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D E C I S I O N
of 11 June 1996

Case Number: T 0671/94 - 3.3.1

Application Number: 84307192.9

Publication Number: 0144135

IPC: C09D 13/00

Language of the proceedings: EN

Title of invention:

Lidded paint container containing aqueous solid paint

Patentee:

IMPERIAL CHEMICAL INDUSTRIES PLC

Opponent:

- (01) Drösser GmbH & Co. KG
- (02) HOECHST Aktiengesellschaft Werk Kalle-Albert
- (03) Fina Research S.A.
- (04) Deutsche Amphibolin-Werke von Robert Murjahn GmbH & Co. KG
- (05) J.W. Ostendorf GmbH & Co.
- (06) Fa. Bösenberg Bauchemie GmbH

Headword:

Lidded paint container/ICI

Relevant legal provisions:

EPC Art. 54(2), 56, 87(1), 123(2)

Keyword:

- "Amendments - admissible"
- "Entitlement to priority - yes"
- "Novelty - yes"
- "Inventive step - yes"
- "Common general knowledge challenged"

Decisions cited:

G 0003/89, T 0171/84, T 0206/83, T 0112/92, T 0939/92

Catchword:



Case Number: T 0671/94 - 3.3.1

D E C I S I O N
of the Technical Board of Appeal 3.3.1
of 11 June 1996

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Decision under appeal: Decision of the Opposition Division of the
European Patent Office posted 10 June 1994
revoking European patent No. 0 144 135 pursuant to
Article 102(1) EPC.

Composition of the Board:

Chairman: A. J. Nuss
Members: P.-P. Bracke
R. E. Teschemacher

Summary of Facts and Submissions

I. This appeal is from the Opposition Division's decision revoking European patent No. 0 144 135, which was granted on the basis of European patent application No. 84 307 192.9, filed on 18 October 1984 and claiming priority from GB 8 329 299, GB 8 329 955 and GB 8 419 720 of 2 November 1983, 10 November 1983 and 2 August 1984 respectively.

II. The patent was opposed by six Opponents.

By a decision announced orally on 27 April 1994, with the reasoned decision being issued on 10 June 1994, the patent was revoked on the ground that it lacked inventive step in view of the combined teachings of documents

(1) US-A-3 602 939 and

(2) GB-A-922 456 (corresponding to DE-C-1 242 306).

III. The Appellant (Proprietor of the patent) lodged an appeal against this decision and, during the oral proceedings held on 11 and 12 June 1996, filed an amended set of 18 claims, independent claims 1, 2, 11, 16 and 17 reading:

"1. A lidded paint container which contains an aqueous solid paint intended to produce a coating having a relatively smooth non-textured surface, the container comprising a tray which is adapted to receive a roller applicator and is closable with the lid when not in use, the tray containing a highly structured shape retaining aqueous solid paint which comprises as essential ingredients a latex polymer dispersion, a thickener and

a titanium chelate structuring agent, the paint being characterised by,

(a) a gel strength (as measured by the ICI Sheen Gel Strength Tester when using a blade of dimensions 3x1 cm) of at least 100 g.cm when measured 4 weeks from manufacture and a gel strength (measured as above) of not greater than 300 g.cm when measured 1 year from manufacture, and

(b) a viscosity (when measured by a technique, including a preshearing at high speed of the test sample for 4 minutes) in the range 0.2 to .9 Pascal (2 to 9 poise) 4 weeks from manufacture and which remains in this range 24 weeks from manufacture."

"2. A lidded paint container which contains an aqueous solid paint intended to produce a coating having a relatively smooth non-textured surface, the container comprising a tray which is adapted to receive a roller applicator and is closable with the lid when not in use, the tray containing a highly structured shape-retaining aqueous solid paint which comprises as essential ingredients a latex polymer dispersion, a thickener and a structuring agent selected from natural and synthetic clays and mixtures thereof, the paint being characterised by a structure which is not irreversibly destroyed by shearing forces and by

(a) a gel strength (measured as in Claim 1) of at least 100 g.cm when measured 4 weeks from manufacture and a gel strength (measured as in Claim 1) of not greater than 300 g.cm when measured 1 year from manufacture, and

(b) a viscosity (when measured by a technique including a preshearing of the test sample at high speed for 4 minutes) in the range 0.2 to .9 pascal (2-9 poise)

4 weeks from manufacture and which remains in this range 24 weeks from manufacture."

