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**Datasheet for the decision
of 6 August 2009**

Case Number: T 1355/07 - 3.3.10

Application Number: 02735954.6

Publication Number: 1404775

IPC: C09K 3/00

Language of the proceedings: EN

Title of invention:

Anti-corrosive pigments and method for making the same

Applicant:

Pigmentan Anticorrosive Pigments For Paints Ltd.

Headword:

Anti-corrosive pigments/PIGMENTAN

Relevant legal provisions:

EPC Art. 123(2)
EPC R. 139

Keyword:

"Main request: Admissibility of correction (no) - not immediately evident that nothing else would have been intended - correction proposed not directly and unambiguously derivable"

"Auxiliary requests 1 and 2: Amendments (not allowable) - alleged basis for amendment in itself inconsistent and ambiguous"

Decisions cited:

G 0011/91

Catchword:

-



Case Number: T 1355/07 - 3.3.10

D E C I S I O N
of the Technical Board of Appeal 3.3.10
of 6 August 2009

Appellant: Pigmentan Anticorrosive Pigments For Paints
Ltd.
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Decision under appeal: Decision of the Examining Division of the
European Patent Office posted 1 March 2007
refusing European patent application
No. 02735954.6 pursuant to
Article 97(1) EPC 1973.

Composition of the Board:

Chairman: R. Freimuth
Members: J. Mercey
F. Blumer

Summary of Facts and Submissions

I. The appeal lodged on 10 May 2007 lies from the decision of the Examining Division dated 1 March 2007 refusing European patent application No. 02735954.6 with the European publication No. 1 404 775 and International publication No. WO 02/099002.

II. Claim 1 of the set of claims underlying the main request of the contested decision read as follows:

"An anti-corrosive pigment comprising a metal salt comprising a metal cation and an anion; and a metal compound having at least one oxygen atom; wherein the molar ratio of the total metal to said anion is in the range of 4:1 to 120:1; wherein said metal is Magnesium (Mg), Calcium (Ca), Iron (Fe), or any combination thereof."

III. The Examining Division found that the amendment made to the then pending main request and first auxiliary request, namely the reversal of the molar ratio of from 1:4 to 1:120 to from 4:1 to 120:1, did not meet the criteria for a correction under Rule 88 EPC 1973 (now Rule 139 EPC 2000) and thus extended beyond the content of the application as filed, thus contravening the provisions of Article 123(2) EPC. The subject-matter of the then pending second, third and fourth auxiliary requests was found to lack clarity and to be insufficiently disclosed.

IV. With a letter dated 11 July 2007, the Appellant (Applicant) submitted a main request, which was identical to the main request on which the decision under appeal was based. With a letter dated 23 July 2009, the Appellant submitted a second auxiliary request which it renumbered as auxiliary request 1 at the oral proceedings before the Board held on 6 August 2009, and at these oral proceedings before the Board, it submitted auxiliary request 2, said requests superseding any previous auxiliary request. Claim 1 of auxiliary request 1 read as follows:

"An anti-corrosive pigment comprising a metal salt comprising a metal cation and an anion; and a metal compound having at least one oxygen atom; wherein the molar ratio of the total metal to said anion in water is in the range of 18:1 to 100:1 when dissolving to equilibrium 10 g of the dried pigment in 100 mL distilled water at 25 °C and measuring the quantities of the total metal and anion in the water; wherein said metal is Magnesium (Mg), Calcium (Ca), Iron (Fe), or any combination thereof."

Claim 1 of auxiliary request 2 read as follows:

"An anti-corrosive pigment comprising magnesium phosphate and magnesium oxide; wherein the molar ratio of the total magnesium to said phosphate in water is 18:1 when dissolving to equilibrium 10 g of the dried pigment in 100 mL distilled water at 25 °C and measuring the quantities of the total metal and anion in the water."

