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**Datasheet for the decision
of 3 June 2022**

Case Number: T 2860/18 - 3.3.02

Application Number: 09767605.0

Publication Number: 2300546

IPC: C09D7/00, C09D7/14, B01F13/10

Language of the proceedings: EN

Title of invention:
EXPANDED COLOR SPACE ARCHITECTURAL PAINT AND STAIN TINTING
SYSTEM

Patent Proprietor:
SWIMC LLC

Opponent:
Akzo Nobel Coatings International B.V.

Headword:

Relevant legal provisions:
EPC Art. 56, 100(a)
RPBA Art. 12(2), 12(4)
RPBA 2020 Art. 25(2)

Keyword:

Inventive step

Statement of grounds of appeal - party's complete case

Decisions cited:

Catchword:



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Case Number: T 2860/18 - 3.3.02

D E C I S I O N
of Technical Board of Appeal 3.3.02
of 3 June 2022

Appellant: Akzo Nobel Coatings International B.V.
(Opponent) Velperweg 76
6824 BM Arnhem (NL)

Respondent: SWIMC LLC
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Representative: Vossius & Partner
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Decision under appeal: **Decision of the Opposition Division of the
European Patent Office posted on 23 October 2018
rejecting the opposition filed against European
patent No. 2300546 pursuant to
Article 101(2) EPC**

Composition of the Board:

Chairman M. O. Müller
Members: S. Bertrand
M. Blasi

Summary of Facts and Submissions

- I. The appeal by the opponent ("appellant") lies from the decision of the opposition division to reject the opposition filed against European patent No. 2 300 546.
- II. The following documents are used in the present decision:
- D2.1 Prior art acknowledged in paragraphs [0004]-[0005] of the patent and of the priority application
 - D2.2 Either one of the prior art machines cited in paragraph [0034] of the patent and in paragraph [0035] of the priority application
 - D3 WO 02/25225 A1
 - D4 US 4,585,148 A
 - D5 US 6,655,555 B1
 - D6 GB 2 133 775 A
 - D8.1 COROB D410 Automatic Dispenser User's Manual, 2006
 - D8.2 COROB D400 Automatic Dispenser User's Manual, 2005
 - D9.1 COROB FUTURA Automatic Dispenser User's Manual, 2006
 - D9.2 Press release from industry PROFILE about the automatic dispensing system AT 1500, 2007
 - D9.3.1 Press release about the automatic dispensing system AT 2000, 2005
 - D9.3.2 Launch article about the automatic dispensing system AT 2000, 2005
 - D10 WO 00/22050 A1
 - D10.1 Table of page 36 of the notice of opposition

D11 WO 2006/102011 A1
D12 WO 97/08255 A1
D13 US 3,851,798 A
D14 GB 1 323 086 A
D15 US 4,027,785 A
D16 EP 0 427 497 A1
D17 EP 1 331 249 A1
D18 US 2007/0221531 A1
D19 US 5,493,840 A
D20 US 5,938,080 A
D21 US 2007/0095421 A1
D22 US 2,787,402 A
D23 US 2,796,194 A
D24 US 2,848,019 A
D25 US 2,878,135 A
D26 US 2,932,580 A
D27 US 2,951,617 A
D28 US 3,483,009 A
D29 US 3,497,374 A
D30 US 3,639,325 A
D31 US 4,089,699 A
D32 US 4,741,781 A
D33 US 4,909,852 A
D34 US 5,401,313 A
D35 US 5,814,144 A
D36 US 6,052,195 A
D37 US 6,081,253 A
D38 US 6,488,760 B1
D39 US 6,531,537 B2
D40 US 6,637,471 B2
D41 US 6,740,154 B2
D42 US 6,957,672 B2
D43 US 6,969,190 B1

D44 US 7,018,458 B2
D45 US 7,065,429 B1
D46 US 7,086,776 B2
D47 US 7,132,470 B2
D48 US 7,250,464 B2
D49 US 7,318,864 B2
D50 US 2006/0076080 A1
D51 US 2006/0152745 A1
D52 WO 93/09187 A1
D57 S.M. Korenkiewicz's affidavit