"11. A method for providing a coating of paint intended to produce a coating having a relatively smooth non-textured surface on a substrate wherein the method comprises the steps of

(1) providing a container comprising a tray adapted to receive a paint roller and closable by a lid,

(2) providing in the tray an aqueous paint which comprises as essential ingredients a latex polymer dispersion, a thickener and a structuring agent selected from natural and synthetic clays, or titanium chelates, so that on storage the paint becomes solid wherein the paint has

(a) a gel strength (measured as in Claim 1) of at least 100 g.cm when measured 4 weeks from manufacture and a gel strength of not greater than 300 g.cm when measured 1 year from manufacture and

(b) a viscosity (when measured by a technique, including a preshearing of the test sample at high speed for 4 minutes) in the range 0.2 to .9 pascal (2 to 9 poise) 4 weeks from manufacture and which remains in this range 24 weeks from manufacture when it is intended to provide a coating having a relatively smooth non-textured surface,

(3) closing the tray with a lid to permit transport and storage of the paint in the tray when the paint is solid,

(4) removing the lid from the tray to enable the tray to receive a paint roller and

(5) taking up paint from the tray onto a paint roller and applying the taken up paint to the substrate by means of the paint roller."

"16. A method for providing a highly structured aqueous solid paint intended to provide a coating having a relatively smooth non-textured surface in a lidded container comprising a tray adapted to receive a paint roller and closable by a closely fitting lid wherein the method comprises:

(1) making a mixture which comprises as essential ingredients a latex polymer dispersion, a thickener and a titanium chelate structuring agent in amounts such that the paint has

(a) a gel strength (measured as in Claim 1) of at least 100 g.cm when measured 4 weeks from manufacture and a gel strength (measured as in Claim 1) of not greater than 300 g.cm when measured 1 year from manufacture and

(b) a viscosity (when measured by a technique, including a preshearing of the test sample for 4 minutes) in the range 0.2 to 0.9 pascal (2 to 9 poise) 4 weeks from manufacture and which remains in this range 24 weeks from manufacture

(2) passing the mixture immediately into the tray,

(3) closing the tray with a lid to permit transport and storage of the paint in the tray and

(4) storing the paint before it is taken up onto the paint roller for a period of time during which the solid structure develops."

"17. A method for providing a highly structured aqueous solid paint intended to provide a coating having a relatively smooth non-textured surface in a lidded container comprising a tray adapted to receive a paint roller and closable by a closely fitting lid wherein the method comprises:

(1) making a mixture which comprises as essential ingredients a latex polymer dispersion, a thickener and a structuring agent selected from natural and synthetic clays and mixtures thereof in amounts such that the paint has

(a) a gel strength (measured as in Claim 1) of at least 100 g.cm when measured 4 weeks from manufacture and a gel strength (measured as in Claim 1) of not greater than 300 g.cm when measured 1 year from manufacture and

(b) a viscosity (when measured by a technique, including a preshearing of the test sample for 4 minutes) in the range 0.2 to 0.9 pascal (2 to 9 poise) 4 weeks from manufacture and which remains in this range 24 weeks from manufacture

(2) passing the mixture immediately into the tray,

(3) closing the tray with a lid to permit transport and storage of the paint in the tray and

(4) storing the paint before it is taken up onto the paint roller for a period of time during which a solid structure develops which is not irreversibly destroyable by shearing forces imparted by a roller applicator."

IV. The Respondents (Opponents) objected that the present claims did not meet the requirements of Article 123(2) EPC, because paints having a viscosity in the range 0.2

to 0.9 pascal (2 to 9 poise) **4 weeks from manufacture** were not mentioned in the originally filed application.

Moreover, they contested that these claims could be entitled to the first or second priority dates, since both priority documents were completely silent about solid paints **intended to produce a coating having a relatively smooth non-textured surface** and about paints having a viscosity in the range **2 to 9 poise 4 weeks from manufacture**.

