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**Datasheet for the decision  
of 22 July 2014**

**Case Number:** T 2111/13 - 3.2.05  
**Application Number:** 07811991.4  
**Publication Number:** 2026978  
**IPC:** B41M3/14, B42D15/00, B42D15/10  
**Language of the proceedings:** EN

**Title of invention:**

Reflective features with co-planar elements and process for making them

**Applicant:**

Cabot Corporation

**Headword:**

**Relevant legal provisions:**

EPC 1973 Art. 113, 84, 54, 116  
EPC 1973 R. 67  
EPC Art. 123(2)

**Keyword:**

Right to be heard - substantial procedural violation (yes)  
Clarity - main request (no)  
          - auxiliary request (yes)  
Novelty - auxiliary request (yes)  
Remittal to the department of first instance (yes)  
Reimbursement of the appeal fee (no)

**Decisions cited:**

J 0010/07, T 0951/92, T 0848/93, T 1221/97, T 0004/00,  
T 0838/02, T 0304/08, T 1384/08

**Catchword:**



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Case Number: T 2111/13 - 3.2.05

**D E C I S I O N**  
**of Technical Board of Appeal 3.2.05**  
**of 22 July 2014**

**Appellant:** Cabot Corporation  
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Boston MA 02210-2019 (US)

**Representative:** Marco Serravalle  
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**Decision under appeal:** **Decision of the examining division of the  
European Patent Office posted on 26 July 2013  
refusing European patent application No.  
07811991.4 pursuant to Article 97(2) EPC.**

**Composition of the Board:**

**Chairman:** M. Poock  
**Members:** O. Randl  
G. Weiss

## Summary of Facts and Submissions

I. The appellant (applicant) appealed against the decision of the examining division by which European patent application No. 07 811 991.4 was refused on the grounds that the subject-matter of claim 1 of the main request (filed on entry into the regional phase before the EPO) and of the auxiliary request (filed with a letter of 20 June 2013) lacked clarity and novelty.

II. The appellant requested that the decision under appeal be set aside and that a patent be granted on the basis of the main request, filed on entry into the regional phase before the EPO, on 4 December 2008, or the auxiliary request, filed with letter of 12 June 2014. Alternatively, it was requested that the decision be set aside and the case remitted to the examining division. Oral proceedings were requested in case the board would not grant any of these requests. The appellant also requested the reimbursement of the appeal fee.

III. In the present decision, reference is made to the following documents:

D1 EP-A-1 422 070;

D3 WO 03/038002.

IV. Claim 1 of the main request reads:

"1. A process for forming a reflective feature, the process comprising direct write printing an ink comprising metallic nanoparticles onto a substrate surface in a design, the design comprising a first element at least partially coplanar with a second element."

V. The following aspects of the examining proceedings leading to the impugned decision are relevant:

In a first communication claim 1 was said to comprise one single step, namely "direct write printing an ink onto a substrate". The remaining features of the claim were said not to be limiting. All the claims on file were said to lack clarity (Article 84 EPC 1973). The steps of a process for forming a reflective feature appeared to be standard steps of printing.

In its response, the appellant objected to the examining division's interpretation of the claims and explained that claim 1 was both novel and inventive over document D1.

On 13 February 2013 the examining division summoned the applicant to attend oral proceedings to be held on 25 June 2013. In the annex to the summons the examining division maintained its objections. The examining division stated: "Due to the very broad wording of claim 1, the subject-matter of claim 1 reads on to many printing processes and is not novel within the meaning of Article 54 EPC". It was argued that although the specific examples of document D1 referred to screen printing, the general disclosure of paragraph [0020] merely referred to printing and, therefore, also covered direct printing. The step of direct printing as an alternative to screen printing was a matter of design choice and could not define an invention. Document D1 also disclosed "metal powder pigment", which qualified as nanoparticles. The novelty objection was maintained.

It its reply dated 24 May 2013 the appellant pointed out that the novelty objection contradicted the Guidelines for examination, according to which a generic disclosure could not take away the novelty of a specific example, and that the metallic particles of document D1 did not qualify as nanoparticles. The appellant also argued that the requirements of Article 84 EPC were met and that the claims on file were inventive. It then requested a new communication pursuant to Article 94(3) EPC and pointed out the possibility of Article 113 EPC being violated if the examining division were to refuse the application based on new arguments or grounds.

