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D E C I S I O N
of 28 November 2005

Case Number: T 0219/04 - 3.4.02

Application Number: 92308229.1

Publication Number: 0532315

IPC: G03G 9/083

Language of the proceedings: EN

Title of invention:

Magnetite particles and process for producing the same

Patentee:

Mitsui Mining & Smelting Co., Ltd.

Opponent:

Lanxess Deutschland GmbH

Headword:

-

Relevant legal provisions:

EPC Art. 56

Keyword:

"Novelty and inventive step (yes)"

Decisions cited:

-

Catchword:

-



Case Number: T 0219/04 - 3.4.02

D E C I S I O N
of the Technical Board of Appeal 3.4.02
of 28 November 2005

Appellant: Mitsui Mining & Smelting Co., Ltd.
(Proprietor of the patent) 2-2-1, Nihombashi-Muromachi Chuo-ku
Tokyo (JP)

Representative: Forstmeyer, Dietmar
Boeters & Lieck
Bereiteranger 15
D-81541 München (DE)

Respondent: Lanxess Deutschland GmbH
(Opponent) Kaiser-Wilhelm-Allee
D-51369 Leverkusen (DE)

Representative: -

Decision under appeal: Decision of the Opposition Division of the
European Patent Office posted 23 December 2003
revoking European patent No. 0532315 pursuant
to Article 102(1) EPC.

Composition of the Board:

Chairman: A. G. Klein
Members: F. J. Narganes-Quijano
C. Rennie-Smith

Summary of Facts and Submissions

- I. The appellant (patent proprietor) has lodged an appeal against the decision of the opposition division revoking European patent No. 0532315 (based on European patent application No. 92308229.1).

The opposition was filed against the patent as a whole on the grounds that the magnetite particles defined in claims 1 to 4 as granted were not new and the process of producing magnetite particles defined in claim 5 as granted did not involve an inventive step (Article 100(a) together with Articles 52(1), 54 and 56 EPC).

In its decision the opposition division held that claim 1 amended according to the requests then on file and directed to magnetite particles was not clear (Article 84 EPC) or did not define novel subject-matter over the state of the art considered during the opposition proceedings (Articles 52(1) and 54 EPC).

- II. With the statement setting out the grounds of appeal, the appellant filed an amended set of claims according to a main and an auxiliary request, and requested that the decision under appeal be set aside and the patent be maintained in amended form.
- III. In a communication the Board drew the attention of the parties to some deficiencies in the amended patent documents according to the appellant's requests. The Board also noted that during the first-instance proceedings the respondent (opponent) did not contest the preliminary opinion expressed by the opposition

division that, in view of the arguments of the parties and the comparative tests then on file, the process of producing magnetite particles according to claim 5 as granted - and to which claim 1 of the appellant's requests is now directed - would be inventive over the prior art under consideration.

- IV. In reply to the Board's communication, the appellant filed with a letter dated 5 September 2005 an amended claim 1 according to a main and an auxiliary request and amended pages 2, 2a, 3 and 4 of the description, and requested maintenance of the patent in amended form.

Subsequently, the respondent informed the Board that it did not plan to submit any observations on the appellant's reply dated 5 September 2005. Apart from this notification, no substantive observations, submissions or requests were received from the respondent in reply to the grounds of appeal, or to the Board's communication, or to the appellant's reply to this communication.

- V. Claim 1 according to the main request of the appellant reads as follows:

"A process for producing magnetite particles comprising the steps of adding a silicon component to a solution of a ferrous salt as a main ingredient, mixing an alkali into the solution at a rate of from 1.0 to 1.1 equivalents of the alkali per equivalent of ferrous ions present, subjecting the obtained mixture to an oxidation reaction while the pH of the mixture is maintained in the range of from 7 to 10, replenishing ferrous ions to adjust the total amount of iron in the

mixture to an amount of from 0.9 to 1.2 equivalents of ferrous ions per equivalent of the alkali initially added in the course of the reaction, and further subjecting the mixture to an oxidation reaction while the pH of the mixture is maintained in the range of from 6 to 10."

The wording of claim 1 according to the auxiliary request is not relevant to the present decision.

- VI. In support of its requests the appellant has essentially submitted that novelty of the subject-matter of claim 1 was not questioned by the respondent during the first-instance proceedings, and that the prior art documents, and in particular the citations considered by the opposition division in the decision under appeal, did not suggest the claimed process of producing magnetite particles.

Reasons for the Decision

1. The appeal complies with the requirements mentioned in Rule 65(1) EPC and is therefore admissible.
2. *Main request - Amendments*

The main request of the appellant contains a single claim, which corresponds to claim 5 of the patent as granted, directed to a method for producing magnetite particles. As a result of the cancellation of claims 1 to 4 of the patent as granted and directed to magnetite particles, the statements of invention in pages 2 to 4 of the description of the patent specification have

been amended to make them consistent with the invention as defined in present claim 1 (Article 84 and Rule 27(1)(c) EPC).

After due consideration of the amendments, the Board is satisfied that the amendments made to the patent according to the main request are admissible (Rule 57a EPC) and comply with the formal requirements of the EPC, and in particular with those set forth in Articles 123(2) and (3) EPC.

3. *Main request - Patentability*

The reasons invoked by the opposition division in the decision under appeal for the revocation of the patent only concerned the issues of clarity and novelty of the amended versions of claims 1 to 4 then on file and directed to magnetite particles. Such claims, however, have been omitted in the present main request of the appellant. Consequently, the appellant's main request overcomes all the reasons for the revocation of the patent given in the decision under appeal.

Claim 1 of the appellant's main request corresponds to independent claim 5 as granted and directed to a process for producing magnetite particles. As already noted by the Board during the appeal proceedings (point III above), the positive preliminary opinion on the issues of novelty and inventive step of claim 5 as granted expressed by the opposition division during the first-instance opposition proceedings was not subsequently contested by the respondent. During the appeal proceedings the respondent did not dispute either novelty and inventive step of the subject-matter

of the single claim according to the appellant's main request. In these circumstances, and after due consideration of the prior art and evidence cited during the proceedings, the Board sees no reason to depart from the opposition division's view that the subject-matter defined in claim 5 as granted - now claim 1 according to the present appellant's main request - is novel and involves an inventive step over the available prior art (Articles 52(1), 54 and 56 EPC).

Having regard to the above, the amendments to the patent according to the appellant's main request overcome the grounds given in the contested decision for the revocation of the patent and, in addition, also overcome the grounds for opposition of novelty and inventive step invoked by the respondent (Articles 52(1), 54 and 56 EPC).

4. In view of the foregoing, the Board is satisfied that the patent as amended according to the main request and the invention to which it relates meet the requirements of the EPC. Accordingly, the contested decision is to be set aside and the patent maintained in amended form on the basis of the patent documents according to the main request of the appellant (Article 102(3) EPC).

Order

For these reasons it is decided that:

1. The decision under appeal is set aside.

2. The case is remitted to the department of first instance with the order to maintain the patent in amended form on basis of the following documents:

- claim 1 according to the main request filed with the letter dated 5 September 2005, and
- description pages 2, 2a, 3 and 4 filed with the letter dated 5 September 2005 and description pages 5 to 9 of the patent as granted.

The Registrar:

The Chairman:

P. Martorana

A. G. Klein