Additionally, it was contested that these claims would meet the requirement of novelty or inventive step vis-à-vis documents (1) and (2) as well as documents

- (6) "Tilcoms for structure in latex paints", a brochure published in 1975,
- (8) US-A-4 196 107,
- (9) US-A-4 304 693,
- (10) ICI Magazine "Square Paint? Stop messing about!", May/June 1984, pages 19-21, and

vis-à-vis a prior use resulting from the launch in January 1984 of a product embraced within the scope of the present claims.

- V. The Appellant essentially argued that the set of claims filed during the oral proceedings met the requirement of Article 123(2) EPC, that it was entitled to the three claimed priority dates and that it met the requirements of novelty and inventive step vis-à-vis the cited prior art documents.

The Appellant *inter alia* provided experimental evidence comprising a series of photographs to demonstrate the amount of spattering occurring when paint according to

the prior art and according to the present invention was applied with a roller.

- VI. The Appellant requested that the decision under appeal be set aside and that the patent be maintained with the claims submitted during the oral proceedings.

The Respondents requested that the appeal be dismissed.

Additionally, Respondent (02) [Opponent (02)] requested that the following point of law be referred to the Enlarged Board of Appeal:

"If an example discloses for a specific composition a range of values concerning a feature essential for the invention which is not otherwise disclosed, is it admissible to regard this range of values as disclosed for all claimed compositions?"

Reasons for the Decision

1. The appeal is admissible.
2. *Article 123(2) and (3) EPC*
 - 2.1 As the amendments to the granted set of claims remove alternatives and limit ranges, the protection conferred by the present claims is more restricted than the protection conferred by the granted set of claims. Consequently, the present claims meet the requirement of Article 123(3) EPC. Since this was not contested by the Respondents, it is not necessary to give detailed reasons.

- 2.2 The Respondents objected, however, that paints characterised by a viscosity in the range 2 to 9 poise **4 weeks from manufacture** were not mentioned in the application as originally filed and, consequently, that the present claims did not meet the requirement of Article 123(2) EPC.
- 2.2.1 More particularly, they argued that in the originally filed application only paints characterised by a viscosity of 1.5-13 poise 4 weeks from manufacture or a viscosity of 2 to 9 poise after 24 weeks from manufacture were mentioned (page 3, lines 25-29, and page 4, lines 9-10 and 26-27) and that the specific combination of "**2 to 9 poise**" with "**after 4 weeks from manufacture**" was not mentioned there. Moreover, they submitted that the viscosity range of 2-9 poise after storage for 4 weeks in example 2 of the application as filed concerns only a paint containing one particular titanium chelate as structuring agent and that this viscosity range could not be regarded as representative of any paint embraced by the wording of the claims.
- 2.2.2 However, in determining whether by an amendment subject-matter is added which extends beyond the content of the application as filed within the meaning of Article 123(2) EPC, it is essential to determine whether a skilled person would objectively have derived the amended feature from the European patent application as a whole on the filing date of the application (see G 3/89 OJ EPO 1993, 117, reasons 2).
- 2.2.3 The citation on page 3, lines 8 ff and, in particular, lines 25-29, of the originally filed application, which corresponds to originally filed Claim 1, that the viscosity of the paints according to the invention, ie containing a structuring agent selected from natural and synthetic clays or titanium chelates, and being intended

to produce a relatively smooth, non-textured surface, is in the range 1.5-13 poise 4 weeks from manufacture and that the viscosity **remains** in this range 24 weeks from manufacture, is a clear and sufficient indication for the skilled person that the said viscosity values correspond to a viscosity which is stable during the thus defined period, ie starting 4 weeks after manufacture and ending 24 weeks after manufacture. This does not preclude a narrower definition of this invention as provided by the teachings of the original dependent claim 4 and the passages on page 4, lines 8-10 and 26-27, according to which **preferred** paints have a stable viscosity in the above sense in the range 2-10 poise or even a more preferred one in the range 2-9 poise.

