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**Datasheet for the decision
of 8 August 2007**

Case Number: T 0582/05 - 3.3.01

Application Number: 95650015.1

Publication Number: 0682094

IPC: C09D 7/00

Language of the proceedings: EN

Title of invention:

A pourable water dispersible thickening composition for aqueous systems and a method of thickening said aqueous systems

Patentee:

Elementis Specialties, Inc.

Opponent:

-

Headword:

Pourable thickener/ELEMENTIS

Relevant legal provisions:

EPC Art. 123(2), 123(3)

Keyword:

"Unallowable extension beyond the content of the application as filed (no) - replacement of an unallowable disclaimer by a positively defined delimitation"

"Unallowable extension beyond the protection conferred by the patent as granted (no)"

Decisions cited:

G 0001/03

Catchword:

-



Case Number: T 0582/05 - 3.3.01

D E C I S I O N
of the Technical Board of Appeal 3.3.01
of 8 August 2007

Appellant: Elementis Specialties, Inc.
(Patent Proprietor) 329 Wyckoffs Mill Road
Hightstown
New Jersey 08520 (US)

Representative: Metten, Karl-Heinz
Forrester & Boehmert
Pettenkoferstrasse 20-22
D-80336 München (DE)

Decision under appeal: Decision of the Opposition Division of the
European Patent Office posted 4 March 2005
revoking European patent No. 0682094 pursuant
to Article 102(1) EPC.

Composition of the Board:

Chairman: J. Jonk
Members: C. M. Radke
J. Van Moer

Summary of Facts and Submissions

I. The Appellant (Patentee) lodged an appeal against the decision of the Opposition Division by which the European Patent No. 0 682 094 (European patent application No. 95 650 015.1) was revoked.

II. The decision was based on a set of claims for all designated contracting states filed with the letter dated 1 August 2003, claim 1 reading as follows:

"1. A pourable water dispersible associative thickener composition for aqueous systems having a viscosity less than 15,000 mPa.s (centipoise) at 25°C comprising:

(a) from 15 to 40% by weight of an associative thickener polymer selected from polyurethanes, polyesters, modified cellulosics, polyester-urethanes, polyether-alpha olefins and polyether-polyols;

(b) at least 30% by weight water;

(c) from 1 to 30% by weight of one or more surfactants selected from anionic and nonionic surfactants and mixtures thereof; and optionally

(d) one or more conventional additives, with the proviso that when such additive includes an organic solvent it is present at a concentration of less than 5% by weight."

III. The opposition was supported by several documents including:

(1) EP-A-0 618 243, and

(14) AU-B-515 783.

IV. The Opposition Division held that the subject-matter of said claim 1 was not allowable, since the proviso under (d):

"that when such additive includes an organic solvent it is present at a concentration of less than 5% by weight"

which had been introduced in order to delimit the claimed subject-matter from document (14) was not allowable as a disclaimer in view of the decision of the Enlarged Board of Appeal G 1/03 (OJ 2004, 413) and therefore did not comply with Article 123(2) EPC.

V. The Respondent, Cognis Deutschland GmbH (Opponent 1) did not comment on the grounds of appeal presented in the Appellant's letter dated 14 July 2005 and withdrew its opposition on 12 November 2005.

Süd-Chemie AG (Opponent (2)) withdrew its opposition during the opposition proceedings on 18 January 2005.

VI. Oral proceedings before the Board were held on 8 August 2007.

VII. The Appellant defended the patentability of the subject-matter of the patent in suit on the basis of a

request submitted during the oral proceedings before the Board consisting of a set of claims 1 to 8 for the designated contracting states BE, DE, DK, ES, FR, GB, IT and NL, and another set of claims 1 to 8 for the contracting state IE.

Claim 1 for the contracting states BE, DE, DK, ES, FR, GB, IT and NL reads as follows:

"1. A pourable water dispersible associative thickener composition for aqueous systems having a viscosity less than 15,000 mPa.s (centipoise) at 25°C consisting of:

(a) from 15 to 40% by weight of an associative thickener polymer selected from polyurethanes, polyesters, modified cellulosics, polyester-urethanes, polyether-alpha olefins and polyether-polyols;

(b) at least 30% by weight water;

(c) from 1 to 30% by weight of one or more surfactants selected from anionic and nonionic surfactants and mixtures thereof; and

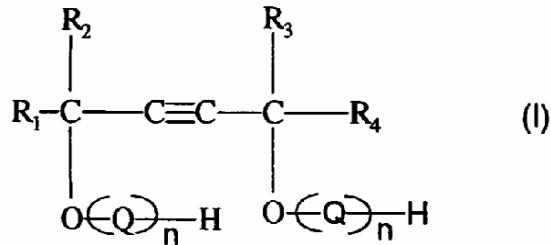
(d) optionally one or more additional components selected from binders, clays, neutralization chemicals, buffering agents, inorganic salts, chelating agents and pH adjusting agents,

except a thickener preparation for thickening aqueous systems consisting of a mixture of

(i) a water-soluble or water-dispersible thickener containing urethane groups,

(ii) a non-ionic emulsifier, and

(iii) at least one compound of the formula (I)



wherein in this formula R₁ and R₃ denote identical or different hydrocarbon residues and R₂ and R₄ denote hydrogen or identical or different hydrocarbon residues, Q denotes alkylene oxide units, as are obtained from alkoxyating alcohols with alkylene oxides having 2 to 4 carbon atoms, and n denotes numbers from 0 to 120,

wherein the thickener preparation is in the form of an aqueous solution or dispersion."

