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**Datasheet for the decision
of 23 January 2023**

Case Number: T 0094/21 - 3.3.02

Application Number: 15723411.3

Publication Number: 3140356

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C08G59/40, C09D163/00, C08K3/22

Language of the proceedings: EN

Title of invention:
CHROMATE FREE PRETREATMENT PRIMER

Patent Proprietor:
PRC-Desoto International, Inc.

Opponent:
Akzo Nobel Coatings International BV

Headword:

Relevant legal provisions:
EPC Art. 123(2), 111(1)
RPBA 2020 Art. 12(4), 12(6)

Keyword:

Amendments - added subject-matter (no)

Request filed with grounds of appeal - should have been
submitted in first-instance proceedings (no) - admitted (yes)

Remittal to the department of first instance (yes)

Decisions cited:

Catchword:



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Case Number: T 0094/21 - 3.3.02

D E C I S I O N
of Technical Board of Appeal 3.3.02
of 23 January 2023

Appellant: PRC-Desoto International, 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 15 December
2020 revoking European patent No. 3140356
pursuant to Article 101(3)(b) EPC.**

Composition of the Board:

Chairman M. O. Müller
Members: M. Maremonti
R. Romandini

Summary of Facts and Submissions

- I. The appeal lodged by the patentee ("appellant") lies from the decision of the opposition division to revoke European patent No. 3 140 356 ("the patent").
- II. The opposition was filed under Article 100(a) and (c) EPC. During prosecution, the appellant filed sets of claims according to a main request and auxiliary requests 1 and 2. The opposition division came to, *inter alia*, the conclusion that the subject-matter of claim 1 according to the main request and auxiliary requests 1 and 2 infringed Article 123(2) EPC.
- III. In its statement of grounds of appeal, the appellant maintained, *inter alia*, that the subject-matter of the claims of the main request and auxiliary requests 1 and 2 underlying the appealed decision complied with Article 123(2) EPC. It also filed further sets of claims according to auxiliary requests 3 to 11.
- IV. In its reply to the appeal, the opponent ("respondent") rebutted the arguments of the appellant and submitted that the subject-matter claimed in the main request and auxiliary requests 1 and 2 infringed Article 123(2) EPC. It also raised objections to the admittance and allowability under Article 123(2) EPC of auxiliary requests 3 to 11.
- V. The parties were summoned to oral proceedings as per their requests. In preparation for the oral proceedings, the board issued a communication under Article 15(1) RPBA 2020 in which it expressed, *inter alia*, the preliminary opinion that the main request and auxiliary requests 1 and 2 underlying the appealed decision did not comply with Article 123(2) EPC.

VI. Oral proceedings before the board were held on 23 January 2023 by videoconference. During oral proceedings, the appellant withdrew its main request and auxiliary requests 1 and 2 and made auxiliary request 3 as filed with the statement of grounds of appeal its main request. Remaining auxiliary requests 4 to 11 were maintained and renumbered as auxiliary requests 1 to 8.

VII. The main request (previous auxiliary request 3) as filed with the statement of grounds of appeal contains 13 claims, with claim 1 reading as follows:

"1. A solvent-borne coating composition comprising:

(a) a first component comprising:

(i) an epoxy functional resin in an amount of greater 10 weight% based on the total solid weight of the blended coating composition; and

(ii) a corrosion resisting particle comprising MgO; and

(b) a second component comprising a crosslinker having a first functionality that crosslinks with the epoxy functionality of the first component and a second functionality that self-crosslinks, wherein the crosslinker comprises an amino silane and the crosslinker is present in an amount of 10 to 70 wt.-%, wherein the weight percent is based on the total solid weight of the blended coating composition."

Claims 2 to 10 define embodiments of the composition of claim 1. Claim 11 is directed to a method of coating a substrate by applying the composition of claim 1.

Claims 12 and 13 define a substrate coated according to claim 11.