Since a change in viscosity between the fourth and the twenty-fourth week is nowhere mentioned or suggested in the originally filed application, a skilled person would, in the Board's view, derive from the originally filed application as a whole that the most preferred paints according to the invention have a still stable viscosity of 2-9 poise 24 weeks after manufacture, in the above sense, ie a viscosity corresponding to that observed 4 weeks after manufacture, independently of whether the structuring agent selected is a titanium chelate or a natural or synthetic clay.

- 2.2.4 It is true, as submitted by the Respondents, that Example 2 of the application as filed is concerned with a method of preparing paints containing one particular titanium chelate as structuring agent. Nonetheless, since **only** a viscosity **range** and **no specific** viscosity **data** are mentioned and since it is not specified in that example which fungicide, anionic or nonionic surfactant, antifoam agent or acrylic copolymer are used in the paint formulation, this example cannot be construed so

narrowly that it describes merely a method of preparing one specific paint.

This example thus supports the general disclosure as set out in point 2.2.3 above.

Moreover, in the paragraph bridging pages 6 and 7 of the application as filed titanium chelates as well as natural and synthetic clays are described as equally suitable structuring agents for carrying out the invention, and nowhere is any distinction concerning viscosity between paints containing a titanium chelate or a clay as structuring agent suggested. Therefore, the Board sees no reason why the above considerations should not apply to natural and synthetic clays.

2.2.5 For the above reasons, the Board finds that a skilled person would objectively derive from the originally filed application that the invention was concerned with paints characterised by a viscosity of 2-9 poise 4 weeks from manufacture, whether they contain a titanium chelate or a natural or synthetic clay as structuring agent.

2.2.6 Since neither the Respondents nor the Board could make out any other amendment in the claims which would add subject-matter extending beyond the content of the application as filed, the Board concludes that the amendments in the present claims do not contravene Article 123(2) EPC.

2.2.7 As the Board has come to the conclusion that Example 2 of the application as filed does not describe a specific composition and is also not essential for deciding whether the contested amendments infringe Article 123(2) EPC, the point of law requested by Respondent (02) to be referred to the Enlarged Board of Appeal according to

Article 112(1) EPC (see point VI. above) does not arise in these terms and is therefore not relevant for the present decision. Consequently, there exists no valid reason for referring the said question to the Enlarged Board of Appeal.

3. *Priority*

3.1 A product embraced by the scope of the present claims and corresponding to that subsequently presented in document (10) was officially launched in January 1984, a fact never contested by the Appellant. Since the launch took place between the second and the third priority date, the question arises - for the purpose of determining whether the launch resulted in a prior use to be considered as state of the art according to Article 54(2) EPC - whether the present claims are entitled to the first and second priority dates.

3.2 Since it was stated neither in the first nor in the second priority document that the solid paints according to the invention were **intended to produce a coating having a relatively smooth non-textured surface** and since paints having a viscosity in the range **2 to 9 poise 4 weeks from manufacture** were not explicitly described therein, contrary to the further requirement that the viscosity remains in the said range 24 weeks from manufacture, the Respondents submitted that the claimed subject-matter could not be entitled to the priority dates of 2 November 1983 and 10 November 1983.

3.3 According to Article 87(1) EPC, a right of priority may only be enjoyed for the same invention. Therefore, in deciding whether the present set of claims is entitled to the priority of any of those documents, it needs to be decided whether in any of those priority documents the **same invention** is described as in the set of claims.

The main criterion in this respect is whether all essential features of the claimed invention are expressly disclosed in each priority document or directly and unambiguously implied by their text.

- 3.4 It has never been disputed by the Appellant that the first and the second priority documents do not *expressis verbis* mention the specific requirement that the paint must have a viscosity in the range 2 to 9 poise 4 weeks from manufacture.

Since there is no support for considering that this feature is not an essential feature of the invention, the question arises whether this feature was directly and unambiguously implied by the texts of both priority documents.

Both priority documents teach that the paint is a "solid" paint since it will retain its shape for a significant period of time when removed from the container after a period of **at least 4 weeks** (see page 1, lines 21-27, of both documents). Additionally, in both priority documents it is stated that the paints according to the invention have a viscosity in the range 2-9 poise 24 weeks after manufacture and, even more generally, that the viscosity of the paint is to lie in the range of 2-9 poise (see page 2, lines 10-11, and page 6, lines 6-7, of GB 8 329 299 and page 2, lines 12-13, and page 6, lines 6-7, of GB 8 329 955).

