity objections were derivable from the reply to the statement of grounds of appeal and should for this reason be admitted into the proceedings.



Clarity - Claim 1 of the first auxiliary request:

- It was not clear where to measure intercoat adhesion in a multilayer system comprising three layers of paint or coating composition and according to which method. Furthermore, claim 1 of the first auxiliary request contained an inconsistency owing to the simultaneous presence of the term "consisting of" and the feature "optionally d) a catalyst".

Rule 80 EPC - Claim 1 of the first auxiliary request:

- The addition of the term "and optionally d) a catalyst" was not occasioned by a ground of opposition under Article 100 EPC.

XIII. The parties' requests were the following:

- The appellant had requested in writing that the decision under appeal be set aside and that the patent be maintained in amended form on the basis of the main request or any of the first to seventh auxiliary requests, all filed with the statement of grounds of appeal.
- Respondent 2 requested that the appeal be dismissed and that the main request and the first to third auxiliary requests not be admitted into the appeal proceedings. It further requested that the case be remitted to the opposition division for a decision on sufficiency, novelty and inventive step, should the board come to the conclusion that the appellant's claim requests did not contravene either of Article 123(2), (3) EPC or Article 84 EPC.

XIV. Respondent 1 did not file any requests and did not make any submissions in substance.

### **Reasons for the Decision**

1. The appellant and respondent 1 were duly summoned but did not attend the oral proceedings. The board continued the proceedings in their absence pursuant to Rule 115(2) EPC and treated the appellant as relying on its written case in accordance with Article 15(3) RPBA 2007.

Main request - Claim 1

2. Admittance

Respondent 2 requested that the main request not be admitted. During the oral proceedings, the board decided to admit the main request into the proceedings. In view of its non-allowability (see below), reasons for its admittance do not need to be given.

3. Amendment - Articles 100 c) and 123(2) EPC

3.1 Claim 1 of the main request relates to the "*Use of a paint or coating composition for improving intercoat adhesion, wherein the paint or coating composition contains a rheological additive **consisting essentially of** the reaction product of:*

*a) ethylene diamine;*

*b) hexanoic acid; and*

*c) 12-hydroxystearic acid" (bold type added by the board).*

- 3.2 Claim 1 of the main request is derived from the combination of claims 1, 3, 5 and 6 as originally filed, wherein the term "heptanoic acid" was deleted, and wherein the claim was recast as a use claim. Furthermore, the term "consisting essentially of" was introduced in place of the term "comprising" present in originally filed claim 1.
- 3.3 Respondent 2 submitted that the replacement of the term "comprising" by the term "consisting essentially of" violated Article 123(2) EPC.
- 3.4 As acknowledged by the appellant, the application as filed does not contain any literal basis for the term "consisting essentially of".
- 3.5 The requirement that a composition consists essentially of certain compounds is generally accepted to mean that the composition contains the certain compounds and possibly additional compounds, provided these do not materially affect the essential characteristics of the composition (see e.g. decision T 759/10, reasons 3.1 to 3.6). In the present case, it thus has to be examined whether in the application as filed the rheological additive may contain, apart from the reaction product of components a) to c), additional components, the nature and the amount of which do not materially affect the essential characteristics of the rheological additive.

As set out above, originally filed claim 1 relates to "a rheological additive comprising the reaction product of" three components a), b) and c). This means that the rheological additive may, for instance, comprise 5 wt.% of the reaction product of components a) to c) and 95

wt.% of any other additive. These other additives may affect the essential characteristics of the rheological additive, contrary to what is now implied by claim 1. Originally filed claim 1 does not therefore provide the required basis.

Contrary to the appellant's submission (X, *supra*), the term "consisting essentially of" is not clearly based on the examples of the application as filed. The only example which gives details is example 1 of the application as originally filed. In example 1, the rheological additive consists of the reaction product of components a) to c). Example 1 is silent as to the additional components which do not materially affect the essential characteristics of the rheological additive, and does not provide the required basis for the additional components.

3.6 For these reasons, the amendment of the term "comprising" to the term "consisting essentially of" in claim 1 of the main request infringes Articles 100 c) and 123(2) EPC.

