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**Datasheet for the decision
of 1 March 2023**

Case Number: T 0869/20 - 3.3.06

Application Number: 09796405.0

Publication Number: 2370631

IPC: D21H19/58, D21H19/54, D21H21/18

Language of the proceedings: EN

Title of invention:
COATING COLOUR COMPOSITION AND PAPER OR PAPERBOARD COATED WITH
IT

Patent Proprietor:
Kemira OYJ

Opponent:
BASF SE

Headword:
Coating colour/KEMIRA

Relevant legal provisions:
EPC Art. 84
RPBA 2020 Art. 12(4), 12(6)

Keyword:

Clarity (no) - unclear definition of measurement conditions
for a parameter

Amendment to case - amendment admitted (yes) - objection

Decisions cited:

T 0728/98, T 0447/03, T 0955/07

Catchword:



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Case Number: T 0869/20 - 3.3.06

D E C I S I O N
of Technical Board of Appeal 3.3.06
of 1 March 2023

Appellant: BASF SE
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Decision under appeal: **Interlocutory decision of the Opposition
Division of the European Patent Office posted on
10 February 2020 concerning maintenance of the
European Patent No. 2370631 in amended form.**

Composition of the Board:

Chairman J.-M. Schwaller
Members: S. Arrojo
R. Winkelhofer

Summary of Facts and Submissions

- I. The present appeal was filed by the opponent contesting the decision of the opposition division to maintain European patent 2 370 631 on the basis of auxiliary request 1 filed during oral proceedings on 21 November 2019.
- II. The appellant requests that the decision under appeal be set aside and the patent be revoked in its entirety, arguing that claim 1 of the request upheld by the opposition division is unclear under Article 84 EPC and not inventive in view of **D3 (EP 0 536 597)** alone or in combination with the teachings of **D5 (US 4,567,099)**.
- III. The proprietor and respondent requests that the appeal be dismissed (main request), or alternatively that the patent be maintained in amended form on the basis of auxiliary requests 1 or 2 filed with the reply to the appeal. It also requests not to admit the clarity objection.
- IV. Claim 1 of the request upheld by the opposition division (**main request**) reads:

"1. A coating colour composition for improving the strength properties of coated paper and/or paperboard comprising

- a pigment,*
- a latex binder, and*
- a binder substitute, which is a styrene acrylate copolymer comprising starch, obtained by free radical emulsion copolymerisation of ethylenically unsaturated monomers in the presence of starch and having mean*

particle size less than 80 nm, wherein the coating colour has a solids content of 60-74 % and viscosity < 2500 mPas, measured by using Brookfield viscometer, type DV-II, with speed 100 rpm, using spindle 3 or 4."

Claim 1 of **auxiliary request 1** differs therefrom by the following amendment highlighted by the board: *"- a latex binder, which is styrene butadiene latex, and ..."*

Claim 1 of **auxiliary request 2** corresponds to that of the main request with the following amendments highlighted by the board:

"1. A coating colour composition for improving the strength properties of coated paper and/or paperboard comprising

- 100 parts of a pigment,*
- 3-6 parts of a latex binder, and*
- 2-4 parts of a binder substitute, which is a styrene acrylate copolymer comprising starch, obtained by free radical emulsion copolymerisation of ethylenically unsaturated monomers in the presence of starch and having mean particle size less than 80 nm,*
- 4-12 parts of starch, and*
- 0-3 parts of additives selected from group consisting preservatives, dispersing agents, defoaming agents, lubricants, hardeners and optical brighteners, ..."*

V. In a further submission, the appellant argued that the objections under Article 84 EPC also applied to claim 1 of auxiliary requests 1 and 2 and that the thus claimed subject-matter was not inventive in view of the combination of D3 and D5.

VI. The board issued a preliminary opinion indicating that the objections under Article 84 EPC would likely be admitted and that none of the requests on file appeared to meet the requirement of clarity under Article 84 EPC.

VII. Oral proceedings took place on 1 March 2023.

Reasons for the Decision

1. Admittance of the clarity objection

1.1 During first instance proceedings and in response to the notice of opposition, the proprietor filed an amended claim 1 restricted by the solid content and the Brookfield viscosity of the composition in order to overcome the novelty objections in view of D1.