From this information a skilled person would infer that the paint should be ready for use 4 weeks from manufacture and, consequently, that, at that moment, the paint should also have the right viscosity for use, ie one within the range of 2-9 poise.

Consequently, the Board finds that it was directly and unambiguously implied by both priority documents that the paint according to the invention had a viscosity in the range 2 to 9 poise 4 weeks from manufacture.

- 3.5 There is furthermore in neither of these two priority documents an *expressis verbis* disclosure that the aqueous solid paint is intended to produce a coating having a relatively smooth non-textured surface.

The Appellant has removed from the claims all viscosities outside the preferred range indicated in example 2 (2 to 9 poise). The remaining range is identical to the viscosity range as disclosed in priority documents 1 and 2 (above, point 3.4). In respect of the upper part of the deleted range from 9 to 50 poise, paints having a viscosity of more than 13 poise were indicated in the claims as filed and granted only in the alternative for paints intended to produce a textured surface, whereas paints having a viscosity up to 13 poise were indicated for both types of paints, ie for those intended to produce a coating having a relatively smooth, non-textured surface as well as for those intended to produce a coating having a textured, patterned, relief surface. It appears from this that the viscosity range deleted on the basis of the disclosure in priority documents 1 and 2 is the range particularly adapted for paints intended to produce textured surfaces.

Priority documents 1 and 2 do not mention anywhere the type of surface to be obtained nor do they disclose any ingredients particularly adapted to obtain textured surfaces. Since paints intended to obtain a textured surface are a specific type of paint and require specific ingredients, the reader of the priority documents would have expected information to this effect

in the specification, if the disclosed paints were only adapted for such restricted purpose. Without any hint in this direction, the question may be left unanswered whether he would have thought of paints for textured surfaces; in any case he had reason to assume that the paints described in both priority documents were at least intended to produce coatings having a non-textured surface. Therefore, the Board is satisfied that priority documents 1 and 2 disclose implicitly that the invention relates to paints intended to produce a relatively smooth, non-textured surface. Consequently, the invention as now claimed is the same as that described in the priority documents and the failure to mention this feature in the first and second priority documents does not deprive the present claims of their entitlement to the respective priority dates.

3.6 In the absence of other objections concerning the priority right, the Board concludes that the present claims are entitled to the first and the second priority dates.

3.7 It follows from the foregoing that the launch in January 1984 of a product falling within the scope of the present claims and the prior use thereof are not to be considered as state of the art within the meaning of Article 54(2) EPC.

4. *Novelty*

During the written stage of the appeal proceedings, Respondent (03) contested the novelty of the present claims on the basis of a prior use mentioned in the first four paragraphs of page 20 of document (10), in particular the market research carried out in the period 1981-May 1982.

According to the Appellant, this market research could not have resulted in the present invention being made available to the public, as required by Article 54(2) EPC, since it was conducted confidentially and since the paint used contained a structuring agent other than that used in the paints embraced by the scope of the present set of claims.

The Respondents neither contested in detail the Appellant's submission nor did they provide any kind of evidence to the contrary. In such circumstances, the Board has to accept the Appellant's statements as correct.

Consequently, the Board concludes that the novelty of the present claims cannot be challenged on the basis of the market research mentioned in document (10).

Since novelty was not further contested by the Respondents, and the Board itself considers that none of the cited documents describes all the features of the claimed invention, the present claims are considered to be novel.

5. *Inventive step*

Common general knowledge

In assessing the common general knowledge at the priority date, the Parties have come to opposing conclusions in respect of the application of thixotropic paints by paint rollers. Since the documents on which the Respondents rely have to be interpreted on the basis of the common general knowledge, this divergence of opinion will be dealt with first.

