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D E C I S I O N
of 16 March 1999

Case Number: T 0083/97 - 3.3.4

Application Number: 88111159.5

Publication Number: 0300335

IPC: C14C 11/00

Language of the proceedings: EN

Title of invention:

A method of finishing hide, leather, and like fibrous substrates

Patentee:

Conceria Conti S.p.A.

Opponent:

Bayer AG, Leverkusen Konzernverwaltung RP Patente Konzern

Headword:

Finishing hide and leather/CONCERIA CONTI

Relevant legal provisions:

EPC Art. 54, 111(1)

Keyword:

"Novelty (yes)"
"Remittal to first instance - yes"

Decisions cited:

T 0326/87

Catchword:

-



Case Number: T 0083/97 - 3.3.4

D E C I S I O N
of the Technical Board of Appeal 3.3.4
of 16 March 1999

Appellant: Conceria Conti S.p.A.
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Respondent: Bayer AG, Leverkusen
(Opponent) Konzernverwaltung RP
Patente Konzern
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Decision under appeal: Decision of the Opposition Division of the
European Patent Office posted 6 December 1996
revoking European patent No. 0 300 335 pursuant
to Article 102(1) EPC.

Composition of the Board:

Chairman: U. M. Kinkeldey
Members: D. D. Harkness
C. Holtz

Summary of Facts and Submissions

I. The appeal lies from the decision of the opposition decision to revoke European patent No. 0 300 335 for lack of novelty of the subject matter of claims 1, 2 and 4, and lack of inventive step for the subject matter of claim 3, being the claims of a request filed on 9 March 1995. These claims read as follows:

"1. A method for finishing hide, leather and the like fibrous substrate and for upgrading split leather according to the so called transfer technique using a supporting web of release paper onto which a thin layer of an aqueous polyurethane emulsion has been applied, the polyurethane of said emulsion being obtained from an isocyanate prepolymer comprising a glycol repeating unit, characterised in that the said isocyanate prepolymer has a number-average molecular weight in the 1500 to 3200 range and in that said glycol repeating unit contains at least one acid polar group.

2. A method according to claim 1 characterised in that the polyurethane concentration in said aqueous emulsion is within the range of 25% to 50% by weight.

3. A method according to claim 2, characterised in that said aqueous emulsion is additivated with 5% to 15% by weight of glycol ether based on the water weight to obtain a water/glycol ether azeotrope.

4. An aqueous emulsion of a polyurethane for finishing hide, leather and the like fibrous substrates and for upgrading split leather, characterised in that it includes a water/glycol ether azeotropic mixture and a polyurethane in an amount of 25% to 50% by weight,

obtained from an isocyanate prepolymer comprising a glycol repeating unit, which contains at least one acid polar group, and having a number-average molecular weight within the range of 1500 to 3200."

II. The relevant document cited under Articles 54 and 56 EPC was:

(1) DE-A-2 144 878.

III. The main points of the opposition division's arguments were that:

Document (1) related to a method for coating leather and textiles with an aqueous polyurethane emulsion being obtained from an isocyanate prepolymer comprising a glycol repeating unit. This aqueous polyurethane emulsion was applied to the leather of fibrous substrate according to the so called transfer technique using a supporting web of release paper onto which a thin layer of said aqueous polyurethane emulsion has been applied. From the composition specified in document (1) a number-average molecular weight of about 2800 could be calculated. The glycol repeating unit in the above isocyanate prepolymer contained at least one acid polar group. Consequently, all features of claim 1 under consideration were known from this document (1). It was conceded that in addition to the above mentioned polyurethane a solubilized casein was used in this prior art. However, claim 1 under consideration did not exclude the presence of other compounds in the aqueous polyurethane emulsion.

During oral proceedings, the proprietor of the patent-in-suit did not deny that all features of claim 1 could be found in cited documents (1) to (3), but that in his opinion one could not pick features from different places in each of said documents and combine these

features, thus arriving at the subject-matter of claim 1. In other words, the subject-matter of claim 1, in the combination of features claimed therein, would not be anticipated by the cited documents, including document (1). However, the features of claim 1 of the patent-in-suit were all disclosed in document (1) in interrelationship, in particular in Examples 2 and 3.

Consequently, having regard to document (1) the subject-matter of claim 1 was not novel contrary to Article 54(1) and (2) EPC.

