



Case Number : T 273/90 - 3.3.1

D E C I S I O N
of the Technical Board of Appeal 3.3.1
of 10 June 1991

Appellant :
(Opponent)

Hoechst AG Werk Kalle-Albert
Zentrale Patentabteilung
Postfach 3540
D-6200 Wiesbaden 1

Respondent :
(Proprietor of the patent)

PPG Industries, Inc.
One PPG Place
Pittsburgh
Pennsylvania 15272 (US)

Representative :

Hann, Michael, Dr.
Dr. H.-G. Sternagel
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D-5060 Bergisch Gladbach

Decision under appeal :

Interlocutory decision of the Opposition Division
of the European Patent Office of 2 November 1989,
posted on 31 January 1991 concerning maintenance
of European patent No. 107 098 in amended form.

Composition of the Board :

Chairman : K. Jahn
Members : P. Krasa
J. Stephens-Ofner

Publication in the Official Journal ~~Yes~~ / No

File Number: T 273/90 - 3.3.1
Application No.: 83 109 730.8
Publication No.: 107 098
Title of invention: Novel pigment grinding vehicle

Classification: C07C 103/44

D E C I S I O N
of 10 June 1991

Proprietor of the patent: PPG INDUSTRIES, INC.

Opponent: HOECHST AG

Headword: Pigment grinding vehicle/PPG

EPC Article 102(3); Rule 67

Keyword: "Maintenance of the European patent in amended form" - "Incomplete adaptation of description to amended claims" - "Substantial procedural violation (no)"

Headnote

Summary of Facts and Submissions

I. This appeal lies from the interlocutory decision of the Opposition Division of 2 November 1989 with written reasons posted on 31 January 1990 maintaining the European patent 107 098, as amended in the course of oral proceedings which took place on 2 November 1989.

II. The only passage of the amended independent Claim 1 which is relevant to the sole issue before the Board relates to the definition of amine to be incorporated into the material concerned. This passage reads as follows:

"... and the amine is an amine containing an organic group which contains an acyclic moiety of at least 12 carbon atoms, ...".

In this amended definition "12 carbon atoms" replaces the former wording of the claim as granted "8 carbon atoms".

The same amendments are to be found in independent Claim 11 and in dependent Claims 6, 7 and 8.

In the above-mentioned oral proceedings the Respondents also submitted consequential amendments on pages 2 to 11 of the description where the figure "8" was replaced accordingly by "12" in several passages. This was the only amendment submitted by them.

III. The appeal was received on 3 April 1990 together with the appeal fee and the statement of grounds of appeal. The Appellants request the description of the disputed patent to be adapted completely to the amended claims. Their basic argument in support of this request can be understood to be that while the scope of protection conferred by a European

patent is determined by the terms of the claims according to Article 69(1) EPC the description and the drawings are also to be used in the interpretation of such claims. A description which is not brought completely in line with the amended claims would give rise to legal uncertainty and therefore result in claims which contravened Article 84 EPC, (relevant under Article 102(3) EPC).

The Appellants submit that the same amendments as already made are necessary additionally on page 2, line 51 and on page 3, line 45.

The Appellants further request the reimbursement of the appeal fee under Rule 67 EPC on the ground of a substantial procedural violation namely the omission of the Opposition Division to effect all necessary consequential amendments in addition to those specifically requested by the Respondents.

- IV. The Respondents agreed to the suggested amendments with their submission received on 7 September 1990 and submitted simultaneously an amended specification and amended claims; they request maintenance of the patent in suit on the basis of these documents.

Reasons for the Decision

1. For an appeal to be admissible it is necessary (Article 107 EPC) for the Appellants to be adversely affected by the impugned decision. This requirement is met - see paragraph III above - because the possible remaining presence of legal uncertainty in the construction of the claims (Article 84 EPC) could be damaging to the Appellants' commercial interests. In this connection it is not necessary for the Board to give a definite judgment on the presence/absence of such legal uncertainty.

2. The suggested amendments are clearly allowable under Article 123 EPC. This not being contested, no further comments are necessary.
3. According to Rule 67 EPC the reimbursement of the appeal fee can only be ordered if the appeal is allowable and if such reimbursement seems to be equitable because of a substantial procedural violation.

Having regard to all the circumstances of this case, the Board cannot accept that the course of action adopted by the Opposition Division in amending the description only to the extent requested by the Respondents and not specifically objected to by the Appellants amounts to a substantial procedural violation under Rule 67 EPC.

4. No other reasons against the maintenance of the patent as amended were either submitted or can be identified.

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 with the order to maintain a patent on the basis of the documents submitted on 7 September 1990.
3. The request for reimbursement of the appeal fee is dismissed.

The Registrar:

The Chairman:

E. Görgmaier

K. Jahn