With a submission dated 18 March 2019, also during the first instance proceedings, the opponent indicated that the definition of the Brookfield viscosity in claim 1 was not allowable under Articles 83 and 84 EPC. In particular, it argued that since the viscosity was dependent on the temperature and the claims did not specify which temperature should be used, the invention was insufficiently disclosed. This argument was thus part of the objections under Article 83 EPC but not of those concerning Article 84 EPC.

1.2 In the appealed decision, the opposition division concluded that claim 1 and the parameter "viscosity" were clear (point 3 of the decision) and that the objection of sufficiency of disclosure represented a new ground for opposition, which was not admitted into the proceedings (point 4 of the decision).

- 1.3 In its grounds of appeal, the appellant argued that the definition of the Brookfield viscosity was not clear under Article 84 EPC, because this parameter was dependent on the temperature, which was not defined in the claim.
- 1.4 The respondent requested not to admit and consider these objections, as they were based on arguments which had been presented before the opposition division to attack sufficiency of disclosure, but not clarity under Article 84 EPC. Since the contested feature was introduced in response to the notice of opposition, the appellant had multiple opportunities to present the clarity objection earlier in the proceedings.
- 1.5 The board first notes that both the alleged lack of clarity of the term "viscosity" and the argument that the claims fail to define the temperature at which the viscosity is measured were part of the discussion during first instance proceedings. The question is thus whether the appellant should be allowed to use the argument (originally used in the objections under Article 83 EPC) to support the clarity objection.
- 1.6 The then observes that the admittance and consideration of new arguments with the grounds of appeal is at its discretion under Article 12(4) RPBA 2020. According to this provision, the board shall exercise its discretion to admit amendments to a party's case *inter alia* in view of procedural economy as well as the complexity and the suitability of the amendments to address the issues raised in the appealed decision. Furthermore, under Article 12(6) RPBA 2020, the board shall not admit objections which should have been submitted in the proceedings leading to the decision under appeal,

unless the circumstances of the appeal case justify their admittance.

The board finds that the clarity objections raised are straightforward and relevant to address the opposition division's conclusion that claim 1 was clear, and they do not negatively affect procedural economy. Thus, following the criteria in Article 12(4) RPBA 2020, there is no reason to disregard the objections under Article 84 EPC.

With regard to Article 12(6) RPBA 2020, the board notes that the lack of clarity of the viscosity parameter was objected to before the opposition division under Article 84 EPC and the omission of the temperature and its relevance for the measurement of viscosity were also raised by the appellant. While it is true that this latter argument was not presented as part of the clarity objections, the opposition division ultimately found that the definition of the parameter viscosity was clear. The newly formulated clarity objection is therefore a legitimate attempt to contest this point of the appealed decision on the basis of arguments raised during first instance proceedings. In view of these facts, the board considers that the circumstances of the appeal case justify the admittance of the new clarity objections under Article 12(6) RPBA 2020.

2. Main request - Clarity

2.1 In the board's view, the requirements of Article 84 EPC are not met in particular because claim 1 as upheld by the opposition includes the feature: *"wherein the coating colour has a ... viscosity < 2500 mPas, measured by using Brookfield viscometer, type DV-II, with speed 100 rpm, using spindle 3 or 4."*

2.2 The appellant argued that it was well-known that viscosity was dependent on the temperature and that consequently, the measuring method for this parameter should always indicate the temperature or temperature range at which the values had to be measured (see for example page 4939 of D10). Since claim 1 did not specify the measuring temperature, the viscosity values would vary depending on the temperature selected for each case, leading to a diffuse scope of demarcation. The subject-matter of claim 1 was thus unclear.

2.3 For the respondent claim 1 was clear because tables 2 and 9 of the patent specified that the viscosity was measured at temperatures between 23 and 32°C, so it was apparent that the Brookfield viscosity of claim 1 would be measured within this narrow range. Furthermore, even if the parameter was considered to be unclear, it was acceptable because it was not the sole differentiating feature.

At the oral proceedings, the respondent further argued that the parameter was clear because claim 1 concerned a coating colour composition and the viscosity was simply intended to provide values at which this composition could be coated. In practice, the specific coating temperatures could vary, so a skilled person would understand that the viscosity requirement in claim 1 had to be fulfilled throughout the entire temperature range at which the composition could be coated. Since it was known that the colour compositions of the invention were water-based, the coating temperatures should not be lower than 0°C or higher than 100°C, so the claim could be considered to cover compositions measured within this temperature range. Moreover, document **D11** (Urban/Takamura, "Polymer Dispersions and their Industrial Applications", pages

84-85, 2002) disclosed coating techniques for colour compositions which referred to the viscosity ranges without providing the measuring temperature, implying that the omission of the measuring temperature was normal in the underlying technical field.

