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**D E C I S I O N**  
**of 20 April 2004**

**Case Number:** T 0491/00 - 3.3.1

**Application Number:** 96905417.0

**Publication Number:** 0822971

**IPC:** C10M 173/00

**Language of the proceedings:** EN

**Title of invention:**

Aqueous lecithin-based release aids and methods of using the same

**Applicant:**

BUCKMAN LABORATORIES INTERNATIONAL, INC.

**Opponent:**

-

**Headword:**

Lecithin emulsion/BUCKMAN LABORATORIES

**Relevant legal provisions:**

EPC Art. 111, 84, 123(2)

**Keyword:**

"Substantially amended request - remittal to the first instance for further prosecution"

**Decisions cited:**

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**Catchword:**

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Case Number: T 0491/00 - 3.3.1

**D E C I S I O N**  
of the Technical Board of Appeal 3.3.1  
of 20 April 2004

**Appellant:** BUCKMAN LABORATORIES INTERNATIONAL, INC.  
1256 North McLean Boulevard  
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Memphis  
Tennessee 38108-0305 (US)

**Representative:** Matthews, Derek Peter  
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**Decision under appeal:** Decision of the Examining Division of the  
European Patent Office posted 15 November 1999  
refusing European application No. 96905417.0  
pursuant to Article 97(1) EPC.

**Composition of the Board:**

**Chairman:** A. J. Nuss  
**Members:** P. F. Ranguis  
S. C. Perryman

## Summary of Facts and Submissions

I. The present appeal lies from the Examining Division's decision to reject the European patent application No. 96 927 644.3 (Publication No. 0 822 971) on the ground that the then pending main and auxiliary requests did not involve an inventive step in view of documents

(1) US-A- 4 073 411

(2) US-A- 1 934 005

(3) US-A- 5 342 872

II. Claim 1 of the main request read as follows:

"1. A water-based release aid composition comprising:

a) an alcohol;

b) a fatty acid or an oil;

c) lecithin;

d) a water soluble or water dispersible surfactant;

e) water; and

f) a thickener".

Claim 1 of the auxiliary request read as follows:

" 1. A water-based release aid composition comprising:

a) an alcohol;

b) a fatty acid or an oil;

c) lecithin;

d) a water soluble or water dispersible surfactant;

e) water;

f) a thickener; and

- g) an anticaking or antigelling agent".
- III. In its decision, the Examining Division held that the subject-matter of Claim 1 of the main request differed from the water-in-oil lecithin emulsion disclosed in document (1) in that no thickener was mentioned. However, the addition of a thickener was obvious in view of document (3) which disclosed aqueous coating compositions comprising lecithin, alcohol and thickeners such as xanthan gum. Nor could an inventive step recognised as regards to the subject-matter of Claim 1 of the auxiliary request in absence of any unexpected effect related to the presence of anticaking or antigelling agent.
- IV. With the statement of grounds of appeal, the Appellant filed a fresh set of twenty six claims as sole request:
- Claim 1 read as follows:
- "1. A water-based release aid composition comprising:
- a) an alcohol;
  - b) a fatty acid or an oil;
  - c) lecithin in an amount of from 5% to 30% by weight relative to the total weight of the composition;
  - d) a water soluble or water dispersible surfactant;
  - e) water;
  - f) a thickener; and
  - g) an anticaking or antigelling agent".
- V. In a communication, the Board expressed the preliminary opinion that the present claimed subject-matter might be objected *inter alia* under Article 54 and Article 56.

VI. In response, the Appellant filed as sole request a set of twenty two claims. Claim 1 read as follows:

"1. A water-based release aid emulsion composition comprising:  
a)an alcohol;  
b)a fatty acid;  
c)lecithin;  
d)a water soluble or water dispersible surfactant; and  
e) water".

VII. The Appellant requested that, in view of the amendments, the procedure be continued in writing.

### **Reasons for the Decision**

1. The appeal is admissible.

2. *Articles 123(2) and 84 EPC*

2.1 The subject-matter of Claim 1 (cf. point VI above) is now restricted to a water-based release aid emulsion composition comprising necessarily a fatty acid. Furthermore, the feature related to the presence of a thickener was deleted. That subject-matter is in line with the original disclosure (cf. Claim 1 as originally filed).

2.2 The limitation of the composition to an "emulsion" is supported by Claim 45 as originally filed. Furthermore, the limitation of the emulsion composition to that comprising a fatty acid is supported by the application as filed which points out that a fatty acid or an oil

alone, or a mixture thereof, or any combination thereof may be used in accordance with the present invention (cf. page 6, lines 13 to 15). Those amendments, therefore, do not contravene the requirements of Article 123(2) EPC.

2.3 Claim 1 is also clear in accordance with Article 84 EPC.

3. *Article 111 EPC - Remittal*

3.1 The Appellant argued that the present claimed subject-matter is directed to a different technical feature since it did not rely on the presence of thickeners and, furthermore, is distinguished from document (1) by limiting the emulsion compositions to those based on fatty acids.

3.2 The Board concurs with the Appellant that the amendments to Claim 1 are substantial and result in a claimed subject-matter never examined by the Examining Division. The Board, furthermore, observes that the grounds of rejection were based on the obviousness of the incorporation of a thickener (now deleted) in a composition comprising an oil, the necessary presence of a fatty acid playing no role in the decision of the Examining Division.

3.3 The Board, therefore, is faced with a complete fresh case never examined before. However, the function of the Boards of Appeal is primarily to give a judicial decision upon the correctness of the earlier decision taken by the first instance, which is not the case here given the substantial change in the claimed subject-matter. Furthermore, although the EPC does not

guarantee the parties an absolute right to have all the issues considered by two instances, it is well-recognised that the Board may exercise its discretion under Article 111 EPC to remit the case to the first instance in order not to deprive the Appellant of the possibility of being heard by two instances.

- 3.4 Therefore, in view of the substantial amendments which require substantial further examination the Board finds it appropriate to exercise its power under Article 111(1) EPC and to remit the case to the first instance for further prosecution.

When assessing the compliance of the subject-matter of the present set of claims with EPC, the Examining Division should pay attention to the formal objection raised in section 4.1 (cf. present claims 16 and 18) of the communication of the Board dated 28 February 2003.

**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 submitted with a letter received on 25 February 2004.

The Registrar:

The Chairman:

N. Maslin

A. Nuss