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**Datasheet for the decision
of 29 July 2008**

Case Number: T 1513/05 - 3.3.01

Application Number: 98963408.4

Publication Number: 1030893

IPC: C09D 5/04

Language of the proceedings: EN

Title of invention:

Thixotropic agent based on an alkyd resin

Patentee:

Akzo Nobel N.V.

Opponent:

CRAY VALLEY S.A.

Headword:

Thixotropic agent/AKZO NOBEL

Relevant legal provisions:

EPC Art. 123(3)

Relevant legal provisions (EPC 1973):

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Keyword:

"Main and sole auxiliary requests - amended claims extending the protection"

Decisions cited:

-

Catchword:

-



Case Number: T 1513/05 - 3.3.01

D E C I S I O N
of the Technical Board of Appeal 3.3.01
of 29 July 2008

Appellant: Akzo Nobel N.V.
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Respondent: CRAY VALLEY S.A.
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Decision under appeal: Decision of the Opposition Division of the
European Patent Office posted 5 December 2005
revoking European patent No. 1030893 pursuant
to Article 102(1) EPC 1973.

Composition of the Board:

Chairman: P. Ranguis
Members: C. M. Radke
D. S. Rogers

Summary of Facts and Submissions

- I. The proprietor appealed against the decision of the opposition division revoking the European patent no. 1 030 893.
- II. The opposition division decided that the patent in suit did not disclose the invention in a manner sufficiently clear and complete to be carried out by the skilled person, so that grounds under Article 100(b) EPC prejudiced the maintenance of the patent.
- III. The decision was based on the patent as granted including its claims 1 to 13. The independent claim 1 reads as follows:

"1. A thixotropic agent comprising the reaction product of an alkyd resin and a poly(ester)amide obtainable by reacting a polycarboxylic acid with a compound of the formula X_m-R-Y_n , wherein R stands for an organic group having at least 2 carbon atoms, X and Y may be the same or different and stand for a primary or secondary amino group or a hydroxyl group and m and n are each at least equal to 1, **characterised in that** at least 50 mole% of the polycarboxylic acid is a dimeric fatty acid having at least 36 carbon atoms, in at least 25 mole% of the compound of the formula X_m-R-Y_n R stands for a substituted or unsubstituted aromatic group having 6 to 18 carbon atoms and X and Y may be the same or different and stand for a primary or secondary amino group directly attached to the aromatic group, and in at most 75 mole% of the compound R stands for a substituted or unsubstituted aliphatic group having 2 to 54 carbon atoms, an araliphatic group having 7 to 18

carbon atoms and/or an aromatic or cycloaliphatic group having 6 to 18 carbon atoms, and which has thermal stability at a temperature of at least 45°C."

- IV. During the oral proceedings before the Board on 29 July 2008, the Appellant presented claims 1 to 8 of a new Main Request and claims 1 to 7 of a First Auxiliary Request, while abandoning all other sets of claims. He stated that these claims were identical to those of the second and third auxiliary requests filed with the letter dated 25 July 2008.

Claim 1 of the Main Request reads as follows:

"1. A thixotropic agent comprising the reaction product of an alkyd resin and a polyesteramide having a molecular weight M_w in the range of 800 to 20,000 and obtainable by reacting a polycarboxylic acid with a compound of the formula X_m-R-Y_n at a temperature between 160°C and 270°C, wherein R stands for an organic group having at least 2 carbon atoms, X and Y may be the same or different and stands for a primary or secondary amino group or a hydroxyl group and m and n are each at least equal to 1, characterised in that:

the molecular weight M_w of the alkyd resin to be reacted with the polyesteramide is at least 50,000;

at least 50 mole % of the polycarboxylic acid is a dimeric fatty acid having at least 36 carbon atoms,

wherein at least 50 mole % of the compound of the formula X_m-R-Y_n , is p-phenylene diamine, and wherein at most 50 mole % of the compound R stands for an aliphatic group having 2 to 54 carbon atoms, an araliphatic group having 7 to 18 carbon atoms and/or a cycloaliphatic group having 6 to 18 carbon atoms, and

which has thermal stability at a temperature of at least 45°C."

Claim 1 of the First Auxiliary Request reads as follows:

"1. A thixotropic agent comprising the reaction product of an alkyd resin and a polyesteramide having a molecular weight M_w in the range of 800 to 20,000 and obtainable by reacting a polycarboxylic acid with a compound of the formula X_m-R-Y_n at a temperature between 160°C and 270°C, wherein R stands for an organic group having at least 2 carbon atoms, X and Y may be the same or different and stands for a primary or secondary amino group or a hydroxyl group and m and n are each at least equal to 1, characterised in that:

the molecular weight M_w of the alkyd resin to be reacted with the polyesteramide is at least 50,000;

at least 50 mole % of the polycarboxylic acid is a dimeric fatty acid having at least 36 carbon atoms,

wherein at least 50 mole % of the compound of the formula X_m-R-Y_n , is p-phenylene diamine, and wherein at most 50 mole % of the compound is neopentyl glycol and

which has thermal stability at a temperature of at least 45°C."

- V. The Respondent argued that the Main Request and the First Auxiliary Request were filed late and that the amendments in the claims contravened the requirements of Article 123(2) and (3) EPC, inter alia because the word "aromatic" in claim 1 of the Main Request was deleted with respect to claim 1 as granted.

