

Internal distribution code:

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

**Datasheet for the decision
of 26 September 2007**

Case Number: T 1082/05 - 3.3.01

Application Number: 00920655.8

Publication Number: 1165696

IPC: C09B 67/22

Language of the proceedings: EN

Title of invention:

Pigment compositions and process of shading

Patentee:

Ciba Specialty Chemicals Holding Inc., et al

Opponent:

CLARIANT INTERNATIONAL LTD

Headword:

Pigment composition/CIBA - STORA KOPPARBERGS

Relevant legal provisions:

EPC Art. 123(2), 114(2), 56
EPC R. 65

Keyword:

"Admissibility of an appeal solely based on documents first
filed during the appeal - yes"
"Admission of late filed documents"
"Inventive step (no) - obvious alternative"

Decisions cited:

T 0389/95, T 0932/99, T 0980/97, T 0122/93, T 0119/82

Catchword:

-



Case Number: T 1082/05 - 3.3.01

D E C I S I O N
of the Technical Board of Appeal 3.3.01
of 26 September 2007

Appellant:
(Opponent)

CLARIANT INTERNATIONAL LTD.
Rothausstr. 61
CH-4132 Muttenz (CH)

Representative:

-

Respondents:
(Patent Proprietors)

Ciba Specialty Chemicals Holding Inc.
Klybeckstrasse 141
CH-4057 Basel (CH)

Stora Kopparbergs
Bergslags AB
SE-79180 Falun (SE)

Representative:

Pfenning, Meinig & Partner GbR
Patent- und Rechtsanwälte
Theresienhöhe 13
D-80339 München (DE)

Decision under appeal:

Interlocutory decision of the Opposition
Division of the European Patent Office posted
7 June 2005 concerning maintenance of European
patent No. 1165696 in amended form.

Composition of the Board:

Chairman: P. Ranguis
Members: C. M. Radke
R. Menapace

Summary of Facts and Submissions

I. The Opponent lodged an appeal against the interlocutory decision of the Opposition Division that the European patent No. 1 165 696 as amended meets the requirements of the EPC.

II. The decision under appeal refers to claims 1 to 25 filed with the letter dated 21 March 2005 (see the front page and the penultimate paragraph of point II), claim 1 of these reading as follows:

"1. A composition comprising

a) a mixture of C.I. Pigment Violet 19 together with either C.I. Pigment Blue 15 or C.I. Pigment Blue 60,

b) a dispersant,

c) optionally a biocide, and

d) water,

which contains 10 to 40 % by weight, based on the total weight of the dispersion, of pigment mixture, component a)."

The claims annexed to the decision under appeal differ therefrom in that in claim 1 the expression "of the dispersion," is missing.

III. Opposition had been filed against the patent in suit for lack of novelty and lack of inventive step of the subject-matter claimed (Article 100(a) EPC).

In its decision the opposition division considered the subject-matter of the claims to be novel on the ground that documents (1) and (2) only disclose compositions containing less than 10 % by weight of pigments while

document (5) does not disclose compositions containing water. It held that the subject-matter claimed involves an inventive step as document (6) does not disclose the use of the pigments mentioned therein for dyeing or shading of paper, whereas document (7) only discloses the use of C.I. Pigment Blue 15 for dyeing paper.

IV. Oral proceedings before the Board were held on 26 September 2007. During these proceedings, the respondents submitted a set of 25 amended claims as the basis of their sole request.

Claim 1 of this set reads as follows:

"1. A composition consisting of
a) a mixture of C.I. Pigment Violet 19 together with either C.I. Pigment Blue 15 or C.I. Pigment Blue 60,
b) a dispersant,
c) optionally a biocide, and
d) water,
which contains 10 to 40 % of pigments, based on the weight of the composition."

