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**Datasheet for the decision
of 17 July 2014**

Case Number: T 2461/12 - 3.3.09

Application Number: 01946876.8

Publication Number: 1185579

IPC: C08J3/215, C08J3/22

Language of the proceedings: EN

Title of invention:
POLYMERS CONTAINING MODIFIED PIGMENTS AND METHODS OF PREPARING
THE SAME

Patent Proprietor:
CABOT CORPORATION

Opponent:
Evonik Degussa GmbH

Headword:

Relevant legal provisions:
EPC Art. 100(c), 111(1)

Keyword:
Grounds for opposition - added subject-matter (no)
Remittal to the department of first instance - (yes)

Decisions cited:

Catchword:



**Beschwerdekammern
Boards of Appeal
Chambres de recours**

European Patent Office
D-80298 MUNICH
GERMANY
Tel. +49 (0) 89 2399-0
Fax +49 (0) 89 2399-4465

Case Number: T 2461/12 - 3.3.09

**D E C I S I O N
of Technical Board of Appeal 3.3.09
of 17 July 2014**

Appellant: CABOT CORPORATION
(Patent Proprietor) Two Seaport Lane,
Suite 1300
Boston, Massachusetts 02210-2019 (US)

Representative: Grünecker, Kinkeldey,
Stockmair & Schwanhäusser
Leopoldstrasse 4
80802 München (DE)

Respondent: Evonik Degussa GmbH
(Opponent) Paul-Baumann-Strasse 1
45764 Marl (DE)

Representative: Evonik Degussa GmbH
Intellectual Property Management
Patente und Marken
Standort Marl
Bau 1042 / PB 15
Paul-Baumann-Strasse 1
45764 Marl (DE)

Decision under appeal: **Decision of the Opposition Division of the
European Patent Office posted on 30 October 2012
revoking European patent No. 1185579 pursuant to
Article 101(3) (b) EPC.**

Composition of the Board:

Chairman: W. Sieber
Members: N. Perakis
K. Garnett

Summary of Facts and Submissions

- I. Mention of the grant of European patent No 1 185 579 in the name of Cabot Corporation was published on 9 September 2009 (Bulletin 2009/37). The patent was granted with 16 claims, with claim 1 reading as follows:

"1. A method of preparing a polymer composition comprising at least one polymer and at least one modified pigment having attached at least one organic group, wherein said method comprises introducing at least one slurry containing at least one modified pigment having attached at least one organic group to an aqueous-based polymer solution to form a mixture (*sic*); wherein said aqueous based polymer solution has not been dewatered; and dewatering said mixture to form the polymer composition."

- II. Notice of opposition had been filed by Evonic Degussa GmbH on the grounds that the claimed subject-matter was neither novel nor inventive (Article 100(a) EPC), and that the European patent did not disclose the invention in a manner sufficiently clear and complete for it to be carried out by a person skilled in the art (Article 100(b) EPC).

During the oral proceedings of 13 September 2012 the opponent raised a fresh ground for opposition against the granted claims, namely that it extended beyond the content of the application as filed (Article 100(c) EPC). The opposition division admitted this late-filed ground for opposition into the proceedings because it considered this ground to be *prima facie* relevant.

III. By a decision announced orally on 13 September 2012 and issued in writing on 30 October 2012 the opposition division revoked the patent on the ground that neither the main request (claims as granted) nor auxiliary requests 1-12 were allowable in view of Article 100(c) EPC.

The opposition division held that the combination of the features "at least one modified pigment having attached at least one organic group" and "an aqueous-based polymer solution" in claim 1 of the main request (and present in all other requests) was not directly and unambiguously derivable from the application as filed.

IV. On 20 November 2012 the patent proprietor (in the following: the appellant) filed an appeal against the decision of the opposition division and paid the appeal fee on the same day. The statement setting out the grounds of appeal was filed on 11 March 2013, including auxiliary requests 1-13. The appellant requested that the decision of the opposition division be said aside and that the patent be maintained as granted. As an auxiliary measure, it requested a decision on the ground for opposition under Article 100(c) EPC and the remittal of the case to the department of first instance for consideration of the ground for opposition under Article 100(a) EPC, namely novelty and inventive step.

The appellant argued as follows:

The opposition division was wrong in deciding that the granted claim 1 did not directly and unambiguously derive from the combination of original claim 1 with

the disclosure on page 3, lines 13 to 14, of the application as filed.

Original claim 1 was one of six independent claims each directed to a different method of preparing a polymer composition. Original claim 1 could be combined with the feature disclosed on page 3, lines 13-14, of the application as filed.

The disclosure on page 3, lines 13 to 14, was placed at the beginning of the part of the description entitled "detailed description of the present invention". It was immediately after the final part of the "summary of the invention" which disclosed that both the forgoing general description and the following detailed description were exemplary and explanatory only and were intended to provide further explanation of the present invention. The disclosure of page 3, lines 13 to 14 generally referred to the claimed methods. Thus the feature that the modified pigment had attached to it at least one organic group was a preferred embodiment of each of the claimed processes including that of original claim 1. Consequently claim 1 of the main request was clearly supported by the combination of original claim 1 and the disclosure on page 3, lines 13 to 14.