3.7 The main request is therefore not allowable.

First auxiliary request

4. Claim 1 of the first auxiliary request relates to the *"Use of a paint or coating composition for improving intercoat adhesion, wherein the paint or coating composition contains a rheological additive consisting of the reaction product of:*

- a) ethylene diamine;*
- b) hexanoic acid;*
- c) 12-hydroxystearic acid; and optionally*
- d) a catalyst."*

Claim 1 of the first auxiliary request differs from claim 1 of the main request in that the term "consisting essentially of" in claim 1 of the main request was replaced by the term "consisting of" and in that the term "optionally d) a catalyst." was added into the claim.

5. Admittance of the first auxiliary request

5.1 During the oral proceedings, respondent 2 objected to the admittance of the first auxiliary request into the proceedings because firstly the request introduced new clarity objections and secondly, it should have already been filed before the opposition division pursuant to Article 12(4) RPBA 2007.

5.2 The allegation that the first auxiliary request would introduce new clarity objections relates to the clear allowability of the new claim set and, linked thereto, to the need for procedural economy. This is however a criterion for admittance under Article 13(1) RPBA 2007, which comes into play only after the statement of grounds of appeal and the reply thereto have been filed. Since the first auxiliary request was filed with the statement of grounds of appeal, the alleged incompatibility with procedural economy cannot prejudice admittance of this request.

The second objection, namely that the first auxiliary request could have been presented in the first-instance proceedings, is based on Article 12(4) RPBA 2007.

5.3 Since the claim set of the first auxiliary request was filed with the statement setting out the grounds of appeal, Article 12(4) RPBA 2007 applies. The claims of

the first auxiliary request merely differ from those of the second auxiliary request pending before the opposition division in that in claim 1:

- The term "with improved intercoat adhesion" was amended to read "*for improving intercoat adhesion*".
- The term "for avoiding impairment of recoatability when the paint or coating composition, after drying, is painted or coated over with a second paint or coating composition" was deleted.

5.4 These amendments were made to overcome the lack of clarity of the term "*for avoiding impairment of recoatability when the paint or coating composition is painted or coated over with a second paint or coating composition*" raised for claim 1 of the second auxiliary request submitted during the opposition proceedings (fourth paragraph of page 5 to penultimate paragraph of page 6 of the opposition division's decision).

Consequently, the first auxiliary request is a reasonable reaction to the decision of the opposition division. In the absence of any argument to the contrary, it could not thus have been filed during the first-instance proceedings.

5.5 In view of the above, the board decided to admit the first auxiliary request into the proceedings pursuant to Article 12(4) RPBA 2007.

6. Admittance of the objections under Articles 123(2), (3) and 84 EPC
- 6.1 Admittance of the objection under Article 123(2) EPC
  - 6.1.1 Claim 1 of the first auxiliary request refers to the "Use of a paint or coating composition for improving intercoat adhesion, wherein the paint or coating composition contains a rheological additive". Claim 6 as filed discloses "*A paint or coating composition with improved intercoat adhesion containing the rheological additive of any of Claims 1 to 5*".
  - 6.1.2 Respondent 2 argued that the use of a paint for improving intercoat adhesion added matter contrary to Article 123(2) EPC.
  - 6.1.3 The objection was essentially based on the allegation that the description of the application as filed disclosed that the improvement of the intercoat adhesion between two layers was achieved by the use of the rheological additive in the inner layer (see paragraph [0004] of the application as filed). The application as filed did not disclose the improvement of the intercoat adhesion of a system comprising three different layers A, B and C, the improvement of the intercoat adhesion between the two inner layers A and B being achieved by the paint or coating composition comprising the rheological additive used for preparing the outer layer C. However, claim 1 of the first auxiliary request covered the improvement of the intercoat adhesion in such a system comprising three layers and for that reason, contained subject-matter extending the content of the application as filed. Respondent 2 further submitted that the term "with improved intercoat adhesion" in originally filed claim

6 was a result to be achieved and that the composition used for improving intercoat adhesion in claim 1 of the first auxiliary request would be different from the composition of originally filed claim 6.

