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D E C I S I O N
of 25 May 2000

Case Number: T 0783/99 - 3.2.5

Application Number: 96201483.3

Publication Number: 0747232

IPC: B41M 5/00

Language of the proceedings: EN

Title of invention:
Thermal dye transfer system with receiver containing an acid moiety

Applicant:
EASTMAN KODAK COMPANY

Opponent:
-

Headword:
-

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

Keyword:
"Novelty (yes); remittal to the first instance"

Decisions cited:
-

Catchword:
-

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Case Number: T 0783/99 - 3.2.5

D E C I S I O N
of the Technical Board of Appeal 3.2.5
of 25 May 2000

Appellant: EASTMAN KODAK COMPANY
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Decision under appeal: **Decision of the Examining Division of the European Patent Office posted 26 February 1999 refusing European patent application No. 96 201 483.3 pursuant to Article 97(1) EPC.**

Composition of the Board:

Chairman: A. Burkhart
Members: W. R. Zellhuber
J. H. P. Willems

Summary of Facts and Submissions

I. The appellant lodged an appeal against the decision of the Examining Division refusing the application No. 96 201 483.3.

II. The Examining Division held that the application did not meet the requirements of Articles 52 and 54 EPC, because the subject-matter of claims 1 to 6, which were subject of the decision, was not novel having regard to the prior art as disclosed in document

D1: EP-A 0 273 307

and taking into consideration the common technical knowledge for the interpretation of the technical terms, in particular the term "acid modified polyester", used in document D1.

In support of its arguments, the Examining Division further referred to the following documents:

D2a: Ullmanns Encyklopädie der technischen Chemie, 4. Auflage, Band 22, page 619;

D2b: Ullman's Encyclopedia of Industrial Chemistry, 5th edition, volume A10, page 460 and

D3: EP-A- 0 384 989.

III. In the statement setting out the grounds of appeal, the appellant requested that the decision under appeal be set aside and the case be remitted to the first instance with the order to further proceed with the

material examination of the further requirements according to the EPC. He was of the opinion that the subject-matter of claims 1 to 6 was novel having regard to the prior art as disclosed in document D1.

As an auxiliary request, the appellant requested that the decision be set aside and the case be remitted to the first instance with the order to further proceed on the basis of amended claims filed together with the grounds of appeal.

IV. With a communication dated 10 January 2000, the Board announced the preliminary opinion that the subject-matter of independent claims 1 and 4 according to the main request and claim 3 according to the auxiliary request was not novel having regard to the prior art as disclosed in document D1.

The Board further referred to the following document cited in the application:

D4: US-A 4 137 042.

In its provisional opinion the Board found that the arguments brought forward by the appellant concerning the subject-matter of claims 1 and 4 according to the main request seemed not to be such as to refute the reasoning presented by the Examining Division.

V. In response hereto, the appellant submitted new claims and requested that the decision under appeal be set aside and the case be remitted to the first instance with the order to further proceed on the basis of the claims filed with a letter dated 29 March 2000.

He did not comment on novelty and inventive step of the claimed subject-matter.

The appellant requested oral proceedings only if the Board cannot decide favourably on the basis of the written submissions.

VI. The independent claims 1 and 3 according to the single request read as follows:

"1. A thermal dye transfer assemblage comprising:

(a) a dye-donor element comprising a support having thereon a dye layer comprising a dye dispersed in a polymeric binder, said dye being a deprotonated cationic dye which is capable of being reprotonated to a cationic dye having a N-H group which is part of a conjugated system, and

(b) a dye-receiving element comprising a support having thereon a polymeric dye image-receiving layer, said dye-receiving element being in a superposed relationship with said dye-donor element so that said dye layer is in contact with said polymeric dye image-receiving layer, said polymeric dye image-receiving layer containing an organic acid moiety comprising a sulfonic acid, a phosphonic acid or a phosphoric acid as part of the polymer chain which is capable of reprotonating said deprotonated cationic dye, said polymeric dye image-receiving layer comprising a polyester, an acrylic polymer or a styrene polymer."

"3. A process of forming a dye transfer image

comprising imagewise-heating a dye-donor element comprising a support having thereon a dye layer comprising a dye dispersed in a polymeric binder, said dye being a deprotonated cationic dye which is capable of being reprotonated to a cationic dye having a N-H group which is part of a conjugated system, and imagewise transferring said dye to a dye-receiving element to form said dye transfer image, said dye-receiving element comprising a support having thereon a polymeric dye image-receiving layer, said polymeric dye image-receiving layer containing an organic acid moiety comprising a sulfonic acid, a phosphonic acid or a phosphoric acid as part of the polymer chain which is capable of reprotonating said deprotonated cationic dye, said polymeric dye image-receiving layer comprising a polyester, an acrylic polymer or a styrene polymer."

Reasons for the Decision

1. *Novelty*

Document D1, which is regarded as representing the closest prior art, describes a thermal dye transfer assemblage from which the subject-matter of claim 1 differs in that the polymeric dye image-receiving layer contains an organic acid moiety **comprising a sulfonic acid, a phosphonic acid or a phosphoric acid** as part of the polymer chain.

Document D1 teaches the use of an acid modified polyester as an organic image receiving layer but does not describe the type of acid. In particular, document D1 does not disclose the use of **a sulfonic acid, a**

phosphonic acid or a phosphoric acid.

The documents D2a, D2b and D4 do not describe a thermal dye transfer assemblage comprising, in particular, a dye-receiving element comprising a support having thereon a polymeric dye image-receiving layer.

Document D3 does not disclose a dye layer wherein the dye is a deprotonated cationic dye which is capable of being reprotonated to a cationic dye having a N-H group which is part of a conjugated system.

Therefore, the subject-matter of claim 1 is novel. The same arguments apply to the subject-matter of process claim 3.

The dependent claims 2 and 4 relate to further embodiments of the subject-matter claimed in claims 1 and 3, respectively, and, therefore, the subject-matter of these claims is also novel.

2. *Inventive step*

The question of inventive step was not subject of the decision under appeal. In order to give the appellant the opportunity to have the issue of inventive step considered at two instances, the Board exercises its powers under Article 111(1) EPC to remit the application for further prosecution before the Examining Division.

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.

The Registrar: The Chairman:

A. Townend A. Burkhart