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D E C I S I O N
of 20 September 1994

Case Number: T 0163/92 - 3.3.1

Application Number: 88302522.3

Publication Number: 0286265

IPC: C09D 5/08

Language of the proceedings: EN

Title of invention:
Surface coating composition

Applicant:
ALCAN INTERNATIONAL LIMITED

Opponent:

Headword:
Anticorrosive coating composition/ALCAN INTERNATIONAL

Relevant legal provisions:
EPC Art. 83, 84

Keyword:
"Sufficient disclosure (no) - an effect defined in a claim (a functional parameter) has not been really achieved"
"Clarity (no) - not clear to which category the claims belong"

Decisions cited:

Catchword:



Case Number: T 0163/92 - 3.3.1

D E C I S I O N
of the Technical Board of Appeal 3.3.1
of 20 September 1994

Appellant: ALCAN INTERNATIONAL LIMITED
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Decision under appeal: Decision of the Examining Division of the
European Patent Office dated 16 August 1991
refusing European patent application
No. 88 302 522.3 pursuant to Article 97(1) EPC.

Composition of the Board:

Chairman: A. Jahn
Members: P. Bracke
R. E. Teschemacher

Summary of Facts and Submissions

- I. European Patent application No. 88 302 522.3 (publication No. 0 286 265) was filed 23 March 1988.
- II. By a decision dated 16 August 1991 the Examining Division refused the application on the ground that both pending sets of claims filed with the letter of 25 June 1991 did not comply with the requirement of clarity according to Article 84 EPC. Claim 1 contained the feature "an environmentally non-hazardous anticorrosion agent" and it was not apparent which anticorrosive agents should be considered as "environmentally non-hazardous". Additionally, the selection and use of environmentally non-hazardous anticorrosive agents in paints and varnishes was held obvious in the light of, inter alia,

D1: GB-A-640 729;

D3: EP-A-0 125 025; and

D6: EP-A-0 161 222.

- III. An Appeal was lodged against this decision on 17 October 1991 (letter of 14 October 1991) and the appeal fee was paid on 15 October 1991.

With the Statement of Grounds of Appeal filed on 23 December 1991 the Appellant filed amended claims intended to overcome the grounds of refusal and argued that the essence of the invention lay in the use of anticorrosion agents which combine good corrosion performance with adequate drying. He submitted that the concept on which the application is based was novel and not obvious.

IV. In response to two communications from the Board the Appellant filed a set of 8 claims on 23 November 1993 with the only independent claim reading:

"1. Use in a paint or varnish composition comprising a medium and at least one drier of an anticorrosion agent selected from tetraethylene pentamine, triethylene tetramine, pentaethylene hexamine, diethylene triamine, 1,10-diaminodecane, dodecylamine, 1,8-diaminooctane, dodecanyl succinic anhydride, high molecular weight imidazolines, phenoxyacetic acid, amino or nitro substituted aromatic acids, diphenylamine and t-butylaniline, which is soluble or adapted to be soluble in the medium and which is selected so as to enable a dry paint or varnish film to be obtained on a metal substrate to which the composition is to be applied, within 24 hours, drying being determined according to BS 3900 part C(2)."

V. In an annex to the summons for oral proceedings the Board indicated inter alia that it was doubtful whether the combined anticorrosion and drying effect as defined in Claim 1 is effectively obtained by using the selected anticorrosion agents.

Furthermore, it was indicated that in the absence of evidence of any improvement vis-à-vis the prior art, the problem underlying the present application could be seen in providing further anticorrosive compositions and that the suggested solution of this problem might be considered obvious in the light of inter alia D1, D3, D6 and

D9: Römpps Chemie-Lexikon, 8. Edition (1981), page 996.

Finally, the Appellant was informed that Claim 1 which related to "use of an anticorrosion agent in a paint or varnish composition", was not clear and might be construed as a process of preparing paint or varnish compositions.

VI. In a letter of 1 July 1994 the Appellant did not express an opinion on the Board's objections but gave notice that he would not be represented at the oral proceedings, fixed for 20 September 1994, and he asked for a decision on the basis of the documents already on file.

VII. The submission of a set of claims with the letter of 23 November 1993 is construed by the Board as a request for the grant of a patent on the basis of this set of claims.

During the oral proceedings on 20 September 1994, at which the Appellant was not represented, the Board's decision to dismiss the appeal was pronounced.

Reasons for the Decision

1. The appeal is admissible.
2. Since in present Claim 1 the term "environmentally non-hazardous anticorrosion agent" has been replaced by a list of specific chemically well-defined compounds, the ground for refusing the application due to lack of clarity according to Article 84 EPC, on which the decision of the Examining Division was based, no longer exists.

3. The wording "use of an anticorrosion agent in a paint or varnish composition" introduces a process feature in Claim 1 without defining an actual act to be performed with the agent, however all the other features of Claim 1 are product related. In order to determine the scope of protection conferred by a claim it must be clear to which category the claim belongs. Therefore a mixture of product and process features is only allowable if it is appropriate to define the invention in a clear and concise manner. In the present case the Board cannot see any reason justifying the process feature. Therefore, Claim 1, as amended, does not meet the requirement of clarity pursuant to Article 84 EPC.

4. There are no objections to the present claims under Article 123(2) EPC. The Board is also satisfied that the use of one of the specifically defined anticorrosion agents in Claim 1 in a paint or varnish composition comprising a medium and at least one drier is not described in any of the cited prior art documents. Thus, the claims meet the requirement of novelty.

