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Datasheet for the decision of 21 May 2024

Case Number: T 0644/22 - 3.2.01

Application Number: 16784423.2

Publication Number: 3362348

IPC: B63B59/04, C09D5/16

Language of the proceedings: EN

Title of invention:
METHOD FOR APPLYING A COATING TO AN EXTERNAL SURFACE OF A MAN-MADE OBJECT TO BE AT LEAST PARTLY IMMERSED IN WATER

Patent Proprietor:
Akzo Nobel Coatings International B.V.

Opponent:
Jotun A/S

Headword:

Relevant legal provisions:
EPC 1973 Art. 56, 83, 100(a), 100(b)
RPBA 2020 Art. 12(3), 15(1)

Keyword:
Inventive step - (yes)
Sufficiency of disclosure - (yes)
Amendment to appeal case - amendment overcomes issues raised (yes)

Decisions cited:

Catchword:

Europäisches Patentamt
European Patent Office
Office européen des brevets

Beschwerdekammern

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Case Number: T 0644/22 - 3.2.01

D E C I S I O N
of Technical Board of Appeal 3.2.01
of 21 May 2024

Appellant: (Patent Proprietor)	Akzo Nobel Coatings International B.V. Christian Neefestraat 2 1077 WW Amsterdam (NL)
Representative:	Akzo Nobel IP Department Christian Neefestraat 2 1077 WW Amsterdam (NL)
Respondent: (Opponent)	Jotun A/S P.O. Box 2021 3202 Sandefjord (NO)
Representative:	Marks & Clerk LLP 15 Fetter Lane London EC4A 1BW (GB)
Decision under appeal:	**Interlocutory decision of the Opposition Division of the European Patent Office posted on 13 January 2022 concerning maintenance of the European Patent No. 3362348 in amended form.**

Composition of the Board:

Chairman	G. Pricolo
Members:	A. Pieracci
	S. Fernández de Córdoba

Summary of Facts and Submissions

I. An appeal was filed by the patent proprietor in the prescribed form and within the prescribed time limit against the interlocutory decision of the opposition division to maintain the European patent No. 3 362 348 in amended form according to the fourth auxiliary request.

II. In preparation for the oral proceedings the Board communicated its preliminary assessment of the case with a communication pursuant to Article 15(1) RPBA, to which only the opponent replied.

III. Oral proceedings before the Board took place on 21 May 2024. At the end of the oral proceedings the decision was announced.

IV. The final requests of the patent proprietor (appellant) are:

that the appealed decision be set aside and that the patent be maintained in amended form according to the main request filed as second auxiliary request at the oral proceedings.

V. The final request of the opponent (respondent) is:

that the appeal be dismissed.

VI. The following documents are mentioned in the present decision:

D1: EP 1 484 700 A1;
D3a: "Advances in marine antifouling coatings and

technologies", pages 429-430, 2009;
D4: "Hull roughness and antifouling paint", M.Bader-Eldin, 2014;
D5: "Hull roughness Penalty Calculator";
D8: "Energiøkonomisering i skipsfarten"; Presentation of 5-6 November 1985, NTNF;
D11: "The measurement of Ship Hull Roughness";
D14: "Marine Propellers and Propulsion";
D22: "Biofouling";
D26: "Marine Propeller Roughness Penalties", Mohamed Ahmed Mossad.

VII. The relevant arguments of the parties are dealt with in detail in the reasons of the decision.

VIII. Claim 1 of the patent as amended according to the main request, which is identical to claim 1 of the patent as granted, reads as follows:

"A method of applying a coating to an external surface of a man-made object to be at least partly immersed in water (e.g. a vessel or an offshore drilling station) for a time period wherein there is relative movement between the immersed object and the water, wherein the coating has a minimal resistance rating for a set of coatings, the method comprising:
- a computer-implemented coating selection process comprising the steps of:
- obtaining, for each coating in the set of coatings, a total roughness value of the external surface based on a fouling roughness value, a macro roughness value and a micro- roughness value associated with each coating,
- selecting a coating from the set of coatings, wherein the selected coating has a minimal resistance rating associated with the obtained total roughness value for the time period;

wherein the method further comprises applying the selected coating to the external surface of the man-made object."

