

Internal distribution code:

- (A) [] Publication in OJ
(B) [] To Chairmen and Members
(C) [X] To Chairmen

D E C I S I O N
of 28 January 1997

Case Number: T 0823/96 - 3.3.1

Application Number: 91109165.0

Publication Number: 0461537

IPC: C09D 5/32

Language of the proceedings: EN

Title of invention:

Coatings for the protection of products in light-transmitting containers

Applicant:

PPG INDUSTRIES, INC.

Opponent:

-

Headword:

Coating/PPG

Relevant legal provisions:

EPC Art. 123(2)

Keyword:

"Amendment by deletion of an essential feature - not allowed"

Decisions cited:

-

Catchword:

-

Case Number: T 0823/96 - 3.3.1

D E C I S I O N
of the Technical Board of Appeal 3.3.1
of 28 January 1997

Appellant: PPG INDUSTRIES, INC.
One PPG Place
Pittsburgh
Pennsylvania 15272 (US)

Representative: Sternagel, Hans-Günther, Dr.
Patentanwälte Dr. Michael Hann, Dr. H.-G.
Sternagel, Dr. H. Dörries
Sander Aue 30
51465 Bergisch Gladbach (DE)

Decision under appeal: Decision of the Examining Division of the
European Patent Office posted 15 March 1996
refusing European patent application
No. 91 109 165.0 pursuant to Article 97(1) EPC.

Composition of the Board:

Chairman: A. J. Nuss
Members: R. K. Spangenberg
R. E. Teschemacher

Summary of Facts and Submissions

I. The present appeal was filed on 21 May 1996. It lies from the decision of the Examining Division of 15 March 1996 refusing European patent application No. 91 109 165.0, filed on 5 June 1991 and published under No. 0 461 537. The patent application as filed comprised a set of 15 claims, Claims 1 and 10 reading as follows:

"1. A water-based thermosetting coating composition comprising: (i) a film-former; (ii) a metal-free colorant which is reactive with the film-former; (iii) an ultraviolet light absorber; and (iv) an adhesion promoter in an effective combination to form a transparent thermoset coating which substantially blocks transmission of product damaging light.

10. A process for reducing the degradation of the contents of a light-transmitting container due to the effect of visible and/or ultraviolet light; said process comprising coating the container with a thermosetting water-based coating composition comprising an effective combination of a film-former, a metal-free colorant which is reactive with a film-former and an ultraviolet light absorber in an effective combination to form a coating which substantially blocks transmission of product damaging light."

II. The decision under appeal was based on an amended set of 15 claims. Claims 1 and 11 of this set were filed

with the letter of 15 January 1996 and read as follows:

"1. A water-based thermosetting transparent colorant coating composition comprising (i) a film-former including a thermosettable material and an internal or external crosslinking agent; (ii) a metal-free polymer colorant which is reactive with the film-former; (iii) an ultraviolet light absorber in an amount ranging from between 0 and 5.0 percent by weight, based on resin solids; and (iv) an adhesion promoter in an effective combination to form a transparent thermoset coating for coloring containers.

11. A process for reducing the degradation of the contents of a light transmitting container due to the effect of visible light; said process comprising coating the container with a water-based thermosetting transparent colorant coating composition comprising (i) a film-former including a thermosettable material and an internal or external crosslinking agent; (ii) a metal-free polymer colorant which is reactive with the film-former; (iii) an ultraviolet light absorber in an amount ranging from between 0 and 5.0 percent by weight, based on resin solids; and (iv) an adhesion promoter in an effective combination to form a transparent thermoset coating for coloring containers."

The sole ground of refusal was that the above Claims 1 and 11 contravened Article 123(2) EPC.

The Examining Division held that in the application as filed the presence of component (iii), i.e. the ultraviolet light absorber, was mandatory, whereas in

the above claims it was only optional, with the effect that these claims related to subject-matter not clearly and unambiguously derivable from the application as filed.

