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**Datasheet for the decision  
of 12 December 2024**

**Case Number:** T 0449/23 - 3.3.02

**Application Number:** 16848689.2

**Publication Number:** 3354701

**IPC:** C09D201/02, C09C1/00, C09C3/10,  
C09D5/02, C09D5/44, C09D175/04,  
C09D7/61

**Language of the proceedings:** EN

**Title of invention:**  
METHOD FOR PREPARING CATIONIC ELECTRODEPOSITION COATING  
COMPOSITION

**Patent Proprietor:**  
Nippon Paint Automotive Coatings Co., Ltd.

**Opponent:**  
PPG Industries, Inc.

**Headword:**

**Relevant legal provisions:**  
EPC Art. 56  
EPC R. 139  
RPBA 2020 Art. 12(2), 12(3), 12(4), 13(1), 13(2), 13(3)

**Keyword:**

Inventive step

Amendments to a party's case under Article 13(2) RPBA

**Decisions cited:**

G 0011/91, J 0014/19, T 0020/81, T 0859/90, T 0741/91,  
T 0912/94, T 0355/97, T 0097/00, T 1392/04, T 0692/09,  
T 1097/09, T 1797/09, T 1742/12, T 2179/13, T 1569/17,  
T 2759/17, T 0131/18, T 2091/18, T 2295/19, T 0246/22

**Catchword:**

1. Inventive step - credibility of the alleged technical effect and burden of proof (reasons, points 2.5.6 and 2.5.7).
2. The amendment referred to in Article 12(4) RPBA is not synonymous with the "amendment to a party's appeal case" within the meaning of Article 13(2) RPBA (reasons, point 3.5).
3. An amendment by way of deletion of an (alternative in an) independent claim is an amendment of the appeal case within the meaning of Art 13(2) RPBA (reasons, point 3.6).



**Beschwerdekammern**

**Boards of Appeal**

**Chambres de recours**

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Case Number: T 0449/23 - 3.3.02

**D E C I S I O N**  
**of Technical Board of Appeal 3.3.02**  
**of 12 December 2024**

**Appellant:** Nippon Paint Automotive Coatings Co., Ltd.  
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**Appellant:** PPG Industries, Inc.  
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**Representative:** f & e patent  
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**Decision under appeal:** **Interlocutory decision of the Opposition  
Division of the European Patent Office posted on  
23 December 2022 concerning maintenance of the  
European Patent No. 3354701 in amended form.**

**Composition of the Board:**

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

## Summary of Facts and Submissions

- I. The appeals of both the opponent and the patent proprietor lie from the decision of the opposition division according to which European patent 3 354 701 in amended form according to the first auxiliary request met the requirements of the EPC.
- II. The following documents *inter alia* were submitted by the parties in opposition proceedings:
- D3 : GB 2 264504 A  
D5 : US 2004/0050704 A1  
D12: Experimental data submitted by the patent proprietor  
D13: Additional experiments (Examples 3a and 3b) submitted by the patent proprietor
- III. With the statement of grounds of appeal the opponent submitted the following documents:
- A16: Calculation of amounts of tartaric acid used in examples 1 and 3 of the patent, and 3a and 3b of D13,  
A17: Summary of examples
- IV. With letter dated 3 December 2024, the patent proprietor submitted experimental report D13a, a correction of experimental report D13.
- V. With letter dated 10 December 2024 the patent proprietor submitted auxiliary requests 1 to 8.

VI. In a communication pursuant to Article 15(1) RPBA, the board *inter alia* provided the preliminary view that the subject-matter of claim 1 of the main request lacked inventive step over D5 as closest prior art.

VII. Oral proceedings by videoconference took place as scheduled on 12 December 2024 in the presence of both parties. During oral proceedings the patent proprietor submitted a set of claims as auxiliary request 9.

VIII. Requests relevant to the present decision

The patent proprietor (appellant I) requested that the contested decision be set aside and that the patent be maintained as granted, or, alternatively, that the patent be maintained on the basis of auxiliary request 1 found allowable by the opposition division and refiled with the letter dated 10 December 2024, or of any of auxiliary requests 2 to 8 filed with the letter dated 10 December 2024, or auxiliary request 9 filed during oral proceedings before the board.

The patent proprietor also requested not to admit the calculations regarding the amounts of (G-1) and (G-2) in A17 as well as the arguments associated thereto.

The opponent (appellant II) requested that the contested decision be set aside and that the patent be revoked in its entirety.

IX. For ease of reference in the following, appellant I and appellant II are referred to as the patent proprietor and the opponent, respectively.

X. For the text of claim 1 of the main request, reference is made to the reasons for the decision set out below.

XI. 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) - Inventive Step, Articles 100(a) and 56 EPC

1. Claim 1 as granted reads as follows:

*"1. A method for preparing a cationic electrodeposition coating composition, wherein the method comprises a step of mixing a resin emulsion (i) and a pigment dispersion paste, wherein the resin emulsion (i) comprises an aminated resin (A) and a blocked isocyanate curing agent (B), the pigment dispersion paste comprises a metal compound (C), a pigment dispersion resin (D) and a pigment (E), and wherein the metal compound (C) is one or more a [sic] metal oxide or a metal hydroxide having at least one metal element selected from the group consisting of La, Nd, Y, Pr, Yb and Ce, the pigment dispersion paste is prepared by mixing the metal compound (C) and the pigment dispersion resin (D), and mixing the resultant mixture, the pigment dispersion resin (D) and the pigment (E)."*

1.1 Closest prior art

1.1.1 The opponent argued that the subject-matter of claim 1 lacked inventive step over patent document D5 as closest prior art, more specifically starting from

Example A of patent document D5. The patent proprietor submitted that D5 did not represent an appropriate starting point, and hence was not to be regarded as the closest prior art.

- 1.1.2 D5 is concerned *inter alia* with providing a cationic electrodeposition coating composition with excellent corrosion resistance while addressing problems associated with "mapping", which happens when differences in the film thickness of the electrodeposition coating telegraphs through the topcoats, thereby creating an undesirable topcoat appearance (D5, paragraphs [0006] and [0007]). In particular, D5 teaches that a variety of metal compounds may be advantageous for minimising mapping, including compounds derived from metals listed for metal compound (C) in claim 1 of the main request (D5, paragraph [0019]).
- 1.1.3 The proprietor argued that the inventive step attack starting from D5 was to be rejected on the basis that the skilled person would not realistically have started from the disclosure in this document. Decision T 2759/17 was referred to in support of the argument that the skilled person selects the closest prior art, and in doing so, is held to generally look for a disclosure that aims at the purpose or effect that is the same or at least similar to the one underlying the patent in question (reasons, 5.3.2). In particular, the patent proprietor argued that D5 was not concerned with the same purpose as the contested patent, namely to improve rust prevention properties using a metal compound (C), while at the same time improving colour unevenness of the coating film. Rather, it addressed a different problem, namely "mapping".