VI. The Appellant argued that the deletion of the word "aromatic" in claim 1 of the Main Request did not extend the scope of protection of claim 1 as the proportion of the aromatic radicals R was defined in claim 1 as granted by the requirement that "at least 25 mole% of the compound of the formula X_m-R-Y_n R stands for a substituted or unsubstituted aromatic group having 6 to 18 carbon atoms".

Also claim 1 of the First Auxiliary Request did not contravene the requirements of Article 123(3) EPC, as claims 4 and 6 as granted referred to at least 50 mole % of the compound of the formula X_m-R-Y_n being p-phenylene diamine, i.e. an aromatic diamine, whereas claim 7 as granted allowed the nonaromatic compound of the formula X_m-R-Y_n to be neopentyl glycol.

VII. The Appellant requested that the decision under appeal be set aside and that the case be remitted to the first instance for further prosecution under Article 100(a) EPC upon the basis of the claims of the Main Request or on the basis of the claims of the First Auxiliary Request, both filed during the oral proceedings on 29 July 2008.

The Respondent requested that the appeal be dismissed.

VIII. At the end of the oral proceedings the decision of the Board was announced.

Reasons for the Decision

1. The appeal is admissible.
2. *Late filed claims*

The boards of appeal have the discretion to accept amended claims at any stage of the opposition appeal proceedings, thus also during oral proceedings (see Article 13(1) of the Rules of Procedure of the Boards of Appeal).

The Board used its discretion to admit the claims of the Main Request and of the First Auxiliary Request since the new claims were not complex, so that their admission was not likely to lead to an undue delay of the appeal proceedings.

3. *Article 123(3) EPC*
 - 3.1 Claim 1 as granted relates to a thixotropic agent comprising the reaction product of an alkyd resin with a poly(ester)amide, where the latter is obtainable by reacting a polycarboxylic acid with a compound of the formula X_m-R-Y_n (see point III above).
 - 3.2 The characterising portion of said claim contains four features.

The third feature requires that

"in at most **75** mole% of the compound R stands for a substituted or unsubstituted aliphatic group having 2 to 54 carbon atoms, an araliphatic group having 7 to

18 carbon atoms and/or **an aromatic or** cycloaliphatic group having 6 to 18 carbon atoms" (Emphasis added).

Main Request

3.3 In claim 1 of this request, the third feature of the characterising portion of claim 1 as granted has been amended *inter alia* by deleting the words "an aromatic or" (see points III and IV above).

3.4 This deletion has the effect that claim 1 no longer defines an upper limit for, e.g., the combined relative amount of the aromatic and aliphatic groups R, i.e. that it can be up to 100 mole % of the groups R.

In contrast to this, claim 1 as granted ruled out that the combined relative amounts of the aromatic and aliphatic groups R exceeded 75 mole% (see the feature cited under point 3.2 above).

3.5 The Appellant referred to the second feature of the characterising portion of claim 1 as granted (see the Appellant's argument summarised in the first paragraph under point VI above). However, that second feature ("in at least 25 mole% of the compound of the formula X_m-R-Y_n ... aromatic group") requires that the radicals X and Y are amino groups; thus it only specifies the **polyamines** of said formula. In contrast to this, the third feature also allows X and Y to mean hydroxyl groups. Therefore, the Board cannot follow the Appellant's argument that the second feature of the characterising portion of claim 1 as granted further specifies the meanings of the aromatic radicals R indicated in the third feature.

- 3.6 Consequently, claim 1 of the Main Request has been amended in such a way as to extend the protection it confers, contrary to the requirements of Article 123(3) EPC.

First Auxiliary Request

- 3.7 Claim 1 of this request requires that

"at least 50 mole % of the compound of the formula X_m-R-Y_n , is p-phenylene diamine, and wherein at most 50 mole % of the compound is neopentyl glycol"

(see point IV above).

- 3.8 This feature of claim 1 allows p-phenylene diamine and neopentyl glycol to be the only compounds of the formula X_m-R-Y_n to be used to prepare the polyesteramide, i. e. that 100 mole % of the radicals R are aromatic (p-phenylene) or aliphatic (neopentanedyl) groups, whereas claim 1 as granted does not cover embodiments where more than 75 mole% of the radicals R are such groups (see point 3.5 above).

- 3.9 The Appellant referred to claims 4, 6 and 7 as granted as providing a basis for the feature cited under point 3.7 above (see the Appellant's argument summarised in the second paragraph under point VI above). However, these claims are dependent on claim 1 as granted which requires that "at most 75 mole% of the compound R stands for a substituted or unsubstituted aliphatic group having 2 to 54 carbon atoms, an araliphatic group having 7 to 18 carbon atoms and/or an

aromatic or cycloaliphatic group having 6 to 18 carbon atoms,". Thus, this feature of claim 1 as granted is also incorporated in claims 4, 6 and 7 as granted.

Hence, claim 1 of the First Auxiliary Request has been amended in such a way as to extend the protection it confers, contrary to the requirements of Article 123(3) EPC.

4. Consequently, the Appellant's requests, namely the Main Request and the First Auxiliary Request, do not meet the requirements of the EPC.

Order

For these reasons it is decided that:

The appeal is dismissed.

The Registrar:

The Chairman:

M. Schalow

P. Ranguis