V. The following documents were *inter alia* cited in the opposition and appeal proceedings:

- (1) EP-A-0 881 523
- (2) WO-A-00 22 232
- (4) Registry file printout for the registry numbers 147-14-8, 81-77-6, 4051-63-2, and 1047-16-1 from Chemical Abstracts, Chemical Abstracts Service, Columbus OH/US
- (5) US-A-3 577 379

- (6) Brochure "Clariant Lieferprogramm für die Druckfarben-, Lack- Kunststoff-Industrie und weitere Anwendungen" dated "Januar 1998", pages 1, 31, 64
- (7) FR-A-800 242
- (8) Brochure "®Flexonyl-Pigment-Präparationen", Hoechst AG, dated "01.97", 8 pages
- (9) Brochure "Manual of Dyes and Pigments for Special Fields", Hoechst AG, bearing the code "DP 5518 E 08.96 /035" on the last page, page 147
- (11) Lin Hai, China Pulp & Paper, no. 4, July 1998, 18-22, and an English translation thereof
- (12) E. Wenderoth and B. Hunke, Wochenblatt für Papierfabrikation 16, 1993, 649-653
- (13) F. Muller et al., Paper Southern Africa, April 1993, pages 4, 8, 10, 12, 14, 16, 18, 22
- (14) Ullmann's Encyclopedia of Industrial Chemistry, 5th edn., vol. A18, VCH Verlagsgesellschaft, Weinheim/DE 1991, 545-547 and 613-614
- (15) DE-A-1 923 846
- (16) DE-B-1 183 884
- (19) Handbuch der Papier- und Pappenfabrikation (Papierlexikon), 2nd edn., vol. II, Dr. Martin Sändig oHG, Niederwalluf, 1971, 2040-2044
- (23) EP-A-0 753 544
- (24) Brochure "Ciba® IRGALITE® Blue R-L Paper Pigment", Ciba Speciality Chemicals Inc., January 2005, 2 pages

Of these, documents (8), (9) and (11) to (16) were first submitted by the Appellant with the letter dated 17 October 2005 setting out the grounds of appeal, and documents (19), (23) and (24) with Appellant's letter dated 15 August 2007.

VI. The Appellant (Opponent) considered document (11) to represent the closest prior art and argued in essence as follows:

The problem solved was to provide further pigment compositions which allow the shading of food packaging materials so as to improve their whiteness, and which are easier to apply.

The subject-matter claimed in claim 1 differs from the disclosure in document (11) in that present claim 1 requires C.I. Pigment Violet 19 to be employed and the pigment mixture to be in the form of a dispersion.

The use of C.I. Pigment Violet 19 for shading paper was known from document (8), the use of an anionic dispersing agent from documents (15) and (23). Therefore, the subject-matter of claim 1 is not based on an inventive step.

VII. The Respondents (Proprietors of the Patent) argued that the appeal was not admissible since it was completely based on newly filed documents. They doubted that documents (8) and (9) had been available to the public before the priority date of the patent in suit. They contended that the English translation of document (11) was not reliable because at least the penultimate line preceding paragraph 2.2.7 was not translated.

Whereas the wording "consisting of" in present claim 1 excludes the presence of a fluorescent whitening agent (FWA), such an agent is mandatory in the compositions disclosed in document (11). The problem solved by the

patent in suit with respect to document (11) was to provide pigment dispersions which can be used for the shading of food packaging materials, especially for paper, and which are stable for a longer period of time (see paragraphs [0002] and [0037] of the patent in suit). Document (11) neither addresses the storage stability of pigment dispersions nor gives any indication that the FWA might be omitted. Moreover, document (19) discloses that whitening of paper using blue pigments reduces its brightness so that the person skilled in the art would not have omitted the FWA (see document (19), left column of page 2042, third paragraph from the bottom).

VIII. The Appellant requested that the decision under appeal be set aside and the patent be revoked.

The Respondents requested that the decision under appeal be set aside and the patent be maintained on the basis of claims 1 to 25 submitted during the oral proceedings before the Board.

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

Reasons for the Decision

1. *Admissibility of the Appeal*

1.1 The Respondents doubted that the appeal was admissible due to the fact that it is totally based on documents presented for the first time with the letter setting

out the grounds for appeal or later in the appeal proceedings.

An appeal is inadmissible if it does not comply with Articles 106 to 108, Rule 1, paragraph 1 and Rule 64 EPC (see Rule 65 EPC).