- 1.1.4 The board disagrees for the reasons provided by the opponent. The problem set out in the introductory part of the patent relates to the provision of a cationic electrodeposition coating composition having excellent edge portion rust prevention and an excellent coating film appearance (paragraphs [0001] and [0010]). The alleged purpose of the patent according to the patent proprietor, namely the avoidance of colour unevenness, is not mentioned as part of the "problem to be resolved by the invention" (patent, page 3, line 13). Rather, colour unevenness is only referred to in paragraph [0042] in connection with a specific amount range for the metal compound (C), which, as noted by the opponent, is lacking in claim 1 of the main request.
- 1.1.5 Colour unevenness is also mentioned in the experimental part of the description of the patent in paragraphs [0176] and [0177], which describes the evaluation thereof in the exemplified electrodeposition coating compositions by visual inspection for the presence/absence of defects "in the coating film appearance". These defects are however equated with an undefined "unevenness" (paragraph [0177]). As stated by the opponent, it is unclear what exactly "color unevenness appearance" means in the context of these passages of the patent. In paragraphs [0004] and [0005], in the context of the prior art however, the patent refers to a "levelling property of a coating film", and issues with deterioration in the "smoothness" of the coating. Hence, while the purpose of the patent may include the avoidance of "color unevenness", however that property is to be defined, the purpose also includes, in a broader sense, improvements in the general coating appearance as set out in paragraph [0010] of the patent, which at least encompasses improvements in



"smoothness", and therefore also "mapping" in the sense described in D5.

1.1.6 Therefore, the aim of the prevention of "mapping" in D5 is at least closely related to that of colour unevenness appearance in the contested patent. Furthermore, the aim of corrosion resistance in D5 is closely related (if not identical) to that of rust prevention in the contested patent.

1.1.7 Irrespective of the above the board notes that for a document to qualify as a suitable starting point in the assessment of inventive step, it is not necessary for it to disclose exactly the same problem as addressed in the patent. Indeed, the presence of inventive step requires that the claimed subject-matter be inventive with regard to any potential starting point in the prior art. The practice of selecting only one "closest prior art" amongst multiple potential starting points on the basis that said closest prior art has the most in common with the features and/or the intended purpose of the claimed subject-matter, is merely a matter of efficiency for the deciding body. Specifically, such a selection may avoid the need to perform a detailed assessment of inventive step also in respect of numerous comparatively more remote alternative starting points, because if the claimed subject-matter involves an inventive step starting from the "closest" disclosure, it will *a fortiori* also involve an inventive step from comparatively more remote starting points. Depending on the circumstances of the individual case however, several alternative starting points may have to be considered, in particular if it is not objectively apparent that one starting point is comparatively closer to the claimed subject-matter and

its intended purpose (see for example T 1742/12, reasons, points 6.3 to 6.6).

- 1.1.8 Hence, even if the specific problems referred to in D5 and addressed by the patent were not the same, this would not necessarily disqualify D5 from being a suitable starting point.
- 1.1.9 In a related objection, the proprietor also argued that in the starting point within document D5 invoked by the opponent, namely example A thereof, the resin blend E6300 was not available to the public at the effective date of the patent. Example A was therefore a non-enabling disclosure (for context, see the discussion below on distinguishing features). For that reason alone, example A would not be considered as a suitable starting point for any development, regardless of the purpose.
- 1.1.10 The board disagrees. While the skilled person would recognise that information was missing in example A of D5, specifically the nature of the resin blend E6300 (as set out below), this in itself would be no reason to ignore said example, as it represents a preferred embodiment of the implementation of the invention according to D5.
- 1.1.11 Consequently, D5 can serve as closest prior art, and example A thereof may serve as the starting disclosure in the assessment of inventive step of the claimed subject-matter.
- 1.2 Distinguishing features
  - 1.2.1 Example A of D5 describes the preparation of an electrodeposition bath used to prepare

electrodeposition coating compositions by mixing the following components (D5, paragraph [0044], table):

- Resin blend E6300, "a resin blend available from PPG Industries, Inc."
- Pigment paste of Example D, and
- Deionised water.

1.2.2 It is undisputed that the pigment paste of example D of D5 falls within the scope of the pigment dispersion paste defined in claim 1 as comprising a metal compound (C), a pigment dispersion resin (D) and a pigment (E). Specifically, the ingredients of the pigment paste of example D (D5, paragraph [0050], table) include:

- a "catalyst paste of Example C", which itself includes a cationic grind resin and yttrium oxide (D5, example C, paragraph [0048], table), thus corresponding to the pigment dispersion resin (D) and the metal compound (C) of claim 1, respectively,
- further "cationic grind resin", corresponding to the pigment dispersion resin (D) of claim 1 (paragraph [0050], table), and
- "Tronox CR-800E", "Printex 200" and "ASP-200", i.e. titanium dioxide, carbon black and aluminium silicate pigments respectively, corresponding to the pigment (E) of claim 1.

1.2.3 It is also undisputed that the composition of example A of D5 is prepared according to the method of contested claim 1, namely by mixing the metal compound (C) and the pigment dispersion resin (D), and mixing the resultant mixture, further pigment dispersion resin (D) and the pigment (E). Specifically, yttrium oxide is mixed with the cationic grind resin to form the

catalyst paste of example C (D5, paragraph [0048]), which is then mixed with further cationic grind resin and pigment in example D (D5, paragraphs [0050] and [0051]).

1.2.4 The sole matter of dispute was whether "resin blend E6300" of example A (D5, table in paragraph [0044]) is a resin emulsion (i) comprising an aminated resin (A) and a blocked isocyanate curing agent (B) as required by claim 1.

1.2.5 To the patent proprietor's advantage, it is assumed in the following that resin emulsion (i) with components (A) and (B) of claim 1 of the main request is not disclosed in example A of D5. More specifically, it is assumed that neither resin blend E6300 nor information pertaining to the nature thereof was made available to the public on the effective date of the patent.

1.2.6 Hence, based on this assumption, the subject-matter of claim 1 is distinguished from example A of D5 in that the latter does not disclose a method using a resin emulsion (i) comprising an aminated resin (A) and a blocked isocyanate curing agent (B) as required by claim 1.

1.3 Objective technical problem

1.3.1 The patent proprietor argued that the technical effect over D5, namely improved edge portion rust prevention and improved colour unevenness, was demonstrated *inter alia* by a comparison of example 1 and comparative examples 2 of the contested patent and example 2' of the patent proprietor's experimental evidence D12. Hence, the objective technical problem was the provision of a method for forming an electrodeposition

coating composition that achieves improved edge portion rust prevention properties and improved colour evenness appearance for the specific set of components set out in claim 1.

- 1.3.2 According to the patent proprietor, the coatings of examples 1 and comparative examples 2 and 2' comprised the same components. They however differed in that in example 1, the mixing step was carried out according to claim 1 of the main request, while in comparative examples 2 and 2', the components of the pigment paste were mixed together in a single step.
- 1.3.3 It was not disputed by the opponent that improved results were reported in the patent for example 1, in terms of "colour unevenness" and "coating performance", compared to comparative example 2 of the patent (table 1, page 24, final three rows) and comparative example 2' of the patent proprietor's experimental data D12.
- 1.3.4 However, as also noted by the opponent, the improvements reported are related to the mixing method, rather than the distinguishing feature over example A of D5. Specifically, the claimed mixing method is employed in example 1, while in comparative example 2 of the patent and 2' of D12, the ingredients are simply added together.
- 1.3.5 As stated by the opponent, the technical effect achieved by the claimed subject-matter must however relate to the distinguishing feature over D5, namely the choice of a resin emulsion (i) comprising an aminated resin and a blocked isocyanate curing agent. Since however, as set out above, the effects proposed by the patent proprietor are not linked to the distinguishing feature, these effects cannot be taken

into account when defining the objective technical problem.