- III. The opposition division's conclusions included that the subject-matter of the claims according to the patent as granted (main request) involved an inventive step in view of any of D3, D4, D6, D8.1, D8.2, D9.1, D9.2, D9.3.1 and D9.3.2 taken as the closest prior art.
- IV. In its statement of grounds of appeal, the appellant contested the reasoning of the opposition division and submitted that the invention defined in the claims as granted was not sufficiently disclosed and that the subject-matter of these claims did not involve an inventive step.
- V. In its reply to the grounds of appeal, the patent proprietor ("respondent") provided counter-arguments on sufficiency of disclosure and inventive step. It submitted sets of claims as auxiliary requests 1 to 5.
- VI. The board summoned the parties to oral proceedings, as requested by the parties, and issued a communication under Article 15(1) RPBA 2020 on 30 November 2021.
- VII. With its letter of 10 December 2021, the appellant stated that it would not attend the oral proceedings.

It withdrew its objection under Article 100(b) EPC but maintained its objection of lack of inventive step.

VIII. Oral proceedings before the board were cancelled by communication of 4 January 2022.

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

Main request - Inventive step

D10 as the closest prior art

- D10, like the opposed patent, was concerned with the provision of custom-made colours chosen by the consumer at a retail store.
- The distinguishing features of claim 1 of the main request was the minimum fluid dispensing quantity of less than 0.01 fluid ounce.
- The low minimum fluid dispensing quantities enabled the attainment of light tints when preparing small batch volumes.
- The objective technical problem was how to enable the custom colour system and method of D10 to prepare lighter tints in small containers.
- The solution proposed by claim 1 of the main request was obvious in view of D2.1 to D6 and D8.1 to D9.3.
- The subject-matter of claim 1 of the main request did not involve an inventive step.

D11 or D12 as the closest prior art

- D11 and D12 belonged to the same technical field as the opposed patent.

- The distinguishing feature was the minimum fluid dispensing quantity of less than 0.01 fluid ounce.
- For the same reasons as those given for D10, the subject-matter of claim 1 of the main request did not involve an inventive step.

Inventive step in view of D13 to D52

- D13 to D52 rendered the subject-matter of claim 1 of the main request obvious.

X. The respondent's case relevant to the present decision may be summarised as follows.

Main request - Inventive step

D10 as the closest prior art

- The distinguishing features of claim 1 of the main request over D10 were the minimum fluid dispensing quantity of less than 0.01 fluid ounce and the colour strength of the red-hued colourant.
- The distinguishing features provided the following advantages:
 - lower number of colourants for providing a wide array of tints ranging from light pastel tints to strong colours,
 - enabling use of an individual colourant to provide both light pastel tints in small containers and strong colours in large containers,
 - avoiding the need to use additional colourants having the same general hue and lower overall strength to make light pastel tints,

- freeing up otherwise dedicated dispenser circuits, thereby permitting the addition of specialty colourants or other fluid products, and
 - reducing inventory complexity, space and cost requirements in a point-of-sale outlet.
-
- The objective technical problem was the provision of a point-of-sale custom colour system that could reduce the need to employ an undesirably large number of different colourants while at the same time allowing small quantities of base paint with a light pastel colour and a large quantity of base paint with a high colour intensity to be obtained.
 - The solution proposed by claim 1 of the main request was not obvious in view of D2.1 to D6 and D8.1 to D9.3. None of these documents comprised the teaching that would lead to a wide array of colours. Furthermore, D10 combined with any of these documents did not disclose the red-hued colourant with the colour strength required by claim 1 of the main request.
 - The subject-matter of claim 1 of the main request involved an inventive step.

D11 or D12 as the closest prior art

- The distinguishing feature was the minimum fluid dispensing quantity of less than 0.01 fluid ounce and the colour strength of each of the green-, blue- and red-hued colourants.
- For the same reasons as those given for D10, the subject-matter of claim 1 of the main request involved an inventive step.

Inventive step over D13 to D52

- None of D13 to D52 taught or suggested the subject-matter of claim 1 of the main request.

XI. The parties' final requests were as follows.

The appellant requested that the decision under appeal be set aside and that the patent be revoked in its entirety.

The respondent requested:

- that the appeal be dismissed, with the result that the opposition likewise be rejected, or,
- alternatively, that the patent be maintained in amended form on the basis of one of the sets of claims of auxiliary requests 1 to 5 filed with the reply to the grounds of appeal.

