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**Datasheet for the decision
of 25 July 2007**

Case Number: T 0400/06 - 3.3.06

Application Number: 95901101.6

Publication Number: 0731826

IPC: C09C 3/10

Language of the proceedings: EN

Title of invention:

Treatment of inorganic pigments with carboxymethylcellulose compounds

Patentee:

MINERALS TECHNOLOGIES INC.

Opponents:

Akzo Nobel N.V.
M-REAL OYJ

Headword:

Treated calcium carbonate/MINERALS TECHNOLOGIES

Relevant legal provisions:

EPC Art. 123(3)

Keyword:

"Extension of protection: yes"

Decisions cited:

-

Catchword:

-



Case Number: T 0400/06 - 3.3.06

D E C I S I O N
of the Technical Board of Appeal 3.3.06
of 25 July 2007

Appellant: MINERALS TECHNOLOGIES INC.
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Decision under appeal: Interlocutory decision of the Opposition
Division of the European Patent Office posted
26 January 2006 concerning maintenance of the
European Patent No. 0731826 in amended form.

Composition of the Board:

Chairman: P.-P. Bracke
Members: L. Li Voti
A. Pignatelli

Summary of Facts and Submissions

- I. The present appeal is from the interlocutory decision of the Opposition Division to maintain in amended form European patent no. 0 731 826, concerning a composition for use as a papermaking filler.

The European patent had been granted with a set of 21 claims, claims 1 and 8 reading, respectively, as follows:

"1. A composition for use as a paper making filler comprising calcium carbonate containing a cellulose derivative thereon, wherein said cellulose derivative is a cellulose modified by or containing at least one ionic substituent."

"8. A method of producing paper wherein cellulose material is formed into an alkaline slurry, dewatered, and shaped into paper, the improvement comprising: providing finely divided calcium carbonate, treating the calcium carbonate with a cellulose derivative formed from a cellulose modified by or containing at least one ionic substituent to provide treated calcium carbonate, and mixing the treated calcium carbonate with cellulosic fiber and water to provide a slurry suitable for forming into paper."

- II. In their notices of opposition the Opponents 01 and 02 sought revocation of the patent *inter alia* on the grounds of Article 100(a) EPC, because of lack of novelty and inventive step of the claimed subject-matter, and of Article 100(c) EPC.

III. In its decision, the Opposition Division found that the claims according to the third auxiliary request submitted in the oral proceedings of 25 October 2005 complied with the requirements of the EPC.

IV. Appeals were filed against this decision by the Patent Proprietor and by both Opponents.

The Appellant/Opponent 02 withdrew its appeal with fax of 06 July 2007.

The Patent Proprietor (hereinafter Appellant) submitted with the fax of 18 July 2007 amended sets of claims according to the main request and to the first to ninth auxiliary requests.

The Appellant/Opponent 01 informed the Board in writing with fax of 19 July 2007 that it had no objections to the claims submitted by the Appellant with fax of 18 July 2007 and it withdrew its appeal.

Oral proceedings were held before the Board on 25 July 2007 in the presence of the Appellant only.

In the oral proceedings the Appellant withdrew all the requests submitted with the fax of 18 July 2007 and filed two newly amended sets of claims to be considered as main request and first auxiliary request, respectively.

V. The set of 5 claims according to the main request comprises claim 1 reading as follows:

"1. A composition for use as a paper making filler comprising calcium carbonate treated with a cellulose derivative, wherein the calcium carbonate is a precipitated calcium carbonate and the cellulose derivative is sodium carboxymethyl cellulose."

Claim 1 of the set of 4 claims according to the first auxiliary request reads as follows:

"1. A composition for use as a paper making filler comprising an aqueous slurry of water and 5 to 75 wt% based on the weight of water and calcium carbonate of precipitated calcium carbonate treated with 0.01 to 5% by weight based on the weight of dry calcium carbonate of a cellulose derivative, wherein the cellulose derivative is sodium carboxymethyl cellulose."

VI. In the oral proceedings the Board submitted that each claim 1 according to the main and the auxiliary request, respectively, contravened the requirements of Article 123(3) EPC since claim 1 of the patent as granted related to a composition comprising calcium carbonate **containing a cellulose derivative thereon** whilst the wordings of each amended claim 1 according to the main and to the first auxiliary requests related to a composition comprising calcium carbonate **treated with a cellulose derivative**.

