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**Datasheet for the decision
of 22 September 2010**

Case Number: T 1931/07 - 3.3.06

Application Number: 98921076.0

Publication Number: 0981667

IPC: D21H 19/38

Language of the proceedings: EN

Title of invention:

Aragonitic precipitated calcium carbonate pigment for coating
rotogravure printing papers

Patentee:

MINERALS TECHNOLOGIES INC.

Opponent:

Solvay (Société Anonyme)

Headword:

Coated rotogravure papers/MINERALS TECHNOLOGIES INC.

Relevant legal provisions:

EPC Art. 123(2)(3)
RPBA R. 15(3)

Keyword:

"Extension of protection conferred - main request (yes)"
"Extension beyond original disclosure - first auxiliary
request (yes)"
"New objection in oral proceedings in absence of a party"
"Prohibition of reformatio in peius"
"Apportionment of costs (no)"

Decisions cited:

T 0341/92, T 0915/02

Catchword:

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Case Number: T 1931/07 - 3.3.06

DECISION
of the Technical Board of Appeal 3.3.06
of 22 September 2010

Appellant: MINERALS TECHNOLOGIES INC.
(Patent Proprietor) 405 Lexington Avenue
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Respondent: Solvay (Société Anonyme)
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Representative: Vande Gucht, Anne
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Decision under appeal: Interlocutory decision of the Opposition
Division of the European Patent Office posted
25 September 2007 concerning maintenance of
European patent No. 0981667 in amended form.

Composition of the Board:

Chairman: P.-P. Bracke
Members: E. Bendl
J. Geschwind

Summary of Facts and Submissions

I. The appeal lies from the decision of the Opposition Division to maintain the European patent 0 981 667 in amended form on the basis of the then pending third auxiliary request. Claim 1 of this request reads

"1. Light weight ground wood paper for rotogravure printing coated with a pigment which comprises from 20 to 100 wt % of aragonitic precipitated calcium carbonate particles having an aspect ratio of from 3:1 to 15:1 and a multi modal particle size distribution such that from 0 (zero) percent to 25 percent of the particles have an equivalent spherical diameter of less than 0.4 μm , from 40 percent to 60 percent of the particles have an equivalent spherical diameter of from 0.4 μm to 1.0 μm , from 10 percent to 35 percent of the particles have an equivalent spherical diameter of from 1 μm to 3 μm , and from 0 (zero) percent to 20 percent of the particles have an equivalent spherical diameter of from 3 μm to 10 μm wherein the coating further comprise [sic] from 5 percent to 10 percent by weight or [sic] a synthetic latex binder based on the weight of dry inorganic pigment and the coating further comprises delaminated clay, talc or blends of delaminated clay and talc."

Independent Claim 14 refers to the use of a pigment for coating paper used in rotogravure printing.

II. The Proprietor, thereafter referred to as Appellant, filed an appeal against this decision. A main request, a first auxiliary request and a second auxiliary request were submitted.

III. Claim 1 of the **main request** reads as follows:

"1. Rotogravure printing paper comprising paper coated with a pigment which comprises from 20 to 100 wt % of aragonitic precipitated calcium carbonate particles having an aspect ratio of from 3:1 to 15:1 and a multimodal particle size distribution such that from 0 (zero) percent [sic] to 25 percent of the particles [sic] have an equivalent spherical diameter of less than 0.4 μm , from 40 percent to 60 percent of the particles have an equivalent spherical diameter of from 0.4 μm to 1.0 μm , from 10 percent to 35 percent of the particles have an equivalent spherical diameter of from 1 μm to 3 μm , and from 0 (zero) percent to 20 percent of the particles have an equivalent spherical diameter of from 3 μm to 10 μm ."

Claim 1 of the **first auxiliary request** differs from Claim 1 of the main request as follows: the passage "Rotogravure printing paper comprising paper coated with a pigment" was replaced with the text "Paper for rotogravure printing coated with a pigment" and at the end of the claim the following text was appended: "wherein the coating further comprise [sic] from 5 percent to 10 percent by weight or [sic] a synthetic latex binder based on the weight of dry inorganic pigment and the coating further comprises delaminated clay, talc or blends of delaminated clay and talc."

The set of claims according to the **second auxiliary request** is identical with the set of claims maintained by the Opposition Division.

IV. The Opponent, thereafter referred to as Respondent, objected inter alia that the requirements of Article 123(2),(3) EPC were not met and requested a decision on apportionment of costs due to the absence of the Appellant at the oral proceedings before the Board without prior notice.

V. The main arguments of the Respondent were as follows:

Main request - Article 123(3) EPC

Claim 1 of the main request extends the protection conferred, because it refers not only to a coated paper for rotogravure printing per se, as defined in the granted version, but to a rotogravure paper comprising inter alia such a coated paper.

First auxiliary request - Article 123(2) EPC

The combination of the pigments with a binder comprising delaminated clay has not been originally disclosed.