Reasons for the Decision

Main request - patent as granted

1. The appellant exclusively relied on lack of inventive step in its objections to the main request.

Inventive step - Article 100(a) and Article 56 EPC

2. Claim 1 of the main request reads as follows:

"1. A point-of-sale custom color system for tinting white-pigmented and unpigmented base paints and stains, the system comprising an automated colorant dispenser having a minimum fluid dispensing quantity less than 0.01 fluid ounce (<0.3 cm³) for placing colorant into

the base paint or stain, the dispenser providing an array of colorants including:

- a) white colorant,*
- b) black colorant,*
- c) yellow-hued colorant,*
- d) green-hued colorant having a color strength greater than that of a comparison colorant containing 12 wt. % PG7 pigment,*
- e) blue-hued colorant having a color strength greater than that of a comparison colorant containing 7 wt. % PB15:2 pigment, and*
- f) red-hued colorant having a color strength greater than that of a comparison colorant containing 17 wt. % PR209 pigment,*

wherein said green-hued or blue-hued colorant is dispensed into the base paint or stain whenever a green-hued or blue-hued tint is required."

- 3. The invention of the patent relates to a point-of-sale customised-colour architectural paint and stain tinting system, such as those used in retail paint stores to make custom-tinted house paints or stains (paragraph [0001]).
- 4. The appellant objected to a lack of inventive step over any of D10, D11 or D12 as the closest prior art, in combination with any of D2.1, D2.2, D3, D4, D5, D6, D8.1, D8.2, D9.1, D9.2, D9.3.1 or D9.3.2. The appellant also submitted that the subject-matter of claim 1 of the main request was obvious in view of D13 to D52.

5. D10 as the closest prior art

D10 relates to a universal tinting concentrate for paints and coatings. The tinting concentrate may be in the form of a set of pigment concentrates (page 5, lines 12-14) intended to be added at the point of sale, such as at retail paint stores (page 1, lines 26-29). This disclosure implies that a point-of-sale custom colour system, as referred to in claim 1 of the main request, is used in D10.

5.1 Distinguishing features

The examples of D10 disclose colourants made of tinting concentrates and being composed of pigment concentrates. As set out above, a point-of-sale custom colour system as required by claim 1 of the main request is used in D10.

D10 does not disclose a minimum fluid dispensing quantity of less than 0.01 fluid ounce as required by claim 1 of the main request. It was not disputed by the appellant that the minimum fluid dispensing quantity is a distinguishing feature.

The specific colourants disclosed in the examples of D10 are a white colourant (example 8), a black colourant (example 1), a yellow colourant (example 7), a green colourant (example 6, comprising 19.3 wt.% PG7), a blue colourant (example 5, comprising 9.2 wt.% PB15:2) and a red colourant (example 4).

It was not disputed that the blue and green colourants of examples 5 and 6 of D10 were as required by claim 1 of the main request (blue- and green-hued colourants e) and d) as defined in the claim).

It was a matter of dispute between the parties whether the red colourant of example 4 of D10 corresponded to a red-hued colourant of claim 1 of the main request and furthermore whether the colour strength of the red colourant disclosed in example 4 of D10 was as required by claim 1 ("color strength greater than that of a comparison colorant containing 17 wt.% PR209 pigment"). The appellant submitted that the red colourant of example 4 of D10 amounted to a red-hued colourant according to claim 1 of the main request. It referred to the comparison made in D10.1. The table of D10.1 is reproduced below:

D10.1 comparison test results:

Standard	Batch	dE2000	dECieLab	%ΣK/S	dL*	da*	db*	dC*	dH*
P.R. 209 (17%)	Acomix wR1 (58.87%)	17.86	25.81	481.02	-18.23	-14.26	11.43	-12.26	13.55
P.R. 209 (29%)	Acomix wR1 (58.87%)	15.88	26.4	279.93	-13.7	-20.11	10.24	-18.09	13.5

The colourant P.R. 209 (17%) in the first column of this table corresponds to the "comparison colorant" mentioned in claim 1 as a reference point for defining the colour strength of the red-hued colourant. The colourant P.R. 209 (29%) in the first column corresponds to a colourant with a pigment concentration that is higher than that of the "comparison colorant" defined in claim 1. The "Acomix wR1 (58.87%)" in the second column of the above table corresponds to the composition of example 4 of D10 and contains 58.87% of red iron oxide. The values given in the third to tenth columns of the table are the differences between the corresponding values obtained for, on the one hand, the "Acomix wR1 (58.87%)" and, on the other hand, P.R. 209 (17%) or P.R. 209 (29%) and are representative of differences in colour characteristics. Hence, positive values imply that the corresponding

characteristic of the "Acomix wR1 (58.87%)" is higher than that of P.R. 209 (17%) or P.R. 209 (29%).

