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**Datasheet for the decision
of 24 March 2026**

Case Number: T 0772/24 - 3.3.02

Application Number: 12151807.0

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Language of the proceedings: EN

Title of invention:
FOULING RELEASE COATINGS

Patent Proprietor:
Jotun A/S

Opponent:
Akzo Nobel Coatings International BV

Relevant legal provisions:
EPC Art. 123(2), 56

Keyword:
Amendments
Inventive step

Decisions cited:
G 0002/21



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Case Number: T 0772/24 - 3.3.02

D E C I S I O N
of Technical Board of Appeal 3.3.02
of 24 March 2026

Appellant: Akzo Nobel Coatings International BV
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Decision under appeal: **Interlocutory decision of the Opposition
Division of the European Patent Office posted/
electronically transmitted on 4 April 2024
concerning maintenance of the European Patent
No. 2617778 in amended form.**

Composition of the Board:

Chairman M. O. Müller
Members: A. Lenzen
M. Blasi

Summary of Facts and Submissions

I. The opponent (appellant) lodged an appeal against the opposition division's decision (decision under appeal) finding that European patent No. 2 617 778 (patent) in amended form meets the requirements of the EPC.

II. Reference is made in the present decision to the following documents filed with the opposition division.

D2 US 2002/0115811 A1

D4 US 2007/0129528 A1

D11 WO 93/13179 A1

D12a Experimental data (3 pages), filed on
22 December 2023

D16 US 2011/0212333 A1

D18 Technical Data Sheet from Jotun entitled
"Alkydprimer"

D19 Technical Data Sheet from Jotun entitled *"Vinyl
Primer"*

D20 Application Guide from Jotun for *"Jotacote
Universal N10"*

III. With the statement of grounds of appeal, the appellant filed the following documents.

D22 Technical Data Sheet from Jotun entitled
"Jotacote Universal N10"

D23 Safety Data Sheet from Jotun entitled *"Vinyl
Primer"*

D24 ASTM D6677-18

IV. With the reply to the statement of grounds of appeal, the patent proprietor (respondent) filed, *inter alia*, a set of claims of auxiliary request II.

- V. With a letter dated 27 January 2025, the appellant filed a further substantive submission together with an additional document. However, as this document relates to an auxiliary request ranked lower than auxiliary request II, it is not relevant to the present decision.
- VI. In preparation for the oral proceedings, which had been arranged at the parties' request, the board issued a communication under Article 15(1) RPBA. In that communication, it summarised the parties' previous substantive submissions and expressed its preliminary opinion on several issues.
- VII. With letters dated 23 January 2026 and 4 March 2026 (appellant), and 24 February 2026 and 11 March 2026 (respondent), the parties filed further substantive submissions.

The appellant filed two additional documents with its letter dated 4 March 2026. However, as these documents relate to an auxiliary request ranked lower than auxiliary request II, they are not relevant to the present decision.

In its letter dated 24 February 2026, the respondent made the set of claims of auxiliary request II as filed with the reply to the statement of grounds of appeal its main request.

- VIII. Oral proceedings before the board were held by videoconference on 24 March 2026 in the presence of both parties. At the end of the oral proceedings, the chair announced the order of the present decision.

IX. The parties' final requests at the end of the oral proceedings, in so far as they are relevant to this decision, were as follows.

- The appellant requested that the decision under appeal be set aside and that the patent be revoked in its entirety.
- The respondent requested that the patent be maintained in amended form based on the set of claims of the main request, filed as auxiliary request II with the reply to the statement of grounds of appeal.

X. Summaries of the parties' submissions, where relevant to the present decision, as well as key aspects of the decision under appeal, are set out in the reasons for the decision below.

Reasons for the Decision

Main request (set of claims filed as auxiliary request II with the reply to the statement of grounds of appeal)

1. The patent relates to a multilayer fouling release coating designed for surfaces submerged in seawater, such as ship hulls and marine structures. Unlike traditional anti-fouling coatings, which are based on the slow release of a biocide contained in the coating, the coating disclosed in the patent relies on physical surface properties which make it difficult for marine organisms to adhere and enable their removal by hydrodynamic forces instead of killing them.

