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**Datasheet for the decision
of 3 May 2024**

Case Number: T 1106/21 - 3.3.02

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Language of the proceedings: EN

Title of invention:

SLIDING MEMBER AND SLIDING MATERIAL COMPOSITION

Patent Proprietor:

Taiho Kogyo Co., Ltd

Opponent:

Federal-Mogul Wiesbaden GmbH

Relevant legal provisions:

EPC Art. 56
RPBA 2020 Art. 12(6), 13(1)

Keyword:

Inventive step
Late-filed request



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Case Number: T 1106/21 - 3.3.02

D E C I S I O N
of Technical Board of Appeal 3.3.02
of 3 May 2024

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Decision under appeal: **Decision of the Opposition Division of the
European Patent Office posted on 10 May 2021
revoking European patent No. 2757277 pursuant to
Article 101(3) (b) EPC.**

Composition of the Board:

Chairman M. O. Müller
Members: P. O'Sullivan
L. Bühler

Summary of Facts and Submissions

- I. The appeal of the patent proprietor (hereinafter appellant) lies from the decision of the opposition division to revoke European patent EP 2 757 277.
- II. The following documents, *inter alia*, cited during opposition proceedings, were invoked by the parties in appeal proceedings:

D1: EP 2 048 391 A2
D3: EP 0 984 182 A1
- III. According to the contested decision, the ground for opposition under Article 100(b) EPC did not prejudice the maintenance of the patent as granted. Furthermore, the granted claims were novel over D1, D2 and D3. However, starting from either D1 or D3 as closest prior art, the claimed subject-matter lacked inventive step. Similarly, the claims of the 1st and 3rd auxiliary requests lacked inventive step. Claim 1 of the 2nd and 4th auxiliary requests failed to meet the requirements of Article 84 EPC. The patent was thus revoked.
- IV. In a communication pursuant to Article 15(1) RPBA sent in preparation for oral proceedings, the board *inter alia* expressed the preliminary view that the subject-matter of at least claim 1 of the main request did not involve an inventive step.
- V. Oral proceedings by videoconference took place as scheduled on 3 May 2024 in the presence of both parties.

VI. Requests relevant to the present decision

The appellant requested that the decision under appeal be set aside, and that the patent be maintained as granted (main request), or, alternatively, that the patent be maintained on the basis of one of the sets of claims of

- the 1st to 3rd, 5th to 7th and 9th auxiliary requests filed during opposition proceedings, the 1st to 3rd auxiliary requests having been submitted with the letter dated 29 July 2019, the 5th and 6th auxiliary request having been submitted with the letter dated 28 April 2020 and the 7th and 9th auxiliary requests having been submitted with the letter dated 18 December 2020,
- the 11th to 16th auxiliary requests submitted with the statement of grounds of appeal, or
- the 17th auxiliary request submitted with the letter dated 13 July 2022.

The appellant also requested that the 11th to 17th auxiliary requests be admitted into the proceedings.

The opponent (hereinafter respondent) requested that the appeal be dismissed. Furthermore, it requested that the 1st to 3rd, 5th to 7th, 9th, and 15th to 17th auxiliary requests not be admitted into the proceedings.

VII. For the text of claim 1 of the main request, as well as claim 1 of each of the auxiliary requests, reference is made to the reasons for the decision set out below.

VIII. For the relevant party submissions, reference is made to the reasons for the decision set out below.

Reasons for the Decision

Main Request (patent as granted) - Article 100(a) and 56 EPC

1. Inventive step - Articles 56 and 100(a) EPC

1.1 Background - the patent

1.1.1 The patent relates to a sliding member and a sliding coating composition. Conventionally, to lubricate sliding sections of machinery, a surface of each sliding member is coated with a sliding material composition. This composition should create a lubricating film having low friction and excellent wear resistance (patent, paragraphs [0001] and [0002]).

