

Internal distribution code:

- (A) [] Publication in OJ
(B) [] To Chairmen and Members
(C) [X] To Chairmen
(D) [] No distribution

D E C I S I O N
of 13 January 2004

Case Number: T 1136/01 - 3.3.1

Application Number: 98810864.3

Publication Number: 0902061

IPC: C09B 67/20

Language of the proceedings: EN

Title of invention:
Stir-in pigment compositions

Patentee:
Ciba Speciality Chemicals Holding Inc.

Opponent:
-

Headword:
Pigments/CIBA

Relevant legal provisions:
EPC Art. 54, 111(1), 123(2)

Keyword:
"Novelty (yes) - after amendment"
"Remittal (yes) - fresh case"

Decisions cited:
G 0010/93

Catchword:
-



Case Number: T 1136/01 - 3.3.1

D E C I S I O N
of the Technical Board of Appeal 3.3.1
of 13 January 2004

Appellant: Ciba Speciality Chemicals Holding Inc.
Klybeckstrasse 141
CH-4057 Basel (CH)

Representative: -

Decision under appeal: Decision of the Examining Division of the
European Patent Office posted 17 May 2001
refusing European application No. 98810864.3
pursuant to Article 97(1) EPC.

Composition of the Board:

Chairman: J. M. Jonk
Members: R. Freimuth
S. C. Perryman

Summary of Facts and Submissions

- I. The appeal lodged on 28 June 2001 lies from the decision of the Examining Division posted on 17 May 2001 refusing European patent application No. 98 810 864.3 (European publication No. 902 061).
- II. The decision of the Examining Division was based on claims 1 to 6 as filed on 5 January 2001 and claims 7 to 10 as originally filed according to the then pending request. The Examining Division found that the subject-matter claimed was neither novel nor inventive, addressing the documents
- (2) EP-A-466 646,
 - (3) US-A-3 904 562 and
 - (4) JP-A-58 208 351, considered in the form of its English translation.

The Examining Division held in particular that the compositions according to the then pending request were anticipated by document (2). That document disclosed in examples 8 and 11 a dried cake comprising the same components as claimed. That cake before being turned into a powder was an aggregation of particles which corresponded exactly to the definition given by the Applicant for the term "granules". The compositions claimed differed from those of document (3) as that document was directed to pigment compositions in the form of discrete particles without specifically disclosing a granulate or aggregate of particles. The claimed subject-matter was also novel vis-à-vis

document (4) due the presence of a disclaimer in claim 1 excluding the content of that document.

With respect to inventive step, the Examining Division held that the disclaimer of the closest prior document (4) comprised in claim 1 was not to be allowed when it was intended not only to restore novelty but also when it could be used to render inventive an obvious teaching (see decision T 710/92, not published in OJ EPO). For this reason alone the present invention was not inventive.

III. At the oral proceedings before the Board held on 13 January 2004 the Appellant (Applicant) no longer maintained the former request. He submitted a fresh set of nine claims superseding any previous request. Independent claim 1 read as follows:

"1. A stir-in pigment composition in the form of microgranules, which comprises 85 to 99.5 parts by weight of a pigment and 0.5 to 15 parts by weight of an additive comprising a vinylpyrrolidone copolymer which is selected from copolymers of vinylpyrrolidone with vinyl ether or vinyl alcohol; acrylic or methacrylic acid or an ester or amide thereof."

The Appellant argued in respect of novelty that document (3) disclosed only a pigment composition of discrete pigment particles coated with an additive polymer while the claimed pigment composition was in the form of microgranules which were aggregates of discrete pigment particles. The pigment compositions claimed were also novel over documents (2) and (4) since the comonomers incorporated into the

vinylpyrrolidone copolymer as defined in claim 1 were different to those comonomers disclosed in that state of the art.

Inventive step should be assessed on a new basis due to the substantial amendments made to claim 1.

IV. The Appellant requested that the decision under appeal be set aside and that the case be remitted to the first instance for further prosecution on the basis of the Main Request submitted at the oral proceedings on 13 January 2004.