1.3.6 Therefore, the objective technical problem can only be formulated as proposed by the opponent, namely as the provision of an appropriate resin for the preparation of the cationic electrodeposition coating composition according to example A of D5.

1.4 Obviousness

1.4.1 The board agrees with the opponent that the solution to this problem is obvious in view of D5 alone. Specifically, paragraph [0023] of D5 discloses acid-solubilised reaction products of polyepoxides and primary or secondary amines as possible cationic electrodepositable resins, and states that these amine salt group-containing resins are usually used in combination with a blocked isocyanate curing agent. This combination corresponds to the resin emulsion (i) as required by claim 1. Hence, the skilled person seeking to solve the objective technical problem formulated above, although not knowing the nature of the resin used in example A of D5, would know that the resin referred to is that discussed in paragraph [0021] as also being comprised within the composition. The skilled person would thus have consulted paragraph [0023] of D5, which provides examples of such resins and teaches, as one possibility, the use of a resin emulsion meeting the definition of resin emulsion (i) of claim 1, thereby arriving at the subject-matter of claim 1 of the main request.

1.4.2 The subject-matter of claim 1 of the main request therefore lacks inventive step over D5.

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

Auxiliary request 1 - Inventive step, Article 56 EPC

2. The set of claims of auxiliary request 1 differs from the main request in the deletion of claim 1. Hence claims 1 and 2 of auxiliary request 1 are identical to claims 2 and 3 of the main request.

2.1 Independent claim 1 of auxiliary request 1 reads as follows:

*"A method for preparing a cationic electrodeposition coating composition, wherein the method comprises a step of mixing a resin emulsion (i) and a pigment dispersion paste, wherein the resin emulsion (i) comprises an aminated resin (A) and a blocked isocyanate curing agent (B), the pigment dispersion paste comprises a metal compound (C), a pigment dispersion resin (D), **a sequestrant (G)** and a pigment (E), and wherein the metal compound (C) is one or more a [sic] metal oxide or a metal hydroxide having at least one metal element selected from the group consisting of La, Nd, Y, Pr, Yb and Ce, **the sequestrant (G) comprises one or more selected from the group consisting of an amine-modified epoxy resin (G-1) having a hydroxyl value of 150 to 650 mg KOH/g and an amine value of 30 to 190 mg KOH/g and a polyvalent acid (G-2), and the pigment dispersion paste is prepared by mixing the metal compound (C), ~~and~~ the pigment dispersion resin (D) **and the sequestrant (G)**, and mixing the resultant***

*mixture, the pigment dispersion resin (D) and the pigment (E)."*

(deletion and addition compared to claim 1 of the main request denoted by strike through and bold text)

- 2.2 Claim 1 therefore differs from claim 1 of the main request in that it additionally requires the presence of a sequestrant component (G), which according to the claimed mixing method, is added to the metal compound (C) and the pigment dispersion resin (D) before the addition of more pigment dispersion (D) and the pigment (E).
- 2.3 The opponent argued that claim 1 lacked inventive step *inter alia* starting from D3 as closest prior art. The patent proprietor did not dispute that D3 could serve as a suitable starting disclosure for the assessment of inventive step.
- 2.4 Distinguishing features
- 2.4.1 The following solely addresses the embodiment of claim 1 in which the sequestrant (G) is (G-1) alone, i.e. an amine-modified epoxy resin having a hydroxyl value of 150 to 650 mg KOH/g and an amine value of 30 to 190 mg KOH/g.
- 2.4.2 D3 concerns an electrodeposition paint composition capable of forming coating films excelling in corrosion resistance (D3, page 1, lines 1-4). Examples 1 to 5 concern the preparation of an electrodeposition coating composition. Example 3, referred to by the opponent in its arguments (D3, table 1, page 9), is a pigment dispersion paste comprising lanthanum oxide (a metal compound (C) according to claim 1), an epoxy resin having quaternary ammonium salt groups (a pigment



dispersion resin (D) according to claim 1), and carbon black pigment (a pigment (E) according to claim 1). The pigment paste of example 3 is added to the resin emulsion of example 1. The resin emulsion of example 1 is prepared from an amine-epoxy resin adduct (page 10, line 16), corresponding to aminated resin (A) of claim 1, and xylylene diisocyanate blocked with 2-ethylhexyl alcohol (page 10, lines 22-24), corresponding to a blocked isocyanate curing agent (B) according to claim 1. Hence, the resin emulsion (i) of example 1 is according to claim 1.

2.4.3 Claim 1 of the main request does not exclude that the sequestrant (G-1) and the aminated resin (A) may be the same. Specifically, as stated by the opponent, according to paragraph [0069] of the patent, the sequestrant (G-1) can be the same as the aminated resin (A) which is contained in the resin emulsion (i) together with the blocked isocyanate curing agent (B). Indeed, in all examples of the patent in which sequestrant (G-1) is used, the product of production example 4 is added to the pigment dispersion paste as sequestrant (G-1). Production example 4 is a resin emulsion comprising an aminated resin (A) (amine-modified epoxy resin) and a blocked isocyanate curing agent (A) and is also employed as resin emulsion (i) in all examples of the patent.

2.4.4 The amine-modified epoxy resin of D3 described above has an amine value of 65, thus falling within the claimed range for sequestrant (G-1). The hydroxyl value is not disclosed in D3.

2.4.5 The subject-matter of claim 1 is therefore distinguishing from example 3 of D3 by:

- the method of addition of the components; according to D3, the components of the examples were fed into a ball mill and dispersed for 40 hours to provide pigment pastes (D3, page 8, lines 23-27). In claim 1 in contrast, the amine-modified epoxy resin is divided into two portions, one portion being added to the metal compound (C) in the first mixing step (i.e. as sequestrant (G-1)), and a second portion as resin emulsion (i) which is mixed with the pigment dispersion paste prepared according to claim 1 to obtain the coating composition, and
- the hydroxyl value of the amine-modified epoxy resin, which is chosen from within the range of 150 to 650 mg/KOH.

2.5 Objective technical problem

2.5.1 The patent proprietor argued that the technical effects of the distinguishing features were improved colour evenness appearance properties and excellent edge portion rust prevention. These technical effects were credible in view of

- a comparison of examples 1 and 3 of the patent,
- a comparison of example 1 of the patent and example 3a of D13a,
- a comparison of example 1 of the patent and the reproduction of example 3 of D3 set out in D12 and
- the information provided in the patent concerning the use of a sequestrant.

### 2.5.2 Comparison of examples 1 and 3 of the patent

Example 1 of the patent, argued by the patent proprietor as being representative of the closest prior art D3, comprises an amine-modified epoxy resin as resin emulsion (i) (patent, paragraph [0124]), but differs from the claimed subject-matter in the method of preparation of the pigment dispersion paste: a sequestrant (G-1) is not mixed with the metal compound (C) and the pigment dispersion resin (D) as required by claim 1. Example 3 of the patent is according to claim 1 and comprises both sequestrants (G-1) and (G-2) (tartaric acid), i.e. according to example 3, the pigment dispersion paste is prepared according to the method of claim 1.