1.1.2 In conventional techniques, mating members to mate with sliding members have high hardness, obtained by heat treatment. Hence, conventional sliding material compositions are configured on the assumption that the mating members are of high hardness. In recent years, in order to lower manufacturing costs, mating members untreated for hardness were developed. A demand has therefore arisen for sliding members having a sliding material composition suitable to these types of mating members (paragraph [0006]).

1.1.3 The sliding material composition according to the patent comprises a binder resin, molybdenum disulfide, and hard substance particles (paragraph [0010]).

1.1.4 The main request consists of three claims. Independent claim 1 reads as follows:

*"1. A sliding member for sliding with a mating member having a ferrite phase at least on a surface thereof, the sliding member comprising:
a coating layer comprising a binder resin, molybdenum disulfide and hard substance particles,
wherein the hard substance particles have a Vickers hardness of equal to or larger than HV 600,
wherein a content of the molybdenum disulfide in the composition is 30 to 70% by volume, and
wherein the hard substance particles have a massive form, wherein massive form means an irregular form that does not substantially contain projections equal to or smaller than 90°, and excludes forms such as spherical and acute angle forms that can be formed by processing.*

Independent claim 3 defines a sliding material composition for use in a sliding member for sliding with a mating member having a ferrite phase at least on a surface thereof, the sliding material composition being defined identically to the coating layer of claim 1.

1.2 Closest prior art and distinguishing feature

1.2.1 Claim 1 as set out above may be summarised as follows:

"A sliding member for [the function stipulated] comprising a coating layer comprising:

- a binder resin,
- 30 to 70% by volume molybdenum disulfide and
- hard substance particles having:

- a Vickers hardness of equal to or larger than HV 600, and
- a massive form [as defined in the claim]"

1.2.2 The parties agreed that either of D1 or D3 may represent the closest prior art. It is undisputed that D1 and D3 disclosed a sliding member having the function stipulated in claim 1, namely *"for sliding with a mating member having a ferrite phase at least on a surface thereof"*.

In the following, the board first assesses inventive step starting from D1.

1.3 D1 is a patent document disclosing a sliding bearing comprising a resin layer composed of one or more of polyamide imide resin, polybenzimidazole resin, and polyimide resin, coated on surfaces of a bearing alloy (paragraph [0001]). Table 1 (D1, page 5) discloses coating compositions which were coated onto the surface of bearing alloys (paragraph [0022]). Example 10 of D1 discloses a composition comprising 51.0 % by volume PBI resin, 9.0 % by volume Al_2O_3 and 40.0 % by volume MoS_2 as solid lubricant.

1.3.1 Al_2O_3 , comprised within the composition of example 10 of D1, is listed in the patent as a compound which may form the hard substance particles of claim 1 (patent paragraph [0031]).

1.3.2 The appellant argued that claim 1 was distinguishing from example 10 of D1 in that the Al_2O_3 in the latter (the hard substance particle according to the patent) displayed neither the claimed Vickers hardness of equal to or larger than HV 600, nor the massive form as required by contested claim 1.

- 1.3.3 The following assessment of inventive step is based on the assumption, to the appellant's advantage, that these features, namely the Vickers hardness and the massive form of the Al_2O_3 hard substance particles distinguish the subject-matter of claim 1 from example 10 of D1.
- 1.4 Technical effects and problem solved
 - 1.4.1 As stated by the respondent, the tests and comparative tests in table 1 of the patent did not investigate the technical effect of the form of the hard substance particles, in particular, whether there was an effect linked to the "massive form" of the particles over the allegedly different particles of D1. Hence, no technical effect linked to this distinguishing feature can be derived from the examples of the patent.
 - 1.4.2 During oral proceedings before the board, the appellant submitted that in view of paragraph [0036] of the patent, which described the results of the examples and comparative examples depicted in the table on page 6, and which stated that "all of the examples are in good lubrication states", an improvement had been demonstrated linked to the massive form.
 - 1.4.3 The board disagrees. It was not denied by the appellant that the examples of the patent did not compare compositions differing in the distinguishing features of claim 1 over D1. Hence, no technical effect can be derived from the examples linked to the massive form as required by claim 1.
 - 1.4.4 Similarly, in relation to the Vickers hardness of the hard substance particles, no specific technical effects

were alleged nor demonstrated in the examples of the patent or elsewhere.