6.1.4 The first auxiliary request was filed with the statement setting out the grounds of appeal. Respondent 2 submitted in its reply to the statement of grounds of appeal no explicit objection under Article 123(2) EPC (paragraph "*B) Requête subsidiaire 1*" on page 6), and no implicit objection under this article is derivable therefrom, i.e. from the submissions regarding, for example, the allowability of the main request made by respondent 2. In fact, as not disputed by respondent 2, this objection had been raised for the first time with the letter dated 13 November 2019 and was only clarified during the oral proceedings (last paragraph on page 2 of the minutes). This objection thus represents a new allegation of fact submitted for the first time after the summons to oral proceedings. The admittance of the objection of respondent 2 is thus at the board's discretion under Article 13(1) RPBA

Had this new objection of respondent 2 been admitted, the following questions would have had to be discussed:

- Does the disclosure of a paint or coating composition with improved intercoat adhesion give a basis for the use of said composition for improving intercoat adhesion?
- Was the improvement of the intercoat adhesion in a system comprising three layers A, B and C encompassed by claim 1 of the first auxiliary request but not disclosed in the application as filed ?



The objection under Article 123(2) EPC made by respondent 2 thus raised complex new issues.

Consequently, the board, in application of Article 13(1) RPBA 2007, decided not to admit the new allegation of fact based on the objection pursuant to Article 123(2) EPC into the proceedings.

## 6.2 Admittance of the objections under Article 84 EPC

The objections of lack of clarity are based on the allegation that it is not clear where to measure intercoat adhesion and according to which method.

In the same way as the objection of respondent 2 under Article 123(2) EPC, the objections under Article 84 EPC were presented in full only with its letter dated 13 November 2019 and clarified during the oral proceedings. However, unlike the objection under Article 123(2) EPC, they are not entirely new objections. More specifically, the submission regarding the multilayer system with three layers was based on the submission already made in the reply to the statement of grounds of appeal, see paragraph "A2) *Défaut de clarté selon l'Article 84 CBE*". The submission in the reply to the statement of grounds of appeal concerned the entities for which the intercoat adhesion ("*l'adhésion intercouche*") was improved (passage from the paragraph bridging pages 2 and 3 to the second full paragraph of page 3). The paragraph bridging pages 2 and 3 referred to a method to measure intercoat adhesion ("*une méthode de détermination de « l'adhésion intercouche » elle-même.*"). The first and second full paragraphs on page 3 related to the entities, between which the improved intercoat adhesion

should be measured, which were not clearly identified (*"Aucune précision entre quoi et quoi on mesure l'amélioration de « l'adhésion intercouche » n'est donnée dans la description, ni dans les exemples"*).

Therefore, the objection raised in the letter of 13 November 2019 complements the objection raised in the reply to the statement of grounds of appeal. For this reason, the board decided to admit the objection under Article 84 EPC into the proceedings in accordance with Article 13(1) RPBA 2007.

### 6.3 Admittance of the objection under Article 123(3) EPC

The objection is based on the change of claim category effected in claim 1 together with the change of the feature "with improved intercoat adhesion" to "for improving intercoat adhesion". According to respondent 2, this change of claim category extended the scope of protection in contravention of Article 123(3) EPC.

Respondent 2 did not raise any objection regarding Article 123(3) EPC in its reply to the statement of grounds of appeal, either explicitly or implicitly. As not disputed by respondent 2, it had been raised for the first time in its letter dated 13 November 2019. Consequently, in the same way as for the objection under Article 123(2) EPC, it is at the board's discretion to admit or not to admit this new objection pursuant to Article 13(1) RPBA 2007.

Had this new objection been admitted, new complex questions would have had to be answered, such as whether there is any change in scope between a paint or coating composition "with improved intercoat adhesion"

and a paint or coating composition "for improving intercoat adhesion".

Consequently, the board, in application of Article 13(1) RPBA 2007, decided not to admit the new allegation of fact based on the objection pursuant to Article 123(3) EPC into the proceedings.