III. In his statement of grounds of appeal and during the oral proceedings, which took place on 28 January 1997, the Appellant (the Applicant) submitted that the decision under appeal was based upon an underestimation of the knowledge of the person skilled in the art. He argued that in all cases where the description as filed mentioned a composition which included an ultraviolet (UV) light absorber as a mandatory constituent, it was expressly stated that the invention was not limited to such a composition. Rather, the composition comprising component (iii) was presented as a preferred embodiment of the disclosed invention. This interpretation was further confirmed by the fact that, in contrast to the detailed description of suitable components (i) and (ii), which each covered about one page of the description, only eight lines were contained in the section headed "detailed description of the invention" which concerned component (iii). In addition, he submitted that it was expressly stated in the description as filed that the composition of the invention is intended to reduce "the degradation of the contents of a light-transmitting container due to the effect of visible and/or ultraviolet light", and that the language used taught the person skilled in the art that the said degradation can be caused by visible light alone. Therefore, so he argued, the compositions now claimed were implicitly disclosed in the patent application as filed, since the person skilled in the

art would have concluded that, if it was only visible light which was the harmful electromagnetic radiation in a particular case, then in such a case the UV absorber did not have a function and could be omitted, and hence, the amendment of the claims constituted no more than an obvious clarification.

- IV. The Appellant requested as his main request that the decision under appeal be set aside and a patent be granted on the basis of the set of claims refused by the Examining Division, i.e Claims 1 and 11 filed with his letter of 15 January 1996 and Claims 3 to 10 and 13 to 17 filed with his letter dated 2 June 1993 (received 4 June 1993). By way of auxiliary request the Appellant requested that the decision under appeal be set aside and the case be referred to the Examining Division for further prosecution on the basis of the set of claims as originally filed.
- V. At the end of the oral proceedings the Board announced its decision to allow the auxiliary request and to remit the case to the Examining Division for further prosecution on the basis of the set of claims as originally filed.

Reasons for the Decision

1. The appeal is admissible.
2. Since the application in suit was refused on the sole ground of non-compliance of the claims according to the

present main request with the requirement of Article 123(2) EPC (see point II above), and since the auxiliary request relates to the unamended claims as filed, to which no objection under Article 123(2) is possible, the issue that remains to be decided in these appeal proceedings is whether or not Claims 1 and 11 according to the main request are properly based on the specification as filed, as required by Article 123(2) EPC.

3. According to the decision under appeal and the statement of grounds of appeal, the only item in dispute in respect of the main request is whether a skilled person, reading the specification as filed, would derive therefrom a clear and unambiguous technical information that the compositions disclosed in the application as filed include compositions containing zero percent of the UV absorber, so that the latter is only an optional and not a mandatory constituent of the disclosed coating composition.
 - 3.1. The Appellant did not dispute that the original claims and the examples contained in the application as filed relate to compositions including a UV absorber as a mandatory constituent. However, he submitted that in the description as filed compositions comprising a UV absorber were consistently presented as embodiments of the invention, but not as the invention itself.
 - 3.2. In support of his submission, he specifically referred to page 1, line 33 to page 2, line 3 of the description as filed, where it was stated that the invention only "encompassed" a composition which included an

ultraviolet (UV) light absorber. Similarly, on page 2, lines 15 to 22, a composition including a particular UV absorber as a mandatory constituent was only disclosed as a preferred embodiment of the invention.

3.3. The Appellant further specifically referred to the disclosure in the description as filed, page 5, lines 4 to 14. This sentence reads: "In the practice of the invention, the coating composition can be employed in a process for reducing the degradation of the contents of a light-transmitting container due to the effect of visible and/or ultraviolet light; said process comprising coating the container with a thermosetting water-based coating composition comprising an effective combination of a film-former; a non-metallic, reactive colorant, an ultraviolet absorber and an adhesion promoter in an amount sufficient to form a transparent thermoset coating which substantially blocks transmission of product damaging light, particularly in the range of about 525 to 300 nm."

In the Appellant's opinion this sentence implicitly disclosed a composition not containing a UV absorber, since a skilled person would have recognised that for a process for reducing the degradation of the contents of a light-transmitting container due to the effect of visible light explicitly addressed in that sentence as one of three possible uses of the claimed compositions, it would not have been necessary for the composition to contain a UV absorber.

4. In the Board's judgment, the question whether or not a composition containing zero percent of a UV absorber is disclosed in the application as originally filed must

take account of the whole content thereof and cannot solely be based on the isolated parts of the description relied upon by the Appellant. The Board has thus considered whether these parts, when read in their proper context with the rest of the description, clearly and unambiguously disclose a composition not containing a UV absorber. As a result, the Board has reached the conclusion that all the information derivable from the description is fully consistent with the mandatory presence of a UV absorber in the compositions disclosed therein.

- 4.1. Thus, whilst it is true that, according to the first statement relied upon by the Appellant (see point 3.2 above), the invention described in the patent application as filed only "**encompasses**" a water-based thermosetting coating composition comprising a combination of a film former; a reactive metal-free colorant; an adhesion promoter, and an ultraviolet (UV) light absorber in an amount which is effective in forming a transparent thermoset coating which substantially blocks the transmission of product damaging light, the Board does not agree that this statement should be construed as implying compositions in which the UV absorber is missing.