- 1.4.5 The appellant also argued that the technical effects of the distinguishing features were derivable from paragraphs [0007] and [0011] of the application as filed.
- 1.4.6 Specifically, paragraph [0007] disclosed that the sliding composition and the sliding member wrapped a roughened portion of the mating member by sliding, thereby leading to excellent wear and seize resistance.
- 1.4.7 According to paragraph [0011], the hard substance particles comprised in the composition imparted a "wrapping effect", thereby improving wear and seize resistance.
- 1.4.8 In view of these effects, the objective technical problem according to the appellant was the provision of a sliding member for sliding with a mating member, which shows an improved excellent wear resistance and seize resistance.
- 1.4.9 The board disagrees. As noted by the opposition division, despite the allegations of improvement according to the above passages of the patent, there is no evidence of said alleged effects. In this regard, it is established case law of the boards of appeal that alleged advantages for which a patent proprietor does not provide sufficient evidence to support the comparison with the closest prior art, cannot be taken into consideration in determining the problem underlying the invention and therefore in assessing inventive step.

1.4.10 Hence, the objective technical problem underlying claim 1 starting from example 10 of D1 is that set out by the opposition division in the contested decision and endorsed by the respondent, namely the provision of an alternative coating layer composition for use in a sliding member.

1.5 Obviousness

1.5.1 The appellant argued only that the claimed subject-matter represented a non-obvious solution to its proposed objective technical problem as set out above, namely the provision of a sliding member for sliding with a mating member, which shows an improved excellent wear resistance and seize resistance. No arguments were however submitted by the appellant in relation to obviousness if the objective technical problem were to be formulated as concluded by the board above.

1.5.2 In this regard, the board agrees with the arguments of the respondent. Specifically, when not justified by a hitherto unknown technical effect distinguishing the claimed solution from other possible solutions, the adjustment of particular features of the known composition such as, in the present case, the particle form and its hardness, represent arbitrary choices from a host of possible solutions. In such a situation, it is not required for the prior art to contain an incentive for the skilled person to select the claimed solution. Rather, all possible solutions are equally suitable and obvious candidates for solving the above objective technical problem. Hence, the skilled person wishing to solve the above-mentioned objective technical problem would have arbitrarily adjusted the hardness and form of the hard substance particles, and

thereby would have arrived at the subject-matter of claim 1.

1.5.3 Consequently, the subject-matter of at least claim 1 of the main request does not involve an inventive step starting from D1 as closest prior art.

1.6 As set out above, the respondent also argued that similar considerations as for D1 applied to D3, and the claimed subject-matter also lacked inventive step starting from D3 as closest prior art.

1.6.1 D3 is a patent document which discloses a sliding bearing for an internal combustion engine coated with a composition comprising a binder resin and 55-95 % by weight MoS₂ (paragraphs [0001]) and [0041], (b)). According to paragraph [0043], components other than MoS₂ and polyamide-imide resin can be used in an amount of up to 10% by weight. In particular, paragraph [0043], section (c) discloses a "friction adjusting agent" which can be chosen from a list including SiC and Al₂O₃ (hard substance particles according to the patent) in a particle size of 5 µm or less. Similarly to D1, D3 discloses no information with regard to the specific form and the Vickers hardness of the particles, and hence the claimed subject-matter is distinguished from D3 in the same features as set out above for D1.

1.6.2 In the same manner as for D1, there are no technical effects associated with the distinguishing features of claim 1 over D3. Hence, the objective technical problem starting from D3 also remains the same as for D1, namely the provision of an alternative coating layer composition for use in a sliding member.

