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**Datasheet for the decision
of 7 March 2023**

Case Number: T 2175/19 - 3.3.02

Application Number: 12839204.0

Publication Number: 2760283

IPC: A01N33/12, A61K31/14, C09D5/14,
C08K5/17, A01N25/04, A01N59/16,
C09D5/16

Language of the proceedings: EN

Title of invention:
HIGH QUALITY ANTIMICROBIAL PAINT COMPOSITION COMPRISING A
QUATERNARY AMMONIUM COMPOUND

Patent Proprietor:
The Sherwin-Williams Company

Opponent:
Strawman Limited

Headword:

Relevant legal provisions:
EPC Art. 123(2)
EPC R. 84(2)
RPBA 2020 Art. 11

Keyword:

Amendments

Remittal

Decisions cited:

Catchword:



Beschwerdekammern

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Case Number: T 2175/19 - 3.3.02

D E C I S I O N
of Technical Board of Appeal 3.3.02
of 7 March 2023

Appellant: The Sherwin-Williams Company
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Decision under appeal: **Decision of the Opposition Division of the
European Patent Office posted on 27 May 2019
revoking European patent No. 2760283 pursuant to
Article 101(2) and Article 101(3)(b) EPC**

Composition of the Board:

Chairman M. O. Müller
Members: P. O'Sullivan
M. Blasi

Summary of Facts and Submissions

I. The appeal of the patent proprietor (appellant) lies from the decision of the opposition division according to which European patent 2 760 283 was revoked.

According to the contested decision, the ground for opposition under Article 100(c) EPC prejudiced the maintenance of the patent as granted, and auxiliary requests 1 to 19 comprised subject-matter extending beyond the content of the application as filed within the meaning of Article 123(2) EPC.

II. With the statement of grounds of appeal, the appellant contested this finding.

III. In preparation for oral proceedings, scheduled according to the parties' requests, the board issued a communication pursuant to Article 15(1) RPBA 2020 and therein expressed the view that the ground for opposition under Article 100(c) EPC did not prejudice the maintenance of the patent as granted.

IV. With the letter dated 31 January 2023 the sole opponent (respondent) withdrew the opposition.

V. Oral proceedings scheduled to take place on 13 February 2023 were cancelled.

VI. Requests relevant to the present decision

The appellant requests that the contested decision be set aside, and that the ground for opposition under Article 100(c) EPC be found not to prejudice the maintenance of the patent as granted, and that the case

be remitted to the opposition division for consideration of the grounds for opposition under Article 100(a) and (b) EPC.

- VII. For the appellant's submissions in relation to the ground for opposition under Article 100(c) EPC, reference is made to the reasons for the decision.

Reasons for the Decision

1. Procedural matters

As set out above, with the letter of 31 January 2023, the sole opponent withdrew the opposition. The withdrawal of the opposition had the effect that the respondent ceased to be a party to the appeal proceedings, as no other issues other than patentability considerations were at stake.

According to established case law, the withdrawal of an opposition has no direct procedural consequences for appeal proceedings if, as in the present case, the opponent was the respondent and the contested patent was revoked by the contested decision (Case Law of the Boards of Appeal, 10th Edition 2022, III.Q.3.3, third and fourth paragraphs). In such a case, the board must review the opposition division's decision, and can only set aside this decision and reject the opposition if the grounds for opposition on which the contested decision was based do not prejudice the maintenance of the patent as granted. The board can take into consideration submissions filed by the respondent prior to the withdrawal of the opposition.

Main request (patent as granted)

2. Added subject-matter (Article 100(c) EPC)

Claim 1 of the main request reads as follows:

"A paint composition comprising:

(a) a carrier liquid;

(b) at least ~~about~~ 10% by weight pigment;

(c) a latex binder polymer selected from acrylic binder, vinyl acrylic binder or styrene acrylic binder having a compatibility score of 0.7 or lower; wherein the compatibility of the binder with the quaternary ammonium compound is determined by observing and measuring the degree of precipitation of binder and pigment when the quaternary ammonium compound is added to the paint composition as described in the specification herein; and

(d) a quaternary ammonium compound, wherein the paint composition comprises 0.25% to 3% by weight quaternary ammonium compound." (strike through and underlined text added by the board indicating deletion and addition, compared to claim 1 of the application as filed)

According to the contested decision, the presence in granted claim 1 of the following text:

"wherein the compatibility of the binder with the quaternary ammonium compound is determined by observing and measuring the degree of precipitation of binder and pigment when the quaternary ammonium compound is added to the paint composition as described in the specification herein;"

led to subject-matter which extended beyond the content of the application as filed. This text is referred to hereinafter as the "disputed text".