Reasons for the Decision

1. Admittance into the proceedings of the main request

1.1 At the oral proceedings the patent proprietor submitted as second auxiliary request an amended set of claims which they then made their main request at the end of the proceedings.
The newly filed amended set of claims corresponds to claims 1 to 13 of the patent as granted.
The submission of this request for the first time at the oral proceedings amounts to an amendment of the patent proprietor's appeal case, the admittance of which is subject to the conditions set out in Article 13(2) RPBA, namely that there are exceptional circumstances which have been justified by cogent reasons.

1.2 The opponent requested not to admit the request into the proceedings due to its late filing, since the objections against claims 14 and 15 of the patent as granted, which caused the filing of the patent proprietor's request, had been submitted from the beginning of the opposition proceedings and again with the reply to the statement setting out the grounds of appeal, to which the patent proprietor had not reacted.

1.3 The Board however concurs with the patent proprietor that the deletion of claims 14 and 15, even at this

late stage of the proceedings, expedite the appeal proceedings and is thus in favour of the procedural economy. Furthermore, no new issue arises due to the deletion of the claims and the debate is limited to the contentious points of claim 1 of the patent as granted on which the opponent already had the opportunity to take position, so that they do not find themselves in a more disadvantageous situation by the admission of the new request. The Board thus considers that the above represents exceptional circumstances in the sense of Article 13(2) RPBA justifying the admittance of the new request into the appeal proceedings.

2. Inventive step of the subject-matter of claim 1 of the patent as amended according to the main request starting from document D1 as closest prior art (Article 56 and 100(a) EPC)

2.1 The patent proprietor contested the finding of the opposition division that the subject-matter of claim 1 of the patent as amended according to the main request, which is identical to claim 1 of the patent as granted, is not inventive starting from D1 as the closest prior art. The patent proprietor argued that the opposition division had not correctly identified the features distinguishing the subject-matter of claim 1 from document D1 and in particular that the method of D1 is based on determining costs and cost differences and that the method of the patent in suit on the contrary is based on the determination of various kind of roughness of the coating and of the minimal resistance rating of the same.

2.2 The Board shares the view of the patent proprietor that the calculations of D1, (see in particular claim 3 of the same and the appealed decision, point 2.2.1.1) and

those of the method of claim 1 of the contested patent are not equivalent, i.e. they are not the same kind of calculations, since the final outcome of the method of D1 is based on costs, or on a cost difference, and is based on parameters not limited to roughness.

2.3 As also acknowledged by the opposition division (see page 13, last paragraph of the appealed decision) and by the opponent, according to D1 the total costs are considered including those linked to the application of the coating. This however, precisely because of the costs linked to the application of the coating, is not equivalent to a method step in which a coating with a minimal resistance rating associated with the obtained total roughness value for the time period is selected.

2.4 Therefore the argument of the opponent (see the opponent's reply to the Board's communication, point 1.1.11) that "whilst D1 considers the costs of applying a particular coating in addition to considering fuel costs (i.e. the roughness and the frictional resistance) this does not result in a different method being performed to a method in which a coating with a minimal resistance rating is selected" is not convincing, since the method steps carried out are different. That the result provided by the method according to claim 1 and by the method of D1 might under certain circumstances be the same is not relevant for distinguishing the subject-matter of claim 1 from the method of D1. What matters are the steps to be carried out, which are indeed not the same.