V. The Appellant argued that the amendment made in claim 1 of the main request that the molar ratio of the total metal to said anion was in the range of 4:1 to 120:1, was merely a correction of the ratio given in claim 1 as originally filed of 1:4 to 1:120. It was evident that the original ratio was in error, since there were several discrepancies between this ratio and the experimental data provided in the application as filed. More particularly, since claim 1 related to a pigment comprising a metal salt comprising a metal cation and an anion and a metal compound having at least one oxygen atom, then it was not chemically possible for 120 moles of anion to be present for each mole of metal. In addition, according to the Declaration by Professor Magdassi filed with letter dated 11 July 2007, the process for making the pigments described on page 10, lines 5 to 8 of the application as filed always resulted in the metal cation being in excess of the phosphate anion. Furthermore, page 10, lines 8 to 10 of the application as filed specifically referred to an excess of magnesium oxide or magnesium hydroxide *vis-à-vis* magnesium phosphate in the anti-corrosive pigment produced and Examples 11 and 12, together with Figures 2 and 3, showed molar ratios of magnesium anion to phosphate of above 100 to about 18, said values also being supported by the sentence on page 11, lines 30 to 31. In a case of lack of agreement between the theoretical description and the experimental data, the skilled person would understand that it is the experimental data on which the description should have been based. The Appellant also cited page 1, lines 27 to 29 and page 6, lines 29 to 30 of the application as filed in support of the fact that the original molar ratio was incorrect. Nothing else

other than the proposed correction, namely reversal of the ratio, could have been intended, since in view of the frequency that the numbers 4 and 120 occurred in the application as filed, it was obvious that the numbers as such must be correct, only their order could be wrong. Since this amendment to the molar ratio was merely an allowable correction of an obvious error, it did not infringe the prohibition of extension under Article 123(2) EPC.

With regard to auxiliary requests 1 and 2, the molar ratio of 18:1 to 100:1 was supported by page 11, lines 30 to 31, together with Examples 11 and 12 and Figures 2 and 3 of the application as filed.

- VI. The Appellant requested that the decision under appeal be set aside and a patent be granted on the basis of the main request filed with letter dated 11 July 2007 or, subsidiarily, on the basis of auxiliary request 1, filed as auxiliary request 2 with letter dated 23 July 2009, or on the basis of auxiliary request 2, filed at the oral proceedings before the Board.

- VII. At the end of the oral proceedings, the decision of the Board was announced.

Reasons for the Decision

1. The appeal is admissible.

Main request

2. *Amendments (Rule 139 EPC 2000 and Article 123(2) EPC)*

- 2.1 Claim 1 is derived from original claims 1 and 2, wherein the molar ratio of the total metal to anion has been amended from the range of 1:4 to 1:120 to the range of 4:1 to 120:1. The Appellant submitted that said amendment was merely the correction of an obvious error and thus did not infringe the prohibition of extension under Article 123(2) EPC.

- 2.2 Rule 139, second sentence, EPC 2000 (former Rule 88 EPC 1973) governs the present issue where the Appellant submits that an error occurred in the specification of the application as filed so that its text does not conform to what was intended and where it seeks to correct that error in order to bring the text into conformity with the intended wording.

In order for a correction under Rule 139, second sentence, EPC 2000 to be allowable in the description or in the claims, it must be established

(a) that an error is in fact present in the document filed with the EPO, and

(b) that the correction of the error is obvious in the sense that it is immediately evident that nothing else would have been intended than what is offered as the

correction (see G 11/91, OJ EPO 1993, 125, points 4 to 6 of the reasons).

2.3 With respect to the above requirement (a), the patent application must contain such an obvious error that a skilled person has no doubt that this information is not correct and - considered objectively - cannot be meant to read as such (see G 11/91, OJ EPO 1993, 125, point 5 of the reasons). In the present case, there is an inconsistency between the passage at page 10, lines 5 to 10, which refers to an excess of magnesium oxide or magnesium hydroxide *vis-à-vis* magnesium phosphate in the anti-corrosive pigment, and the molar ratio given in claim 1 as originally filed. Furthermore, the Appellant submitted that in a pigment comprising a metal salt comprising a metal cation and an anion and a metal compound having at least one oxygen atom, as defined in claim 1, it was not chemically possible for 120 moles of anion to be present for each mole of metal. The Board thus accepts that in view of these inconsistencies, the skilled person would have recognised that an error was present in the molar ratio given in the originally filed claim 1, such that it is not necessary for the Board to go into more detail on the remaining text passages cited by the Appellant (see point V above) in support of the fact that it was obvious that an error had occurred.