A telephone interview took place on 3 June 2013 in which the examiner refused the request for a new communication. According to the "Result of consultation" dated 6 June 2013, the examiner pointed out that the subject-matter of claim 1 was to be interpreted as a process **suitable** for forming a reflective feature. She also expressed the conviction that claim 1 was so broadly worded that it lacked novelty over "for example any ink jet printing process which prints two letters on a piece of paper" and that inks comprising metallic nanoparticles were known, as cited in the search report of the parallel application cited (US 2007/281136 or WO 2008/024542). The "Result of consultation" also contains a footnote that was not discussed on the phone, in which the examiner drew the attention of the representative to the Guidelines F-IV 4.13, last paragraph. The date for the oral proceedings was maintained.

On 19 June 2013, i.e. six days before the oral proceedings, the examining division sent a fax to the

appellant, which consisted essentially of the following statement:

*"Pursuant to the conversation of the 3rd June 2013, the attention of the Applicant is drawn to the document cited in the search report WO 03/038002 (D3) and, in particular, page 1, whole page, page 8, lines 1 and 2 and page 10, lines 1 to 3." ("Brief Communication" dated June 19, 2013)*

In its reply dated 20 June 2013, the appellant pointed out that there had not been any objection based on document D3 so far, requested a postponement of the oral proceedings and announced that it would not attend the oral proceedings were they to be held as scheduled. An auxiliary request was filed at the same time.

The oral proceedings were held on 25 July 2013 in the absence of the appellant. The application was refused on the ground that claim 1 of both requests on file was *"neither novel ... over generally known direct write printing processes, inter alia (sic) the printing processes disclosed in the prior art documents D1 or D3, nor [did] it satisfy the requirements of Article 84 EPC ..."* (Minutes of the oral proceedings, point 3).

VI. The examining division *inter alia* gave the following reasons for the decision:

Claim 1 of the main request comprised one single step, namely "direct write printing an ink onto a substrate". Based on the Guidelines F IV 4.13, the process was said to be merely a process suitable for forming a reflective feature. The limitation related to the nature of the ink and the design to be printed were said not to be steps of the process. As claim 1

attempted to define the invention by physical features of the ink and the resulting process, it was unclear.

Any direct write printing fell within the scope of claim 1. Ink jet printing was suitable for printing an ink comprising metallic nanoparticles, as attested by document D3, and for printing two elements on a sheet. Therefore, claim 1 was not novel over an ink jet printing process and read on the disclosure of documents D3 and D1.

VII. In support of its requests (see point II. above), the appellant submitted the following in its statement of grounds of appeal:

Its right to be heard had been violated by the examining division. As the appellant did not participate in the oral proceedings, the refusal of the application was based on arguments and evidence on which it did not have an opportunity to comment.

Also, the argument concerning lack of novelty was very vague. The appellant's argument according to which a generic disclosure could not destroy the novelty of a specific example was not taken into consideration.

The appellant also cited decision T 951/92 (OJ EPO 1995, 202) and argued that it had been insufficiently informed of the essential legal and factual reasons on which the refusal was based.

Regarding the clarity objection, the appellant contested the interpretation of the Guidelines F-IV 4.13 by the examining division and pointed out that its reading of claim 1 was incorrect.



Moreover, claim 1 was novel over document D3 because this document was directed at the preparation of conductive features; there was no reference to a reflective effect. Also, the specific type of the reflective feature as defined in claim 1 was not disclosed.

Claim 1 was also novel over document D1, which did not disclose direct write printing and ink comprising nanoparticles.

- VIII. Upon enquiry by the board, the appellant withdrew its request for oral proceedings if the only subject to be discussed was the request for reimbursement of the appeal fee.
- IX. The board issued a communication pursuant to Rule 100(2) EPC in which it raised a clarity objection regarding the expression "in a design" in claim 1 of both requests on file and invited the applicant to amend the claim in order to make it clear. The board also announced that it would order a remittal to the first instance if the amended claims then complied with Article 84 EPC 1973 and Article 123(2) EPC.
- X. In its response the applicant filed a new auxiliary request comprising an amended claim 1 in which the expression "in a design" was replaced by the expression "to form a design". The applicant stated that it did not request oral proceedings if the board found the main request or the auxiliary request to comply with Article 84 EPC 1973.