These provisions require that "... a written statement setting out the grounds for appeal must be filed ." but do not specify on which evidence these grounds are to be based (see Article 108 EPC).

Hence, the provisions of the EPC do not give any indication that an appeal the grounds of which are based completely on newly filed documents would be inadmissible.

In line with this it is the consistent jurisdiction of the Boards of Appeal that an appeal is not to be considered inadmissible merely because it is based on evidence submitted for the first time with the grounds for appeal (e.g. T 389/95 of 15 October 1997, not published in the OJ EPO, point 1 of the reasons; T 932/99 of 3 August 2004, not published in the OJ EPO, point 1.3 of the reasons).

- 1.2 The Board has verified that the appeal does comply with the provisions under Articles 106 to 108, Rule 1, paragraph 1 and Rule 64 EPC. Hence it is admissible.

2. *Amendments (Article 123(2) and (3) EPC*

2.1 The Appellant argued that the replacement of the word "comprising" by "consisting of" in claim 1 contravened the requirements of Article 123(2) EPC.

The examples 1 and 7 as originally filed disclose compositions consisting of the components listed in present claim 1 and thus form a basis for said replacement (see T 980/97 of 29 September 1999, point 3.1 of the reasons; see T 122/93 of 30 April 1996, point 2 of the reasons; both decisions not published in the OJ EPO).

A further basis for present claim 1 in the application as filed is found in claim 1 in combination with page 2, fourth paragraph, of the description.

Present claims 2-25 are based on claims 2-13 and 15-25 and on page 2, third paragraph of the description, both as originally filed.

Therefore, the amendments meet the requirements of Article 123(2) EPC.

2.2 The claims under consideration differ from the granted ones in that in claim 1 the amount of component a) has been specified, thus restricting the scope of the claims.

Therefore, the amendments meet the requirements of Article 123(3) EPC.

3. *Late filed documents*

3.1 Document (8) consists of pages of a brochure of Hoechst AG and bears the footnote "01.97" on pages 4 to 8. The Appellant contended that the brochure has been printed in January 1997 and distributed shortly afterwards. He has, however, not provided any evidence for this contention, so that it is not proven that this document had indeed been made available to the public before the priority date of the patent in suit (i.e. before 8 April 1999).

3.2 Document (24) has been published after the relevant priority date and describes "Ciba® IRGALITE® Blue R-L" merely as "A Copper phthalocyanine pigment preparation". It thus cannot serve as evidence for the Appellant's contention that the IRGALITE® Blue R-L mentioned in document (11) is C.I. Pigment Blue 15.

3.3 The Board exercised its discretion under Article 114(2) EPC by not admitting documents (8) and (24) to the appeal proceedings as none of them is prima facie relevant for the outcome of these appeal proceedings.

4. *Reliability of the English Translation of Document (11)*

4.1 The Respondents argued that the English translation of document (11) was not reliable as at least the penultimate line preceding paragraph 2.2.7 was not translated (see point VII above).

4.2 This line consists of one Chinese character, the number 6, three Chinese characters, the letter C, one Chinese character, the letters CIE, and, finally, three Chinese

characters (see the right hand column on page 21 of the Chinese text).

The wording of this line is identical with those of the lines immediately under the Figures in the left hand column of the same page, except that

- the number 6 is replaced by the numbers 4 and 5, respectively,
- the first letter C is replaced by the letters A and B, respectively.

These two lines under the figures in the left hand column of page 21 of the Chinese text were translated as follows:

"Figure 4. CIE Shade Diagram for Formulation A" and
"Figure 5. CIE Shade Diagram for Formulation B".

It follows that the line not translated has the meaning

"Figure 6. CIE Shade Diagram for Formulation C".

- 4.3 This omission of the subtitle of Figure 6 - evidently by error - renders the translation incomplete in this respect but does not give rise to reasonable doubts as to the correctness of the translation as a whole.

Therefore, the Board has no reason to assume that the English translation of document (11) is not reliable.