2.4 It remains to be considered whether the requested correction fulfils the above requirement (b), namely it must be shown that **nothing else** (emphasis added) would have been intended than what is offered as the correction (see G 11/91, *loc cit.*, points 2 and 6 of the reasons). In the present case, the Appellant

submitted that nothing else other than the proposed correction, namely reversal of the ratio, could have been intended, since in view of the frequency (11 times) that the numbers 4 and 120 occurred in the application as filed, it was obvious that the numbers as such must be correct, only their order could be wrong.

However, one cannot infer from the frequency with which the numbers occur that they must be correct, since to follow this line of argumentation would necessarily imply that the original ratio was itself in fact correct, which it is not. It is possible and plausible that one or both of the numbers 4 and 120 are incorrect. Even if these numbers as such were considered to be necessarily correct, as the Appellant argued, there were other plausible corrections possible which would still make technical sense, such as reversal of only one of the ratios to give a range of 1:4 to 120:1, or insertion of a decimal point in one or more of the numbers, such as 1:0.4, thereby embracing pigments wherein the total metal was in excess and no longer those wherein 120 moles of anion to metal were present.

- 2.5 Consequently, the correction proposed by the Appellant is not the only possible one which makes technical sense. It follows that the correction is not obvious in the sense that it is not immediately evident that nothing else would have been intended than what is offered as the correction, i.e. that the second criterion for a correction within the terms of Rule 139 EPC 2000 is not met.

- 2.6 The amendment made to claim 1, having no basis in the application as filed, results in subject-matter extending beyond the application as filed, contrary to the requirements of Article 123(2) EPC, with the consequence that the main request is not allowable.

Auxiliary requests 1 and 2

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

- 3.1 In order to determine whether or not an amendment offends against Article 123(2) EPC, it has to be examined whether technical information has been introduced which a skilled person would not have directly and unambiguously derived from the application as filed.

- 3.2 In claim 1 of both auxiliary requests 1 and 2, the molar ratio of the total metal to anion has been amended to include the ratio of 18:1. The Appellant argued that support for said ratio was to be found at page 11, line 32, together with Figure 2 of the application as filed.

- 3.3 However, the embodiment of the invention described in the paragraph from page 11, line 27 to page 12, line 7, said passage describing Figure 2, although indeed indicating at page 11, line 32 that "the molar ratio of Mg^{+2} /phosphate in equilibrium [...] was reduced after the 10th equilibrium step to approximately 18", goes on to specify that "The molar ratio of Mg^{+2} /phosphate at steady state is about 1:18 meaning that for each molecule of Mg^{+2} there are 18 molecules of phosphate". Thus two diametrically opposed, mutually exclusive

features are specified within a single paragraph, both purporting to define one and the same embodiment of the invention. The former, namely the molar ratio of 18:1, is supported by Figure 2 in combination with page 5, lines 22 to 23 of the application as filed, and the latter, namely the molar ratio of 1:18, has the added emphasis of being written out in words and is supported by original claims 24 and 25, as well as falling under the molar ratio of the total metal to anion of 1:4 to 1:120 specified in original claim 1. Since this embodiment of the invention described in the paragraph bridging pages 11 and 12 is in itself inconsistent, the disclosure of this embodiment is ambiguous and thus cannot form a basis for any amendment specifying a particular molar ratio. As a consequence, technical information has been introduced into claim 1 of both requests which a skilled person would not have directly and unambiguously derived from the application as filed.

- 3.4 The Board concludes that claim 1 of auxiliary requests 1 and 2 is amended in such a way that subject-matter extending beyond the application as filed is added, contrary to the requirements of Article 123(2) EPC, with the consequence that auxiliary requests 1 and 2 are not allowable.

Order

For these reasons it is decided that:

The appeal is dismissed.

The Registrar:

The Chairman:

C. Rodríguez Rodríguez

R. Freimuth