As argued by the opponent, any technical effect demonstrated by this comparison cannot be accepted as linked to the distinguishing features set out above. Specifically, in example 3 of the patent, both types of sequestrant (G-1) and (G-2) are employed in a method according to claim 1: according to paragraph [0131] of example 3, tartaric acid (sequestrant (G-2)) and the resin emulsion (i) (sequestrant (G-1)) are added to a mixture of pigment dispersion (D) and metal oxide (C) prepared in paragraph [0130]. Therefore, example 3 differs from example 1 not only in that a sequestrant (G-1) is present, but also in the presence of a sequestrant (G-2). Thus, the effects observed in example 3 may also be attributable to the presence of sequestrant (G-2). Hence, this comparison is not suitable for demonstrating a technical effect for the use of only one type of sequestrant, i.e. (G-1) in the present context.

2.5.3 Comparison of example 1 of the patent and example 3a of D13a

Example 3a of the patent proprietor's experimental data D13a discloses the use of an amine-modified resin as sequestrant (G-1) in the absence of sequestrant (G-2). The same amine-modified resin is also included in example 1 of the patent, but solely as the resin emulsion (i) mixed with the pigment dispersion paste (patent, paragraph [0124]). In example 3a, the resin emulsion was included both as resin emulsion (i) mixed with the pigment dispersion paste (as in example 1 of the patent; see D13a, page 1, final paragraph) **and** as the sequestrant (G-1), mixed with the metal compound (C) and the pigment dispersion resin (D) (D13a, page 1, second paragraph of example 3a).

However, as noted by the opponent, in order for example 3a to be suitable for demonstrating a technical effect, it must differ from example 1 only in the distinguishing features, and in particular, the total amount of amine-modified resin present in example 1 and example 3a should be identical. According to example 3a of D13a however, while the relative amounts of the further ingredients used are similar to example 1 of the patent, the total amount of amine-modified resin used in example 3a is more than double that used in example 1 of the patent. Specifically, in example 3a of D13a, 15 parts of resin emulsion (i) are used (7.5 parts as sequestrant (G-1) and 7.5 parts as resin emulsion (i); D13a, page 1, second and fourth paragraphs of example 3a), while in example 1, 7.1 parts thereof are used (patent, paragraph [0124]).

Hence, the comparison of example 1 of the patent and example 3a of D13a is not suitable for demonstrating

that technical effects originate from the distinguishing features over claim 1, rather than simply from the total amount of resin emulsion (i) employed. Hence, any such effects cannot be taken into account in the formulation of the objective technical problem.

2.5.4 Comparison of example 1 of the patent and the reproduction of example 3 of D3 set out in D12

With experimental report D12 the patent proprietor submitted *inter alia* an alleged reproduction of example 3 of D3. The product obtained was tested for edge portion rust prevention, colour unevenness and coating performance (D12, table, final three rows). The patent proprietor argued that the tests demonstrated that the product of example 3 of D3 had poor colour unevenness compared to the products of example 3 of the patent and 3a of D13a according to claim 1.

As stated by the opponent however, and similarly to the comparisons above in relation to example 3 of the patent and 3a of D13a, the electrodeposition coating composition of example 3 of D3 is a completely different system to that disclosed in example 3 the patent and example 3a of D13a. For example, dioctyltin oxide is used as the catalyst in example 3 of D3 (page 9, table 1, penultimate row), while in example 3a of D13a, and indeed in the relevant examples of the patent, a bismuth catalyst is used.

It has therefore not been demonstrated that any technical effect originates from the distinguishing features over claim 1, rather than from other factors, such as the catalyst employed. Hence, any alleged effects arising from this comparison cannot be taken

into account in the formulation of the objective technical problem.

2.5.5 The information provided in the patent concerning the use of a sequestrant

Finally, the patent proprietor argued that the alleged effects were credible on the basis of the statements provided in the patent. In this context it referred to paragraphs [0071] and [0082] of the patent, the relevant parts of which read as follows:

paragraph [0071]:

*"In the amine-modified epoxy resin (G-1), when the hydroxyl value is 150 to 650 mg KOH/g and the amine value is 30 to 190 mg KOH/g, sequestration (sealing) property is satisfactorily obtained, which provides improved dispersion stability of a resulting pigment dispersion paste. Therefore, there is an advantage that an electrodeposition coating composition having excellent storage stability and edge portion rust prevention property can be obtained"*

paragraph [0082]:

*"Use of the sequestrant (G) in combination with the pigment dispersion resin (D) can cause the pigment dispersion resin (D) to be self-aggregated, leading to consolidation of covering of the pigment dispersion resin (D) and the metal compound (C) ... Since the self-aggregation force is strong, there is an advantage that by using the sequestrant (G) in combination with the pigment dispersion resin (D), favorable dispersion stability can be attained even when the amount of the pigment dispersion resin (D) is reduced."*

Hence, the patent taught that the sequestrant improved the coating effect by preventing aggregation, thus improving dispersion stability and consequently, colour unevenness.

The board disagrees for the reasons provided by the opponent. Despite the statements in the patent, there is no evidence that the problems with aggregation occur in the method described in example 3 of D3, and even if it did occur, there is no evidence that it would be solved by the claimed method. The board agrees with the opponent that in the absence of any evidence, the above statements amount to theoretical considerations which are not sufficient to render the alleged effects credible.

#### 2.5.6 Burden of proof

The patent proprietor argued that the burden of proof lay with the opponent to demonstrate that the alleged technical effects were not present.

The board disagrees.

- (a) The legal burden of proof is the duty of a party to persuade the deciding body of allegations of facts on which the party's case rests. In principle, a party must prove alleged facts (assertions) from which it infers a legal consequence, i.e. which establish the basis for the party's legal claims. Thus, the allocation of the burden of proof depends on a party's substantive case.
- (b) To discharge its legal duty of persuasion, a party must prove the alleged facts by appropriate

evidence to the required standard of proof. The party with whom the legal burden of proof lies therefore bears the risk that the alleged facts remain unproven, i.e. that the deciding body has not been persuaded in accordance with the required standard of the existence of these facts. In this case, the deciding body will decide against that party and reject its legal claims. Thus, the legal burden of proof requires the production of appropriate evidence to persuade the deciding body to the required standard.

- (c) In principle, the legal burden of proof does not shift. References in the case law to a shift of burden of proof relate to the so-called evidentiary/evidential burden of proof (see for this distinction T 741/91, point 4.3). The notion of evidentiary/evidential burden of proof relates to the state of the evidence produced in the course of proceedings. Once the party bearing the legal burden of proof has adduced sufficient evidence to support its allegations of facts to the required standard of proof, the onus is on the adverse party to rebut the asserted facts by adducing appropriate evidence. Otherwise, the adverse party risks that the deciding body is persuaded of the existence of the facts and allows the claims. Thus, if the party having the legal burden of proof has made a "strong case" by filing convincing evidence, the onus of producing counter-evidence shifts to the adverse party (see e.g. T 859/90, reasons, points 2.2.2 and 2.2.3). However, this does not mean that the legal burden of proof is on the adverse party to prove the non-existence or the contrary of asserted factual allegations. It is sufficient that the adverse party raises substantiated doubts that



prevent the deciding body from being persuaded of the existence of the alleged facts.