2. Amendments (Article 123(2) EPC)

2.1 The appellant argued that the subject-matter of claims 1, 6 and 10 of the main request extended beyond the content of the application as filed.

As far as the application as filed is concerned, in the following the board will refer, in agreement with the appellant, to the published version (EP 2 617 778 A1).

2.2 Claims 1 and 10

2.2.1 The board agrees with the respondent that the subject-matter of claims 1 and 10 of the main request is based on claims 4 and 11 as filed, respectively, as well as paragraphs [0019], [0020], [0063], [0091] and [0095] of the application as filed. The reasons for this are as follows.

2.2.2 Claims 1 and 10 of the main request have the wording shown below, with the amendments made with respect to claims 4 and 11 as filed, respectively, shown in bold.

Claim 1

"A multilayer fouling release coating comprising:

*(I) **an anticorrosive epoxy based** a primer layer;
and*

*(II) a layer comprising at least one **curable or crosslinkable** polysiloxane and, at least one silane terminated polyurethane; **and a catalyst;***

wherein layers (I) and (II) are adjacent."

Claim 10

*"A process for the preparation of a **cured multilayer** fouling release coating comprising applying a layer comprising at least one curable or crosslinkable polysiloxane ~~and~~, at least one silane terminated polyurethane **and a catalyst directly to an anticorrosive epoxy based primer coated on a metallic** a surface and allowing curing to occur."*

Thus, claim 1 of the main request and claim 4 of the application as filed relate to a multilayer fouling release coating comprising the two layers (I) and (II), while claim 10 of the main request and claim 11 of the application as filed essentially relate to a process for making this coating.

2.2.3 Paragraph [0091] of the application as filed relates to the primer layer of the invention, which corresponds to layer (I) of claim 4 as filed. This paragraph explains that such primer layers have anticorrosive properties in order to impart corrosion protection to the metallic substrates on which they have been applied, and that *"[t]hey are typically based on epoxys"*. Epoxy resins are in fact the only materials disclosed in the application as filed from which the primer layer can be made. Accordingly, if anything, epoxy resins are to be regarded as being a preferred material for the primer layer.

The board acknowledges that the subject-matter of claims 1 and 10 of the main request permits the primer layer to be based on only one epoxy resin, as pointed out by the appellant. However, contrary to the appellant's view, the board takes the position that the skilled person would not consider the wording *"[t]hey*

are typically based on epoxys" to imply that a primer layer is based on two or more epoxies. The wording states that "they", i.e. the primer layers (plural), are typically based on "epoxys", and does not disclose that the proposed primer layer (singular) is based on epoxys (plural). The board therefore agrees with the respondent that there is no substantial difference in meaning between "epoxy based" (claims 1 and 10 of the main request) and "based on epoxys" (paragraph [0091] of the application as filed).

Hence, paragraph [0091] of the application as filed provides a basis for the amendment "*an anticorrosive epoxy based*" in claim 1 as well as the amendment "*an anticorrosive epoxy based primer coated on a metallic*" in claim 10 of the main request.

2.2.4 Paragraph [0063] of the application as filed relates to a preferred embodiment of the fouling release composition and the layer obtained therefrom, which corresponds to layer (II) of claim 4 as filed. This paragraph states that this layer not only comprises at least one silane-terminated polyurethane (SPU) composition but also at least one curable or crosslinkable polysiloxane and a catalyst.

It is clear from this paragraph that the specific components mentioned (SPU, curable or crosslinkable polysiloxane, catalyst) define the fouling release composition of the invention. Therefore, contrary to the appellant's argument, the fact that claim 1 of the main request does not specify the fact that layer (II) is obtained from a fouling release composition does not result in added subject-matter.

Hence, paragraph [0063] of the application as filed provides a basis for the amendment "*curable or crosslinkable ... and a catalyst*" in claim 1 as well as the amendment "*and a catalyst*" in claim 10 of the main request.

2.2.5 Paragraphs [0019] and [0020] of the application as filed specify that layers (I) and (II) are preferably adjacent. Paragraph [0095] states that, in a preferred embodiment, the coating of the invention is applied directly to the epoxy primer layer. Hence, these paragraphs of the application as filed provide a basis for the amendment "*wherein layers (I) and (II) are adjacent*" in claim 1 as well as the amendment "*directly*" in claim 10 of the main request.