5.1 The Appellant submitted that, on the priority date of the patent in suit, it was common general knowledge in the field of roller-painting that thixotropic non-drip paints should generally not be used with rollers or, if they were used, that they should be stirred to make them fully liquid. At that time paint rollers presented a mess problem, especially for inexperienced amateurs, although other more static painting tools such as brushes or pads could also create mess. However, unlike the latter, rollers had to be rotated when used during painting. Accordingly, the paint hit the surface to be painted with much more force than was the case with a brush or pad, and as a result a fine spray of rebounding paint was hard to avoid. In support of this submission, the Appellant referred to two textbooks published before the priority date of the patent in suit, both recommending that if a thixotropic (non-drip) paint is used with a roller, the paint should be stirred to make it fully liquid, namely

(A) "Handbook of Painting and Decorating Products" by Albert Beckly, published by Granada of London in 1983, page 32, and

(B) "All Colour Guide to Home Decorating", edited by Jane Rimmell and published by Galley of London in 1978, page 38.

Additionally, he referred to a textbook published in 1986, ie well after the priority date of the patent in suit, advising against the use of a non-drip paint if a roller was to be used, namely

(C) "The Complete Interior Decorator" by Mike Lawrence, published by Macdonald of London in 1986, page 83.

5.1.1 The Board finds that **textbooks** can indeed be regarded as an appropriate means for showing what is common general knowledge in a technical field. This is in accordance with the established jurisprudence of the Boards of Appeal (see decision T 171/84, OJ EPO 1986, 95, reasons 5, and decision T 112/92, OJ EPO 1994, 192, reasons 3.4). Information has not usually become common general knowledge because it was published in a particular handbook or textbook, but rather it appears in handbooks or textbooks because it was already common general knowledge. Thus, such a publication is evidence both that the information is known and that it is common general knowledge.

Since no evidence to the contrary was provided by the Respondents, the Board accepts that it was the wholly consistent common general knowledge at the priority date of the patent in suit that thixotropic paints should be liquefied before being applied with a roller and, consequently, that the teachings of the cited prior art documents are to be interpreted hereafter in the light of this common general knowledge.

This common general knowledge corresponds to that relied on by the Appellant during the examination procedure and, although at the opposition and appeal stage this common general knowledge was explicitly referred to by the Appellant, it was only during the oral proceedings in the appeal procedure that it was strongly contested by the Respondents. They argued that it was well-known before the priority date of the patent in suit that solid paints could be applied by a roller, as was evidenced, for example, by the teaching in document (2), page 2, lines 104-109 (published in 1963), that the paints described in that document could be easily applied with a roller.

First of all, a distinction has to be made between the technical information to be found in textbooks and that contained in patent documents. Whereas the former do indeed qualify for documenting the common general knowledge, the latter normally do not (see T 206/83, OJ EPO 1987, 5, reasons 5 and 6). Consequently, patent documents cannot normally have the same technical authority as a textbook in proving common general knowledge.

Apart from that, the above-mentioned passage in document (2) merely states that the paints described in that document may be applied with a roller, without specifying, however, whether the paints were to be liquefied or not before being applied. In this document the Board only finds one further indication of the nature of the thixotropy of the paint, namely in example 9, where it is said that "the resulting liquid after 1 hour became a soft thixotropic gel which could be easily broken down by stirring to form a viscous liquid which upon standing at room temperature regelled in less than an hour", which passage certainly does not exclude liquefying the paint before applying it with a roller. The information provided in document (2) is thus not at variance with that found in the said textbooks.

Consequently, the Board finds that document (2) is disqualified as an illustration, at the priority date of the patent in suit, that contrary to the information found in textbooks it was known in the art that thixotropic paints could well be applied by a roller without being previously liquefied.

- 5.1.2 The Respondents also pointed out that a lengthy period had elapsed between the "real" common general knowledge and its appearance in textbooks and, consequently, that the passages referred to in the textbooks are not

representative of the common general knowledge at the claimed priority date.

It is clear from point 5.1.1 above that document (2) does not contain any technical information which would conflict with that contained in the said textbooks. If such evidence were to exist, it had in any case not been produced thus far despite the fact that, as already pointed out, the Appellant repeatedly argued in the course of the different proceedings before the EPO that it was common general knowledge that, for the purpose of applying thixotropic (non-drip) paints with a roller, the paint had first to be liquefied, and the Respondents, therefore, necessarily had to be aware that this was an important argument in the present case. Without such evidence available to it the Board has no reason to consider that the submissions did not reflect the common general knowledge at the priority date of the patent in suit, because in the case of any dispute as to the extent of the relevant common general knowledge, this, like any other fact under contention, has to be proved, eg by documentary evidence (see T 939/92, OJ EPO 1996, 309, reasons 2.3).