V. At the end of the oral proceedings the decision of the Board was announced.

Reasons for the Decision

1. The appeal is admissible.
2. *Amendments (Article 123(2) EPC)*

Fresh claim 1 differs from original claim 1 in that the additive has been restricted to comprise vinylpyrrolidone copolymers with particular comonomers. That amendment finds support on page 4, last paragraph of the application as filed. Furthermore, the proviso of original claim 1 excluding a copolymer of vinylpyrrolidone with an ethylenically unsaturated sulfonic acid as comonomer has been deleted since that specific comonomer is anyhow no longer covered by fresh claim 1. Thus, the original proviso became superfluous. Claims 2 to 9 are based on original claims 3 to 10.

Therefore, the amendments made to the claims do not generate subject-matter extending beyond the content of the application as filed and the Board concludes that the requirements of Article 123(2) EPC are satisfied.

3. *Novelty*

3.1 Document (2) discloses pigment compositions wherein the pigment particles are coated with a polar polymer (claim 1). The polar polymer may be a vinylpyrrolidone polymer (claim 2) optionally modified with the comonomers styrene, acrylonitrile, vinylpropionate, vinylchloride or vinylacetate (page 3, lines 19 and 20).

Document (4) discloses powdered pigment compositions comprising a water-soluble copolymer of vinylpyrrolidone with an ethylenically unsaturated sulfonic acid (claim 1).

Present claim 1 is directed to pigment compositions which comprise a vinylpyrrolidone copolymer wherein the comonomers are selected, however, from vinyl ether or vinyl alcohol, (meth)acrylic acid or an ester or amide thereof. The claimed pigment compositions, hence, differ from those disclosed in documents (2) and (4) in the particular comonomers incorporated into the vinylpyrrolidone copolymer.

3.2 Document (3) discloses pigment compositions in the form of discrete pigment particles coated with a vinylpyrrolidone polymer (claim 1). However, the claimed pigment composition is in the form of microgranules which, based on their common definition

presented by the Appellant, are not discrete pigment particles, but agglomerates thereof. Thus, the arrangement of the pigment particles in the claimed compositions is different to that in document (3).

3.3 For these reasons, the Board concludes that the subject-matter of claim 1, and, by the same token, that of claims 2 to 9 all referring back to the pigment compositions of claim 1 is novel within the meaning of Article 54 EPC.

4. *Remittal*

Having so decided, the Board has not, however, taken a decision on the whole matter, since substantial amendments have been made to independent claim 1 which amended claim was presented at the oral proceedings before the Board. The decision under appeal dealt exclusively with lack of novelty and inventive step of claim 1 according to the then pending request and did not consider claim 1 in the present form as such request was never submitted to the first instance. The amendments leading to fresh claim 1, in particular in restricting the scope of the claims to vinylpyrrolidone copolymers with particular comonomers, have the effect that the reasons given in the contested decision for refusing the present application no longer apply since the present claims have never been challenged under Article 56 EPC for lack of inventive step.

Thus, the Board considers that the substantial amendments made by the Appellant remove all the objections raised in the decision under appeal and that present claim 1 generates a fresh case not yet

addressed in examination proceedings and requiring reexamination.

While Article 111 (1), second sentence, first alternative, EPC gives the Boards of Appeal the power to decide in *ex-parte* proceedings on fresh issues where the application has been refused on other issues, proceedings before the Boards of Appeal in *ex-parte* cases are primarily concerned with examining the contested decision (see decision G 10/93, OJ EPO 1995, 172, points 4 and 5 of the reasons), fresh issues normally being left to the Examining Division to consider after a referral back, so that the Appellant has the opportunity for these to be examined and decided upon without "loss of an instance".

Under these circumstances, the examination not having been concluded and the Appellant having requested remittal, the Board considers it appropriate to exercise the power conferred on it by Article 111(1), second sentence, second alternative, EPC to remit the case to the Examining Division for further prosecution.

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 Main Request submitted at the oral proceedings on 13 January 2004.

The Registrar:

The Chairman:

N. Maslin

J. Jonk