2.5 The fact that in the patent specification (see column 4, lines 49 to 56) reference is also also made to costs for selecting the coating, as argued by the opponent at

the oral proceedings, does not render the method of claim 1 equivalent to the method disclosed in D1. As argued by the patent proprietor the first sentence of the passage cited by the opponent reads:

"In one embodiment, the costs of the coating material and the costs of application are additionally taken into account in the selection process",

whereby by the use of the terms "in one embodiment" and "additionally" it is made clear that this only represents a further preferred embodiment of the method according to claim 1 of the patent in suit and does not lead to a different interpretation of claim 1 itself.

2.6 The Board also shares the view of the patent proprietor that the fact that the person skilled in the art knows that the difference in fuel costs between two coatings is linked to the roughness difference, does not lead the person skilled in the art to modify a method determining the costs of a coating in a method in which a coating is selected on the basis of the minimal resistance value and thus to disregard the installation costs.

2.7 The Board is thus convinced by the arguments of the patent proprietor that the finding of the opposition division (see the appealed decision, page 13, last paragraph - page 14, first paragraph) that it is obvious to modify the method of D1, i.e. a method for determining the costs of a coating, in a method in which the minimal resistance coating is determined, is not correct.

2.8 There is therefore no need to consider whether in view of D4 it would be obvious to obtain the total roughness

from micro roughness and macro roughness in the method of document D1, as the Board is already convinced in view of the discussion above that the finding of lack of inventive step of the opposition division starting from D1 in combination with D4 is not correct.

2.9 For analogous reasons the Board is not convinced by the other objections of lack of inventive step starting from D1 raised by the opponent with the reply to the statement setting out the grounds of appeal and at the oral proceedings, such as D1 in combination with D3a, D26, D11 or D14.
In fact these documents have only been cited to show that the person skilled in the art would consider each of the macro roughness value, micro roughness value and fouling roughness value when assessing the total roughness of a ship’s hull and do not change the assessment of the issues discussed above.

3. Inventive step of the subject-matter of claim 1 of the patent as amended according to the main request starting from document D5 as closest prior art (Article 56 and 100(a) EPC)

3.1 The opponent in its reply to the statement setting out the grounds of appeal and at the oral proceedings also objected for lack of inventive step of the subject-matter of claim 1 starting from D5 as the closest prior art, arguing that the subject-matter of claim 1 differs from the method of D5 in that the total roughness value should also take the micro roughness into account.

3.2 However, the Board is not convinced by the argument of the opponent that D5 also shows the feature of selecting a coating from the set of coatings,

"wherein the selected coating has a minimal resistance rating associated with the obtained total roughness value for the time period."

3.3 This is because, it is evident from the results of the user interface shown on the last page of D5 that the selection is also linked to the total costs, including those due to the "paint scheme difference" and not only to the fuel consumption, which has been related by the appellant to the roughness value.

3.4 Since the identification of the distinguishing features is not correct, the Board is not convinced by any of the inventive step attacks made starting from D5, such as D5 alone and D5 in combination with either of D4, D3a, D11 and D14.

3.5 The argument of the opponent that "whilst D5 also considers the costs of applying a particular coating scheme in addition to considering the fuel costs this does not result in a different method being performed to a method in which a coating with a minimal resistance rating is selected" (see the opponent's reply to the Board's communication, point 1.2.7), cannot be followed, since the method steps are indeed different, analogously to what discussed above for document D1 (see point 2.4 above).

4. Inventive step of the subject-matter of claim 1 of the patent as amended according to the main request starting from document D8 as closest prior art (Article 56 and 100(a) EPC)

4.1 The opponent also contested lack of inventive step starting from D8 as the closest prior art, arguing that claim 1 differs from D8 in that in D8 a total roughness

is obtained using the hull roughness development whereas according to claim 1 a macro roughness and a micro roughness are considered and the coating process is computer implemented.

4.2 The Board is however not convinced by the argument of the opponent that the selection of a coating is made on the basis of a minimal resistance rating associated with the total roughness.

4.3 This is because, as apparent from the section on page 4 with title "cost-benefit analysis of protection systems", there appear to be other factors apart from the roughness development which affect the choice to be made, such as the initial cost and the maintenance cost for the system (see the second paragraph of the above mentioned section at page 4 of D8).