5. *Novelty*

During the oral proceedings before the Board, the Appellant no longer contested the novelty of the subject-matter of the present claims and the Board sees no reason to question it either. In view of the outcome of this appeal there is no need to give detailed reasons in that respect.

6. *Inventive step*

- 6.1 In accordance with the "problem-solution" approach consistently applied by the Boards of Appeal, it is necessary, as a first step, to establish the closest state of the art which is normally a prior art document disclosing subject-matter aiming at the same objective as the claimed invention and having the most relevant technical features in common.

The objective of the patent in suit is "to provide a pigment composition which can be used for the shading of food packaging materials, especially such materials which are made of paper." (see paragraph [0002] of the patent in suit). The shading of paper improves its whiteness (see paragraph [0035]).

Document (11) is the only document cited in the opposition and appeal proceedings dealing with the shading of paper with a combination of violet and blue pigments. It thus represents the closest prior art.

More specifically, this document deals with the use of fluorescent whitening agents and shading dyes for the whitening of paper (see its title). The document

recommends blends of violet and blue pigments for shading ordinary paper and defines such blends by citing the trade names of the pigments (see Figure 1 on page 6, the second paragraph on page 2, chapter 2.3.3 on page 12, chapter 3.4 on page 13 and chapter 3.6 on page 14 of the English translation).

- 6.2 Then it has to be determined which technical problem was to be solved in view of the closest prior art and if this problem was indeed solved over the whole scope of the subject-matter claimed.

The Respondents referred to the problems and advantages mentioned in paragraphs [0002] and [0037] of the patent in suit.

- 6.2.1 Paragraph [0037] of the patent in suit claims that "Furthermore, the dispersions are stable for a longer period of time and can therefore be stored before application, without showing deposits resulting in deteriorous application properties."

However, neither does the patent in suit contain any data indicating that the dispersions show an increased stability, nor have the Respondents provided any evidence in this respect.

Hence, this alleged effect cannot be taken into account when determining which problem is solved.

- 6.2.2 According to paragraph [0002] of the patent in suit the subject-matter claimed was "... to provide a pigment composition which can be used for the shading of food

packaging materials, especially such materials which are made of paper."

Document (11) provides pigment preparations for the shading of paper (see the abstract and the paragraph immediately preceding chapter 1). The Respondents did not provide any evidence showing that the pigment compositions disclosed in document (11) were not suitable for the shading of food packaging materials made of paper.

- 6.2.3 Therefore, the problem solved in view of document (11) can only be considered as to provide alternative pigment compositions which can be used for the shading of food packaging materials.

The examples in the patent in suit show that this problem is indeed solved.

- 6.3 It remains to be determined whether or not the claimed solution to the technical problem mentioned above was obvious in view of the cited prior art as a whole.

- 6.3.1 Document (11) discloses shading paper by means of a fluorescent whitening agent (FWA) and violet and blue shading dyes (see the abstract). One of the shading compositions disclosed there contains the pigments Irgalite Violet M and Irgalite Blue RL (see the paragraph immediately preceding chapter 1.1.2, and Figure 1). The Respondents mentioned that these pigments are C.I. Pigment Violet 3 and C.I. Pigment Blue 15:1 (see page 3, lines 4-7, of their letter dated 23 February 2006).

However, document (11) also reports on experiments using combinations of other blue and violet dyes (see Figure 6, in particular compositions H, I, L, G, J and K defined in the footnotes, and chapters 2.3.3 and 3.6). So, the teaching of document (11) is clearly not limited to the use of blends of C.I. Pigment Violet 3 and C.I. Pigment Blue 15:1.

Moreover, the person skilled in the art knew that the whitening observed in document (11) was due to the fact that to the human eye a paper having a yellow tinge is considered to be less bright than one having a blue tinge of comparable intensity (see e.g. document (19), page 2042, right hand column, the first two paragraphs of the chapter "Weißfärbung"). Hence, the whitening observed in document (11) is due to the colours and not to the chemical structures of the violet and blue pigments used.

So, the teaching of document (11) reads on any blend of violet and blue pigments.