2.2.6 Lastly, the only remaining amendment, i.e. "*cured multilayer*" in claim 10 of the main request, merely constitutes an alignment with the wording used later in the same claim, according to which curing is allowed to occur, and with that of claim 1, which relates to a corresponding multilayer coating. These alignments do not result in subject-matter extending beyond the content of the application as filed.

2.2.7 As is evident from the above, the amendments made in claims 1 and 10 of the main request are at least disclosed in the application as filed as being preferred. Thus, even if selections have to be made for one or more of the amendments made, there is a clear pointer in each case towards the subject-matter of the claims of the main request. The subject-matter of claims 1 and 10 of the main request is therefore directly and unambiguously disclosed.

2.3 Claim 6

2.3.1 Claim 6 of the main request reads as follows.

"A coating as claimed in any of claims 1 to 5, further comprising a top coat layer, above the polysiloxane/polyurethane layer, which is a polysiloxane layer free of silane terminated polyurethane."

2.3.2 The board agrees with the respondent that the subject-matter of claim 6 of the main request is based on paragraphs [0093] and [0094] of the application as filed, which explain that a further layer, called a top coat, may be present on layer (II), which top coat may be a conventional polysiloxane top coat free of SPU.

2.3.3 In the appellant's view, paragraph [0094] limited the polysiloxane top coats mentioned therein to "conventional" ones ("*Such a further top coat can be a **conventional** polysiloxane top coat free of the SPU of the invention*", emphasis added). As could be inferred from the use of this word in relation to weapons (i.e. weapons and conventional weapons were not the same), the use of it here had a limiting effect. Therefore, in the appellant's view the omission of this word from claim 6 of the main request resulted in a generalisation that was not disclosed in the application as filed.

The board does not find this convincing, however. This is because the context in which the word "conventional" is used influences its meaning. It is true that in relation to weapons, it may imply a distinction from weapons of mass destruction and thus may constitute a limitation of the broader term "weapons". However, in

the present case, it is used in a patent document with reference to a class of components or layers obtainable therefrom. Here, it merely indicates that the selection of the specific representative of this component is not critical to the invention. Therefore, in the present case, the term cannot be regarded as having a limiting effect. Consequently, its omission from claim 6 of the main request does not result in added subject-matter.

3. Inventive step (Article 56 EPC)

3.1 The appellant put forward inventive-step objections based on D11 alone as well as on D16 as the closest prior art in combination with one of D2, D4 or D11. These objections are assessed in turn below.

D11 as the closest prior art

3.2 D11 (page 1, first paragraph; page 3, third paragraph) discloses non-fouling protective coating compositions comprising the following two polymers, (A) and (B):

- (A) a polymer carrying pendant and/or terminal curable functional groups, at least a major proportion of the repeating units in the polymer of (A) being other than siloxane units, and
- (B) a curable organohydrogen polysiloxane or poly(diorganosiloxane),

the curable functional groups in component (A) being capable of undergoing a condensation curing reaction with component (B).

The application of these compositions yields non-fouling protective coatings suitable, for example, for marine environments (D11, page 1, first paragraph, and

page 3, last paragraph, to page 4, first paragraph). These coatings exhibit such a strong adhesion to a variety of substrates that adhesion promoters or intermediate tie coats can be omitted (D11, page 4, third paragraph). In particular, D11 discloses (page 24, second paragraph) that the coatings adhere well to steel, concrete, aluminium, and fibre-reinforced polyester surfaces, as well as to known anticorrosive coatings such as epoxy, vinyl or alkyd coatings.

In the example section, D11 gives 13 examples of coating compositions comprising representatives of polymers (A) and (B). Of these, composition example 5 comprises the following components:

- (a) the reaction product of a polyurethane polyol and an aminopropyl silane as polymer (A)
- (b) a hydroxy-functional siloxane polymer as polymer (B)
- (c) dibutyltin dilaurate as a catalyst

The only coatings tested are those prepared from composition examples 1 to 3, and they are evaluated solely for their non-fouling properties (D11, page 31, last paragraph).