1.6.3 At oral proceedings, the appellant failed to provide any arguments according to which the conclusion starting from D3 would be any different to that starting from D1. Therefore, at least the subject-matter of claim 1 lacks inventive step starting from D3.

1.7 Hence, the ground for opposition under Article 100(a) EPC in combination with Article 56 EPC prejudices the maintenance of the patent as granted.

1st to 3rd, 5th to 7th and 9th auxiliary requests - admittance

2. The appellant requested alternatively that the patent be maintained on the basis of the sets of claims of the 1st to 3rd, 5th to 7th and 9th auxiliary requests filed during opposition proceedings, the numbering referring to that valid prior to the oral proceedings before the opposition division. Of these requests, the 1st to 3rd auxiliary requests were submitted with the letter dated 29 July 2019, the 5th and 6th auxiliary request with the letter dated 28 April 2020 and the 7th and 9th auxiliary requests with the letter dated 18 December 2020.

2.1 During oral proceedings before the opposition division, the auxiliary requests were renumbered. In this regard, reference is made to the table in the respondent's reply to the grounds of appeal (pages 2-3). As depicted in this table, stated by the respondent and confirmed by the decision of the opposition division (page 6, point 12, final sentence), the 1st to 3rd, 5th to 7th and 9th auxiliary requests were withdrawn during oral proceedings before the opposition division. This was not contested by the appellant.

- 2.2 The respondent requested that the 1st to 3rd, 5th to 7th and 9th auxiliary requests not be admitted into appeal proceedings.
- 2.3 According to Article 12(6) RPBA, the board shall not admit *inter alia* requests which were no longer maintained in the proceedings leading to the decision under appeal, unless the circumstances of the appeal case justify their admittance.
- 2.4 No such justification was provided by the appellant, neither with the statement of grounds of appeal, nor with the letter dated 13 July 2022 in response to the respondent's reply with which the objection against the admittance of said requests was raised, nor during oral proceedings before the board.
- 2.5 The board also saw no circumstances justifying the resubmission and admittance of these withdrawn requests in appeal proceedings.
- 2.6 Hence, the board decided not to admit the 1st to 3rd, 5th to 7th and 9th auxiliary requests into the proceedings pursuant to Article 12(6) RPBA.

11th auxiliary request - inventive step

3. The set of claims of the 11th auxiliary request is identical to that of the 1st auxiliary request underlying the contested decision.
4. Claims 1 and 3 were amended compared to claims 1 and 3 of the main request by the addition of the text:
- "wherein a content of the hard substance particles in the composition is 0.1 to 5 % by volume".*

- 4.1 As stated by the respondent, this limitation compared to claim 1 of the main request fails to render the claimed subject-matter inventive over either D1 or D3.
- 4.2 The board acknowledges in this respect that the amount of Al_2O_3 used in example 10 of D1 was 9.0 % by volume, hence outside the range of claim 1 of the 11th auxiliary request. Nevertheless, as set out by the respondent, D1 generally discloses that the particles may be present in an amount of from 3 to 15 vol. % (paragraph [0017]), which overlaps with the claimed range of 0.1 to 5 vol.%.
- 4.3 Similarly, in D3, the amount of Al_2O_3 employed may range from 0.3 to 10% by weight, more preferably 0.5 to 5% by weight (paragraph [0043], (c)). The respondent calculated the latter as corresponding to 0.18 to 9.1 vol.% (reply, page 30, second full paragraph). This calculation was not contested by the appellant. This range almost entirely overlaps with the claimed range of 0.1 to 5 vol.%.
- 4.4 Since no technical effect was demonstrated for selecting an amount of hard substance particles within the claimed range, the objective technical problem remains an alternative as set out for claim 1 of the main request. Given the board's conclusion for claim 1 of the main request, this was not contested by the appellant.
- 4.5 The appellant however argued that there was no indication in D1 or D3 to reduce the amount of the particles while still providing a composition having satisfactory results as shown in the examples of the

patent. Hence, the claimed solution involved an inventive step.