VIII. Final requests relevant to the decision

The appellant requested that the appealed decision be set aside and that the patent be maintained in amended form on the basis of the claims of the main request or, alternatively, one of auxiliary requests 1 to 8. These requests have been filed with the statement of grounds of appeal as auxiliary requests 3 and 4 to 11, respectively.

The respondent requested that the appeal be dismissed. It also requested that the main request and auxiliary requests 1 to 8, corresponding to auxiliary requests 3 to 11 filed with the statement of grounds of appeal, not be admitted into the proceedings. The respondent further requested, should the board decide to set aside the appealed decision, that the case be remitted to the opposition division for further prosecution.

IX. The appellant's submissions relevant to the present decision are summarised as follows.

Admittance of the main request

- No objection against the specification in claim 1 of the main request underlying the appealed decision of the crosslinker being a "silane" in general had been raised by the respondent during the proceedings before the opposition division.
- This objection appeared in the appealed decision for the first time.
- Therefore, the current main request, addressing this objection, could not have been filed before the opposition division, and the statement of

grounds of appeal represented the first opportunity to file it.

- The sole restriction of "*silane*" to "*amino silane*" contained in the current main request as compared with the main request underlying the appealed decision did not raise any new issue and addressed an objection raised in the decision under appeal.
- Hence, the main request should be admitted into the proceedings.

Compliance with Article 123(2) EPC

- Claim 1 of the main request specified the nature of the coating, the amounts of epoxy resin and crosslinker, and the nature of the crosslinker as an amino silane.
- The feature expressing the claimed coating as a "*solvent-borne coating composition*" was selected from a list of alternative compositions disclosed in paragraphs [0030] and [0039] of the application as filed.
- The ranges of the amounts of epoxy resin and crosslinker were disclosed respectively in the first and second sentences of paragraph [0029] of the application as filed. In view of the expressions "*certain embodiments*" in the first sentence and "*in these embodiments*" in the second sentence, it was clear that the disclosed amounts of crosslinker applied to any of the previously specified amounts of epoxy resin.
- The expression "*certain embodiments*" was used in the application as filed for single features. It identified preferred features of the components of the coating composition of the invention and not coating compositions different from each other,

i.e. comprising different combinations of components.

- The same paragraph [0029] of the application as filed also disclosed the preference that the crosslinker be amino silane.
- Therefore, once a solvent-borne coating composition had been selected, it could be combined with the remaining features of claim 1 of the main request without adding any new subject-matter. Moreover, the example of the application as filed constituted a clear pointer towards the claimed combination of features.
- It had to be concluded that the main request complied with Article 123(2) EPC.

X. The respondent's submissions relevant to the present decision are summarised as follows. For further details, reference is made to the reasons for the decision below.

Admittance of the main request

- The current main request could and should have been filed before the opposition division.
- Therefore, it should not be admitted into the proceedings.

Compliance with Article 123(2) EPC

- Claim 1 of the main request defined subject-matter obtained by selecting features from different embodiments disclosed in the application as filed.
- No pointer towards the claimed combination of features was present in the application as filed.
- It had to be concluded that the main request did not meet the requirements of Article 123(2) EPC.

Reasons for the Decision

Main request - admittance into the proceedings

1. The main request was filed as auxiliary request 3 with the statement of grounds of appeal. The respondent requested that this request not be admitted into the proceedings.
- 1.1 The respondent submitted that the main request could and should have been filed before the opposition division. It argued that the appellant, as the patent proprietor, should have revealed all its claim requests during the first-instance proceedings. This would have been in the interest of the public, so that legal certainty could be guaranteed. The admittance of the main request into the appeal proceedings would lead to a ping-pong situation between the opposition division and the board, waiting for the appellant to eventually file all its claim requests. Moreover, the restriction to amino silane as the crosslinker in claim 1 of the main request did not render this request *prima facie* allowable under Article 123(2) EPC.
- 1.2 The board finds these arguments unconvincing.
 - 1.2.1 The only difference between the main request underlying the appealed decision and the current main request concerns the crosslinker contained in the claimed composition. Indeed, while the former main request indicated "*silane*", the current main request mentions "*amino silane*" as the crosslinker.
 - 1.2.2 The respondent confirmed at the oral proceedings before the board that it had not raised an objection under Article 123(2) EPC before the opposition division against the inclusion of "*silane*" as the crosslinker in

claim 1 of the main request underlying the appealed decision.