2.1 Interpretation

2.1.1 The disputed text indicates to the skilled person that the compatibility of the binder with the quaternary ammonium compound is determined "by observing and measuring the degree of precipitation of binder and pigment when the quaternary ammonium compound is added to the paint composition", and that said determination is to be carried out "as described in the specification herein".

2.1.2 According to the respondent, and as essentially concluded in the contested decision, instructed to do so by the disputed text ("as described in the specification herein;"), the skilled person would look to the description of the patent for the method described. However, the sole compatibility test comprised in the description (paragraphs [0016] to [0019]) did not disclose the "degree of precipitation of binder and pigment" as required in the disputed text, but rather was performed in the absence of a pigment (patent, paragraph [0021]). Consequently, the skilled person would not consider said compatibility test to be the method "described in the specification herein" to which the disputed text in claim 1 referred. The skilled person would hence look to the description for an alternative disclosure concerning the addition of the quaternary ammonium compound to a paint composition, within which a pigment would be comprised, as required by the disputed text. Such a disclosure was to be found in example 1 (patent, paragraph [0032]).

Hence, it was reasoned, the skilled person following the instructions in contested claim 1 would observe and measure the degree of precipitation of the binder and pigment in example 1, i.e. the compatibility of the individual quaternary ammonium compound of example 1 with the individual binder and pigment (i.e. paint) composition of example 1. This interpretation however contrasted with the application as filed, which only disclosed a specific compatibility test for determining the compatibility score for a specific binder derived as an average of the level of precipitation when mixed with six specific quaternary ammonium compounds (application as filed, paragraph [0021] final three lines). There was hence no disclosure in the application as filed of a compatibility measurement method using individual binder/quaternary ammonium compound pairs, let alone combinations of a binder, a pigment and a quaternary ammonium compound, such as in the proposed method based on example 1.

2.1.3 Hence, claim 1 referred the skilled person to a new kind of "individual" compatibility test, in which the compatibility score in claim 1 related to an individual score for a specific polymer/pigment/quaternary ammonium combination, and not the compatibility score as described in paragraphs [0018] to [0025] of the application as filed.

Since such a test was not disclosed in the application as filed, claim 1 added subject-matter (see contested decision, section 2, in particular page 4, second and fourth paragraphs).

2.2 The board's view

- 2.2.1 The board considers that the assessment of the ground for opposition under Article 100(c) EPC in the present case involves two steps.

In a first step, it must be established how claim 1 would be interpreted by the skilled person, in particular in relation to the disputed text.

In a second subsequent step, it must be established whether the claimed subject-matter, based on this interpretation, is directly and unambiguously derivable, explicitly or implicitly, from the application as filed.

If in the second step a direct and unambiguous disclosure is established, then it must be concluded that contested claim 1 does not comprise added subject-matter.

- 2.2.2 Regarding the first step, there is no reason on the basis of the disputed text itself, and therefore on the basis of the wording of contested claim 1, to discount it as illogical or lacking technical sense. Hence, based on an initial reading of claim 1, there would be no reason for the skilled person to ignore the disputed text.
- 2.2.3 Directed by said disputed text and in particular by the wording "as described in the specification herein" to the description of the patent, the skilled person would search for the corresponding instructions on how the method described in said disputed text should be carried out.

- 2.2.4 Directly preceding paragraph [0016] of the patent, the skilled person would read the heading entitled "Polymer/Quaternary Ammonium Compound Compatibility Test", with thereafter (paragraphs [0016] to [0019]) a detailed description of this specific test. The board acknowledges that the disputed text in claim 1 is in contradiction to the test described in paragraphs [0016] to [0019]. Specifically, a contradiction arises in that the disputed text refers to the precipitation of the binder and pigment when the quaternary ammonium compound is added, while the test described in paragraphs [0016] to [0019] refers to the precipitation of the binder only. Furthermore, the disputed text in claim 1 refers to the addition of "*the quaternary ammonium compound*" while the test described in paragraphs [0016] to [0019] requires several quaternary ammonium compounds to carry out the test.
- 2.2.5 However, the board does not agree that the skilled person, based on these contradictions, would exclude the compatibility test described in paragraphs [0016] to [0019] of the patent as the relevant test referred to by the text "*as described in the specification herein*" in contested claim 1.
- 2.2.6 Specifically, the disputed text, in addition to being recited in contested claim 1, is also found in the patent in paragraph [0015], immediately preceding the section of the patent relating to the compatibility test. This text is identical to the disputed text with the exception that while the end of the disputed text reads "... *as described in the specification herein*", the end of the text in the description reads: "... *as described in detail below*".