5.2 The technical problem and its solution

The Appellant held that document (8) was the closest state of the art, whereas Respondents (01) and (03) held documents (9) and (2) respectively to be the closest state of the art.

The Board considers that the closest state of the art is to be selected from the available prior documents disclosing subject-matter concerning the same purpose as the claimed invention. Since documents (8) and (9) are the only cited prior art documents concerning the problem of mess caused prior to and during the actual

application of coating compositions, the Board can accept that both documents qualify as representing the most relevant prior art.

However, since the two documents have the same disclosure value and since document (9) concerns a further development of the paints described in document (8), modified so as to avoid the need for a heating step, the former will be used as the starting point for the assessment of inventive step.

This was not objected to by the Respondents.

- 5.3 Document (9) proposes as a solution to the mess problem solid coating compositions characterised by the fact that there is little or no recovery of a substantial gel structure once this structure is destroyed by the application of shearing forces (column 1, lines 32-37, column 2, lines 6-33, column 8, lines 16-28, and column 9, lines 43-50). Although this document teaches that such coating compositions may be applied by any conventional coating applicator (column 8, line 46, and column 9, line 37), it follows from a more detailed study of the document that only a pad applicator is explicitly mentioned as a suitable conventional coating applicator (column 8, line 52, column 9, line 40, and column 10, line 18). This document therefore clearly concentrates on the use of a pad applicator.

The Appellant repeatedly submitted that the paints known from document (9) have the disadvantages that they are only suitable for application with a pad applicator, since their structure is irreversibly destroyed by shearing forces, which results in an unacceptable spattering when applied with a roller applicator, rendering those paints unsuitable for application with a

roller applicator by non-professional painters. This was not contested by any of the Respondents.

5.4 Thus, starting from document (9), the problem to be solved can be seen in providing a further paint means causing such a reduced level of spattering that it is suitable for being applied with a roller applicator by non-professional painters. This was not contested by any of the Respondents either.

5.5 According to the patent in suit it is proposed that this problem be solved by the lidded containers with the paint as claimed (see point III. above).

In view of the information contained in the patent in suit and the experimental evidence provided with the Appellant's letter of 3 June 1995, it has been satisfactorily shown that the problem is indeed solved. This was not contested by any of the Respondents.

5.6 It therefore has to be examined whether this solution to the stated technical problem was suggested by the cited state of the art.

According to the Respondents, such suggestion was to be found in the combined teaching of document (9) and document (6) or (2).

5.6.1 Document (9) is concerned with conventional water-based coating compositions containing, in addition to their conventional components, an electrolyte and a colloidal gelling agent, gellable by interaction with said electrolyte, resulting in the effect that there is little or no recovery of a substantial gel structure once the gel structure is destroyed by the application of shearing forces (see column 1, lines 32-38, column 2, lines 6-33, and column 8, lines 16-28).

Consequently, the question arises whether there was any suggestion in document (2) or in document (6) that paints containing a titanium chelate or a natural or synthetic clay as structuring agent, and having specific rheological properties, would show such a reduced level of spattering when applied with a roller applicator by non-professional painters.

- 5.6.2 Document (2) concerns the use of water-soluble titanium chelates in thixotropic emulsion paints (page 1, lines 74-76, and page 2, lines 7-16). Furthermore, it is taught that thixotropic paints and, in particular, the paints containing titanium chelates may be applied by a roller applicator (page 1, lines 25-31, and page 2, lines 104-109).

Document (6) concerns general information about the recommended use of titanium chelates as structuring agents in paints and, under the heading "What are structured paints?", in the left-hand column of page 2, it is taught that structured paints break down under the kind of shear exerted during roller application and that they are less liable to spatter during roller application.