VII. The Appellant submitted in the oral proceedings that the skilled person, by taking into account the wordings of the product claim 1 and the method claim 8 as granted and the description of the patent in suit, would have interpreted the wordings "calcium carbonate containing a cellulose derivative thereon" of granted

claim 1 and "calcium carbonate treated with a cellulose derivative" of amended claim 1 to have the same meaning.

Therefore each claim 1 according to the main and the auxiliary requests complied with the requirements of Article 123(3) EPC.

VIII. The Appellant requests that the decision under appeal be set aside and that the patent be maintained on the basis of the claims 1 to 5 of the main request or of claims 1 to 4 of the first auxiliary request as filed during oral proceedings.

The Respondents did not submit any request in writing.

Reasons for the Decision

1. *Main request*

1.1 According to Article 123(3) EPC, the claims of a European patent may not be amended during opposition proceedings in such a way to extend the protection conferred.

Claim 1 as granted related to a composition comprising calcium carbonate **containing a cellulose derivative thereon.**

The wording of the newly amended claim 1 according to the main request relates to a composition comprising calcium carbonate **treated with a cellulose derivative.**

The Board had thus to examine if this amended claim complies with all the requirements of the EPC and therefore with the requirements of Article 123(3) EPC also.

- 1.2 The Board finds that the skilled person would have understood the wording "calcium carbonate **containing a cellulose derivative thereon**" in claim 1 as granted to require that calcium carbonate contained some cellulose derivative linked or bound in some way on its surface.

On the other hand, the skilled person would understand the wording "calcium carbonate **treated with a cellulose derivative**" in claim 1 according to the main request as requiring that the calcium carbonate has been treated with a cellulose derivative.

It is thus to be examined if these different wordings have the same meaning and if claim 1 according to the main request has the same or a different scope than claim 1 as granted.

- 1.3 The Board notes that the granted method claim 8, though relating to the production of paper including the treatment of calcium carbonate with a cellulose derivative to provide **treated calcium carbonate** (see point I above), did not refer back to the product of claim 1 which related to a composition comprising calcium carbonate **containing a cellulose derivative thereon**.

Therefore, since the wordings of the granted claims 8 and 1 with regard to the calcium carbonate were different, it cannot be concluded on the basis of their

wordings alone that they related to identical calcium carbonates, i.e. that the wordings "carbonate treated with a cellulose derivative" and "carbonate containing a cellulose derivative thereon" had the same meaning in the context of the patent as granted.

Moreover, by taking into consideration the description of the patent in suit, the skilled person would have noted that it contained mostly references to calcium carbonate **treated with** a cellulose derivative and described some not limitative suitable treatment methods (see e.g. paragraphs 01, 012, 014 to 016, 019, 022, 025 to 028 and the examples of the patent in suit). Moreover paragraph 026 taught that the specific methods described in paragraphs 022 to 025 provided a calcium carbonate having (and thus "comprising") specific amounts of cellulose derivative thereon.

Therefore, in the Board's view, there was a clear indication in the description of the patent in suit that the specific treatment methods described therein led to calcium carbonate comprising specific amounts of cellulose derivative thereon but that a generic treatment as claimed in granted claim 8, not comprising the essential process features of these specific methods of the description, might not necessarily result in such a product.

Therefore, also by taking into account the description, it is not possible to consider the wordings "carbonate treated with a cellulose derivative" of granted claim 1 and "carbonate comprising a cellulose derivative thereon" of claim 1 according to the main request as having the same meaning.

1.4 The wording of claim 1 according to the main request thus encompasses in the Board's view calcium carbonate which has been modified in an unspecified way by means of a cellulose derivative, thereby including carbonate not containing the cellulose derivative bound or linked on its surface as required by claim 1 as granted.

Therefore, the Board finds that the scope of claim 1 according to the main request is broader in scope than that of claim 1 as granted.

Moreover, even though the granted method claim 8, directed to a method of producing paper, involved the use of a "carbonate treated with a cellulose derivative", its scope was more limited than that of claim 1 as granted directed to the treated carbonate as physical entity.

Therefore, the scope of claim 1 according to the main request is also broader in scope than that of claim 8 as granted.

The Board concludes that claim 1 according to the main request contravenes the requirements of Article 123(3) EPC.

2. *First auxiliary request*

Since claim 1 according to the first auxiliary request comprises the wording "calcium carbonate treated with... a cellulose derivative", the same arguments submitted with regard to the main request apply *mutatis mutandis* to the first auxiliary request.

Order

For these reasons it is decided that:

The appeal is dismissed.

The Registrar:

The Chairman:

G. Rauh

P.-P. Bracke