5. The Appellant submitted that the essence of the present invention lies in the selection of specific anticorrosion agents which confer to paint or varnish compositions containing a drier sufficient chelating power to bond to the particular metal surface, thus providing good corrosion performance, while not being a strong chelating agent for the drier, which would prevent adequate drying (see also page 2, lines 18 to 20, of the published application).

Such drying properties of the anticorrosion agents in paint and varnish compositions containing a drier have been specified in Claim 1 by the requirement that the anticorrosion agent is selected in such a way that it must "enable a dry paint or varnish film to be obtained

on a metal substrate to which the composition is to be applied, within 24 hours, drying being determined according to BS 3900 part C(2)".

However, in all the examples of the present application the paint or varnish compositions, when applied to a metal surface, are dried at ambient temperature during 7 days (examples 1, 2 and 4 to 7) or even 14 days (example 3).

Neither in the present application nor by any evidence filed during the examination or the appeal procedure was it made credible that the use of such anticorrosion agents, in combination with a drier, enables a dry paint or varnish film to be obtained on a metal substrate within 24 hours.

Consequently, since the present application does not provide sufficient information how to perform the invention, more particularly, how to obtain paint or varnish compositions which enable a dry film to be obtained within 24 hours, drying being determined according to BS 3900 part C(2), in the Board's judgement the invention as defined in Claim 1 is not disclosed in a manner sufficiently clear and complete for it to be carried out by a person skilled in the art, this being contrary to the requirement of Article 83 EPC.

6. The disclosure of the present application gave Appellant the opportunity to redefine the invention in such a way that a less ambitious problem is solved, such as the preparation of paints or varnishes forming a dry film within 7 days. However, the Appellant did not take this opportunity as he was not represented at the oral proceedings and had asked for a decision on the basis of the documents already on file, without filing any

comments on the objections made in the annex to the summons to oral proceedings and without filing any amended set of claims (e.g. as an auxiliary request).

- 6.1 If the drying period of 24 hours had been removed from Claim 1, the problem underlying the application would be the provision of further anticorrosive paint and varnish compositions having an acceptable drying time (7 to 14 days), which problem could be considered to have been solved by the claimed process.
- 6.2 In the annex to the summons for oral proceedings, the Board expressed its opinion that D3 was the closest prior art as this was the only document describing anticorrosive paints drying within 24 hours (Example 9). However, on the basis of the redefined problem the closest prior art would not be D3, because the underlying problem would no longer be to prepare paint or varnish compositions enabling a dry film to be obtained within 24 hours but such compositions enabling a dry film to be obtained within 7 days and because in defining the closest prior art it is general practice to consider as the closest prior art that document which solves the same problem and which has the closest similarities in respect of the features in common with the claimed subject matter. In these circumstances D6 which describes in Example 5 a varnish composition containing a medium, a drier and a heterocyclic anticorrosion agent, and which dries within 7 days, would be considered a closer prior art than D3, not mentioning the presence of a drier.
- 6.3 In assessing inventive step in such a case, it would have to be decided whether it was obvious for a skilled man faced with the problem to prepare paint or varnish

compositions having an acceptable drying time to replace the heterocyclic anticorrosion agent of Example 5 of D6 by one of the anticorrosion agents defined in Claim 1.

In the Board's view this would have to be decided in the affirmative, because the agents defined in Claim 1 were known to have anticorrosive properties and from several of those agents it was known that they could be used in paints or varnishes (e.g. D6 and D9).

D6 teaches in the paragraph bridging pages 25 and 26 that salts of nitroisophthalic acid are corrosion inhibitors which may be used in anticorrosive paints. It is true that these salts are suggested in combination with the heterocyclic anticorrosive agent forming the essence of D6. However, this does not alter the fact that the above salts per se are described to be anticorrosion agents.

Moreover, in D9 dodecenylnsuccinic anhydride is described as an anticorrosion agent which may be used as an additive in paints (cf. the fifth compound in the right-hand column of page 996).

Thus, the Appellant's submission that a skilled person was dissuaded from employing anticorrosion agents used in systems other than paints and varnishes must fail.

- 6.4 The Appellants argumentation that strong chelating agents, e.g. the benzaldoximes disclosed in D3, would interfere with the drier, thus preventing adequate drying is not supported by evidence. On the contrary, it seems to be apparent from D6 that the heterocyclic anticorrosion agents considered by the Appellant as strong chelating agents do not interfere with the drier, since the paints described in Example 5 comprising a combination of heterocyclic anticorrosion agents and

cobalt naphthenate as drier require, like the paints of the present application, drying during 7 days at ambient temperature.

- 6.5 Thus, in the Boards view, the cited prior art would have provided reasonable expectation that the above redefined technical problem would be solved by paints comprising the claimed combination of anticorrosion and drying agents.

The same considerations would apply to dependent Claims 2 to 8.

7. In summary, the invention as claimed does not meet the requirement of Article 83 EPC. Moreover, since it is not clear to which category the present claims belong, the set of claims does not meet the requirement of clarity according to Article 84 EPC.

Even if the Applicant had taken the opportunity to remove from Claim 1 the effect which has not been made credible, a patent could not have been granted, because the invention based on a less ambitious problem would not have involved an inventive step.

Order

For these reasons it is decided that

The appeal is dismissed.

The Registrar:



P. Marterana

The Chairman:



A. Jahn