

Internal distribution code:

- (A) [] Publication in OJ
(B) [] To Chairmen and Members
(C) [X] To Chairmen

D E C I S I O N
of 7 June 2000

Case Number: T 1029/97 - 3.3.1

Application Number: 92304329.3

Publication Number: 0514159

IPC: C09D 11/00

Language of the proceedings: EN

Title of invention:
Ink for ink jet printing

Applicant:
XEROX CORPORATION

Opponent:
-

Headword:
Ink/XEROX

Relevant legal provisions:
EPC Art. 54, 111(1), 123(2)

Keyword:
"Novelty (yes) - after amendment"

Decisions cited:
-

Catchword:
-



Case Number: T 1029/97 - 3.3.1

D E C I S I O N
of the Technical Board of Appeal 3.3.1
of 7 June 2000

Appellant: XEROX CORPORATION
Xerox Square
Rochester
New York 14644 (US)

Representative: Grünecker, Kinkeldey,
Stockmair & Schwanhäusser
Anwaltssozietät
Maximilianstrasse 58
D-80538 München (DE)

Decision under appeal: Decision of the Examining Division of the
European Patent Office posted 17 July 1997
refusing European patent application
No. 92 304 329.3 pursuant to Article 97(1) EPC.

Composition of the Board:

Chairman: A. J. Nuss
Members: R. Freimuth
J. P. B. Seitz

Summary of Facts and Submissions

- I. The appeal lodged on 15 September 1997 lies from the decision of the Examining Division posted on 17 July 1997 refusing European patent application No. 92 304 329.3 (European publication No. 514 159).
- II. The decision was based on claims 1 to 8 filed on 3 August 1996 according to the then pending request. The Examining Division held that the subject-matter of claims 1 to 3 and 6 was not new in view of document (1) WPI 88-231 717, thus contravening Article 54(1) EPC.
- III. The Appellant (Applicant) submitted an amended set of claims 1 to 6 and a part of claim 7 together with the written statement setting out the grounds of appeal on 15 September 1997. He argued that the amendments now made to the claims overcame the objections raised in the decision under appeal.
- IV. In a communication pursuant to Article 110(2) EPC the Board informed the Appellant in particular that, considering unamended claims 3 and 6, these claims still appeared to cover subject-matter anticipated by document (1), thus not complying with the requirements of Article 54 EPC.
- V. In reply, the Appellant submitted on 20 April 2000 new claims 1 to 6, dropping former claims 3 and 6. He argued essentially that those claims as amended were restricted to subject-matter delimited from document (1), independent claims 1, 3 and 5 reading as follows:

"1. An ink composition comprising water, dye and at least one cosolvent, characterised in that said cosolvent is present in about 2% to about 40% by weight, in that the composition has a viscosity of about 1.6 to about 2.5 centipoise at 25°C, a surface tension of about 28 to less than about 35 dynes/cm, and in that said at least one cosolvent is selected from the group consisting of propylene carbonate, ethylene carbonate, 1-cyclohexyl-2-pyrrolidone, isopropanol, 1-methyl-2-pyrrolidone, 2-amino-2-methyl-1-propanol, methyl diethanol amine, pyrazole, benzyl alcohol, 1,3-dimethyl-2-imidazolidinone, propylene glycol monomethyl ether, dipropylene glycol monomethyl ether, tripropylene glycol monomethyl ether, propylene glycol mono-t-butyl ether, ethylene glycol ethyl ether acetate, ethylene glycol methyl ether acetate, ethylene glycol butyl ether, diethylene glycol butyl ether acetate, propylene glycol methyl ether acetate, dipropylene glycol methyl ether acetate, tripropylene glycol methyl ether acetate, and mixtures thereof.

3. An ink composition comprising a colorant, water and at least one cosolvent characterised by being free of surfactant, in that the cosolvent is present in an amount of about 2% to about 40% by weight based on total weight of the composition and is selected from the group consisting of propylene carbonate, ethylene carbonate, 1-cyclohexyl-2-pyrrolidone, 2-amino-2-methyl-1-propanol, pyrazole, benzyl alcohol, ethylene glycol ethyl ether acetate, ethylene glycol methyl ether acetate, ethylene glycol butyl ether, diethylene glycol monobutyl ether acetate, propylene glycol methyl ether acetate, dipropylene glycol methyl ether acetate, tripropylene glycol methyl ether acetate, and mixtures thereof.

5. An ink composition comprising an ink vehicle and a colorant, characterised by being free of surfactant and by further comprising diethylene glycol monobutyl ether and glycerol."

VI. The Appellant requested that the decision under appeal be set aside and the case be remitted to the first instance for further prosecution on the basis of claims 1 to 6 submitted on 20 April 2000.

Reasons for the Decision

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

The subject-matter of claim 1 is based on claims 1 and 2 as originally filed. The temperature of 25°C for measuring the viscosity is supported by page 4, line 3 of the application as filed. Claims 2 to 6 are backed up by claims 3, 5, 6, 8 and 9 as originally filed. The absence of a surfactant in claims 3 and 5 finds support on page 5, paragraph 4, lines 1 and 2, and page 6, paragraph 1, last line of the application as filed.

For these reasons, the Board concludes that the claims meet the requirements of Article 123(2) EPC.

3. *Novelty*

The only issue arising from this appeal is whether or not the subject-matter of the claims is novel over document (1), which is stated in the decision under appeal as being the sole ground for refusal of the

application.

Document (1) is directed to an ink composition comprising a water-soluble dye, a mixture of a polyhydric alcohol derivative and a polyhydric alcohol, and a surfactant. That document discloses specifically an ink composition wherein both diethylene glycol monobutyl ether and glycerol are contained in that mixture.

The compound diethylene glycol monobutyl ether has been deleted from the list of alternative cosolvents in claim 1 thereby delimiting the subject-matter of that claim from the disclosure of document (1). Claims 3 and 5 require the absence of a surfactant with the consequence that the ink compositions of document (1), which mandatorily comprise a surfactant, cannot anticipate the subject-matter of those claims.

For these reasons, the Board concludes that the subject-matter of independent claims 1, 3 and 5, and by the same token that of dependent claims 2, 4 and 6 referring to preferred embodiments within the ambit of those claims, is novel over document (1).

4. *Remittal*

It follows from the above, that by substantially amending the refused independent claims, the Appellant has overcome the objection pursuant to Article 54 EPC raised in the decision under appeal in respect to document (1). The examination not yet having been concluded, the Board exercises its power conferred to it by Article 111(1) EPC to remit the case to the Examining 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 first instance for further prosecution on the basis of claims 1 to 6 submitted on 20 April 2000.

The Registrar:

The Chairman:

N. Maslin

A. Nuss