Independent claim 4 was directed to an aqueous emulsion of a polyurethane for finishing hide, leather and the like fibrous substrates and for upgrading split leather, said emulsion being defined by the same features as discussed herein above with respect to claim 1, with the additional features that said emulsion included a water/glycol ether azeotropic mixture and a polyurethane in an amount of 25% to 50% by weight. As previously argued the features specified in claim 1 were known from document (1). This document also disclosed the use of glycolmonomethylether acetate as a solvent, said ether acetate being considered to be the glycol ether as defined in claim 4. In the prior art this solvent was not removed from the reaction product but remained therein till the mixture of all other ingredients, including water, was applied to the leather substrate using the so called transfer technique. In the course of the preparation of the polyurethane emulsion, which included a heating procedure, the resulting emulsion would apparently contain a water/glycol ether azeotropic mixture. This emulsion also contained a polyurethane in an amount of 36% by weight, i.e. within the range of 25% to 50% by weight as specified in claim 4 of the patent-in-suit

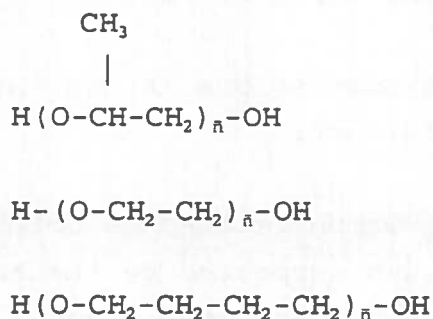
(page 11, line 21 of the document). Consequently, having regard to document (1) also the subject-matter of claim 4 was not novel contrary to Article 54(1) and (2) EPC.

The additional features of claim 2 being dependent on claim 1 and specifying the amount of polyurethane present in the emulsion were also known from document (1).

The additional features of claim 3 being dependent on claim 1 were not known from document (1) nor from any of the other documents. It was conceded that document (1) disclosed the presence of a water/glycol ether azeotrope in the emulsion. However, this document did not specify that the glycol ether was added to the polyurethane emulsion after preparation thereof as claimed in claim 3. However, after having learned from document (1) that the presence of a water/glycol ether azeotrope in the emulsion was advantageous in finishing leather, it would be obvious for a person skilled in the art to add the glycol ether to the polyurethane emulsion after preparation thereof. Consequently, the subject-matter of claim 3 would not meet the requirements of Article 56 EPC.

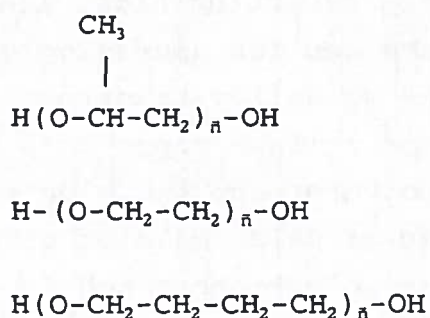
- IV. The appellant (patentee) lodged an appeal and submitted a statement of grounds with main and auxiliary requests.
- V. The respondent (opponent) replied to the appeal.
- VI. Oral proceedings were arranged for 16 March 1999 and during these proceedings a new main request which replaced all previous requests was filed. The independent claims 1 and 4 read as follows:

"1. A method for finishing hide, leather and the like fibrous substrate and for upgrading split leather according to the so called transfer technique using a supporting web of release paper onto which a thin layer of an aqueous polyurethane emulsion has been applied, the polyurethane of said emulsion being obtained from an isocyanate prepolymer obtained from a diisocyanate monomer, having the formula $\text{ONC-R}'\text{-NCO}$, where R' is selected from a group consisting of hexamethylene, isophorone, methylenedicyclohexyl, a polyether monomer selected from a group consisting of



where \bar{n} is in the 10 to 80 range, and a glycolic monomer containing at least one acid polar group, said isocyanate prepolymer having a number-average molecular weight in the 1500 to 3200 range."

"4. An aqueous emulsion of a polyurethane for finishing hide, leather and the like fibrous substrates and for upgrading split leather comprising 25% to 50% by weight of said polyurethane, characterised in that said polyurethane is obtained from an isocyanate prepolymer obtained from a diisocyanate monomer having the formula $\text{ONC-R}'\text{-NCO}$, where R' is selected from a group consisting of hexamethylene, isophorone, methylenedicyclohexyl, a polyether monomer selected from a group consisting of



where \bar{n} is in the 10 to 80 range, and a glycolic monomer containing at least one acid polar group, said isocyanate prepolymer having a number-average molecular weight within the range of 1500 to 3200."