3.3 Distinguishing features

- 3.3.1 In its communication under Article 15(1) RPBA, the board considered the second paragraph on page 24 of D11 to be an appropriate starting point for the assessment of inventive step. As set out above, this paragraph discloses that the coating compositions of D11 adhere well to various surfaces such as, *inter alia*, known anticorrosive epoxy, vinyl or alkyd coatings.

The respondent argued - and the board agrees - that starting from this paragraph the following two selections must be made in order to arrive at the subject-matter of claim 1 of the main request.

- (i) Firstly, the selection of an epoxy coating must be made from the three anticorrosive coatings disclosed in D11 (alkyd, vinyl, epoxy) as the surface to be coated with a coating composition from D11.
- (ii) Secondly, the selection of composition example 5 must be made as the actual coating composition, which the parties agreed is the only one of the 13 coating compositions disclosed that contains a silane-terminated polyurethane, and the additional components of which likewise correspond to those recited in claim 1 of the main request for layer (II).

3.3.2 At the oral proceedings, the appellant did not agree with this finding. In its view, composition example 5 of D11 was structurally closer to the subject-matter of claim 1 of the main request than the layer structure disclosed in the second paragraph on page 24 of D11. Consequently, composition example 5, rather than the second paragraph on page 24 of D11, should be considered the most appropriate starting point for the assessment of inventive step.

The board's considerations in this regard can be summarised as follows. Claim 1 of the main request relates to a coating comprising two adjacent layers of a defined composition. By contrast, composition example 5 of D11 merely discloses a specific coating

composition. Even if it is assumed that the layer obtained from this coating composition is implicitly disclosed by composition example 5, this example does not disclose any further underlying layers or their arrangement relative to the implicitly disclosed layer. It was precisely with regard to this missing disclosure that the appellant referred to the same passage relied upon as the starting point by both the board and the respondent when assessing inventive step, namely the second paragraph on page 24. Only this paragraph discloses the possibility of applying a coating according to D11 onto, *inter alia*, an anticorrosive epoxy coating. The appellant relied on this paragraph to argue that the feature "*an anticorrosive epoxy based primer layer*" of claim 1 of the main request was already disclosed in D11 and resulted from a simple selection from D11 (see the statement of grounds of appeal, page 10, penultimate paragraph). However, as already established above, the second paragraph on page 24 of D11 relates to the coating compositions according to D11 only in general terms and not specifically to composition example 5. In the board's view, this means that, when starting from composition example 5 while relying on the second paragraph on page 24, a selection has already implicitly been made, namely the selection of composition example 5 from the coating compositions described there only in general terms. Accordingly, the appellant's approach ultimately does not lead to a different result from that reached when starting from the second paragraph on page 24 of D11. The board further notes that the appellant's submissions, insofar as they imply that starting from composition example 5 does not involve a selection, appear contradictory. In that case, the only remaining selection would be the selection of the anticorrosive epoxy coating from the second paragraph on page 24 of

D11. However, this selection alone would not establish novelty. The appellant nevertheless explicitly refrained from raising a novelty objection based on D11.

3.4 Technical effect

3.4.1 For the technical effect associated with selection (i) above, the respondent referred to D12a.

In D12a ("*Experiment series 1*" on pages 1 and 2), steel panels are coated with one of three commercial primers: an alkyd primer (see D18 for its technical data sheet), a vinyl primer (see D19 for its technical data sheet), or an epoxy primer (see D20 for the corresponding application guide and D22 for its technical data sheet). The coating composition of formulation example 5 of the patent, i.e. a coating composition as required for layer (II) in claim 1 of the main request, is then applied to each of these primer layers. After curing, the adhesion of the second coating layer is evaluated according to the method described in identical terms in the application as filed and in the patent (paragraphs [0109] and [0105], respectively), namely by scratching the surface with a spatula and rating the adhesion on a scale of 1 to 5, where 1 denotes poor adhesion and easy removal of the coating, and 5 indicates strong adhesion. The ratings shown in table 1 of D12a demonstrate that the adhesion of the second coating layer is strongest with the epoxy primer, i.e. a primer layer (I) as defined in claim 1 of the main request.