According to the appellant, the values in the third to tenth column of the above table evidenced that "Acomix wR1 (58.87%)" was darker than a composition comprising 17% PR209 and had a greater colour strength. It concluded that the composition of example 4 of D10 thus had a colour strength greater than the comparison colourant of claim 1 of the main request and thus corresponded to the red-hued colourant f) of this claim.

The board does not agree for the following reasons. As submitted by the respondent, the appellant's conclusion that the colour of Acomix wR1 (58.87%) is darker, and hence stronger, than the colour of the comparison colourant P.R. 209 (17%) is not correct.

More specifically, hue (and colour strength of a specific colourant) depends on da^* (redness), db^* (yellowness) and dC^* (chroma). In the above table da^* is negative (seventh column of the table), meaning that Acomix wR1 (58.87%) is significantly less red than the comparison colourant P.R. 209 (17%). Indeed, this was accepted by the appellant: "*negative da means batch is less red*"; see page 23 of the statement of grounds of appeal, last bullet before paragraph 3.5.3.

Consequently, it has not been established by the appellant that the red colourant of example 4 of D10 amounts to a red-hued colourant having a colour strength according to claim 1 of the main request.

Thus the colour strength of the red-hued colourant is a further distinguishing feature of claim 1.

To sum up, the distinguishing features of claim 1 over the disclosure of D10 are at least:

- (i) a minimum fluid dispensing quantity of less than 0.01 fluid ounce
- (ii) the colour strength of the red-hued colourant.

5.2 Objective technical problem

The respondent argued that the objective technical problem was the provision of a point-of-sale custom colour system that can reduce the need to employ an undesirably large number of different colourants while at the same time allowing small quantities of base paint with a light pastel colour and a large quantity of base paint with a high colour intensity to be obtained.

The board is of the view that the problem formulated by the respondent is indeed solved by the claimed subject-matter.

As explained by the respondent, colour dispensing units conventionally have higher minimum fluid dispensing quantities than that defined in claim 1. In particular with a small amount of base paint to be coloured, these higher dispensing quantities mean that adding drops of the desired colour may lead immediately to too high a colour intensity of the base paint coloured in this way in the container. Thus, a second colour needs to be added, this second colour having a colour which is able to reduce the intensity of the colour in the base paint to change it into the desired light pastel colour.

As further explained by the respondent, one possible way of avoiding the above problem is to reduce the colour strength of the colours in the dispensing units. But with such a reduced colour strength it would not be possible to get high colour intensities in large quantities of base paint.

Hence the problem as formulated by the respondent constitutes the objective technical problem.

5.3 Non-obviousness of the solution

The appellant referred to D2.1 to D6 and D8.1 to D9.3 for assessing the obviousness of the solution proposed by claim 1 of the main request.

D2.1 and D2.2 refer to automated paint colourant dispensers such as the ACCUTINTERTM 1500, 2000, 7000 and 8000 series machines, the COROB MODULA HFTM machine and the TATOCOLORTM machine.

D3 (claim 13, 3rd paragraph on page 6, 1st full paragraph on page 11) and D4 (column 4, lines 25 and lines 42-56; column 10, lines 2) disclose an automated paint colourant dispenser for tinting unpigmented paints which has a low minimum fluid dispensing quantity of 1/256th of an ounce (i.e. less than 0.01 ounce, D3) or 0.01 to 0.1 g (D4).

D5 (column 7, lines 61-63; column 8, lines 1-3 and 11-13) discloses a paint colourant dispenser for tinting unpigmented paints which comprises a rotating carousel and has a low minimum fluid dispensing quantity of 1/96th of an ounce.

D6 (abstract) discloses an apparatus for dispensing colourants which has a low minimum fluid dispensing quantity 0.1 ml (i.e. less than 0.3 cm³).