4.6 The board disagrees. Given the teaching of D1 that one can work within the range of 3 to 15% for the Al₂O₃ particles, or in D3 that one can work within the range of 0.5 to 5% by weight (0.18 to 9.1 vol.%) as set out above, the skilled person would expect to obtain satisfactory results by adjusting the amount of the hard substance particles to within these ranges. Doing so is nothing but routine experimentation and as such cannot contribute to inventive step.

4.7 Consequently, at least claim 1 of the 11th auxiliary request lacks inventive step starting from either D1 or D3.

12th auxiliary request - inventive step

5. In the 12th auxiliary request (corresponding to the 2nd auxiliary request underlying the contested decision), claims 1 and 3 were amended compared to claims 1 and 3 of the main request by addition of the text:

"wherein the hard substance particles have an average particle diameter that is 0.5 to 10 times as large as a surface arithmetic average roughness Ra of a sliding surface of the mating member, wherein the surface arithmetic average roughness Ra is measured in accordance with JIS B 0610 (2001)".

5.1 The respondent objected to claim 1 of the 12th auxiliary request *inter alia* under Articles 84 EPC.

5.2 The board agrees with the respondent. Specifically, in the text added to claim 1, which was not present in any

of the granted claims, the average particle diameter of the hard substance particles is provided relative to another measurement, namely the "surface arithmetic average roughness Ra of a mating member". However, since the latter mating member is not subject-matter of claim 1, the actual bounds of the average particle size remains unclear and undefined. Hence, the apparent limitation in claim 1 is not in fact a limitation at all, or at best, remains unclearly defined.

5.3 The appellant merely stated that the skilled person would understand how to determine the variables in question on the basis of the information in the claim. However, this is not convincing, as it does not explain how the average particle diameter of the hard substance particles can be calculated on the basis of a specific size variable relating to a mating member which is undefined in the claim.

5.4 Consequently, claim 1 of the 12th auxiliary requests fails to meet the requirements of Article 84 EPC.

13th auxiliary request - inventive step

6. In the 13th auxiliary request (corresponding to the 3rd auxiliary request underlying the contested decision), claims 1 and 3 were amended compared to claims 1 and 3 of auxiliary request 11 by the addition of the following text:

"wherein the composition contains a solid lubricant other than the molybdenum disulfide, wherein the other solid lubricant is at least one kind of solid lubricant selected from the group consisting of graphite, polytetrafluoroethylene (PTFE), tungsten disulfide, mica, boron nitride, graphite fluoride, and fullerene,

wherein the content of the other solid lubricant is 5 to 35% by volume".

- 6.1 The respondent submitted that claim 1 of the 13th auxiliary request *inter alia* lacked inventive step starting from D3 as closest prior art.
- 6.2 The board agrees. The appellant submitted that it would not have been obvious to include the features added to claim 1 in view of the fact that a technical effect linked thereto had been demonstrated in the examples of the patent. Specifically, examples 1-3 and examples 7-9 of the patent (table, page 6) provided evidence for an improvement. Hence, the objective technical problem was essentially the provision of an improved composition.
- 6.3 The board disagrees. In examples 1 to 3 of the patent (table, page 6), only the composition of example 3 included a solid lubricant other than MoS₂, namely PTFE in an amount of 35% by volume. However, this was not the sole difference with examples 1 and 2, since all three examples also differed in the amount of the hard substance particles (Al₂O₃; 1, 3 and 5% by volume, respectively), in the average diameter of said particles (0.05, 0.5 and 1 µm, respectively), and in the amount of MoS₂ added (30, 50 and 35 % by volume, respectively). Hence, independently of the results shown for the respective examples (table page 6, final two columns), it is not possible to attribute any potential effect to the presence of a further solid lubricant according to claim 1.
- 6.4 Similarly, in examples 7 to 9, the composition of all three examples comprised graphite (Gr) as an additional solid lubricant. Since there is no comparison with a composition not comprising an additional solid

lubricant, these examples also do not contain any evidence of a technical effect linked to this distinguishing feature.

