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Bezeichnung der Erfindung: Photo-polymerizable light-sensitive resin
Title of invention: composition and light-sensitive sheet material
Titre de l'invention :

Klassifikation / Classification / Classement : G03C 1/68

ENTSCHEIDUNG / DECISION

vom / of / du 23 February 1990

Anmelder / Applicant / Demandeur :

Patentinhaber / Proprietor of the patent /
Titulaire du brevet :

ARAI, Tokuji, et al

Einsprechender / Opponent / Opposant :

Hoechst Aktiengesellschaft

Stichwort / Headword / Référence : Resin composition/ARAI

EPÜ / EPC / CBE Articles 69, 84, 100

Schlagwort / Keyword / Mot clé :

"Novelty, inventive step (affirmed)" -
"Amendment to text of granted patent not
admissible if not arising out of grounds for
opposition."

Leitsatz / Headnote / Sommaire



Case Number : T 59/88 - 3.3.2

D E C I S I O N
of the Technical Board of Appeal 3.3.2
of 23 February 1990

Appellant : HOECHST AKTIENGESELLSCHAFT, Frankfurt (Main)
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Decision under appeal : Decision of the Opposition Division of the European Patent Office posted 7 January 1988 rejecting the opposition filed against European patent No. 0 035 574 pursuant to Article 102(2) EPC.

Composition of the Board :

Chairman : P. Lançon
Members : S. Schödel
R. Schulte

Summary of Facts and Submissions

- I. European patent No 35 574 was granted with fifteen claims on 6 February 1985 in response to application No. 80 901-622.3 filed as international patent application No. PCT/JP80/00198 on 28 August 1980 and published under No. WO 81/00626.

Claim 1 was worded as follows:

"A photopolymerizable radiation-sensitive resin composition comprising a styrene-maleic acid copolymeric resin, one or more ethylenic compounds having a molecular weight of 150 or more, a boiling point, under normal pressure, of 100°C or more, and at least one acryloyl or methacryloyl group; and a photopolymerization initiator, characterized in that it contains in addition one or more ethylenic compounds having a molecular weight of 150 or more, a boiling point, under normal pressure, of 100°C or more, at least one acryloyl or methacryloyl group, and a terminal hydroxyl group and that the photopolymerization initiator comprises benzil and dimethyl amino benzaldehyde."

Claims 2 to 8 were dependent on Claim 1. Claims 9 to 15 related to a radiation-sensitive sheet material comprising a support and a layer of a photopolymerizable radiation-sensitive resin composition, the latter being identical to that in Claim 1.

- II. Notice of opposition was filed by the Appellants who requested that the patent be revoked owing to lack of inventive step in the light of three documents ((1) DE-A-2 420 409, (2) DE-B-2 044 233, (3) DE-B-1 267 547). Objections were also raised under Articles 83, 84 and 69(1) EPC.

III. In the decision dated 7 January 1988 the Opposition Division rejected the opposition and maintained the patent unamended, acknowledging that the subject-matter as patented met the requirements of novelty, inventive step and feasibility. Neither (1) nor (2) nor (3) disclosed photopolymerisable resin-compositions comprising benzil (B) and dimethyl amino benzaldehyde (DAB) as initiators. Although (B) was, inter alia, mentioned in (1) and (3), there was no suggestion that the said component be used simultaneously with DAB. The Article 84 and 69 objections did not need to be considered since they did not constitute grounds for opposition under Article 100 EPC.

IV. Notice of appeal was lodged by the Appellants on 3 February 1988, the appeal fee being paid on the same day. A statement of grounds was submitted on 5 May 1988.

The Appellants pointed out that their opposition was based solely on Article 100(a) EPC, in which the term "subject-matter of the European patent" implied that the terms used in the claims should be interpreted in the description.

The statements in the description (cf. page 7, lines 29-34) suggested that Claim 1 comprised not only compositions having a combination of B and DAB as an initiator, but also compositions containing B or DAB separately. If B was present as the sole initiator, the embodiment was no longer novel. The Opposition Division had not tackled this problem.

In reply the Respondents took exception to this sophisticated approach, but nevertheless submitted a set of amended Claims 1 to 15 and a description modified accordingly.