On the contrary, in the Board's judgment this sentence merely confirms that the invention does not only comprise the above-mentioned composition but also a process for reducing the degradation of the contents of a light transmitting container and to an article of matter (see Claims 1, 10 and 12 as filed). This sentence is further consistent with the fact that, as

the description later on makes clear, the claimed compositions may contain **further** components, e.g. silane coupling agents (see page 4, lines 32 to 35 of the description as filed).

4.2. The Board further agrees with the Appellant's statement that the second sentence mentioned by the Appellant (see point 3.2. above) relates to a preferred embodiment of the claimed composition, which comprises as the film-former a hydroxy-functional acrylic resin in combination with a crosslinkable melamine resin, as the reactive metal-free colorant a macromolecular chromophore-modified polymeric dye, as the UV absorber 2,2'4,4'-tetra hydroxybenzophenone and as the adhesion promoter gamma-glycidoxypropyl-trimethoxysilane. The Board observes, however, that this preferred coating composition **does** contain a UV absorber, in accordance with the general statement discussed in the preceding paragraph. Therefore neither from this part of the description alone nor from the combination of the technical information contained in it with the information contained in the sentence considered in point 4.1 above does it follow that there is any clear and unambiguous disclosure of a composition **not** containing a UV absorber.

4.3. Similarly, the Board is unable to infer from the fact that the detailed description of suitable UV absorbers does not require more than 8 lines of the description (see page 4, lines 22 to 29), that the UV absorber is an inessential component of the described compositions. Rather, such an inference would be contrary to the express statement therein that the UV absorber is

"typically" present in an amount of 0.5 % to 5 % and preferably about 1.5 to 4 % by weight based on resin solids.

4.4. The sentence referred to in paragraph 3.3 above relates to the **use** of a composition which comprises a UV absorber, as it is clearly and unambiguously stated in the second part of this sentence. During the oral proceedings, the Appellant admitted that the compositions containing the UV absorber would be suitable for reducing the degradation of the contents of a light-transmitting container due to the effect of visible light. Thus, the Board holds that this sentence is fully consistent with the rest of the description as filed, in that it describes a composition which is suitable for protecting the contents of a light transmitting container against damages caused by **all sorts** of "harmful light", which is light with the wavelength of electromagnetic radiation in the visible **and ultraviolet** regions which can cause undesirable flavour and/or odour changes in the contents of transparent containers (see page 2, lines 10 to 14 of the description as filed).

4.5. By contrast, the interpretation which the Appellant is seeking to give the parts of the description as filed referred to in paragraphs 3.2 and 3.3 above would relate to a **quite different concept**, namely that of compositions specifically adapted to the sort of damaging light concerned. Such a concept, however, is neither explicitly nor implicitly disclosed in the description as filed.

In this respect, the Board observes that the term "implicit disclosure" should **not** be construed to mean matter that does not belong to the **content** of the technical information provided by a document but may be rendered **obvious** on the basis of that content. In the Board's judgment, the term "implicit disclosure" relates solely to matter which is not explicitly mentioned, but is a clear and unambiguous consequence of what is explicitly mentioned. Therefore, whilst common general knowledge must be taken into account in deciding what is clearly and unambiguously implied by the explicit disclosure of a document, the question of what may be rendered obvious by that disclosure in the light of common general knowledge is not relevant to the assessment of what is implied by the disclosure of that document. On the contrary, these two questions must be strictly separated. The Board therefore does not agree with the Appellant's submission that the decision under appeal was based on an underestimation of the common general knowledge.

5. For these reasons, the main request must fail.

6. As already stated (see point 2 above), the auxiliary request is not open to objection under Article 123(2) EPC. The examination of the application in suit can thus be resumed on the basis of these claims. Since the Examining Division has not yet formed a final opinion on the remaining requirements of the EPC, including the substantive issues of patentability, the application in suit is, however, not yet ready for a decision to grant a patent. The Board thus makes use of its power under Article 111(1) EPC and remits the case to the Examining

Division for further prosecution on the basis of the claims as originally filed. The Board is well aware of the fact that against this set of claims the Examining Division had already raised other objections than that dealt with in the present decision. It is thus appropriate to observe that remittal on the above basis does **not** imply that these other objections cannot be raised again (see point 2 above in combination with Article 111(2) EPC).

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 for further prosecution on the basis of the set of claims as originally filed.

The Registrar: The Chairman

E. Görgmaier A. Nuss