- (d) In opposition and opposition-appeal proceedings, each of the parties carries the legal burden of proof for the asserted allegations of facts on which their respective substantive case rests. As regards an alleged lack of inventive step, the burden is on the opponent to adduce appropriate prior art which - when following the established substantive test, i.e. the problem-solution approach - persuades the opposition division or the board of the obviousness of the solution provided by the subject-matter claimed. On the other hand, if the patent proprietor asserts that, in comparison to the prior art, there is an advantage or effect giving rise to a more ambitious formulation of the objective technical problem than that presented by the opponent and hence to an inventive step, the burden of proving this advantage or effect to the required standard of proof is on the patent proprietor (T 20/81, OJ EPO 1982, 217, headnote and reasons, point 3; T 912/94, reasons, point 3.5; T 355/97, reasons, point 2.5.1; T 1392/04, reasons, points 15, 19 and 20; T 2179/13, reasons, points 5.3 and 7). The mere assertion in the patent specification of an advantage or effect cannot be regarded as evidence of such an assertion.
- (e) The above principles have been confirmed in the following selected cases in which the underlying circumstances were comparable to those of the present case.

In T 97/00 (reasons, points 3.1.2, 3.1.4 and 3.1.6), the relevant claim concerned a process for the activation of a Fischer Tropsch catalyst. The board accepted that the examples in the patent demonstrated that under specific activation conditions, the alleged technical effects of providing an activated catalyst having increased activity, improved stability and a higher selectivity had been demonstrated. However, the board concluded that said effects had not been demonstrated over the whole scope of the claim, which was not limited to the specific activation conditions of the examples. The board did not accept the patent proprietor's (respondent's) argument that it was up to the appellant (opponent) to demonstrate that said effects were not obtained over the complete claimed scope. Rather, it referred to the established jurisprudence that each of the parties to the proceedings carried the separate burden of proof for any fact they allege, and concluded that the burden of proof for showing that the claimed method led to the alleged and unsupported advantageous effects mentioned in the patent in suit, rests upon the patent proprietor. The board stated that in the absence of any corroborating evidence that said advantageous effects are obtained, the alleged effects were unsubstantiated and consequently, were not to be taken into account in the assessment of inventive step.

In T 355/97 (catchword and reasons, point 2.5.1), the board decided that since the patent proprietor (respondent) alleged that the claimed invention improved the performance index of the claimed preparation process without loss of selectivity, it

bore the burden of proof. An unverifiable statement in the patent that the performance index is improved without loss of selectivity was considered to be devoid of any corroborating evidence. In the absence of such evidence, however, the unsubstantiated allegation was not taken into account by the board.

Similarly, in T 1097/09 (reasons, point 2.3.3), the patent proprietor (respondent) did not consider it to be its task to prove an advantageous effect over the closest prior art, since the burden of proof to establish an alleged lack of inventive step lay with the appellant and opponent. The board disagreed, stating that according to established case law, each party has the burden of proving the facts on which it relied.

Finally, decision T 1392/04 (reasons, points 15, 19 and 20) provides guidance on the legal approach to be adopted regarding the burden of proof in cases of lack of novelty and inventive step and on the requirement for experimental evidence to support an alleged improvement over the closest prior art:

*"15. The general rule is that the legal burden of proof is on the party who has to establish a fact.*

*19. When it comes to considering inventive step the legal burden of proof of showing that at least part of the claimed subject matter can be derived in an obvious manner from the state of the art is on the opponent.*

*20. However, where the proprietor alleges that the problem to be solved by the subject matter claimed*

*over the closest prior art is to obtain an improvement of some particular property of this closest prior art, the legal burden of proof that there is an improvement is on the proprietor. A mere allegation that there is an improvement is not sufficient, there should be at least some experimental evidence that the particular property of the prior art is improved, when this closest prior art is modified in the minimum way necessary to fall under the subject matter now claimed. Experimental evidence is required to show that the improvement is necessarily attributable to the difference between the claimed subject matter and the closest prior art. The instances of the EPO should also be satisfied that this evidence makes it plausible that the problem has been solved over the whole range of the subject matter claimed."*

2.5.7 The patent proprietor cited decision T 1797/09 (reasons, point 2.7) in support of its view that the burden of proof rested on the opponent. The patent proprietor further referred to the Case Law of the Boards of Appeal, 10th edition 2022, pages 866 to 867 of the English language version.

(a) In the board's opinion, decision T 1797/09 cannot support the patent proprietor's view. It appears that point 2.7 of the reasons is in reply to an allegation by the respondent (patent proprietor) relying on decision T 692/09 that no evidence for the solution of the technical problem of the patent had to be provided where the technical problem underlying the invention was completely new at the priority date of the patent (T 1797/09, reasons, point 2.6). This allegation appears, however, to misrepresent the findings in case T 692/09. Point

2.7 of T 1797/09 moreover fails to analyse the findings in T 692/09 and to relate this decision to the specific facts under consideration. From the reference to the Case Law of the Boards of Appeal, 6th Edition 2010, chapter VI.H.5, it is also not possible to identify a specific section in support of the statements in point 2.7 of T 1797/09. In fact, on the basis of the statements in decision T 1797/09, which lack any reasoning, the present board is unable to determine whether and why the conclusions in said decision could be relevant to the present case.

- (b) As is apparent from the Case Law of the Boards of Appeal, 10th edition 2022, pages 866 to 867 of the English language version, decision T 1797/09 has remained a singular decision which was not followed by any other decision of the boards of appeal.
- (c) Of course, an advantageous technical effect could be notorious or part of the common general knowledge. In the first case, no evidence is needed in support of such effect, in the second case, only proof of such common general knowledge must be provided by the patent proprietor relying on such an effect. However, there are no such circumstances in the present case.

2.5.8 In view of the above evaluation of the available evidence and the findings on the allocation of the burden of proof, the objective technical problem underlying the subject-matter of claim 1 is that formulated by the opponent, namely the provision of an alternative method for forming an electrodeposition coating composition.

2.6 Obviousness

2.6.1 The board agrees with the opponent that the solution to this objective technical problem would be obvious to the skilled person in view of D3 alone. Specifically, adding starting materials in different batches or with a different order of addition as prescribed in claim 1 is within the routine ability of the skilled person and thus an obvious modification of the method disclosed in D3, in which all ingredients are simply added together, as set out above. Furthermore, the range claimed for the hydroxyl value of the sequestrant (G-1) of from 150 to 650 mg KOH is very broad and in the absence of any technical effect linked thereto, can only be seen as an arbitrary selection among standard hydroxyl value ranges, to which the skilled person would arrive routinely.

2.6.2 The subject-matter of claim 1 therefore lacks inventive step over D3 pursuant to Article 56 EPC.

2.6.3 Consequently, the set of claims of auxiliary request 1 is not allowable.

Auxiliary requests 2 to 8 - Admittance

3. Auxiliary requests 2 to 8 were submitted by the patent proprietor with the letter dated 10 December 2024 and received by the EPO on 11 December 2024, one day in advance of oral proceedings before the board.

