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**Datasheet for the decision
of 8 January 2024**

Case Number: T 1808/20 - 3.3.02

Application Number: 13770989.5

Publication Number: 2890749

IPC: C09D4/06, C09D167/07,
C09D133/08, E04B1/92

Language of the proceedings: EN

Title of invention:
DURABLE UV CURABLE COATINGS

Patent Proprietor:
Armstrong World Industries, Inc.

Opponent:
Akzo Nobel Coatings International BV

Relevant legal provisions:
EPC Art. 56
RPBA 2020 Art. 12(6)

Keyword:
Inventive step - (no)
Amendment to case - reasons for submitting amendment in appeal proceedings (no)



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Case Number: T 1808/20 - 3.3.02

D E C I S I O N
of Technical Board of Appeal 3.3.02
of 8 January 2024

Appellant: Armstrong World Industries, Inc.
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Respondent: Akzo Nobel Coatings International BV
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Representative: Akzo Nobel IP Department
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Decision under appeal: **Decision of the Opposition Division of the
European Patent Office posted on 7 July 2020
revoking European patent No. 2890749 pursuant to
Article 101(2) EPC and Article 101(3)(b) EPC.**

Composition of the Board:

Chairman M. O. Müller
Members: A. Lenzen
B. Burm-Herregodts

Summary of Facts and Submissions

- I. This decision concerns the appeal filed by the patent proprietor (appellant) against the opposition division's decision (decision under appeal) to revoke European patent No. 2 890 749 (patent).
- II. The following document, filed before the opposition division, is relevant to the present decision:

D4 US 2012/0094129 A1
- III. The decision under appeal is based, *inter alia*, on the patent as granted (main request) and auxiliary requests 1 to 3, filed during the oral proceedings before the opposition division. Summaries of the relevant points of the decision under appeal are contained in the reasons for the decision.
- IV. With its statement of grounds of appeal, the appellant filed, *inter alia*, the sets of claims of auxiliary requests 1 to 5 and the following document:

A01 Wikipedia entry "Sharpie (marker)"
- V. By letter of 30 August 2023, the appellant announced that it would not be attending the scheduled oral proceedings.
- VI. The board then cancelled the oral proceedings.
- VII. The essentials of the parties' appeal cases are contained in the reasons for the decision.

VIII. The parties' requests relevant to the present decision are as follows:

The appellant requests that the decision under appeal be set aside and the patent be maintained as granted, i.e. that the opposition be rejected (main request) or, in the alternative, that the patent be maintained based on one of the sets of claims of auxiliary requests 1 to 5, filed with the statement of grounds of appeal.

The sets of claims of auxiliary requests 1 to 3 filed with the statement of grounds of appeal are identical to the sets of claims of auxiliary requests 1 to 3 on which the decision under appeal is based.

The opponent (respondent) requests that the appeal be dismissed (main request). It also requests that A01, auxiliary requests 4 and 5 as well as the technical information contained in the following passages of the statement of grounds of appeal not be admitted:

- the first two paragraphs under the table on page 8
- the penultimate and last paragraph on page 11

Reasons for the Decision

Auxiliary request 3

1. Claim 1 reads as follows:

"A UV curable coating comprising:

*from 65 wt.% to 85 wt.% of an acrylate component;
from 0.1 wt.% to 5 wt.% of a photoinitiator;
from 0.1 wt.% to 5 wt.% of an amine synergist;
from 7 wt.% to 8 wt.% of a lubricant; and*

*from 1 wt.% to 15 wt.% of an abrasive,
wherein the acrylate component comprises a silicone
acrylate present in an amount from 3 wt.% to 7 wt.%
by weight of the coating; and
wherein the lubricant is a wax lubricant."*

2. In the decision under appeal, the opposition division considered D4 to represent the closest prior art and the composition of example 1 disclosed therein to be a suitable starting point for assessing inventive step.

With regard to the above claim 1, the opposition division essentially concluded that its subject-matter differs from D4, example 1 in that the coating composition comprises a wax lubricant in a specific amount and an amine synergist.

This was not contested by the appellant on appeal.

3. As set out by the respondent, the opposition division held that the experimental data of the patent did not allow any conclusion to be drawn as to whether the distinguishing features identified above were associated with a technical effect or not. This was either because the compositions tested were referred to only in general terms without identifying their specific ingredients and their amounts, or - if ingredients and amounts were identified - because two compositions differed from each other by more than the distinguishing features identified above. Hence the objective technical problem was to provide an alternative UV curable coating.

- 3.1 On appeal, the appellant essentially argued that the exact chemical composition of the coating compositions of examples I to IV was disclosed in the patent. These

coating compositions contained a wax lubricant and, optionally, silicone acrylate. According to the patent, the presence of these ingredients resulted in coatings with advantageous properties such as increased resistance to water-based stains. The chemical composition of the coating compositions of comparative examples CI to CV was indeed not disclosed in the patent. However, since the coatings obtained therefrom did not exhibit the properties described as advantageous, it had to be concluded that the coating compositions of the comparative examples contained neither wax lubricant nor silicone acrylate. Thus the patent did allow a comparison with regard to one of the distinguishing features, namely the presence of a wax lubricant.