7. Article 84 EPC - Claim 1
  - 7.1 Respondent 2 objected to the clarity of claim 1 of the first auxiliary request.
  - 7.2 Claim 1 refers to the use of a specific composition "**for improving intercoat adhesion**". The specific composition contains a rheological additive **consisting of** the reaction of ethylene diamine, hexanoic acid and 12-hydroxystearic acid and **optionally** a catalyst.
  - 7.3 As set out above, respondent 2 submitted that claim 1 according to the first auxiliary request lacked clarity since it was not clear where to measure intercoat adhesion and according to which method.
  - 7.4 The effect of improving intercoat adhesion to be achieved according to claim 1 of the first auxiliary request is a feature present in granted claim 1. Granted claim 1 is directed to a paint or coating composition **with improved intercoat adhesion**. Thus, the purpose of the use in claim 1 according to the first request ("for improving intercoat adhesion") is already present in granted claim 1.

Should the position where to measure and the method how to measure intercoat adhesion in a multi-layer system in claim 1 of the first auxiliary request not be clear, they would not be clear either for claim 1 as granted

and thus would also represent a lack of clarity in granted claim 1.

Therefore, no lack of clarity was introduced in claim 1 of the first auxiliary request. Thus, the feature "for improving intercoat adhesion" is not open to clarity objections (see decision G 3/14, OJ EPO 2015, A102, order). For these reasons, the objection of respondent 2 regarding the term "for improving intercoat adhesion" must be disregarded.

7.5 Respondent 2 further submitted that claim 1 of the first auxiliary request contained an inconsistency owing to the simultaneous presence of the term "consisting of" and the feature "optionally d) a catalyst". It argued that this optional technical feature contradicted the definition of the term "consisting of", which excluded the presence of any further optional component. In view of the feature "optionally d) a catalyst", claim 1 of the first auxiliary request encompasses two alternatives, one with a catalyst and one without. In the first alternative, the reaction product is obtained by the reaction between reactants a), b) and c) as defined in claim 1 in the presence of a catalyst. In the second alternative, the reaction product is obtained by the reaction between reactants a), b) and c) in the absence of the catalyst. The formulation of the claim is clear, since the two alternatives are clearly identifiable in the claim. For this reason, the claim does not contain any inconsistency between the term "consisting of" and the feature "optionally d) a catalyst".

7.6 The board therefore concludes that claim 1 of the first auxiliary request meets the requirements of Article 84 EPC.

8. Rule 80 EPC - Claim 1

8.1 Respondent 2 submitted in writing that the addition of the term "and optionally d) a catalyst" in claim 1 was not occasioned by a ground of opposition under Article 100 EPC.

8.2 Whether the requirements of Rule 80 EPC are met for claim 1 of the first auxiliary request is to be considered for the whole amendments made in the claim. When compared to granted claim 1, the scope of claim 1 of the first auxiliary request is restricted by, *inter alia*, the amendment of the term "consisting essentially of" to the term "consisting of" linked with the addition of "and optionally d) a catalyst". This amendment results in the exclusion of further products other than the reaction product of ethylene diamine, hexanoic acid and 12-hydroxystearic acid and optionally the catalyst.

Thus, since the amendment in claim 1 taken as a whole restricts the scope of granted claim 1, it potentially overcomes a ground of opposition.

The board, therefore, considers that this amendment complies with Rule 80 EPC.

9. Article 123(2) EPC

As set out above, the only objections raised by respondent 2 under Article 123(2) EPC were not admitted into the proceedings. The board is convinced that the requirements of Article 123(2) EPC are met for the claims of the first auxiliary request.

Claim 1 of the first auxiliary request is based on the combination of originally filed claims 1, 3, 5, 6, wherein the term "heptanoic acid" was deleted, and

paragraph [0019] of the application as originally filed.

Claim 2 of the first auxiliary request is based on originally filed claim 2.

Claim 3 of the first auxiliary request finds its basis in originally filed claim 7.

Remittal - Article 111(1) EPC

10. The appealed decision was restricted to the questions of added subject-matter and clarity. Therefore, and in conformity with the request of respondent 2, the case is remitted to the opposition division for further prosecution.

## 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 based on the claims of the first auxiliary request filed with the statement of grounds of appeal.

The Registrar:

The Chairman:



B. Atienza Vivancos

M. O. Müller

Decision electronically authenticated