The complete text of paragraph [0015] of the patent is reiterated below:

"The compatibility of the binder with the quaternary ammonium compound is determined by observing and measuring the degree of precipitation of binder and pigment when the quaternary ammonium compound is added to the paint composition as described in detail below:"

2.2.7 It is thus apparent that the contradictions identified above between the disputed text and paragraphs [0016] to [0019] also exist between the text in paragraph [0015] and the test described subsequently in paragraphs [0016] to [0019]. As stated above, the text describing the compatibility test in paragraph [0016] immediately follows the text in paragraph [0015] in the patent. Hence, a link is established between said text in paragraph [0015], and the specific compatibility test which follows.

2.2.8 More importantly, this link is rendered unambiguous by the presence of the colon punctuation mark ":", typically employed to introduce text that clarifies, explains, or elaborates on that which came before it. It would therefore be immediately clear to the skilled person that only this specific compatibility test applied, despite the inconsistency and apparent contradiction between the method mentioned in paragraph [0015] of the patent and the specific method of the compatibility test in paragraphs [0016] to [0019]. Due to the fact that the disputed text in claim 1 is essentially identical to the text in paragraph [0015], the same conclusion must apply, namely that the method referred to in claim 1 can only be that described in paragraphs [0016] to [0019]. Said link would also be

further reinforced by the fact that the remainder of the description of the patent is devoid of any further disclosure describing, by observing and measuring, the determination of the compatibility by any other method, in particular by a method which includes the presence of a pigment, as required according to the method set out in the disputed text. It is to be noted in this respect that example 1 referred to in the contested decision does not describe the measurement of a compatibility index.

2.2.9 Therefore, the skilled person, having consulted the description of the patent following the specific instruction in the disputed text to do so, would arrive at the conclusion that the section of the disputed text preceding "*as described in the specification herein*" in claim 1 was to be ignored in favour of the specific and only compatibility test set out in paragraphs [0016] to [0019] of the patent. This interpretation corresponds to that submitted by the appellant.

It follows that the conclusion in the contested decision that the skilled person would interpret claim 1 as referring to a new and undisclosed compatibility test based on a kind of "individual" compatibility score, is not convincing.

2.2.10 In relation to the second step, it is noted that neither the opposition division nor the respondent questioned whether the above interpretation of contested claim 1 was directly and unambiguously derivable from the application as filed. Nevertheless, the board notes that the relevant passages of the patent relating to the disputed text, and the link established between the text and the compatibility test which immediately follows said text, addressed above

(patent, paragraphs [0015] and [0016] to [0019]) are present identically in the application as filed (paragraphs [0017] and [0019] to [0025]). More importantly however, since the disputed text of contested claim 1 is not present in claim 1 of the application as filed, it is unambiguous that the compatibility score recited in the latter at least includes its measurement using the sole compatibility test disclosed in the description of the application as filed.

Consequently, the interpretation of contested claim 1 as set out in the first step, above, is directly and unambiguously derivable from the application as filed.

2.3 Hence, the board sees no reason to conclude that contested claim 1 comprises added subject-matter.

2.4 It follows that the ground for opposition under Article 100(c) EPC does not prejudice the maintenance of the patent as granted.

3. Remittal - Article 11 RPBA 2020

The appellant requests, in the event that the board found the ground for opposition under Article 100(c) EPC not to prejudice the maintenance of the patent as granted, that the case be remitted to the opposition division for further prosecution.

Insofar as the main request is concerned, the contested decision only addressed the ground for opposition under Article 100(c) EPC. For at least this reason, and in line with the appellant's request, the board decides to remit the case to the opposition division for further prosecution.

During further prosecution, in view of the withdrawal of the sole opposition, the opposition division will have to decide pursuant to Rule 84(2) EPC whether to continue the opposition proceedings of its own motion. The board's decision to remit should be not interpreted in such a way that it has any bearing on this decision.

Order

For these reasons it is decided that:

1. The appeal is dismissed.
2. The case is remitted to the opposition division for further prosecution.

The Registrar:

The Chairman:



N. Maslin

M. O. Müller

Decision electronically authenticated