In D12a (see the section entitled "*Repeated experiments with immersion in artificial seawater and adhesion testing according to ASTM D6677-18*" on pages 2 to 3),

adhesion is also tested on essentially identical multilayer structures, but in accordance with ASTM D6677-18 and after one month of immersion in artificial seawater. The same trend is observed, i.e. better adhesion to the epoxy primer than to the alkyd and vinyl primers. The appellant raised numerous arguments as to why these repeated experiments could not show the effect relied upon by the respondent (e.g. that only the epoxy primer was suitable under the chosen conditions and that the ASTM D6677-18 test had to be considered unreliable in view of D24). However these arguments are irrelevant, since an inventive step can already be acknowledged on the basis of the above-mentioned "*Experiment series 1*" section of D12a alone.

Thus, the following considerations regarding D12a are based solely on, and refer exclusively to, the first part of D12a, namely "*Experiment series 1*".

3.4.2 As regards the technical effect relied upon by the respondent, namely improved interlayer adhesion, the appellant raised the following two objections.

- (a) The skilled person, having common general knowledge in mind, and based on the application as filed, would not derive the above effect as being encompassed by the technical teaching and embodied by the same originally disclosed invention. Hence, the respondent could not rely on the above effect for inventive step (G 2/21, order no. 2).
- (b) The comparative examples in D12a were designed to fail. Hence, the experiments in D12a were not suitable for showing a technical effect over D11.

These objections are addressed in turn below.

3.4.3 Objection (a) above (reliance on a purported technical effect in view of decision G 2/21)

Specifically, the appellant argued that the invention of the application as filed was based on the finding that adding an SPU to a polysiloxane increased adhesion to standard anticorrosive epoxy primers. However, the application as filed did not disclose or suggest any comparison between epoxy, alkyd, and vinyl primers. In other words, the skilled person using common general knowledge would not derive from the application as filed any effect concerning adhesion to anticorrosive primers other than epoxy primers.

This is not convincing, however. The application as filed (paragraphs [0015] and [0016]) discloses that incorporating an SPU into a polysiloxane coating improves its adhesion. In other words, the effect of improved adhesion is derivable from the application as filed. Accordingly, the respondent may rely, for the assessment of inventive step, on a comparison between the subject-matter of claim 1 of the main request and the closest prior art with regard to this adhesion effect, as shown in D12a. The fact that, in comparison with the closest prior art, it emerges that, in addition to the SPU, selection (i) - i.e. the choice of the coating onto which the SPU/polysiloxane-containing layer is applied - also contributes to this effect does not change this conclusion.

3.4.4 Objection (b) above (suitability of the experimental results in D12a to show a technical effect over D11)

The appellant essentially argued that the comparative experiments in D12a should not be taken into account for the following reasons.

- Firstly, the comparative experiments in D12a were designed to fail. The alkyd and vinyl primers were unsuitable for the steel substrate used. Moreover, the three primers were applied at different film thicknesses. It was apparent from, *inter alia*, D18, D19, D22 and D23 that they differed in composition. This precluded a meaningful comparison. As confirmed by the technical data sheets (D18 and D19, respectively), the alkyd and vinyl primers were used under conditions for which they were neither designed nor recommended by the manufacturer.
- Secondly, the comparative experiments in D12a were not reproducible because the test used for evaluating the adhesion strength was not reliable and because commercial products were used whose exact composition was unknown.

These arguments failed to convince the board for the following reasons.

- D12a employs commercially available alkyd, vinyl and epoxy primers as specific examples of the coatings based on alkyd, vinyl and epoxy resins that are described in general terms in D11. The board therefore fails to see why the experiments described in D12a would not be suitable for demonstrating a technical effect in connection with selection (i) above. Even if - as alleged by the appellant - the alkyd and vinyl primers used in D12a were to lack anticorrosive properties, for example due to additional components beyond the respective base resin, it is not apparent why such a lack of anticorrosive properties would significantly affect the results reported in D12a.