- 3.2 It is true that the experimental results of the patent do not contradict the appellant's argument that the coating compositions of the comparative examples CI to CV contain neither wax lubricant nor silicone acrylate. However, without any indication of their chemical composition, the appellant's argument - as pointed out by the respondent - is ultimately still based only on conjecture. After all, the observed different properties of the coatings could also be due to entirely different ingredients. The board therefore concurs with the opinion expressed in the decision under appeal and the objective technical problem formulated therein, i.e. the provision of an alternative UV curable coating. The same position was adopted by the respondent in its reply to the statement of grounds of appeal.
4. In its decision, the opposition division stated that paragraphs [0029] and [0039] of D4 suggested amine synergists and waxes as possible additional ingredients

of the coating compositions disclosed therein. The skilled person would have routinely included them in the coating composition of example 1 of D4 and varied their amounts. Thus they would have arrived at the subject-matter of claim 1 in an obvious manner based on D4 alone.

4.1 On appeal, the appellant did not contest the opposition division's conclusion as regards the amine synergist. Nor did it contest that the waxes, as referred to in paragraph [0039] of D4, are wax lubricants within the meaning of claim 1. However, with regard to the wax lubricant of claim 1, it essentially argued as follows. Paragraph [0039] of D4 required that the amount of wax be carefully chosen so as not to substantially compromise the ink resistance of the coating. The invention of D4 was essentially based on hydrophilic coatings and the fact that lipophilic colourants, such as those contained in Sharpie pens, as shown by A01, could not penetrate a hydrophilic coating but essentially remained on it and could be easily wiped off. If a wax were included in the coating compositions of D4, the resulting coatings would be more lipophilic. This would interfere with the actual goal of D4, as lipophilic colourants could more easily penetrate a more-lipophilic coating, resulting in less-easy removal. Thus the skilled person would not have included a wax in the composition of D4, example 1, at least not in an amount as provided in claim 1.

4.2 First of all, it is not at all apparent that D4 is aimed at hydrophilic coatings as alleged by the appellant, nor is it apparent that it addresses lipophilic colourants. As correctly pointed out by the respondent, the words hydrophilic and lipophilic are not used anywhere in D4. The appellant's corresponding

statements, therefore, are merely unproven conjectures. Secondly, D4 teaches a silicone compound as one of the required ingredients of the coating compositions disclosed therein. As also pointed out by the respondent, it is precisely this ingredient which prevents penetration of colourants into the coating (D4, paragraph [0023]). Without corroborating evidence, which the appellant did not provide, there is therefore no reason to assume that the incorporation of a wax in the coating composition of D4, example 1 in an amount as provided in claim 1 compromises the ink resistance of the resulting coating.

The board therefore concurs with the conclusions drawn in the decision under appeal that the subject-matter of claim 1 of the third auxiliary request does not involve an inventive step and that this request is not allowable.

- 4.3 For the above conclusion, it is irrelevant whether the patent is aimed at hydrophobic coatings, as argued by the appellant. Therefore it is not necessary to decide on the admittance of the technical information in the first two paragraphs under the table on page 8 of the statement of grounds of appeal, which is intended to prove that a coating obtained with the coating composition of example I of the patent also has a hydrophobic character.

Main request, auxiliary requests 1 and 2

5. Claim 1 of auxiliary requests 1 and 2 differs from claim 1 of auxiliary request 3 only in that the weight percentage range for the wax lubricant is broader (auxiliary request 1: "*from 5 wt.% to 9 wt.%*"; auxiliary request 2: "*from 6 wt.% to 8 wt.%*").

Claim 1 of the main request differs from claim 1 of auxiliary request 3 not only in having a broader weight percentage range for the wax lubricant ("from 1 wt.% to 10 wt.%") but also in not imposing a limitation on the amount of the silicone acrylate in the coating.

Hence the subject-matter of claim 1 of the main request and auxiliary requests 1 and 2 fully encompasses the subject-matter of claim 1 of auxiliary request 3. The above conclusion must therefore apply *a fortiori* also to the main request and auxiliary requests 1 and 2. As already stated in the decision under appeal, these requests are not allowable either.

Auxiliary requests 4 and 5

6. The appellant filed auxiliary requests 4 and 5 with the statement of grounds of appeal. The respondent requests that auxiliary requests 4 and 5 not be admitted.
7. Article 12(6) RPBA 2020 stipulates that a board shall not admit requests, facts, objections or evidence which should have been submitted, or which were no longer maintained, in the proceedings leading to the decision under appeal, unless the circumstances of the appeal case justify their admittance.
8. According to the appellant, these auxiliary requests overcame objections that were only raised during the oral proceedings before the opposition division. Therefore auxiliary requests 4 and 5 could not have been filed earlier (statement of grounds of appeal, page 2, first paragraph).

First of all, it must be noted that the appellant has not explained at all which objections exactly are supposed to have been raised only at the oral proceedings before the opposition division. For this reason alone, its argument is not convincing. In addition, the mere fact of new objections at oral proceedings before an opposition division cannot be sufficient for admittance only on appeal. For this purpose, it would additionally have to be explained why it would have been impossible or at least unreasonable to file the requests still during the oral proceedings before the opposition division. The appellant has not submitted anything in this regard either. As set out by the respondent, auxiliary requests 4 and 5 could and in fact should have been filed at the latest during the oral proceedings before the opposition division.

The board therefore exercises its discretion under Article 12(6) RPBA 2020 and decides not to admit auxiliary requests 4 and 5.

9. In view of the non-admittance of auxiliary requests 4 and 5, it is not necessary to decide on the admittance of the technical information in the last two paragraphs on page 11 of the statement of grounds of appeal filed by the appellant in support of inventive step of these requests.
10. The respondent requested that document A01 filed by the appellant not be admitted. Since the final decision is to grant the respondent's main request, i.e. to dismiss the appeal, it is not necessary to give reasons why A01 is taken into account in the present decision.

Order

For these reasons it is decided that:

The appeal is dismissed.

The Registrar:

The Chairman:



M. Schalow

M. O. Müller

Decision electronically authenticated