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**Datasheet for the decision  
of 20 October 2021**

**Case Number:** T 0075/19 - 3.3.06

**Application Number:** 09756797.8

**Publication Number:** 2358942

**IPC:** D21H19/24, D21H19/58,  
D21H19/82, D21H23/22

**Language of the proceedings:** EN

**Title of invention:**

Coated recyclable paper or paperboard and methods for their  
production

**Patent Proprietor:**

Premium Board Finland Oy

**Opponents:**

Walki Plastiroll Oy  
Metsä Board Oyj  
Stora Enso AB OYJ

**Headword:**

Coated recyclable paper / PREMIUM BOARD FINLAND

**Relevant legal provisions:**

EPC Art. 100(c), 123(2)

**Keyword:**

Amendments - extension beyond the content of the application  
as filed (yes)

**Decisions cited:**

**Catchword:**



**Beschwerdekammern**

**Boards of Appeal**

**Chambres de recours**

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**Case Number:** T 0075/19 - 3.3.06

**D E C I S I O N**  
**of Technical Board of Appeal 3.3.06**  
**of 20 October 2021**

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**Decision under appeal:**      **Decision of the Opposition Division of the  
European Patent Office posted on 17 October 2018  
revoking European patent No. 2358942 pursuant to  
Article 101(3) (b) EPC.**

**Composition of the Board:**

**Chairman**                      J.-M. Schwaller  
**Members:**                    L. Li Voti  
                                     C. Heath

## **Summary of Facts and Submissions**

- I. The patent proprietor's appeal is against the decision of the opposition division to revoke European patent no. 2 358 942.
- II. In its statement of grounds the appellant requested that the board confirms that there was no added subject-matter or extension of protection in the patent and that the case be returned to the opposition division for further handling. Further it requested oral proceedings and the reimbursement of the appeal fee, arguing that its right to be heard had been violated by the opposition division.
- III. The respondents (also opponents 1 to 3) contested the appellant's arguments and requested that the appeal be dismissed.
- IV. The parties were summoned to oral proceedings.
- V. In response to the board's preliminary opinion that all pending requests appeared to contravene the requirements of Article 123(2) EPC, the appellant with letter dated 8 October 2021 informed that it did not intend to attend the oral proceedings.
- VI. Oral proceedings were then cancelled.
- VII. The parties' requests appearing from the file are the following:

The Appellant requests that the decision under appeal be set aside and the case be remitted to the opposition division for further prosecution on the basis of the

claims as granted (main request) or, in the alternative, on the basis of any of the auxiliary requests 1 to 6, filed by letter of 27 July 2018 before the opposition division, or of auxiliary request 7, filed during oral proceedings before the opposition division on 28 September 2018. Further it requests the reimbursement of the appeal fee pursuant to Rule 103(1) (a) EPC.

The Respondents request that the appeal be dismissed.

VIII. Claim 1 as granted (main request) reads as follows:

*"1. A method for producing coated recyclable paper or paperboard, wherein the paper or paperboard is coated with at least a first and second coating layers consisting of an aqueous polymer dispersion, characterized in that:*

*- the aqueous polymer dispersion in each layer consists of from about 70 to about 90 weight % of a polymer emulsion based on the dry weight of the coating and from about 10 to about 30 weight % of a pigment based on the dry weight of the coating with any remainder consisting of additives selected from the group consisting of thickening agents, de-foaming or antifoaming agents, dispersing aids, crosslinking agents, slip additives, release agents and antiblocking agents, with no waxes present;*  
*and in that the method of coating comprises the steps of:*

*a) drying each coating layer to an elevated temperature by applying heated air having a temperature above about 100°C; and*

*b) cooling the coated paper or paperboard to a temperature below about 40°C;*

*wherein the drying and cooling steps (a) and (b) result in the coated paper or paperboard product having a water resistance of less than 10 g/m<sup>2</sup> and a moisture vapor transfer rate of less than 120 g/m<sup>2</sup>, and wherein the coated paper or paperboard product is heat sealable."*

Claim 1 of auxiliary request 1 differs from this claim in that step a) contains the following amendment put in evidence by the board: "*... by applying heated air having a temperature above about 100°C **such that a temperature of a web does not exceed about 110°C***".

Claim 1 according to auxiliary request 2 differs from that of the main request in that step a) contains the following amendment: "*... by applying heated air having a temperature above about 100°C **but not more than 500°C***".

Claim 1 according to auxiliary request 3 differs from that of the main request in that step a) reads as follows: "*... by applying heated air having a temperature above about 100°C **but not more than 500°C such that a temperature of a web does not exceed about 110°C***".

Claim 1 according to auxiliary request 4 differs from that according to auxiliary request 3 by the following additional feature at the end of the claim: "*... wherein the coated paper or paperboard product is heat sealable **with pressure of 80-100 psi (551-689 kPa) and temperature of 160-200°C***".

Claim 1 according to auxiliary request 5 differs from that according to auxiliary request 4 in that it

requires additionally that "**no fluorochemicals**" are present in the aqueous polymer dispersion.

Claim 1 according to auxiliary request 6 differs from that of auxiliary request 5 in that "**talc**" is "*the pigment present in amounts from about 10 to about 30 weight % based on the dry weight of the coating*".

Claim 1 according to auxiliary request 7 differs from that of the main request in that step a) contains the following amendment: "*... by applying heated air having a temperature ~~of above~~ about 100°C **to about 150°C***".