- 5.6.3 In view of these disclosures, the Respondents argued that there was at least a hint in the state of the art that the coating compositions according to the present claims could be applied with a roller applicator and that such paints would have reduced spattering.

However, since both documents are completely silent about any detail concerning the practical aspects of trying to use the disclosed paints with a specific applicator, namely whether or not paints containing titanium chelates as structuring agent have to be liquefied before being applied with a roller applicator,

the Board considers that the teaching of this document is to be interpreted in the light of the common general knowledge, as discussed in point 5.1.1 above, with the consequence that a skilled person would not have understood the reference to the roller application in this document as meaning that the paint could be applied with a roller applicator without being previously liquefied.

- 5.6.4 Therefore, the Board finds that the claimed lidded paint containers are not obviously derivable from document (9) in combination with either of documents (2) or (6).

This is also true when natural or synthetic clays are used as an alternative for the titanium chelate, since no relevant prior art was submitted by the Respondents in connection with this claimed alternative.

- 5.7 Although the Board has come to the conclusion that document (2) could not be considered to be the closest state of the art (see point 5.2 above), it is to be noted that the different approach followed by the Opposition Division as well as the Respondents, namely in considering that the claimed lidded paint containers would not be inventive since the paint used in the patent in suit is known from document (2) and a tray adapted to receive a roller applicator is known from document (1), cannot actually lead to a different result, except with the benefit of hindsight.

- 5.7.1 Document (1) is essentially concerned with the problem according to which, with conventional roller applicators, it is necessary to pour the paint (not comparable with that of the patent in suit) from a can into a tray (column 1, lines 9-11 and 14-17), and proposes to solve this problem by means of a specially designed paint container which includes, as an integral

part, a regulator (column 1, lines 67-71). Since regulators were generally used for regulating liquefied paints on a roller, it clearly follows that the tray proposed therein was specifically developed for paints which were liquid when applied and, consequently, that a skilled person would not have been led to consider such trays as containers for solid paints which are applicable by means of a roller without previously being liquefied. This is irrespective of whether the regulator is an integral part of the paint container or removably attached thereto, since from the teaching in column 3, lines 12-18, it clearly follows that the regulator is used to distribute the paint uniformly on the roller and said paint must, consequently, be liquid.

Thus, a skilled person would not have any incentive to consider document (1).

5.7.2 As already stated in point 5.5.3 above, the only concrete information provided in document (2) is that the thixotropic paints are suitable for use with rollers, whereby the skilled person would have known, as already pointed out above, that the thixotropic paints must be liquefied before being applied by a roller applicator. This could explain the teaching in example 9, in which it is pointed out that the thixotropic gel could be broken down by stirring and thereby form a viscous liquid (page 4, lines 19-24).

Thus, in the Board's view, solid non-drip paints applied with a roller, which are not liquefied before application, are also not suggested in document (2).

5.8 The Board therefore concludes that the lidded paint containers according to Claims 1 and 2 are not obviously derivable from any of the cited prior art documents.

Claims 3 to 10, which depend on Claims 1 and 2 and represent preferred embodiments thereof, are, consequently, also not obvious in the light of the cited state of the art.

For the same reasons, Claims 11-15, relating to a method for providing a coating of paint according to Claims 1 and 2, and Claims 16-18, relating to a method of providing a paint according to Claims 1 and 2 in a lidded container, are not obviously derivable from the cited state of the art either.

Conclusion

6. In view of the above, the grounds for revoking the patent in suit do not prejudice the maintenance of the patent on the basis of the set of claims filed during oral proceedings held on 11 and 12 June 1996.

Order

For these reasons it is decided that:

1. The decision under appeal is set aside.
2. The case is remitted to the first instance with the order to maintain the patent with the set of claims (Claims 1 to 18) submitted during the oral proceedings **and a description to be adapted thereto.**

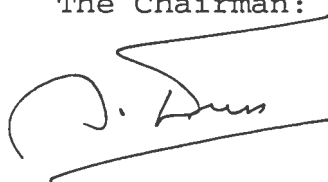
3. The request for referral of a point of law to the Enlarged Board of Appeal is refused.

The Registrar:



E. Gorgmaier

The Chairman:



A. Nuss