In the communication dated 25 October 1989 under Article 110(2) EPC the parties were informed that the Board, after deliberation, had reached the following conclusion:

- ~~(a)~~ Insofar as the appeal referred to Article 100(a) EPC, the cited prior art did not affect the novelty of the subject-matter of the claims. The claimed photopolymerisation initiator clearly comprised only two compounds, i.e. B and DAB.
- (b) The Board did not share the Appellants' opinion that the wording of Claims 1 and 9 would be unclear in this respect and could give rise to a misinterpretation in the light of the description. There was no need for any clarification, the wording of the claims being unambiguous.
- (c) Objections with regard to clarity and the interpretation of the scope of the protection conferred did not constitute grounds for opposition within the meaning of Article 100 EPC and could not form the basis of this appeal.
- (d) The appeal was to be prosecuted on the basis of the patent in its granted form.

While the Respondents went along with the Board's intention, the Appellants emphasized that the text of the present description on page 7 and the use of the term "... comprises ..." in Claim 1 showed that the claim was not restricted to the combination of the two photo-initiators. Amendments to that claim and to the description were necessary to avoid any misinterpretation which could influence the decision on issues under Article 100 EPC (cf. T 127/85, OJ EPO 1989, 271).

A European patent was subject to the laws of the Contracting States for which it was granted. These States had different legal systems and traditions. The granting of legally valid and clearly defined protective rights could, in the case of infringement, prevent different interpretations of the extent of the protection conferred.

- V. The Appellants requested that the patent be revoked (main request) or partially revoked (auxiliary request) for the reasons given. The request for oral proceedings was no longer maintained.

The Respondents requested that the patent be maintained as granted.

Reasons for the Decision

1. The appeal complies with Articles 106-108 and Rule 64 EPC and is therefore admissible.
2. The patent in suit relates to a photopolymerizable radiation-sensitive resin composition and a radiation-sensitive sheet material comprising a layer of such composition, which are suitable for use in the preparation of identity cards or similar cards having an encapsulated image.
3. Insofar as the appeal refers to Article 100(a) EPC, the Appellants have put forward no grounds which could challenge the patentability of the claims as granted (Articles 54, 56 EPC). In the absence of new facts or evidence the Board does not see any reason in the present circumstances to question other points of its own motion. The objections raised, in fact, relate to Article 84 EPC.

4. The Appellants allege that the wording of the present Claims 1 and 9 is unclear. In particular, the term "... comprises B and DAB" when read in conjunction with the description implied that they might also cover an embodiment containing B and one containing DAB in addition to the said two-component initiator. The relevant passages in the description on page 7, lines 29 to 34 are worded as follows:

".. they (i.e. B and DAB) are optionally combined and used (..) and

".. a combination of the photopolymerisation initiators is preferred ..".

As the variant containing B was not considered patentable (cf. point III and point IV, paragraph 3), this embodiment should clearly be eliminated from the present Claims 1 and 9 prior to a decision on issues under Article 100 EPC. The request for amendment of the claims and the description in the present case was justified in the light of decision T 127/85 (OJ EPO 1989, 271).

This line of argument is not convincing.

In the Board's judgement, Claims 1 and 9 are ambiguous neither in respect of the technical terms used nor the literal sense of the text. Concerning the definition of the photopolymerisation initiator, which is criticised, the examples and comments in the description tell the skilled person that nothing else could be meant than the joint use of B and DAB. On page 7, lines 37 to 46, it is clearly stated that ".. a practically effective sensitivity cannot be obtained, if each of B and DAB is added separately to the composition, while a very fast rate of photopolymerisation can be attained if B and DAB are used in combination and furthermore, if they are combined at a

specific ratio ..", that ".. the .. resin composition of the present invention can be kept stable for a remarkably long duration .., if a combination of B and DAB is used as the photopolymerisation initiator .." and that ".. the notably excellent results, which were obtained, when B and DAB were used in combination, could not be obtained when other combinations are used." For these reasons the term ".. comprising .." in the claims cannot be understood in the present case as an open-ended definition.

On the basis of a proper interpretation of the granted claims, there is no need for any amendment either of the claims or of the description.

This is in line with decisions of the Boards of Appeal, according to which amendments which do not arise out of the grounds for opposition set out under Article 100 EPC are considered inappropriate and unnecessary (cf. T 127/85, OJ EPO 1989, 271; T 295/87 *ibid* 10; T 406/86, *ibid*, 302).

Therefore the patent in suit had to be maintained in the granted form and the appeal be dismissed.

5. The Appellants' annotations on the conduct of the grant procedure before the EPO, and on problems which may arise if unclear European patents are granted and the scope of protection conferred depends on interpretation by national authorities have been placed on record (cf. T 175/84, OJ EPO 1989, 71).

Order

For these reasons, it is decided that:

The appeal is dismissed.

The Registrar:


M. Beer

The Chairman:


P. Lançon