## Reasons for the Decision

Main request (patent as granted)

1. *Compliance with the requirements of Articles 100(c)/123(2) EPC*
- 1.1 Claim 1 relates to a method for producing coated recyclable paper or paperboard, which method comprises a step a) requiring drying each (of the at least two) coating layer to an elevated temperature by applying heated air having a temperature above about 100°C.
- 1.2 In the appellant's view the wording of step a) is supported by paragraph [0031] of the application as filed (reference being made to its version published as WO 2010/052571 A1) reading: "*In this aspect, heated air having a temperature of about 100 to about 150°C is provided to the paper or paperboard web such that the temperature of the web does not exceed about 110°C.*"
- 1.2.1 The board notes that claim 1 as granted neither specifies any upper limit for the air temperature nor



for the web temperature, which both are disclosed in the above paragraph in combination with the lower limit of air temperature. Moreover, the features of paragraph [0031] are disclosed in connection with a method making use of the system of figure 2 which represents a preferred embodiment of the invention (paragraph [0029]). Therefore, the features of paragraph [0031] are not directly and unambiguously let alone generically applicable to all methods encompassed by claim 1 at issue.

- 1.2.2 Furthermore, even though the air temperatures of the drying steps applied in examples 2 (260°C, 500°C and 160°C) and 3 (200°C, 500°C and 160°C) of the application (paragraphs [0046] and [0047]) are higher than 100°C and so higher than the upper limit disclosed in said paragraph [0031], these examples concern the application of very specific coating compositions and coating steps involving for each coating different air temperature(s) and time(s) of application.

As acknowledged by the appellant at page 8, last paragraph of its statement of grounds, paragraph [0032] of the application as filed states that: "Drying temperatures and line speeds are dictated by the drying characteristics of **specific coating formulations... and equipment characteristics**".

Thus, it is clear that the temperatures disclosed in these examples and manifestly contradicting the disclosure of paragraph [0031] cannot be considered either to represent a generic disclosure supporting the use of any possible air temperature within the claimed range, including an unlimited upper limit, for any possible coating formulation encompassed by the wording of claim 1.

1.2.3 Hence a drying step a) applicable to any possible coating layer as required by claim 1 at issue is not directly and unambiguously derivable from the application as filed.

1.3 Therefore, the ground of opposition under Article 100(c) EPC in combination with Article 123(2) EPC prejudices the maintenance of the patent as granted.

#### Auxiliary request 1

2. *Compliance of claim 1 with the requirements of Article 123(2) EPC*

2.1 Claim 1 of this request differs from that according to the main request in that it additionally requires that during the drying step a) the temperature of the web does not exceed about 110°C.

2.2 This additional feature is disclosed in paragraph [0031] of the application as filed discussed above, which paragraph also requires that the used heated air has a temperature not exceeding about 150°C, the latter feature being however not recited in amended claim 1.

2.3 As exposed above, paragraph [0031] relates to the preferred embodiment making use of the system of figure 2 which is not generically applicable to all methods encompassed by claim 1 at issue, as also confirmed by paragraph [0032] indicated above.

2.4 Moreover, also the disclosures of examples 2 and 3 wherein the web reaches temperatures in the range of 100-108°C cannot be considered to support the claimed combination of features for the same reasons exposed with respect to the main request.

- 2.5 Claim 1 according to auxiliary request 1 thus does not comply with the requirements of Article 123(2) EPC.

Auxiliary requests 2 to 6

3. *Compliance with the requirements of Article 123(2) EPC*

- 3.1 Each claim 1 according to auxiliary requests 2 to 6 requires that the heated air applied in the drying step a) has a temperature above about 100°C but not more than 500°C.

- 3.2 The amended upper limit for such a temperature range is, in the appellant's view, supported by the highest air temperature used in examples 2 and 3.

However, as exposed above, these examples concern the application of very specific coating compositions and coating steps involving for each coating different air temperature(s) and time(s) of application. In particular, a temperature of 500°C is applied in example 2 in the first drying step of the second coating only, the second drying step for the same coating being shorter in time (4 seconds vs 0.4 seconds) and being carried out at a lower temperature (160°C). Moreover, the air temperature used for drying the first coating is also lower (260°C). A similar consideration applies to example 2.

Moreover, as also exposed above, it is clear from paragraph [0032] that drying temperatures are dictated by the drying characteristics of specific coating formulations.

Therefore, the upper limit of 500°C cannot be considered to be applicable to any coating (first or

second coating) and independently from the particular coating composition used.

3.3 The claimed combination of features is thus not generically applicable to any method encompassed by claim 1 according to any of auxiliary requests 2 to 6.

3.4 Therefore, claim 1 according to any of auxiliary requests 2 to 6 contravenes the requirements of Article 123(2) EPC.

Auxiliary request 7

4. *Compliance with the requirements of Article 123(2) EPC*

4.1 Claim 1 according to this request differs from that according to the main request in that step a) requires that the applied heated air has a temperature of about 100°C to about 150°C.

4.2 In the appellant's view this amendment is supported by paragraph [0031] of the application as filed.

However, as exposed above, paragraph [0031] requires additionally that during drying the temperature of the web does not exceed about 110°C, feature not contained in the amended claim 1.

Moreover, the characteristics of paragraph [0031] are disclosed in connection with a method making use of the system of figure 2 which represents a preferred embodiment of the invention (paragraph [0029]), which is not generically applicable to all coating formulations and methods encompassed by claim 1 at issue as confirmed by paragraph [0032].

- 4.3 Claim 1 according to auxiliary request 7 thus does not comply with the requirements of Article 123(2) EPC.
5. The board thus concludes that none of the pending requests complies with the requirements of the EPC.
6. Since the patent proprietor's appeal does not succeed, its request for a reimbursement of the appeal fee according to Rule 103(1)(a) EPC must equally fail.

## Order

### **For these reasons it is decided that:**

The appeal is dismissed.

The Registrar:

The Chairman:



A. Pinna

J.-M. Schwaller

Decision electronically authenticated