- 1.2.3 Also, no such objection is reported in the minutes of the oral proceedings before the opposition division as having been raised by the opposition division during the oral proceedings.
- 1.2.4 However, this objection to the specification in claim 1 of the main request underlying the appealed decision of "*silane*" in general as the crosslinker is mentioned by the opposition division in its reasons for the decision under appeal (paragraph bridging pages 4 and 5). Therefore, considering the available evidence, this objection was raised in the appealed decision for the first time. Hence, the statement of grounds of appeal represented the first opportunity for the appellant to react to this objection by filing the current main request.
- 1.2.5 Contrary to the respondent's view, it lies in the very nature and usual routine of *inter partes* proceedings that when objections are raised by an opponent or the opposition division, a patent proprietor promptly files fallback positions, *inter alia*, auxiliary claim requests in response.
- 1.2.6 In the case at hand, absent any objection to the specification of the crosslinker as comprising "*silane*" in general, the appellant had no reason to file a claim request restricting silane to "*amino silane*" before the opposition division.
- 1.2.7 Thus, the board holds that the appellant should not have filed the current main request in the first-instance proceedings (Article 12(6) RPBA 2020).
- 1.2.8 Additionally, the amendment of "*silane*" to "*amino silane*" in claim 1 of the current main request is not

complex and, as set out above, directly addresses an objection leading to the decision under appeal.

- 1.3 For these reasons, the board, in exercising its discretion under Article 12(4) and (6) RPBA 2020, decided to admit the current main request into the proceedings.

Main request - claim 1 - added subject-matter under Article 123(2) EPC

2. Claim 1 of the main request (point VII above) contains the following amendments to claim 1 as filed.

(a) The coating is defined as a "*solvent-borne coating composition*".

(b) The epoxy functional resin is stated to be present "*in an amount of greater 10 weight% based on the total solid weight of the blended coating composition*".

(c) The corrosion resisting particle is stated to comprise "*MgO*".

(d) The crosslinker is stated to comprise "*amino silane*" and

(e) to be present "*in an amount of 10 to 70 wt.-%, wherein the weight percent is based on the total solid weight of the blended coating composition*".

3. The respondent submitted that the combination of features (a), (b), (d) and (e) did not have any basis in the application as filed.

- 3.1 It argued that feature (a) had been selected from a list of equally preferred alternative compositions disclosed in paragraphs [0030] and [0039] of the application as filed. Neither the single example nor other passages of the application as filed constituted

a pointer towards the claimed selection of a "*solvent-borne coating composition*".

- 3.2 The respondent further submitted that features (b) and (e) had each been selected from respective lists of three ranges disclosed in paragraph [0029] of the application as filed. The disclosed ranges were alternatives to each other, i.e. there was no level of preference. The chosen combination of the first member of the first list (feature (b)) with the second member of the second list (feature (e)) was arbitrary since there was no pointer towards this combination.
- 3.3 Moreover, the ranges indicated in paragraph [0029] of the application as filed for the epoxy resin and the crosslinker were stated to belong to "*certain embodiments*" only. There was no disclosure in the application as filed that these ranges applied to the "*solvent-borne coating composition*" (feature (a)) selected from paragraphs [0030] and [0039] of the application as filed.
- 3.4 As regards feature (d), the respondent argued that although amino silanes were referred to in paragraph [0029] of the application as filed, there was no connection between the amino silanes and the weight% ranges disclosed in the first part of the same paragraph [0029] for the crosslinker. This was because paragraph [0029] was made up of four sentences where:
- the first sentence referred to "*certain embodiments*"
 - the second sentence referred to "*these embodiments*"
 - the third sentence referred to "*certain embodiments*"
 - the fourth sentence referred to "*certain embodiments*"