3.1 It is undisputed that these requests are identical to auxiliary requests 2 to 8 submitted in opposition proceedings with the patent proprietor's reply to the notice of opposition dated 1 October 2021. With its grounds of appeal (page 15), the opponent provided a

table with an overview of the amendments to the auxiliary requests compared to the granted claims. This table is reproduced here for reference:

	Claim 1	Claim 2	Claim 3
Aux. 1	deleted		
Aux. 2			metal compound (C) : organic acid (F) = 1:0.3 to 1:2.7
Aux. 3			metal compound (C) : organic acid (F) = 1:0.3 to 1:2.7 +organic acid (F) = lactic acid, dimethylolpropionic acid, or methanesulfonic acid
Aux. 4	deleted		metal compound (C) : organic acid (F) = 1:0.3 to 1:2.7
Aux. 5	deleted		metal compound (C) : organic acid (F) = 1:0.3 to 1:2.7 +organic acid (F) = lactic acid, dimethylolpropionic acid, or methanesulfonic acid
Aux. 6	deleted	deleted	
Aux. 7	deleted	deleted	metal compound (C) : organic acid (F) = 1:0.3 to 1:2.7
Aux. 8	deleted	deleted	metal compound (C) : organic acid (F) = 1:0.3 to 1:2.7 +organic acid (F) = lactic acid, dimethylolpropionic acid, or methanesulfonic acid

3.2 The amendments to auxiliary requests 2 to 8 compared to the main request therefore either involve:

- the deletion of one or more of granted claims 1 and 2, and/or
- in independent granted claim 3, a limitation to the ratio of the metal compound (C) to the organic acid (F), and to the types of organic acid used in the method to those of granted claims 6 and 7.

3.3 Whether auxiliary requests 2 to 8 were part of appeal proceedings from the outset

3.3.1 With the letter dated 10 December 2024, with which the above auxiliary requests were submitted, the patent proprietor noted that the communication of the board pursuant to Article 15(1) RPBA had not mentioned auxiliary requests 2 to 8 filed before the opposition division. In the proprietor's view, these requests were however to be considered as part of the appeal

proceedings from the outset within the meaning of Article 12 RPBA.

3.3.2 The board disagrees. Rather, as argued by the opponent, and indeed as understood by the board in drafting the communication pursuant to Article 15(1) RPBA, prior to the letter dated 10 December 2024, there was nothing in the patent proprietor's submissions in appeal indicating that as an alternative to its main request or auxiliary request 1, it requested maintenance of the patent on the basis of auxiliary requests 2 to 8.

3.3.3 In support of its position that auxiliary requests 2 to 8 were part of the appeal proceedings from the outset, the patent proprietor referred to section IV of its notice of appeal, which concerns the "Request defining the subject of the appeal", and reads as follows:

*"The decision of the Opposition Division to maintain European Patent No. 3354701 in amended form. It is requested that the decision under appeal is set aside and the patent is maintained on the basis of the Main Request or an Auxiliary Request filed in these proceedings, taking account of any other requests that may be submitted in these proceedings."*

3.3.4 Even assuming that the mentioning of auxiliary requests 2 to 8 in the notice of appeal would be sufficient to consider them part of the appeal proceedings, this text does not explicitly refer to auxiliary requests 2 to 8. Furthermore, it also cannot be interpreted to implicitly refer to these requests, since in the text "an auxiliary request filed in **these** proceedings", "these proceedings" can only be understood to refer to appeal proceedings. Hence, the text at best merely appears to refer to hypothetical requests which may be



submitted at a later stage of the appeal proceedings. In the view of the board however, the above text is also sufficiently vague that "other requests" may also be understood as referring to procedural requests different from claim requests. Consequently, the patent proprietor's argument in this regard fails.

- 3.3.5 Irrespective of this, the patent proprietor's grounds of appeal and reply collectively defined its requests as the main request and auxiliary request 1. Hence, even if the notice of appeal were to have referred to auxiliary requests 2 to 8, this would have been superseded by the grounds of appeal and reply which were absent any reference thereto. In this regard, Article 12(3) RPBA stipulates that the statement of grounds of appeal and the reply shall contain a party's complete appeal case and *inter alia* should specify expressly all the requests relied on.
- 3.3.6 The patent proprietor also argued that auxiliary requests 2 to 8 had been set out in its reply to the notice of opposition dated 1 October 2021 (pages 22 to 25). Since this document was submitted as an annex to the patent proprietor's statement of grounds of appeal, auxiliary requests 2 to 8 were part of the appeal proceedings.
- 3.3.7 The board disagrees. It is established case law that requests made by a party in opposition proceedings are not automatically part of the appeal proceedings (e.g. Case Law Book, V.A.4.2.2 b)). Rather, it is for the appellant, in the present case the patent proprietor, to define the extent of the appeal and as set out above, in accordance with Article 12(3) RPBA, set out its complete case in the statement of grounds of appeal or the reply thereto.

- 3.3.8 The submission of the reply to the notice of opposition as an annex to the grounds of appeal does not fulfil this requirement. Specifically, it does not change the fact that the patent proprietor's express requests in appeal did not include auxiliary request 2 to 8. Indeed, the board notes that in its grounds of appeal, the patent proprietor only referred to its reply to the notice of opposition in the context of inventive step starting from D3 (grounds of appeal, page 7, point 2.2, first paragraph). Hence, the patent proprietor's argument in this regard also fails.
- 3.3.9 To support the argument that auxiliary requests 2 to 8 were part of the appeal proceedings, the patent proprietor also referred to the opponent's grounds of appeal, in which said requests were addressed. Specifically, the opponent's grounds of appeal comprised a table on page 15 referring to auxiliary requests 1 to 8 submitted by the proprietor in opposition proceedings, as well as providing some comments on the allowability of said requests. Hence, the requests were part of the appeal proceedings within the meaning of Article 12(3) RPBA.
- 3.3.10 The board disagrees. As stated by the opponent, its submissions related to auxiliary requests 2 to 8 were filed merely "as a precautionary measure" (grounds of appeal page 15, paragraph below the table), i.e. in anticipation of the possibility that the patent proprietor might request maintenance of the patent on the basis of these requests. However, the patent proprietor did not request maintenance of the patent on the basis of auxiliary requests 2 to 8, neither with its statement of grounds of appeal nor with its reply to the opponent's appeal. Indeed, given the fact that

auxiliary requests 2 to 8 were addressed in the opponent's grounds of appeal, the lack of any reference to those requests in the patent proprietor's reply to the opponent's grounds of appeal served to confirm that auxiliary requests 2 to 8 did not form part of its requests in appeal.

3.3.11 In summary therefore, auxiliary requests 2 to 8 were not part of the appeal proceedings from the outset.

3.4 Article 13(2) RPBA

3.4.1 The relevant point in time for the assessment of the admittance of auxiliary requests 2 to 8 is therefore the date on which these requests were submitted in appeal proceedings, namely with the letter dated 10 December 2024, received by the EPO on 11 December 2024, one day before the oral proceedings before the board.

3.4.2 Since this letter was received after the issuance of the board's communication pursuant to Article 15(1) RPBA, the admittance of these requests is governed by the provisions of Article 13(2) RPBA.