Claim 1 for the contracting state IE differed from this claim in that the disclaimer at the end of the claim ("except a thickener preparation ... wherein the thickener preparation is in the form of an aqueous solution or dispersion.") was omitted.

VIII. The Appellant requested that the decision under appeal be set aside and the patent be maintained in amended form on the basis of the request filed during the oral proceedings before the Board.

IX. At the conclusion 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))*
 - 2.1 The subject-matter of claim 1 for the contracting states BE, DE, DK, ES, FR, GB, IT and NL is supported by:
 - claims 1 and 2 of the application as filed,
 - page 12, lines 19 to 25, of the description of the application as filed (with respect to the viscosity),
 - page 13a, lines 2 to 5, of the application as filed (concerning the optional additives specified under d)), and
 - claim 1 of document (1) with respect to the specified disclaimer.

2.1.1 It is true that the water content of

"at least 30% by weight"

as indicated under b) in present claim 1 does not correspond to the amount of water of

"from about 30 to 85 %"

as specified under b) in claim 1 of the application as filed. However, the deletion of the upper limit of 85% has been made in order to correct an obvious error,

since the sum of the maximum amounts of the claimed components a), b) and c) would exceed 100%. In fact, the composition according to claim 1 of the application as filed relates to a "thickener composition for aqueous systems". This means that further amounts of water are to be added to said composition when applied as a thickener and that the amount of water indicated in claim 1 as originally filed was only meant to indicate the minimum content of 30% by weight and that higher amounts of water would then add up the given contents of the other components to a total of 100 percent.

Hence, it was immediately evident that nothing else had been intended than what is proposed as the correction and that consequently this amendment is admissible under Article 123(2) EPC.

2.1.2 The disclaimer has been introduced to establish novelty of the subject-matter claimed in view of document (1) which is state of the art within the meaning of Article 54(3) EPC. Furthermore, the Board has verified that the disclaimer is clear and concise. Therefore, the disclaimer meets the requirements for allowability set out in point 2 of the order of the decision G 01/03 (OJ EPO 2004, 413).

2.2 The subject-matter of claim 1 for the contracting state IE corresponds to that of claim 1 for said contracting states BE to NL, except that the disclaimer with respect to document (1) has been omitted. Therefore, the support for its subject-matter is as indicated above under points 2.1, 2.1.1 and 2.1.2.

2.3 Claims 2 to 8 of both sets of claims have their basis in claims 3 to 7, 9 and 10 of the application as filed.

2.4 Therefore, the Board concludes that the subject-matter of the present claims does not extend beyond the application as filed, and consequently meets the requirement of Article 123(2) EPC.

3. *Amendments (Article 123(3) EPC)*

3.1 Apart from the disclaimer mentioned in points 2.1 and 2.1.2 above, both claims 1 of the present set of claims for the respective contracting states contain the following amendments with respect to claim 1 as granted:

3.1.1 The insertion of "at 25 °C" after the word "(centipoise)".

3.1.2 The replacement of the word "comprising" in line 2 in claim 1 as granted by "consisting of".

3.1.3 The replacement in claim 1 as granted of the expression

"and optionally (d) one or more conventional additives, with the proviso that when such additive includes an organic solvent it is present at a concentration of less than 5% by weight"

by

"(d) optionally one or more additional components selected from binders, clays, neutralization chemicals, buffering agents, inorganic salts, chelating agents and pH adjusting agents".

3.2 The disclaimer and the amendments mentioned under points 3.1.1 and 3.1.2 above clearly restrict the scope of protection with respect to claim 1 as granted.

Furthermore, the amendment mentioned in point 3.1.3 above further restricts the optional additives to "binders, clays, neutralization chemicals, buffering agents, inorganic salts, chelating agents and pH adjusting agents" thus excluding the addition of organic solvents. Consequently, this exclusion is more restrictive than the proviso in claim 1 as granted "that when such additive includes an organic solvent it is present at a concentration of less than 5% by weight".

3.3 Therefore, the Board concludes that the present claims are not amended in such a way as to extend the protection conferred by the claims as granted, and consequently meet the requirement of Article 123(3) EPC.

4. *Remittal (Article 111(1) EPC)*

Having so decided, the Board has not, however, taken a decision on the whole matter, since the essential feature of the appeal proceedings is to consider whether the decision which has been issued by the first instance is correct. Therefore, and in view of the fact that the first instance only decided upon the issue of the allowability of the amendments under Article 123(2) EPC and did not have an opportunity to consider further the patentability of the subject-matter of the present claims, the Board considers it appropriate to exercise

its power conferred on it by Article 111(1) EPC to remit the case to the Opposition Division.

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.

The Registrar:

The Chairman:

N. Maslin

J. Jonk