## Reasons for the Decision

1. The application under consideration was filed on 31 May 2007; therefore, according to Article 7 of the Act revising the EPC of 29 November 2000 (Special edition No. 4 OJ EPO, 217) and the Decision of the Administrative Council of 28 June 2001 on the transitional provisions under Article 7 of the Act revising the EPC of 29 November 2000 (Special edition No. 4 OJ EPO, 219), Articles 54 (1), (2), 84 and 113 EPC 1973 apply in the present case.
  
2. Alleged violations of the right to be heard, Article 113 EPC 1973

The appellant argues that its right to be heard has been violated in several respects.

- 2.1 First, the appellant points out that "*[s]ince [it] did not participate to the Oral Proceedings, the examining division refused the application based on an argument and an evidence on which [it] did not have opportunity to comment, in clear violation of Art. 113 EPC*" (Statement of grounds of appeal, p. 4, second paragraph).

As already mentioned above (point V. of the Summary of Facts and Submissions), six days before the oral proceedings, the examining division sent a fax to the applicant, drawing its attention to certain passages of document D3 disclosing the use of inks containing metal nanoparticles for ink-jet printers. No objection based on these passages was expressed. In its decision refusing the application, the examining division then

stated that claim 1 of the main request was not novel over document D3 (Reasons for the decision No. 12.3).

Although the examiner had not raised an explicit novelty objection based on these passages of document D3, such an objection should not have been a surprise to the applicant, because document D3 and in particular passages were cited as a novelty destroying disclosure. The examining division could have provided a more explicit objection but this shortcoming does not constitute a procedural violation.

- 2.2 The appellant also argued that its right to be heard had been violated because the examining division did not take into account its arguments and explain why they were not considered convincing (Statement of grounds of appeal, page 4, fourth paragraph).

The alleged vagueness of the argument concerning lack of novelty is related to the broad interpretation of claim 1 by the examining division. However, the appellant is correct in pointing out that its argument that D1 only contained a generic disclosure but not a specific disclosure of, say, inkjet printing had been ignored. The examining division ought to have addressed that point when maintaining its objection raised in the summons to oral proceedings at point 3 (Reasons for the impugned decision No. 12.4). The absence of any discussion of this argument constitutes a procedural violation.

- 2.3 The appellant also cited decision T 951/92 (*loc. cit.*) and argued that it had not been informed of the essential legal and factual reasons on which the

finding of non-compliance was based (Statement of grounds of appeal, page 5, paragraph 2 et seq.).

As has already been stated, claim 1 of both requests before the examining division were found not to comply with Article 84 EPC 1973 and to lack novelty over any disclosure of inkjet printing and hence over documents D3 and D1.

The examining division had already stated that claim 1 did not meet the requirements of Article 84 EPC 1973 in its Communication pursuant to Article 94(3) EPC dated 9 January 2012. Lack of novelty over document D1 was asserted in the Annex to the summons to oral proceedings dated 13 February 2013. Thus the applicant was informed of each requirement of the EPC which was considered as not being met. Apart from the objection of lack of novelty over document D3, which has already been discussed under point 2.1 above, the applicant knew the legal and factual reasons that led the examining division to refuse the application, and it had the opportunity to comment on them. The fact that the examining division referred to certain documents cited in parallel cases without actually using them to the detriment of the applicant cannot possibly qualify as a violation of the applicant's right to be heard. The board, therefore, judges that the appellant's assertion of an additional violation of its right to be heard is unfounded.

### 3. Claim interpretation

#### 3.1 The correct interpretation of claim 1 is of crucial importance for this case.

- 3.2 According to the examining division (page 4 of the decision under consideration), "[a]s given in the Guidelines F-IV 4.13 final paragraph, the process of claim 1 on file is merely a process **suitable** for forming a reflective feature." (emphasis of the examining division)
- 3.3 The preceding paragraph of the Guidelines refers to decision T 848/93 where it is said that in a process claim the use feature is to be understood as a functional process feature comparable in category with the other (steps of) the process (Reasons No. 3.2; see also T 1384/08, Reasons No. 5.1.3 et seq.)
- 3.4 The passage of the Guidelines to which the examining division has referred in the impugned decision is based on decision T 304/08 of 26 August 2009. The deciding board found that the purpose of the method under consideration ("for reducing malodor associated with a disposable absorbent product intended for the absorption of body fluids") could not be regarded as a functional technical feature. The present board agrees that this intended purpose cannot be said to define features of implicit process steps. In the present case, however, the intended purpose of the method ("forming a reflective feature") is of a different nature and does indeed define a process step consisting in forming a reflective feature on the substrate surface. Therefore, the reasoning of decision T 304/08 (and the passage of the Guidelines based on it) is not applicable.
- 3.5 The feature "... comprising metallic nanoparticles" is not part of the intended purpose ("for forming a reflective feature") but part of the claimed process as such ("... comprising direct write printing an ink

comprising metallic nanoparticles") and further defines the ink to be used in the printing step.