4.4 Since the identification of the distinguishing features of the subject-matter of the claim with respect to D8 is not correct, the Board is not convinced by any of the inventive step attacks made starting from D8, such as D8 in combination with either of D5, D4, D3a and D22, D26 and common general knowledge, D11 and common general knowledge and D14 and common general knowledge.

4.5 The argument of the opponent that document D8 does not provide a "different method being performed to a method in which a coating with a minimal resistance rating is selected" (see the opponent's reply to the Board's communication, point 1.3.3) cannot be followed in analogy to what was discussed above for D1 and D5 in points 2.4 and 3.5 above, since the methods steps to be performed according to D8 are different from those according to claim 1.

5. Sufficiency of disclosure (Article 100 b) and 83 EPC)

5.1 The opponent contested with the reply to the statement setting out the grounds of appeal that the claimed invention is not sufficiently disclosed arguing that it is not credible that a skilled person reading the patent would reliably arrive at a coating, which factually has the minimal resistance rating for the set of coating and conditions considered, since there is a huge amount of missing information, which is not provided by the patent, that the skilled person has to retrieve to implement the method.

5.2 The opponent also argued that in view of the missing information it is plausible that the invention cannot be carried out and the corresponding burden of proof shifts to the patent proprietor.

5.3 The opponent specifically argued that the patent does not teach how to construct a fouling database and how to convert its values to a roughness database and that this is not part of the common general knowledge.

5.4 The opponent also contested the finding of the opposition division that the person skilled in the art is capable to gather information to form a fouling database as there is no evidence in this respect.

5.5 The Board notes that it is established jurisprudence of the Boards of Appeal that an objection of lack of sufficient disclosure presupposes that there are serious doubts substantiated by verifiable facts. The burden of proof is upon the opponent to establish on the balance of probabilities that a skilled reader of the patent, using their common general knowledge, would

be unable to carry out the invention (see the Case Law of the Boards of Appeal, 10th edition, 2022, II.C.9.)

5.6 In the present case the Board is of the opinion that the objection of insufficiency of disclosure raised by the opponent is not substantiated by verifiable facts and that therefore the opponent has failed to discharge its burden of proof, which thus does not shift to the patent proprietor.

5.7 The fact that some information apparently necessary to implement the invention is not present in the specification of the patent in suit, does not render credible that a person skilled in the art is not in the position of carrying out the invention with the support of the common general knowledge. The Board has no reason not to concur with the opposition division (see page 9, points 2.1.1 to page 10, point 2.1.4 of the appealed decision), that methods for determining roughness values are known in the art and that it is not apparent why it should not be possible to form a roughness and fouling database, since, as indicated by the opposition division, establishing a fouling database presupposes just a gathering of data of which the person skilled in the art is capable (see the appealed decision, page 12, point 2.1.8).

5.8 The above opinion of the Board had been provided to the parties with the Board's communication pursuant to Article 15(1) RPBA. The opponent has not provided counterarguments to the above opinion of the Board neither in writing nor at the oral proceedings, where they referred to their written submissions for this issue.
After having reconsidered all the legal and factual aspects of the case the Board has come to the

conclusion that the finding of the opposition division that the claimed invention is sufficiently disclosed is correct.

6. Adaptation of the description

In view of the amendments which appear to be needed to the description in view of the amended set of claims, and considering that the opponent had no objections in this regard, the Board granted the request of the patent proprietor to remit the case to the opposition division for adaptation of the description.

Order

For these reasons it is decided that:

The decision under appeal is set aside.

The case is remitted to the opposition division with the order to maintain the patent with claims 1 to 13 of the main request filed as second auxiliary request during oral proceedings before the Board of appeal and a description to be adapted thereto.

The Registrar: The Chairman:

N. Schneider G. Pricolo

Decision electronically authenticated