D8.1, D8.2, D9.1, D9.2, D9.3.1 and D9.3.2 are brochures, press releases and articles on COROB™ D410, D400 and FUTURA, and ACCUTINTER™ 1500 and 2000, automated paint colourant dispensers belonging to the series referred to in paragraph [0034] of the patent.

However, the subject-matter of claim 1 is not obvious for the following reasons: no teaching is available in these prior-art documents regarding preparation of the red-hued colourant to have a colour strength as high as required by claim 1 of the main request. For this reason alone, the skilled person would not have arrived at the subject-matter of claim 1 even when combining D10 with any of these documents.

Furthermore, there is no teaching in these prior-art documents regarding use of a dispenser with a minimum fluid dispensing quantity of less than 0.01 fluid ounce in combination with at least the red-hued colourant having a colour strength as high as required by claim 1 of the main request to provide both light pastel tints in small containers and strong colours in large containers.

Thus the subject-matter of claim 1 involves an inventive step over D10 as the closest prior art.

6. D11 or D12 as the closest prior art

D11 and D12 are prior art disclosures which are further remote than D10 for the following reasons.

D11 comprises a similar disclosure to that of D10. D11 (abstract) discloses universal colourant compositions for colouring solvent- and water-based paints and coatings. The tinting concentrates may be in the form of a set of pigment concentrates (page 5, lines 3-5).

Like D10 and D11, D12 relates to colourant composition for tinting paints. The tinting compositions referred to in D12 form a series of colourants (page 2, lines 7-9).

As set set out by the board in the communication under Article 15(1) RPBA 2020 (points 21 and 22) and not contested by the appellant, there is no disclosure in D11 and D12 of the colour strength of the green-hued, blue-hued and red-hued colourants and the colour strength of each of said colourants is an additional distinguishing feature. This was not contested by the appellant. Thus D11 and D12 are prior art disclosures which are further remote than D10 and inventive step can be established in view of each of D11 and D12 as the closest prior art.

7. The appellant also referred to documents D13 to D52 in the context of inventive step (point 4.12 of the statement of grounds of appeal). However, the appellant merely indicated passages in D13 to D21, without making any detailed submissions. With regard to D22 to D52, only a general statement that these documents contained "*relevant features regarding color systems, colorants, paints and color measurement*" was provided. No problem-solution approach starting from any of these documents or using any of these documents as secondary documents was presented.

Under Article 12(4) RPBA 2007 (applicable to the present case pursuant to Article 24 and Article 25(2) RPBA 2020) the board, without prejudice to the power to hold inadmissible certain facts, evidence or requests, takes into account everything presented by the parties in the statement of grounds of appeal and the reply if and to the extent it relates to

the case under appeal and meets the requirements under Article 12(2) RPBA 2007.

Under Article 12(2) RPBA 2007, the statement of grounds of appeal and the reply must contain a party's complete case. It should set out clearly and concisely the reasons why it is requested that the decision under appeal be reversed, amended or upheld, and should specify expressly all the facts, arguments and evidence relied on. For the above reasons (first paragraph of this point), this requirement has not been met as regards the objections of lack of inventive step based on documents D13 to D52.

Hence, for the above reasons, the board has decided not to admit these objections into the proceedings.

8. The board concludes that the subject-matter of claim 1 of the main request, and by the same token of claims 2 to 20, which are claims dependent on claim 1 or include the features of claim 1, involves an inventive step within the meaning of Article 56 EPC. The ground for opposition under Article 100(a) EPC in combination with Article 56 EPC does not prejudice the maintenance of the patent as granted.

9. Partial reimbursement of the appeal fee

The appellant stated within one month of notification of the board's communication pursuant to Article 15(1) RPBA 2020 that it would not attend the scheduled oral proceedings. The board considered this statement as a withdrawal by the appellant of its request for oral proceedings made earlier in the appeal proceedings, allowing the board to cancel the scheduled oral proceedings and to take a decision on the appeal

in written proceedings at any time after receipt of this statement. As, indeed, no oral proceedings take place since the board finds in favour of the respondent's main request being the dismissal of the appeal, the requirements under Rule 103(4)(c) EPC for a reimbursement of the appellant's appeal fee at 25% are met.

Order

For these reasons it is decided that:

1. The appeal is dismissed.
2. The appeal fee is to be reimbursed at 25%.

The Registrar:

The Chairman:



M. Schalow

M. O. Müller

Decision electronically authenticated