- It is true that the alkyd primer used in D12a is suitable, according to its technical data sheet D18, for coating carbon steel and that, as pointed out by the appellant, D12a does not disclose the carbon content of the steel substrates used. However, it is not apparent why the carbon content of the steel substrate should have any influence on the adhesion between two layers applied to that substrate. Hence, the fact that the carbon content is unknown has no bearing on the evidential weight of D12a for proving the effect of improved interlayer adhesion.
- D19 discloses only wood as being a typical application case for the vinyl primer described therein. However, this does not justify the appellant's conclusion that this primer must therefore generally be unsuitable for steel substrates. The results reported in D12a likewise provide no support for such an assumption. Similarly to the previous point, it is not evident why using in D12a a substrate not recommended in D19 would affect the adhesion between two layers applied to that substrate.
- It is also true that the primer layer thicknesses in D12a differ. However, it is not apparent why the thickness of the primer layers should affect the adhesion to the overlying layer, since, as argued by the respondent, adhesion primarily concerns the interface between the layers and would typically be less dependent on the thickness thereof. Ultimately, the board agrees with the respondent that this argument and those assessed above are mere assertions by the appellant in support of which no evidence was provided.
- Moreover, the board sees no reason to question the reproducibility of D12a with regard to the test

method used to assess adhesion strength. The test method is suitable for obtaining at least an approximate assessment of adhesion strength and for identifying the differences between various embodiments.

- Finally, the appellant's argument that D12a was not reproducible because commercial products with unknown compositions were used is unconvincing. More specifically, knowledge of the exact composition of a product is not necessary to reproduce experiments involving that product, provided it is commercially available. Moreover, the appellant did not provide any evidence to the contrary, showing that the effect relied upon by the respondent is not achieved with other products.

3.5 Objective technical problem

In view of the results described in D12a, the board agrees with the respondent that the objective technical problem is to provide a multilayer coating with improved interlayer adhesion.

3.6 Obviousness

- 3.6.1 As set out above, D11 essentially discloses that its coatings adhere well to various surfaces and coatings such as anticorrosive epoxy, vinyl or alkyd coatings. While it is true that different primer coatings, for example, have different qualities and properties - otherwise there would be no reason to provide different primers in the first place, as argued by the appellant - D11 nevertheless presents these three primers (epoxy, vinyl, and alkyd) on an equal footing. Therefore, there is nothing in D11 that suggests that the three primer coatings disclosed therein would

perform differently in terms of adhesion to a coating applied thereto. Fully in agreement with this, the coatings according to D11 are only assessed in terms of their non-fouling properties in the example section; they are not assessed with respect to their adhesion to underlying surfaces or coatings. Accordingly, while experiments testing these three primers for a given property such as adhesion might have been routine for the skilled person, the fact remains that there is no incentive to be found in D11 to perform this testing. The targeted testing and comparison of these primers with respect to their adhesion to a coating applied thereto in order to determine which primer performs best in this regard, would not have been obvious, contrary to the appellant's argument. In other words, on the basis of D11 alone, the skilled person would not have had a reasonable expectation that an epoxy primer would have solved the objective technical problem.

An additional factor that must be taken into account is that D11 discloses 13 different coating compositions in its examples section. Of these, only composition example 5 contains the components recited in claim 1 of the main request for layer (II). The remaining 12 composition examples do not. Most of these 12 composition examples contain a polyacrylate as polymer (A), rather than the polyurethane-based polymer (A) used in composition example 5. Furthermore, D11 reports non-fouling tests for only three composition examples, and all three use a polyacrylate as polymer (A). Thus, if anything, D11 teaches a preference for acrylate-based polymers (A) over polyurethane-based polymers (A) such as the SPU used in composition example 5.

Thus, in order to arrive at the subject-matter of claim 1 of the main request, the skilled person would not only have had to decide to test the three different primer coatings disclosed in D11 for their adhesion - despite the absence of any suggestion that they might perform differently in this respect - but would also have had to select and test specifically one out of 13 coating compositions, which had not even been presented as being preferred.

- 3.6.2 Therefore, the board concludes that the subject-matter of claim 1 of the main request involves an inventive step within the meaning of Article 56 EPC when starting from D11 as the closest prior art.

D16 as the closest prior art

- 3.7 In example IV of D16 (paragraphs [0189] to [0191]), a steel sheet is provided successively with an epoxy primer coat, a tie coat and a top coat. The latter is prepared from a polyorganosiloxane composition and an iron catalyst.

- 3.8 Distinguishing feature

The parties agreed that the subject-matter of claim 1 of the main request is distinguished from D16 at least in that layer (II), which corresponds to the tie coat of example IV of D16, comprises an SPU.