This is in line with the third sentence of the abstract which states in general that violet and blue dyes can raise the whiteness of paper (see page 1 of the English translation and the abstract in English on page 22 of the original document).

- 6.3.2 The person skilled in the art looking for alternative pigment compositions which can be used for the shading of food packaging materials would therefore have taken into consideration any violet and blue pigments, such as the pigment preparations disclosed in document (23).

Document (23) discloses liquid pigment preparations which may be used for many purposes including the manufacture of printing inks (see column 1, lines 3-5 and 16-25). These preparations contain from 20 to 60 % by weight, preferably from 30 to 50 % by weight of pigment (see column 3, lines 21-35). Dispersions in aqueous or aqueous organic media are preferred (see column 7, lines 26-32).

Examples 3 and 18 of said document disclose aqueous dispersions of C.I. Pigment Blue 15 with a pigment concentration of 37 % by weight and an ethoxylated novolak as the dispersant, example 11 discloses a dispersion of C.I. Pigment Red 122 and C.I. Pigment Violet 19 in an organic medium with a total pigment concentration of 24 % by weight, and example 5 an aqueous dispersion of C.I. Pigment Blue 15:1 and C.I. Pigment Violet 23 with a total pigment concentration of 30 % by weight and an ethoxylated novolak as the dispersant.

According to the established jurisprudence of the Boards of Appeal, the disclosure of a prior art document is not confined to the detailed information given in a specific example. Document (23) also discloses to the person skilled in the art aqueous dispersions containing blue and violet pigments (as disclosed in example 5) in a total pigment concentration of from 20 to 60 % by weight, preferably of from 30 to 50 % by weight based on the weight of the composition (as disclosed in column 3, lines 21-35) where the blue pigment is C.I. Pigment Blue 15 (as disclosed in examples 3 and 18) and the violet pigment is C.I. Pigment Violet 19 (as disclosed in example 11).

Therefore it was obvious to the expert to replace the blend of C.I. Pigment Violet 3 and C.I. Pigment Blue 15:1 disclosed in document (11) by an aqueous dispersion of C.I. Pigment Violet 19 and C.I. Pigment Blue 15, where said dispersion contains a dispersant and has a total pigment concentration of from 20 to 60 % by weight based on the weight of the composition.

- 6.3.3 Document (11) discloses pigment compositions containing a fluorescent whitening agent (FWA) as a mandatory component. Present claim 1 restricts the components to components a) to d) by the use of the expression "consisting of" and thus excludes the presence of a FWA.

The Respondents argued that the omission of the FWA was not obvious as document (11) discloses that shading with violet and blue dyes in the absence of any FWA slightly reduced the brightness of the paper (see the third sentence of the abstract and chapters 3.1 and 3.4).

However, the Respondents have neither provided any evidence demonstrating that such a decrease in brightness does not occur when the pigment compositions presently claimed are used, nor did they claim an unexpected effect due to the absence of the FWA. Hence, it has to be expected that the omission of the FWA in the pigment compositions disclosed in document (11) merely results in a predictable disadvantage with respect to those disclosed in the prior art and cannot contribute to the presence of an inventive step (see T 119/82, OJ EPO 1984, 217, point 16 of the reasons).

- 6.4 In conclusion the person skilled in the art would have tried to solve the problem mentioned above by replacing in document (11) the combination of violet and blue pigments cited therein by an aqueous dispersion of C.I. Pigment Violet 19 and C.I. Pigment Blue 15 having a total pigment concentration of from 20 to 60 % by weight, preferably of from 30 to 50 % by weight, and including a dispersant while omitting the FWA.
- 6.5 When doing this, he is directed towards the solution which is now the object of claim 1 of the patent in suit. For these reasons, the subject-matter of claim 1 is not based on an inventive step
7. As the subject-matter of claim 1 of the sole request is not based on an inventive step and the Board can only decide on a request as a whole, the patent is revoked.

Order

For these reasons it is decided that:

1. The decision under appeal is set aside.
2. The patent is revoked.

The Registrar:

The Chairman:

N. Maslin

P. Ranguis