VII. The appellant's submissions at oral proceedings can be summarised as follows:

The new request which related to both method and product claims was supported by the application as filed, in particular at pages 4 and 7 and claims 8 and 13. Also there was no broadening of the protection conferred because the amendments made were of a limiting nature having regard to the claims of the opposed patent. Accordingly the requirements of Article 123(2) and (3) EPC were met.

The subject-matter of the independent method and product claims 1 and 4 respectively was novel by virtue of the combination of the stated prepolymer components. Such a combination was not disclosed in any one of the prior art documents cited by the opponent. The subject-matter of the dependant claims 2, 3 and 5 was also novel since each comprised the novel feature from one of the independent claims.

VIII. The respondent agreed that the subject-matter of the new request met the requirements of Article 123(2) and (3) EPC. Whilst holding the opinion that the features of the prepolymer which characterised both independent

claims of the patent in suit were generally disclosed in document (1), he did not refer to any specific disclosure in (1) and finally accepted novelty for the claimed subject-matter.

- IX. The appellant requested that the decision under appeal be set aside and that the patent be maintained on the basis of claims 1 to 5 as submitted in the oral proceedings. In case the Board could not grant this request, the appellant requested that the case be remitted to the first instance.
- X. The respondent requested that the appeal be dismissed. In case that the Board could not grant this request, the respondent requested that the case be remitted to the first instance.

Reasons for the Decision

1. The appeal is admissible.
2. *Amendments, Article 123(2) and (3) EPC*

Having considered the amendments, in particular the glycol components of the prepolymer have been specifically defined and the word "comprising" replaced by "consisting of", in relation to the disclosure of the application as filed, the subject-matter of the claims of the granted patent and that of the request filed at oral proceedings, the Board is of the opinion that the amendments made are all based on the application as filed (page 4 first full paragraph) and are of a limiting nature vis-à-vis the claims of the opposed patent, thus ensuring that no extension of protection has taken place. The requirements of this article are therefore met and both the parties were also in agreement on this point.

3. *Novelty, Article 54 EPC*

The Board considered the disclosure of document (1) and determined that the prepolymers therein described are either polyester-polyglycol combinations or contain polyglycol components not conforming to the formulae prescribed by the patent in suit. Thus it came to the conclusion that the combination of components required to prepare the polyurethane prepolymer which is specified in the independent method and product claims of the patent in suit has not been disclosed in this prior art. Accordingly novelty is acknowledged for the subject-matter of the independent claims 1 and 4.

4. *Procedural matters*

4.1 The opposition division only addressed inventive step in respect of claim 3 of the request before them. Nevertheless, in the interest of providing an efficient procedure, the board declared itself in the oral proceedings prepared to decide also upon inventive step as regards the request filed in those proceedings. The board did so from the standpoint that the right to two instances may not in each and every procedural situation be an absolute right of the parties concerned and, since the parties had argued on inventive step.

4.2 Although the amended claims present a new case that the first instance has not yet examined, there may be merits in avoiding a remittal, especially if the patent application has been pending for a long time (the present patent application was filed in 1988, claiming priority from 1987). The board is aware that this opinion might go against a long-standing practice of the boards of appeal as regards remittal in order to ensure the parties' right to two instances, see for example decision T 326/87 (OJ EPO 1992, 522), and decisions mentioned in Case law of the Boards of Appeal

of the European Patent Office, 3rd edition 1998, page 491 ff. Under the established case law, a board would normally only decide all outstanding issues with the agreement of the parties. However, Article 111(1) EPC leaves an option open for the board to remit a case to the first instance, "the Board of Appeal may ... remit the case". It is therefore not mandatory for the appellate instance to remit every time a fresh case has been raised before it.

- 4.3 In view of the fact that both parties filed requests which were mutually incompatible and which left the board no margin for any procedural measure, in view of the long standing practice of the boards of appeal to recognise a right to two instances, and since it would have been a violation of Article 113 EPC to have given a final decision on all outstanding substantive matters against the requests of the parties who had had no advance warning of such a procedural possibility, the board finds that the case must be remitted to the first instance in accordance with Article 111(1) EPC.

Order

For these reasons it is decided that:

1. The decision under appeal is set aside.
2. The case is remitted to the first instance for further prosecution on the basis of claims 1 to 5 as submitted in the oral proceedings.

The Registrar:

The Chairwoman:

U. Bultmann

U. Kinkeldey

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