Apportionment of costs

Given the failure of the Appellant to inform the Board in time about the absence at the oral proceedings, the proceedings could have been avoided. Consequently, a decision on the apportionment of costs was requested.

The Appellant did not submit any arguments with regard to Article 123 EPC.

VI. In the written procedure the Appellant requested that the patent be maintained on the basis of the main request or the first or second auxiliary request, all filed with the letter of 23 January 2008.

The Respondent requested that the appeal be dismissed and that a decision on the apportionment of the costs incurred be issued.

Reasons for the Decision

1. *Admissibility of the objection concerning Article 123(3) EPC*
- 1.1 In the oral proceedings before the Board the Respondent presented a further objection with regard to the main request: in the course of the discussion it turned out that Claim 1 was considered to extend the protection conferred.
- 1.2 The Board had to clarify the question whether the objection raised for the first time in the oral proceedings was to be admitted, in particular since the Appellant, although duly summoned, was not present at the said proceedings.
- 1.3 Article 15(3) RPBA (Supplement OJ EPO 1/2009, page 41) reads as follows: "The Board shall not be obliged to delay any step in the proceedings, including its decision, by reason only of the absence at the oral proceedings of any party duly summoned who may then be treated as relying only on its written case."
- 1.4 Furthermore, it is common practice at the EPO and in particular at the Boards of Appeal to examine amended claims with regard to the requirements of Article 123(2) and (3) EPC (see T 0341/92, paragraph 2.3.4, OJ EPO 1995, 373; also T 0915/02, paragraph 3.3, not published

in OJ). The Appellant must therefore have been aware that such an examination would take place and that further objection could be raised in the oral proceedings, all the more given the fact that with regard to the amended wording of the main request the Appellant should have been conscious that the extension of the protection conferred would arise from the comparison of the wording of the respective claim according to the patent as granted and the corresponding claim of the main request.

1.5 By not reacting to the objections already raised in the annex to the summons and in particular by not attending the oral proceedings the Appellant consciously decided not to present (further) comments.

1.6 Thus, the Board decided to admit the objection with regard to Article 123(3) EPC of Claim 1 of the main request.

2. *Main request - Article 123(3) EPC*

2.1 The first part of the wording of Claim 1 of the main request reads "Rotogravure printing paper comprising paper coated with a pigment", whereas Claim 1 as granted refers to a "Paper for rotogravure printing coated with a pigment".

2.2 Thus, the granted patent describes a paper with a specific coating, whereas Claim 1 of the main request refers to a rotogravure printing paper **comprising a paper** with the coating. Claim 1 of the main request therefore embraces not only the coated paper, but also any rotogravure printing paper comprising such coated

paper, which was not included in the wording of Claim 1 as granted.

2.3 Thus, Claim 1 of the main request extends the protection conferred and does therefore not meet the requirement of Article 123(3) EPC.

3. *First auxiliary request - Article 123(2) EPC*

3.1 Claim 1 of the first auxiliary request refers to a paper for rotogravure printing with a coating comprising among other ingredients delaminated clay or blends of delaminated clay and talc.

3.2 Delaminated clay is in the application as originally filed only described in the context of prior art papers and in the examples. However, the examples refer to **specific** amounts and kinds of aragonitic precipitated calcium carbonates in combination with **specific** amounts of delaminated clays. The **combination** of features as shown in Claim 1 of the first auxiliary request has not been originally disclosed.

3.3 Thus, Claim 1 of the first auxiliary request does not meet the requirement of Article 123(2) EPC.

4. *Prohibition of reformatio in peius*

4.1 The Proprietor being the sole appellant and the second auxiliary request being identical with the set of claims as maintained by the Opposition Division, the principle of the prohibition of reformatio in peius applies.

4.2 The patent is therefore maintained in the form as maintained by the Opposition Division, i.e. on the basis of the second auxiliary request in appeal proceedings.

5. *Request for apportionment of costs*

5.1 Given the absence of the Appellant at the oral proceedings without prior announcement, the Respondent requested a decision on the apportionment of costs.

5.2 In the present case, **both** the Appellant and the Respondent, independently of each other requested oral proceedings.

5.3 Although it is correct that the Appellant did not inform the Board in advance that he would not be represented at the oral proceedings, this does not influence Respondent's right to present his arguments at the oral proceedings. The Respondent did not only exercise this right, but even took the opportunity to comment on an argument which has not been discussed previously to the oral proceedings although the admissibility of the amended main request was still at issue and was to be considered by the Board at oral proceedings.

5.4 Thus, Appellant's non-appearance did not have any impact on the Respondent's attendance at the oral proceedings.

5.5 Therefore, the Board does not consider an apportionment of costs in favour of the Respondent to be justified in this particular case.

Order

For these reasons it is decided that:

1. The appeal is dismissed.
2. The request for apportionment of costs is refused.

The Registrar

The Chairman

D. Magliano

P.-P. Bracke