- 3.9 Technical effect

As set out by the respondent, example 1 of the patent and the application as filed shows that the interlayer adhesion between an epoxy primer coating and an additional coating layer applied thereto, the latter

comprising a curable or crosslinkable polysiloxane and a catalyst, is increased upon the addition of an SPU to the additional coating layer.

For the reasons already set out above with regard to D12a, the board does not consider this example to be irreproducible merely because of the test method for evaluating adhesion (which is the same as that used in D12a) and the fact that commercial products with allegedly unknown compositions are used for preparing the coatings.

3.10 Objective technical problem

In view of the results described in the patent and the application as filed, respectively, the board agrees with the respondent that the objective technical problem is to provide a multilayer coating with improved interlayer adhesion.

3.11 Obviousness

- 3.11.1 As regards obviousness, the appellant pointed to D11, D4 and D2. Each of these documents disclosed a coating composition comprising components which corresponded to those recited in claim 1 of the main request for layer (II) (D11, composition example 5; D4, paragraphs [0003] to [0005] and [0011]; D2, paragraphs [0004] and [0048] to [0062]). In the appellant's view, it would have been obvious for the skilled person to substitute the tie coat of example IV of D16 for a layer made from such a composition according to D11, D2 or D4. In addition to this, the aspect of adhesion was even expressly mentioned in D11 (see the summary of this document in section 3.2 above) and in D2 (e.g. paragraph [0094], last sentence).

3.11.2 The board is not convinced by these arguments for the following reasons.

As set out by the respondent, and this was not contested by the appellant, D16 (see claim 1) expressly seeks to avoid the use of tin in its tie and top coats. Against this background, and despite the fact that D11 associates its coating compositions with good adhesion to underlying surfaces/coatings, the board agrees with the respondent that the skilled person would not have considered composition example 5 of D11, which relies on dibutyltin dilaurate as the curing catalyst, to be a candidate for replacing the tie coat of example IV of D16 at all. Rather, the teachings of D16 and D11 are not compatible in this regard.

Even if the skilled person, starting from D16, had turned to D11, they would have seen that composition example 5 of D11 concerns a top coat specifically formulated to include polymer (A). This formulation is intended to eliminate the need for an underlying tie coat. The board therefore shares the respondent's view that the skilled person would not have contemplated using composition example 5 of D11 as a substitute for the tie coat of example IV of D16, since this layer not only differs in function and composition from composition example 5, but is also intended to be rendered superfluous by the latter. The appellant's argument relies on hindsight.

Secondary document D4 (paragraphs [0003] to [0005]) relates to a two-part curable composition essentially comprising a) a first part comprising a silylated polyurethane resin and b) a second part comprising silanol-terminated diorganopolysiloxane. However, there

is no mention in D4 that this two-part curable composition, let alone its component a), which corresponds to the silane-terminated urethane recited in claim 1 of the main request, is characterised by, or increases adhesion to, the surface to which it is applied. Starting from D16, therefore, a combination with D4 cannot render the subject-matter of claim 1 of the main request obvious.

Lastly, secondary document D2 (paragraph [0004]) relates to silicone oligomers useful as reactive diluents for curable polymer systems such as, for example, silylated polyurethanes, silylated polyethers, or mixtures thereof. According to paragraph [0094] of D2, the good adhesion of compositions comprising these silicone oligomers is attributed to the silicone oligomers themselves, which - as discussed during the oral proceedings - are structurally distinct from the SPU recited in claim 1 of the main request. Starting from D16, therefore, a combination with D2 cannot render the subject-matter of claim 1 of the main request obvious either.

- 3.12 Therefore, the board concludes that the subject-matter of claim 1 of the main request also involves an inventive step within the meaning of Article 56 EPC when starting from D16 as the closest prior art.
- 3.13 As no further objections were raised, the main request is allowable.

Order

For these reasons it is decided that:

1. The decision under appeal is set aside.
2. The case is remitted to the opposition division with the order to maintain the patent in amended form with the following claims, and a description to be possibly adapted thereto:
 - claims 1 to 10 of the main request, filed as auxiliary request II with the reply to the grounds of appeal

The Registrar:

The Chairman:



U. Bultmann

M. O. Müller

Decision electronically authenticated