V. No reply was filed on behalf of the opponent (in the following: the respondent).

By letter of 10 April 2013 the previous representative of the respondent merely informed the board that he no longer represented his client. Consequently, any further correspondence should be directly sent to the respondent's patent department.

- VI. In an official communication dated 28 April 2014 the board indicated that on the present state of the file it was minded to decide in favour of the appellant as regards the objection under Article 100(c) EPC raised against the main request and to remit the case to the opposition division for further prosecution. Since, however, this did not seem possible without oral proceedings in view of the appellant's main request that the board maintain the patent as granted and its further request to hold oral proceedings, the appellant was requested to clarify its requests regarding oral proceedings.
- VII. By letter of 7 May 2014, the appellant requested remittal of the case to the opposition division for consideration of the requirements of Articles 54 and 56 EPC. It also withdrew its request for oral proceedings provided that the opponent refrained from requesting oral proceedings.
- VIII. The respondent did not file any reply or request.

Reasons for the Decision

1. The appeal is admissible.
2. Ground for opposition under Article 100(c) EPC
 - 2.1 The decision of the opposition division concerning the main request, ie the claims as granted, is limited to its compliance with Article 100(c) EPC.
 - 2.2 Granted claim 1 (see point I above) is based on claim 1 as filed with the additional feature that the modified pigment has "attached at least one organic group". This

further specification of the modified pigment is the only feature which did not form part of claim 1 as originally filed.

- 2.3 The decision under appeal did not dispute that the further specification of the modified pigment was disclosed in the application as filed at page 3, lines 13 to 14:

"The present invention relates to methods of preparing polymer compositions containing modified pigments, wherein the modified pigment has attached at least one organic group".

However, the opposition division held in the second paragraph of page 4 of the decision that claim 1 as filed and the disclosure on page 3, lines 13 to 14 could not be combined, and thus did not provide a basis for the wording of claim 1 as granted.

- 2.4 The board disagrees for the following reasons:

- 2.4.1 The application as filed discloses six independent claims directed to methods of preparing a polymer composition comprising at least one polymer and at least one modified pigment (see claims 1, 5, 6, 7, 8 and 9 as filed). It is true that claims 1, 5 and 7 as filed do not require the presence of at least one organic group whilst the other independent claims do.

- 2.4.2 However, the last sentence of the chapter entitled "SUMMARY OF THE INVENTION" on page 3, lines 8-10 of the application as filed states:

"It is to be understood that both the foregoing general description and the following detailed description are

exemplary and explanatory only and are intended to provide further explanation of the present invention as claimed."

Two lines further down from the heading "DETAILED DESCRIPTION OF THE PRESENT INVENTION" is then the above cited passage that "the present invention relates to methods of preparing polymer compositions containing modified pigments, wherein the modified pigment has attached at least one organic group". The use of the plural form in the term "methods" directly and unambiguously discloses that the feature that the modified pigment has attached to it at least one organic group generally applies to each of the originally claimed methods, including the method of claim 1.

- 2.4.3 The fact that modified pigments having attached to them at least one organic group are indeed preferred in the originally claimed methods is also apparent from the application as a whole. A large part of the description (ie page 4, line 11 to page 6, line 23 of the application as filed) describes the various organic groups and methods for attaching them to the pigment in great detail. Thus, there can be no doubt for the skilled reader that the cited passage on page 3, lines 13 to 14 relates to all disclosed process variants.

This conclusion is also not invalidated by the passage on page 3, lines 27 to 33 of the application as filed, which describes specific modified carbons products (ie pigments) that can be used as such or can have an organic group attached thereto (page 3, lines 31 to 32). Similar statements can be found in the following two paragraphs describing also specific

modified carbon products. Because independent claims 1, 5 and 7 as filed did not require the presence of an organic group attached to the pigment, such a disclosure is within the ambit of the methods as originally filed. Nevertheless, granted claim 1 requires now a modified pigment having attached to it at least one organic group. In this context the board notes that the corresponding paragraphs [0023] to [0025] in the patent specification have not been adapted properly.

2.4.4 The opposition division also held that claim 1 as granted resulted from the combination of features of two separate embodiments amounting to an unallowable intermediate generalisation (also this part of the decision, namely page 4, 3rd and 4th paragraphs, is not entirely clear to the board). However, in view of the above conclusion that claim 1 as filed and the cited passage on page 3 provide a clear basis for claim 1 as granted there is no need to elaborate on this issue.

2.5 In summary, the board thus concludes that claim 1 as granted is directly and unambiguously disclosed in the application as filed.

3. Remittal

The decision under appeal exclusively dealt with the ground for opposition under Article 100(c) EPC, whereas grounds for opposition under Articles 100(a) and 100(b) EPC had been raised by the respondent.

Since the appellant has requested the remittal of the case to the opposition division for consideration of the requirements of Articles 54 and 56 EPC, the board, exercising the discretionary power contained in

Article 111(1) EPC, decides to remit the case to the opposition division for further prosecution.

Order

For these reasons it is decided that:

1. The decision under appeal is set aside.
2. The case is remitted to the opposition division for further prosecution on the basis of the granted claims.

The Registrar:

The Chairman:



B. Atienza Vivancos

W. Sieber

Decision electronically authenticated