3.6 Therefore, the board judges that the examining division was wrong in ignoring the purpose of the process claim as well as the particular nature of the ink when assessing the novelty of the process claim.

4. Clarity (Article 84 EPC 1973)

4.1 Main request

Claim 1 defines a direct printing process for forming a reflective feature by using ink containing metal nanoparticles. The board is unable to endorse the examining division's objection according to which claim 1 did "not clearly define all the essential steps of a process for forming a reflective feature" (Point 1.1 of the communication pursuant to Article 94(3) EPC dated 9 January 2012; Reasons No. 11.1 of the impugned decision). The examining division did not explain which essential steps were missing, nor does the board see any.

It should also be noted that it is not because a claim is broad that it necessarily lacks clarity.

The examining division also stated that the attempt to define the invention by physical features of an ink and of the resulting product was not a clear definition and failed to comply with the requirements of Article 84 EPC 1973.

The main purpose of Article 84 EPC 1973 is to ensure that the subject-matter for which protection is sought is clearly defined, so that the skilled person reading

the claim knows what exactly is covered by the claim. The examining division has not explained why the limitation of a printing method by physical features of the ink used and the design printed would create uncertainty in the mind of the skilled person as to the scope of protection of the claim, nor does the board see any good reason. The skilled person would understand that only direct printing methods using certain inks and resulting in certain designs are encompassed in the scope of protection.

Therefore, the board judges that the clarity objections raised by the examining division are unfounded.

This notwithstanding, the board of appeal finds the feature "... in a design ..." of claim 1 to lack clarity. It is not clear from the wording of the claim as such whether the design is the result of the direct write printing (i.e. whether "in" is to be understood as "such as to form") or whether the design is pre-existent to the printing and the printing is performed on a surface that is found within a design (i.e. "into" the design). However, a claim has to be clear in itself. Therefore, claim 1 of the main request does not comply with the requirements of Article 84 EPC 1973.

#### 4.2 Auxiliary request

In claim 1 of the auxiliary request the expression "in a design", which the board had found to be ambiguous, has been replaced by the expression "to form a design". It is, therefore, clear that the design is the result of the direct write printing. As a consequence, the board has no clarity objections regarding claim 1 of the auxiliary request.

5. Article 123(2) EPC

In view of the disclosure on page 3, lines 1-2, page 22, lines 19-22 and page 21, lines 16-19 of the application as filed, the board is satisfied that the amendment meets the requirements of Article 123(2) EPC.

6. Novelty (Article 54 EPC 1973)

6.1 Based on its different interpretation of claim 1, the examining division reached the conclusion that claim 1 of the main request lacked novelty.

6.2 Document D1 discloses a process for forming a reflective feature, the process comprising printing an ink comprising metallic particles ("metal powder pigment", see e.g. claim 8) onto a substrate surface in/to form a design, the design comprising a first element at least partially coplanar with a second element. This has not been contested by the appellant.

Claim 1 differs from the process disclosed in document D1 in that the process comprises direct write printing of ink and in that the metallic particles are nanoparticles. Document D1 discloses the use of various printing methods such as offset, intaglio or screen printing (see e.g. paragraph [0150]) but does not disclose the use of direct write printing. As already mentioned, document D1 discloses the use of "metal powder pigment", but there appears to be no disclosure that the pigments comprise nanoparticles, i.e. particles of a size below one micrometer. The examining division has not established that metal powder pigments necessarily contain metallic nanoparticles. As a consequence, the subject-matter of claim 1 is novel over document D1.



6.3 Document D3 discloses ink-jet inks containing metallic nanoparticles for use in ink jet printing onto a substrate (see, for instance, claim 1), which can be paper (see claim 18). It is said in document D3 (*inter alia* at the end of the first paragraph) that "[u]sing the present invention, decorative and conductive patterns can be obtained" (emphasis added). When examining the novelty of the subject-matter of claim 1 over document D3, based on a correct interpretation of the claim, it will have to be discussed whether it is possible to imagine such decorative patterns not always having reflective effects to some extent.