3.4.3 According to Article 13(2) RPBA, any amendment to a party's appeal case made after notification of a communication under Article 15(1) RPBA, shall, in principle, not be taken into account unless there are exceptional circumstances, which have been justified with cogent reasons by the party concerned.

3.5 Interpretation of "any amendment to a party's appeal case" in Article 13(2) RPBA

- 3.5.1 The patent proprietor argued that having been filed during opposition proceedings, auxiliary requests 2 to 8 were "carry-over" requests. Therefore, to determine whether such requests represented an amendment to its appeal case in the sense of Article 13(2) RPBA, the criteria set out in Article 12(4) RPBA were to be applied. Specifically, it first needed to be determined whether auxiliary requests 2 to 8 were "admissibly raised and maintained in the proceedings leading to the decision under appeal". Since this requirement was met for these requests, they did not represent amendments to the patent proprietor's case, and there was no discretion not to admit them into the proceedings under Article 13(2) RPBA. Decision T 246/22 was cited in support of the argument that the criteria under Article 12(4) RPBA would apply to the admittance of auxiliary requests 2 to 8.
- 3.5.2 The board cannot follow the patent's proprietor's arguments. First, decision T 246/22 concerns the question of whether certain auxiliary requests **which had been submitted with the statement of grounds of appeal** met the admissibly raised criterion of Article 12(4) RPBA (Summary of Facts and Submissions, III). This is not the same situation as in the present case in which the relevant requests were submitted one day before oral proceedings before the board. Hence, the board does not see the relevance of T 246/22 to the present case.
- 3.5.3 More importantly however, in contrast to the patent proprietor's view, the reference point for determining an "amendment" under Article 13(2) RPBA is not the same as under Article 12(4) RPBA. Article 12(4) RPBA defines an "amendment" by way of reference to Art 12(2) RPBA as any matter departing from the framework of the decision

under appeal (i.e. the requests, facts, objections, arguments and evidence underlying the contested decision), unless this matter was admissibly raised and maintained in the proceedings leading to the decision.

- 3.5.4 As explained above, matter which was not considered in the decision under appeal is not automatically part of the appeal proceedings, but only if it is also part of a party's "complete appeal case" within the meaning of Art 12(3) RPBA. The party's complete appeal case as determined by Article 12(1) to (6) RPBA is the reference point in Article 13(1) and (2) RPBA.
- 3.5.5 Hence, the amendment referred to in Article 12(4) RPBA is an amendment of the party's case **relative to its requests, facts, evidence, arguments and objections on which the decision under appeal is based**, which is distinct from "amendments to a party's **appeal** case" in Article 13(2) RPBA, carried out at a later stage of the appeal proceedings relative to earlier submissions in appeal.
- 3.5.6 While this conclusion is unambiguously based on the wording of the provisions themselves, it also follows from the systematic context. Article 12 RPBA is concerned with the factual and legal framework at the initiation stage of an appeal. Article 12(4) RPBA cannot therefore refer to amendments to a party's appeal case, since a party can amend its appeal only after having set out its case in the statement of grounds of appeal and/or the reply thereto. Furthermore, the patent proprietor's interpretation would have as a consequence that any submission or request admissibly raised and maintained in opposition proceedings could be reintroduced without impediment at any stage of the appeal proceedings, since following

said interpretation, such a request would never be an amendment of the party's appeal case under Article 13(1) and (2) RPBA, with the consequence that the board would not have the discretion to exclude it. This would in turn run contrary to the legislator's intent underlying Article 13(2) RPBA (see explanatory remarks to the RPBA in relation to Article 13(2) RPBA, third paragraph), namely that at an advanced stage of appeal proceedings, amendments to a party's appeal case, in the absence of exceptional reasons justified by cogent reasons, are not taken into consideration.

- 3.5.7 In summary, the admissibly raised criterion of Article 12(4) RPBA is not relevant to the question whether a claim request represents an amendment to a party's appeal case under Article 13(2) RPBA.
- 3.6 It therefore needs to be decided whether the filing of auxiliary requests 2 to 8 represents an amendment to the patent proprietor's appeal case under Article 13(2) RPBA, and if so, whether exceptional circumstances exist justifying their admittance into appeal proceedings.
  - 3.6.1 In its arguments at oral proceedings the patent proprietor focused on auxiliary request 6. It argued that the set of claims of this request differed from the claims of the main request (claims as granted) solely in the deletion of independent claims 1 and 2. The claims of auxiliary request 6 were thus identical to claims 3-12 of the main request (claims as granted).
  - 3.6.2 The patent proprietor argued that auxiliary request 6 clearly addressed the conclusion of the board set out for claim 1 of auxiliary request 1. Furthermore, the claims of auxiliary request 6 had already been

addressed by the opponent in relation to the main request and auxiliary request 1 and hence did not require any changes to the parties' preparation or to the technical discussions at oral proceedings.

- 3.6.3 The board understands the patent proprietor's position to equate to an argument that the subject-matter of auxiliary request 6 was already part of the appeal proceedings (in the main request as well as in auxiliary request 1) and hence did not represent an amendment to the patent proprietor's appeal case.
- 3.6.4 The board acknowledges that discretion not to admit a claim request exists under Article 13(2) RPBA only if this claim request constitutes an amendment in the sense of Article 13(2) RPBA.
- 3.6.5 The board is also aware of the existence of two lines of case law, one according to which a deletion of (an alternative in) an independent claim is always an amendment in the sense of Article 13(2) RPBA and one according to which the deletion of (an alternative in) an independent claim represents an amendment in the sense of Article 13(2) RPBA only if this deletion alters the factual and legal framework of the proceedings (see in this regard Case Law Book, V.A. 4.2.2 d)).
- 3.6.6 The board does not agree with the latter approach for the reasons set out in T 2091/18 (reasons, point 4), agreeing with the conclusions set out in T 1569/17 (reasons, point 4.3.1). In summary, Article 12(3) RPBA provides that the statement of grounds of appeal and the reply must contain the complete appeal submissions of a party. According to Article 12(2) RPBA, the grounds of appeal or reply must be directed *inter alia*

to the requests on which the contested decision is based. As the Legal Board of Appeal explained in J 14/19 (reasons, point 1.4 and 1.5), it follows by implication that submissions by the parties that are not directed to the requests contained in the statement of grounds of appeal or reply have the effect of amending the appeal submission.

- 3.6.7 Hence, any new and amended claim request is to be considered as an amendment to the party's appeal case.
- 3.6.8 In the view of the present board, this is the only reasonable interpretation of an "amendment to a party's appeal case" in the meaning of Article 13(2) RPBA. In the present case, the patent proprietor's appeal case set out in its statement of grounds and its reply was based on the main request and auxiliary request 1. Since according to Article 12(3) RPBA these submissions contain the patent proprietor's complete case, it follows that through its claim requests, the patent proprietor implicitly indicated at the outset of appeal proceedings that it was not interested in, and did not intend to pursue the maintenance of the patent on the basis of only some of the claimed alternatives, e.g. on the basis of claim requests in which certain independent claims, or certain alternatives within independent claims are deleted.
- 3.6.9 In the view of the board, the filing of a new claim request must always have a substantive purpose related to the potential outcome of the patent proprietor's appeal case, since otherwise there would be no need for the patent proprietor to file it and request its admittance into the proceedings. If there is in turn a substantive reason for filing the new set of claims, for example, as in the present case, an independent



claim is deleted for the purpose of overcoming an inventive step objection in relation to a higher ranking request, then there is an amendment of the party's case, since the claimed subject-matter previously relied upon not only changed, but changed in such a manner as to potentially lead to a different outcome, not only for the patent proprietor, but also for the opponent.