The first two sentences disclosing the weight% ranges of epoxy resin and crosslinker were connected because of the word "*these*" in the second sentence. But the third sentence contained no language connecting it to the previous one(s). In going from the second to the third sentence, the focus shifted from crosslinkers in general to one type, i.e. the "*amino silane used according to certain embodiments*". This shift in focus caused a disconnection between the weight% ranges for epoxy resin and crosslinker in the first two sentences and the amino silane in the third sentence of paragraph [0029] of the application as filed.

3.5 The respondent acknowledged that according to paragraph [0024] of the application as filed, amino silanes were preferred. However, the same paragraph [0024] stated that in "*certain embodiments*", the crosslinker comprised dipodal silane. In view of the expression "*certain embodiments*", if a connection between paragraphs [0024] and [0029] were present, this linked the weight% ranges of paragraph [0029] to dipodal silane and not to amino silanes.

3.6 Therefore, the respondent concluded that selections from different embodiments had been carried out to arrive at the subject-matter of claim 1 of the main request. However, under the case law of the Boards of appeal, the content of an application as filed must not be considered a reservoir from which features pertaining to separate embodiments could be combined to artificially create a particular embodiment. Therefore, the requirements of Article 123(2) EPC were not met.

4. The board disagrees.

4.1 The application as filed (paragraphs [0004] and [0005]) makes it directly and unambiguously clear that the coating composition of the invention comprises an epoxy

functional resin, a corrosion resisting particle, and a crosslinker having a first functionality to crosslink with the epoxy functionality of the resin and a second functionality able to self-crosslink. These are also the basic components mentioned in claim 1 of the main request (point VII above).

4.2 The expression "*certain embodiments*" referred to by the respondent is used numerous times throughout the application as filed (see e.g. paragraphs [0008] to [0010], [0012] to [0015], [0018], [0019], [0024], [0029], [0031] and [0036]). However, as pointed out by the appellant, this expression merely refers to preferred features, i.e. further specifications of the above-defined components of the coating composition of the invention and not to coating compositions different from each other, i.e. comprising different combinations of components.

4.3 In view of this reading of the expression "*certain embodiments*", paragraph [0029] of the application as filed merely discloses the preferred concentrations by weight of the epoxy resin component and the crosslinker component. In particular, paragraph [0029] reads:

*"In certain embodiments of the present invention, the epoxy resin is present in the coating compositions of the present invention in an amount greater than 10 weight %, such as 20 to 90 weight %, or, in some cases, 20 to 60 weight %, with weight percent being based on the total solid weight of the blended coating composition. The total amount of crosslinker **in these embodiments** may be present in an amount of up to 70 weight %, such as 10 to 70 or 10 to 40 weight %" (emphasis added by the board).*

The board concurs with the appellant that the expression "*in these embodiments*" clearly links each of the three mentioned amounts of crosslinker to each of the amounts of epoxy resin previously specified. Therefore, the board holds that paragraph [0029] directly and unambiguously discloses the combination of features (b) and (e) mentioned above, expressing the amounts of epoxy resin and crosslinker specified in claim 1 of the main request.

4.4 Moreover, immediately after this, paragraph [0029] of the application as filed further discloses that amino silane is used as the crosslinker "*according to certain embodiments of the present invention*". Again in view of the above reading of the expression "*certain embodiments*", this sentence directly and unambiguously discloses amino silanes as preferred crosslinkers. The fact that this sentence immediately follows the sentence specifying the amounts of crosslinker directly and unambiguously reveals to the skilled person that these amounts preferably apply to amino silanes. In other words, paragraph [0029] directly and unambiguously discloses the combination of features (b), (d) and (e) mentioned above, specifying the amount of epoxy resin as well as the amount and nature of the crosslinker.