2.4 The board does not agree with these arguments for the following reasons:

2.4.1 Neither the claim nor the description indicates which temperature range should be used to measure the viscosity in claim 1. While tables 2 and 9 of the patent refer to the specific temperatures (23, 26, 31 and 32°C) used in the viscosity measurements of the exemplary compositions of the patent, there is no reason to interpret the subject-matter of claim 1 narrowly on the basis of the description, let alone to conclude that the viscosity should be measured within a range defined by the lowest and the highest temperatures in these examples (i.e. 23 to 32°C).

2.4.2 The board also disagrees with the argument that an unclear feature might be retained in the claim as long as it is not the sole differentiating feature. This conclusion appears to be based on T 728/98 (point 1. of the Headnote and Reasons 3.1-3.3), which indicates that the requirement of clarity is particularly relevant to ensure legal certainty when it concerns an essential feature or the sole feature distinguishing the subject-matter of the invention from the prior art. This decision does however not conclude that clarity should only be examined when the unclear feature is the sole differentiating feature, but simply stresses that in such case the requirement of clarity is particularly important to ensure legal certainty.

In the present board's view, an unclear feature might also be detrimental for legal certainty when it is not the sole distinguishing feature with respect to the cited prior art, because a member of the public working or intending to work with non-public or post-published compositions (i.e. which are not part of the public prior art) should also be able to recognise whether they are working within the forbidden area of the claims.

2.4.3 Point 4.4.1 of D11 describes different coating techniques with their typical operating conditions, so the viscosity ranges represent appropriate or usual values measured under the prevailing coating conditions. In this respect, the board does not contest that a skilled person would recognise that the definition of the viscosity range in claim 1 (as in D11) is intended to ensure that the composition has an appropriate consistency to be coated at the prevailing temperature. However, the relevant question for assessing clarity is not whether a skilled person would be able to identify the appropriate measuring temperatures to reproduce the claimed colour composition (this question could be relevant for assessing sufficiency of disclosure), but whether they are able to distinguish colour compositions falling within the forbidden area of the claims from those falling outside.

2.4.4 The board considers that a skilled reader would readily recognise that the invention covers viscosities measured at ambient temperature (e.g. 20 to 25°C) and excludes viscosities measured at extreme temperatures (e.g. 500°C or -100°C). However, there is no objective way of establishing the specific limits between the temperatures which would be considered part of the

claim and those which would not. From this conclusion it follows that a skilled person working or intending to work with compositions having viscosities which only fall within the scope of the claim when they are measured at temperatures falling within this gray area (i.e. neither extreme nor ambient) would be in doubt as to whether or not they fall within the forbidden area of the invention.

This issue is further illustrated by the different lines of argumentation brought forward by the respondent, who first indicated that the viscosity should be measured within the narrow temperature range of the examples (i.e. 23°C to 32°C) and subsequently concluded that claim 1 covered viscosities measured at any temperature between 0°C and 100°C. The fact is that different temperature ranges can be selected for different reasons, which necessarily leads to a diffuse scope of demarcation and to a lack of clarity.

2.4.5 For the sake of completeness, the board notes that these conclusions are also in line with the jurisprudence of the boards, which in several decisions (for example T 447/03, Reasons 2.2 and T 955/07, Reasons 3) held that defining viscosity values without providing the measuring temperatures gave rise to a problem of clarity.

2.5 The subject-matter of claim 1 does therefore not meet the requirements of Article 84 EPC.

3. Auxiliary requests 1 and 2 - Clarity

Claim 1 of these requests also including the contested viscosity feature, it does not meet the requirements of

clarity under Article 84 EPC for the same reasons as the main request.

4. Since none of the requests submitted by the patent proprietor meets the requirements of the EPC, the appeal of the opponent succeeds.

Order

For these reasons it is decided that:

1. The decision under appeal is set aside.
2. The patent is revoked.

The Registrar:

The Chairman:



A. Pinna

J.-M. Schwaller

Decision electronically authenticated