3.6.10 For the sake of completeness, the board does not consider Article 13(2) RPBA to necessarily prevent the correction of obvious errors under Rule 139 EPC (see e.g. T 131/18). In any case, in order for a correction under Rule 139 EPC to be allowable, both the error and the correction must be obvious (e.g. G 11/91, reasons, points 5 and 6). Hence, a correction only clarifies what already would have been understood by the skilled person, and hence does not alter the subject-matter of the claim.

3.6.11 Lastly, the board comes to the same conclusion when following the line of case law that considers a deletion of (an alternative in) an independent claim to be an amendment in the sense of Article 13(2) RPBA only if it alters the factual and legal framework of the proceedings. By way of example this is illustrated below on the basis of the deletion of a certain alternative from an independent claim:

If a claim request comprises an independent claim comprising alternatives, and the opponent argues that a certain alternative is not allowable, then, in the absence of further claim requests comprising an independent claim with said alternative deleted, it is legitimate for the opponent to rely on the assumption that, should the independent claim be deemed not

allowable on the basis of said alternative, other alternatives will not be pursued. The filing of claim requests shortly before or during oral proceedings before the board, which for the first time lack the alternative to which the opponent's objections were formulated, must be objectively seen as an unforeseeable change of the framework of the appeal proceedings. Even if the subject-matter of the remaining alternatives was encompassed by the claims of previously pending claim requests, the deletion of the contested alternative creates a new object which shifts the discussion in that the amendment "moves the target" out of the focus of the objections that have been debated on appeal. Therefore, the deletion of a critical alternative in a set of claims also represents an amendment of the proprietor's appeal case in terms of Article 13(2) RPBA under the second line of case law. At the final stage of the appeal proceedings, such change of the framework of the debate, which departs from the patent proprietor's previous conduct of the proceedings and for which the opponent cannot be reasonably expected to prepare, can indeed only be accepted in exceptional circumstances justified by cogent reasons and on condition that the opponent has a proper opportunity to react (Article 13(3) RPBA).

3.6.12 In conclusion, irrespective of which of the two lines of case law is considered, the result is the same, namely that a claim request in which an (alternative in an) independent claim has been deleted represents an amendment in the sense of Article 13(2) RPBA.

3.6.13 Consequently, in the present case auxiliary request 6 represents an amendment of the patent proprietor's appeal case pursuant to Article 13(2) RPBA. The same applies to auxiliary requests 2 to 5, 7 and 8, all of

which, compared to auxiliary request 6, comprise at least a further amendment in independent claim 3, as set out in the table above.

3.7 Exceptional circumstances under Article 13(2) RPBA

3.7.1 The final question is whether any exceptional circumstances under Article 13(2) RPBA exist justifying the admittance of auxiliary requests 2 to 8 into the proceedings. No particular justification for the late filing of these requests was submitted by the patent proprietor, and the board also sees none. Indeed, there is no apparent reason why these requests could not have been submitted with the patent proprietor's reply to the opponent's grounds of appeal.

3.7.2 The patent proprietor did however argue that auxiliary requests 2 to 8 presented no new circumstances relevant for the assessment of patentability, and were therefore not detrimental to procedural economy. While not submitted specifically as a justification for the late filing under Article 13(2) RPBA, the board notes that in some decisions, exceptional circumstances were considered to be present if allowing the amendment was not detrimental to procedural economy (e.g. T 2295/19).

3.7.3 The board does not agree with this approach, since if the exceptional circumstances justifying admittance under Article 13(2) RPBA can simply be certain criteria under Article 13(1) RPBA, then Article 13(2) RPBA becomes ineffective as the third level of the convergent approach.

3.7.4 Hence, there are no exceptional circumstances justifying the admittance of auxiliary requests 2 to 8 into the proceedings. The board therefore decided not

to admit auxiliary requests 2 to 8 into the proceedings pursuant to Article 13(2) RPBA.

Auxiliary request 9 - admittance

4. Auxiliary request 9 was submitted by the patent proprietor during oral proceedings before the board. Compared to claim 1 and 2 of auxiliary request 1, claim 1 and 2 were amended by deletion of the alternative in which the sequestrant is (G-1).

The opponent requested non-admittance of this request pursuant to Article 13(2) RPBA.

- 4.1 As already established above *inter alia* in relation to the admittance of auxiliary request 6, an amendment by deletion of an alternative corresponds to an amendment to the party's case. Therefore, such a claim request can only be admitted by the board if there are exceptional circumstances which have been justified with cogent reasons by the party concerned.

- 4.2 The patent proprietor argued that the filing of auxiliary request 9 was justified by the conclusion of the board taken at oral proceedings in relation to the alternative of claim 1 of auxiliary request 1 in which the sequestrant is (G-1) (above). It argued that prior to the oral proceedings before the board, there had been no indication that sequestrants (G-1) and (G-2) would be assessed separately in relation to inventive step. Furthermore, the alternative remaining in claim 1 of auxiliary request 9, in which the sequestrant was (G-2), had already been addressed by the parties in written appeal proceedings. Hence, the admittance of auxiliary request 9 was not detrimental to procedural economy.

- 4.3 The board does not find the patent proprietor's justification convincing. As stated by the opponent, already with its grounds of appeal, the opponent submitted separate inventive step objections against alternatives (G-1) and (G-2) of claim 1 of auxiliary request 1 (opponent's grounds of appeal, section II.1.1 in relation to alternative (G-1) (pages 2 to 7) and section II.1.2 in relation to alternative (G-2) (pages 7 to 10)). Furthermore, both alternatives were addressed separately in the board's communication pursuant to Article 15(1) RPBA (points 3.3 and 3.4). Consequently, the patent proprietor's contention that (G-1) and (G-2) were dealt with separately for the first time during oral proceedings before the board, is incorrect.
- 4.4 Furthermore, as set out above in relation to *inter alia* auxiliary request 6, not being detrimental to procedural economy cannot be considered as an exceptional circumstance in the context of Article 13(2) RPBA.
- 4.5 Hence, there are no exceptional circumstances justifying the admittance of auxiliary request 9 into the proceedings. The board therefore decided pursuant to Article 13(2) RPBA not to admit auxiliary request 9 into the appeal proceedings.
5. Remaining admittance issues
- 5.1 In the context of discussions under inventive step, the patent proprietor requested not to admit the calculations regarding the amounts of (G-1) and (G-2) in A17 as well as the arguments associated thereto.

5.2 Since the board did not address A17 at all in reaching its conclusions set out above, there is no need for the board to deal with this request.

6. Conclusion

7. Since there are no allowable claim requests, the patent is to be revoked.

## 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:



U. Bultmann

M. O. Müller

Decision electronically authenticated