6.5 The examples of the patent therefore fail to demonstrate any technical effect linked to the presence of a solid lubricant other than the molybdenum disulfide.

6.6 Consequently, the objective technical problem underlying claim 1 of the 13th auxiliary request remains the same as for claim 1 of the 11th auxiliary request set out above. As stated by the respondent, the presence of a further solid lubricant in addition to MoS₂ is taught as an optional possibility in D3. Specifically, in paragraph [0043] it is stated that components other than *inter alia* MoS₂ can be used in a total amount of 10% by weight or less. These components include graphite, boron nitride (BN) and tungsten disulfide, also listed as solid lubricants other than the molybdenum disulfide in claim 1 of the 13th auxiliary request.

6.7 The skilled person seeking to solve the above problem would implement these features as an arbitrary alternative, and would thereby arrive at the subject-matter of claim 1 of the 13th auxiliary request.

6.8 Consequently, claim 1 of the 13th auxiliary request fails to meet the requirements of Article 56 EPC.

14th auxiliary request - inventive step

7. In the 14th auxiliary request (corresponding to the 4th auxiliary request underlying the contested decision),

claims 1 and 3 were amended compared to claims 1 and 3 of auxiliary request 13 by addition of the text:

"wherein the molybdenum disulfide has an average particle diameter equal to or less than 5 μm ".

- 7.1 The respondent submitted that claim 1 of the 14th auxiliary request lacked inventive step under Article 56 EPC starting from D3 as closest prior art.
- 7.2 Compared to claim 1 of the 13th auxiliary request, the further distinguishing feature is not linked to any technical effect, and none was relied on by the appellant in its arguments. Therefore, the objective technical problem remains the provision of an alternative as set out above. As stated by the respondent, the average size of the MoS₂ particles in D3 is stipulated as being "preferably 15 μm or less, particular from 0.2 to 10 μm " (D3, paragraph [0042]). This range overlaps with the claimed range of less than 5 μm . The skilled person wishing to solve the objective technical problem set out above would work within the particle size range disclosed in D3, and would, based on mere routine experimentation, arrive at the claimed average particle diameter of equal to or less than 5 μm as an arbitrary alternative from within the disclosed range in D3.
- 7.3 Consequently, claim 1 of the 14th auxiliary request fails to meet the requirements of Article 56 EPC.

15th auxiliary request - inventive step

8. Claims 1 and 3 of the 15th auxiliary request were amended compared to claims 1 and 3 of the 11th auxiliary request by addition of the text:

"wherein a content of the hard substance particles in the composition is 1 to 4 % by volume".

- 8.1 Compared to claim 1 of the 11th auxiliary request, this amendment represents a limitation in the amount of the hard substance particles from 0.1 to 5% in the former to 1 to 4 % by volume.
- 8.2 The appellant argued that the limitation in the range compared to claim 1 of auxiliary request 11 rendered the claimed subject-matter inventive.
- 8.3 The board disagrees. As stated by the respondent, there is no technical effect associated with the limitation, and none was alleged by the appellant as being specifically linked to this technical feature. The objective technical problem underlying claim 1 hence remains the provision of an alternative as set out for claim 1 of auxiliary request 11.
- 8.4 As also stated above in relation to claim 1 of auxiliary request 11, D3 teaches that the amount of Al_2O_3 employed may range from 0.3 to 10% by weight, more preferably 0.5 to 5% by weight (paragraph [0043], (c)), corresponding to 0.18 to 9.1 Vol.% as calculated by the respondent (see above). Hence, in an identical manner as that set out above for claim 1 of the 11th auxiliary request, the skilled person wishing to solve the objective technical problem set out above would arbitrarily work with the range set out in D3, and thereby would arrive at the subject-matter of claim 1 in an obvious manner.
- 8.5 Consequently, claim 1 of the 15th auxiliary request fails to meet the requirements of Article 56 EPC.