7. Remittal to the first instance (Article 111(1) EPC 1973)

The appellant has requested the board to remit the case to the examining division, and the board indeed considers this to be the most appropriate course of action, in order for the examining division to be able to consider the outstanding issues of novelty and, as the case may be, inventive step based on the correct interpretation of claim 1.

8. Composition of the examining division

The appellant has requested the board to order that a new examining division be set, "in view of the hostile attitude of the present examining division". As a matter of fact, nothing in the procedure allows the board to detect such a hostile attitude.

Be that as it may, the board cannot allow this request, as the boards of appeal do not have any power regarding the designation of the division responsible for the

further prosecution of the case in case of a remittal. The allocation of duties within the departments of first instance is an administrative function within the competence of the responsible director (see, for instance, decisions T 1221/97 of 13 October 1998 and T 838/02 of 29 January 2003).

9. Oral proceedings (Article 116 EPC 1973)

The appellant has only requested oral proceedings in case the board would neither grant a patent on the basis of the main or auxiliary request, nor set aside the decision and remit the case to the examining division. As the board has decided to set aside the decision and remit the case, there is no need to hold oral proceedings, all the more as the appellant has confirmed, upon enquiry by the board, that the request for oral proceedings was withdrawn if the only question to be discussed was the reimbursement of the appeal fee.

10. Reimbursement of the appeal fee (Rule 67 EPC 1973)

Only Rule 67 EPC 1973 is the legal basis for the reimbursement of the appeal fee. Although the content of the relevant legal basis under the Implementing Regulations to EPC 1973, Rule 67, was incorporated in identical form into Rule 103(1)(a) EPC 2000, Rule 67 EPC 1973 is applicable here. Amended Rules are applicable to pending cases if they are linked to an amended article contained in the list of amended articles to be applied to pending cases; see Article 2, first sentence, of the decision of the Administrative Council of 7 December 2006 amending the Implementing Regulations of the EPC 2000, Special edition No. 1 of OJ EPO 2007, 89; decision of the Administrative Council

of 28 June 2001, *loc. cit.* and J 10/07, OJ EPO 2008, 567, Reasons No. 7. Rule 103(1)a) EPC is linked to Articles 109 and 111 EPC which have remained unchanged as to the substance, with only minor editorial amendments. Both Articles are not mentioned in the decision of the Administrative Council. Consequently, Rule 67 EPC 1973 is applicable in the present case.

This rule provides that the reimbursement of appeal fees shall be ordered ... where the board of appeal deems an appeal to be allowable, if such reimbursement is equitable by reason of a substantial procedural violation.

As mentioned above (points 3.1 and 3.2), the board has judged that the examining division has violated the appellant's right to be heard by ignoring an argument of the appellant regarding the novelty objection based on document D1.

However, the novelty objection based on D1 was not the only novelty objection and it is clear from the decision (and from the annex to the summons to oral proceedings) that the examining division had come to the conclusion that any inkjet printing process destroyed the novelty of claim 1.

Therefore, the appellant would have had to appeal, regardless of said violations of its right to be heard.

The boards of appeal have dealt with such situations in different ways.

According to the established case law of the boards of appeal, as summarised in Case Law of the Boards of Appeal, 7th edition, September 2013, section IV-

E-8.5.1, for the reimbursement of the appeal fee to be equitable the boards require a causal link between the substantial procedural violation and the filing of the appeal. When there is no such causal link, as in the present case, the reimbursement of the appeal fee is not equitable.

An alternative approach is to consider that a procedural violation is not to be deemed substantial if the outcome of the proceedings would not have been different had the violation not occurred (see, for instance, decision T 4/00 of 17 January 2003, Reasons No. 2.6).

The present board sees no need to choose between these approaches. It comes to the conclusion that under the circumstances of the present case there is no justification for the reimbursement of the appeal fee.

Therefore, the appellant's request for reimbursement of the appeal fee is dismissed.

## **Order**

### **For these reasons it is decided that:**

1. The decision under appeal is set aside.
2. The case is remitted to the examining division for further prosecution on the basis of the auxiliary request filed on 12 June 2014.
3. The request for reimbursement of the appeal fee is refused.

The Registrar:

The Chairman:



D. Meyfarth

M. Poock

Decision electronically authenticated