4.5 A preference for amino silanes as the crosslinker is also disclosed in paragraph [0024] of the application as filed: "*Particularly suitable crosslinkers include amino silanes*". The fact that immediately after this paragraph [0024] also discloses that "*In certain embodiments, the crosslinker comprises dipodal silane*" merely indicates, in view of the reading of the expression "*certain embodiments*" set out above, an additional preference within amino silanes for dipodal silanes. Therefore, contrary to the respondent's view,

the expression "*certain embodiments*" does not link the amounts of epoxy resin and crosslinker mentioned in paragraph [0029] only to the dipodal silane disclosed in paragraph [0024].

- 4.6 In claim 1 of the main request, the above-mentioned combination of features (b), (d) and (e), which, as set out above is directly and unambiguously disclosed in paragraph [0029] of the application as filed, has been combined with feature (a), expressing that the coating composition is a "*solvent-borne coating composition*". This feature is disclosed in paragraph [0039] of the application as filed reading that "*the coating compositions **of the present invention** can be liquid coating compositions, examples of which include aqueous or water-based **and solvent-based coating compositions** and electrodepositable coating compositions, or in the form of a co-reactable solid in particulate form, i.e., a powder composition*" (emphasis added by the board).
- 4.7 Therefore, paragraph [0039] refers to "*the coating compositions of the present invention*" when disclosing that these can especially be solvent-borne compositions. By way of the reference to the coating compositions of the present invention, paragraph [0039] makes it directly and unambiguously clear that what follows encompasses any teaching disclosed before, including the one in paragraph [0029] discussed above. Hence, the combination of the feature that the composition is solvent-borne (feature (a)) and features (b), (d) and (e) is directly and unambiguously derivable from the application as filed.
- 4.8 A solvent-borne composition comprising an epoxy functional polymer and an amino silane as the crosslinker is also pointed to in paragraph [0032] and

the sole example of the application as filed (tables 1 and 2 on pages 15 to 17).

4.9 Even though no objection to the inclusion in claim 1 of the main request of the above-mentioned feature (c), expressing that the corrosion resisting particle comprises MgO, has been raised by the respondent, the board notes that this feature is directly and unambiguously disclosed and pointed to, e.g. in paragraphs [0010], [0011], [0013], [0014], [0016] and [0017] of the application as filed, where a preference for MgO as the corrosion resisting particle is indicated.

5. For these reasons, the board concludes that the subject-matter of claim 1 of the main request meets the requirements of Article 123(2) EPC. The objection raised by the respondent against the allowability of the main request under Article 123(2) EPC must therefore fail.

Remittal to the opposition division

6. The respondent requested to remit the case to the opposition division for further prosecution if a claim request of the appellant was found to comply with Article 123(2) EPC so that the appealed decision had to be set aside. The appellant did not raise any objection against this request of the respondent in the written or oral proceedings.

6.1 Under Article 12(2) RPBA 2020, the primary object of the appeal proceedings is to review the decision under appeal in a judicial manner to give the losing party an opportunity to challenge the decision on its merits.

6.2 The appealed decision deals only with the issue of added subject-matter under Article 123(2) EPC. However,

the opposition also invoked lack of novelty and lack of inventive step (Article 100(a) EPC).

6.3 Therefore, essential questions concerning the patentability of the claimed subject-matter have not yet been examined and decided on by the opposition division.

6.4 Hence, the board finds it appropriate to make use of its discretion under Article 111(1) EPC and remit the case to the opposition division for further prosecution, in accordance with the respondent's request.

Order

For these reasons it is decided that:

1. The decision under appeal is set aside.
2. The case is remitted to the opposition division for further prosecution.

The Registrar:

The Chairman:



N. Maslin

M. O. Müller

Decision electronically authenticated