16th auxiliary request - inventive step

9. Claims 1 and 3 of the 16th auxiliary request were amended compared to claims 1 and 3 of the 13th auxiliary request as follows:

- by replacing the term "the sliding member comprising" by "the sliding member consisting of", and
- by stipulating that the composition "*optionally contains an inorganic additive, which is selected from the group consisting of calcium carbonate, barium sulfate and calcium phosphate, wherein the content of the inorganic additive in the composition is 5 to 10% by volume.*"

9.1 During oral proceedings before the board, the appellant did not explain how the amendment of "comprising" to "consisting of" would alter the board's conclusion provided in relation to claim 1 of the 13th auxiliary request. As stated by the respondent, the limitation does not change the open language employed for the coating layer itself, defined in line 3 of claim 1 as "comprising" certain components. Hence, this amendment cannot lead to a different conclusion in relation to inventive step compared to claim 1 of the 13th auxiliary request.

9.2 Furthermore the stipulation in claim 1 that the composition may contain a further optional component has no influence on the assessment of inventive step of embodiments of the claim in which the optional component is not present. Hence, inventive step also cannot be acknowledged on the basis of this feature.

9.3 Consequently, claim 1 of the 15th auxiliary request fails to meet the requirements of Article 56 EPC.

17th Auxiliary request - admittance

10. Claim 1 of the 17th auxiliary request differs from claim 1 of the 16th auxiliary request in that the expression "coating layer comprising" is replaced with "coating layer consisting of".

10.1 The respondent requested that the 17th auxiliary request not be admitted into appeal proceedings.

10.2 The 17th auxiliary request was submitted by the appellant with the letter dated 13 July 2022, after it had filed its grounds of appeal, and before the notification of the summons to oral proceedings before the board was issued. Consequently, Article 13(1) RPBA applies to the admittance thereof into the proceedings.

10.3 According to this provision, any amendment to a party's appeal case after it has filed its grounds of appeal is subject to the party's justification for its amendment and may be admitted only at the discretion of the board. The party shall provide reasons for submitting the amendment at this stage of the appeal proceedings, and the board shall exercise its discretion in view of, inter alia, the current state of the proceedings, the suitability of the amendment to resolve the issues which were admissibly raised by another party in the appeal proceedings or which were raised by the board, whether the amendment is detrimental to procedural economy, and, in the case of an amendment to a patent application or patent, whether the party has demonstrated that any such amendment, *prima facie*, overcomes the issues raised by another party in the

appeal proceedings or by the board and does not give rise to new objections.

- 10.4 The appellant argued that the 17th auxiliary request was submitted in response to the respondent's objections concerning the 16th auxiliary request, raised with the reply to the grounds of appeal, without specifying the precise objections concerned.
- 10.5 As stated by the respondent, it is not apparent why the amendment to claim 1 of the 17th auxiliary request was submitted at this late stage of appeal proceedings. Even if this new request had been submitted in response to objections raised against the 16th auxiliary request, the latter request was submitted for the first time with the grounds of appeal. Hence the respondent's reaction thereto was timely, i.e. at the earliest possibility, namely with the reply to the grounds. If new objections to claim requests newly filed in appeal were alone to be considered adequate justification for the filing of further new requests, the process could repeat itself without end, to the detriment of procedural economy. Hence, the submission of the 17th auxiliary request only with the letter dated 13 July 2022 is not justified.
- 10.6 For these reasons, the board decided to not to admit the 17th auxiliary request into the proceedings.
11. In view of the foregoing, none of the appellants requests are allowable, and the appeal is to be dismissed.

Order

For these reasons it is decided that:

The appeal is dismissed.

The Registrar:

The Chairman:



K. Boelicke

M. O. Müller

Decision electronically authenticated