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**Datasheet for the decision
of 16 February 2011**

Case Number: T 0222/08 - 3.3.01

Application Number: 96307573.4

Publication Number: 0770648

IPC: C09D 17/00

Language of the proceedings: EN

Title of invention:
Pigment concentrates

Patentee:
BASF SE (after transfer of patent)

Opponents:
Clariant Verwaltungsgesellschaft mbH
BASF SE
Sun Chemical Corporation

Headword:
Pigment concentrates/BASF

Relevant legal provisions:
EPC Art. 123(2)
RPBA Art. 12(2), 13(1)

Relevant legal provisions (EPC 1973):

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Keyword:
"Respondent opponent 2: transfer of opponent status (no),
party to proceedings (no)"
"Auxiliary request 1: admitted in the procedure (no)"
"Main request and auxiliary request 2: added matter (yes)"

Decisions cited:
G 0009/93

Catchword:

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Case Number: T 0222/08 - 3.3.01

D E C I S I O N
of the Technical Board of Appeal 3.3.01
of 16 February 2011

Appellant: BASF SE
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Decision under appeal: Decision of the Opposition Division of the
European Patent Office posted 23 November 2007
revoking European patent No. 0770648 pursuant
to Article 102(1),(3) EPC 1973.

Composition of the Board:

Chairman: P. Ranguis
Members: L. Seymour
C.-P. Brandt

Summary of Facts and Submissions

I. European patent No. 0 770 648, based on application No. 96 307 573.4, was granted on the basis of ten claims. Independent claim 1 as granted reads as follows:

"A process for the manufacture of a pigment concentrate which comprises dispersing dry organic pigment granules in an ink varnish."

II. The patent was opposed by three opponents under Article 100(a) EPC for lack of novelty and inventive step.

III. The appeal lies from the decision of the opposition division revoking the patent under Article 102(1),(3) EPC 1973.

The decision was based on a main request and seven auxiliary requests filed during oral proceedings before the opposition division. The opposition division considered that claims relating to "a process for producing an ink" present in the main request and auxiliary requests 1 to 3, 5 and 7 contravened the requirements of Article 123(3) EPC. In addition, the opposition division was of the opinion that the subject-matter of claim 1 of each of the requests under consideration extended beyond the content of the application as originally filed (Article 123(2) EPC).

IV. The appellant (patentee) lodged an appeal against this decision, and filed forty-two requests with the grounds of appeal.

- V. The respondents (opponents 1, 2 and 3) filed counterarguments.
- VI. With its letter of 29 October 2008, the appellant filed thirty-six requests to replace all previously filed requests.
- VII. In the communication of 20 September 2010 accompanying the summons to oral proceedings, the board *inter alia* expressed doubts as to whether the introduction of optional features into independent claims could be seen as being occasioned by a ground of opposition, as required by Rule 80 EPC.
- VIII. With letter of 3 January 2011, respondent opponent 2 (BASF SE, formerly BASF AG) requested that a transfer of opponent status from BASF Aktiengesellschaft to Flint Group Germany GmbH be established.
- IX. With letter of 11 January 2011, the appellant requested that BASF SE be registered as the new proprietor of the patent in suit.
- X. With letter of 14 January 2011, the appellant filed a main request and two auxiliary requests to replace all requests previously on file. Each of these requests consisted of as single independent claim and two dependent claims.

Claim 1 of the main request reads as follows:

"1. A process for the manufacture of a dispersed pigment concentrate for printing inks comprising from

30 to 75% of pigment, which process comprises the steps of

- (a) preparing dry organic pigment granules having 0-5% content of moisture and a mean size of 0.1 to 50 mm by wet granulation using an extruder granulator followed by drying of the granular extrudate;
- (b) dispersing the dry organic pigment granules from step (a) in a printing ink varnish using a kneader of the Z-blade type or an extruder, to produce a pulp of 40-80% pigment concentration; and
- (c) diluting the resulting fully dispersed pulp from step (b) to the required pigmentation level carefully with carrier vehicle."

Claim 1 of the auxiliary request 1 reads as follows:

"A process for the manufacture of a pigment concentrate which comprises dispersing dry organic pigment granules in an ink varnish, the dry pigment granules containing 0-5% moisture and having a mean size of 0.1 to 50 mm, and wherein dispersing is carried out in an extruder."

Claim 1 of auxiliary request 2 differs from claim 1 of the main request in that the feature "or an extruder" has been deleted from step (b).

- XI. In a communication of 25 January 2011, the board expressed its preliminary opinion that the documentation annexed to the letter of 3 January 2011 (cf. point VIII above) did not provide sufficient

evidence for a valid transfer of opponent status to be acknowledged.

XII. On 26 January 2011, the registration of a transfer of the patent in suit to BASF SE took effect.

XIII. With letter of 3 February 2011, respondent opponent 2 announced that it would not be attending oral proceedings.

XIV. Oral proceedings were held before the board on 16 February 2011.

At the beginning of the oral proceedings, the board announced that, in the absence of any counterarguments from respondent opponent 2, it saw no reason to deviate from its preliminary opinion with respect to the transfer of opponent status, as set out in its communication of 25 January 2011 (cf. point XI above).

Consequently, in view of the fact that respondent opponent 2 and the patent proprietor were now the same legal person (BASF SE), respondent opponent 2 could no longer be considered as being a party to the proceedings. In this context, the board referred to the decision of the Enlarged Board of Appeal G 9/93 (OJ EPO 1994, 891).

XV. The appellant's arguments, insofar as they are relevant to the present decision, may be summarised as follows:

With respect to the question of admissibility of auxiliary request 1 filed with letter of 14 January 2011, the appellant argued that the amendments

introduced could be readily understood and were clearly allowable, since they were purely based on features that were to be found in the claims as granted. The complexity of the issues raised was therefore not such that the respondents could not have been expected to deal with them in the time available.

The appellant conceded that auxiliary request 1 should ideally have been filed with the statement of grounds of appeal. However, the appellant justified the timing of the filing by the fact that a change of representative had taken place only a few months prior to the date set for oral proceedings.

As regards the basis in the application as originally filed for claim 1 of the main request (Article 123(2) EPC), the appellant pointed to the passage of description starting from the last paragraph on page 5 to the bottom of page 6, and argued that all the individual features of the process now claimed were directly and unambiguously disclosed therein.

In reply to the objection of the respondents that a number of features of the dispersion step as disclosed in the last paragraph on page 6 of the application as originally filed were missing in step (b) of claim 1 of the main request, the appellant argued that the skilled person would understand the features relating to the mode and duration of mixing as not being essential to the process and as being adjustable according to need. Therefore, the omission of these features did not generate any new information with respect to the process disclosed in the application as originally filed.

Regarding the basis for the subject-matter of claim 1 of auxiliary request 2, the appellant relied on the arguments already brought forward with regard to the main request.

XVI. The respondents' (opponents 1 and 3) arguments, insofar as they are relevant to the present decision, can be summarised as follows:

The respondents did not raise any objections to the admissibility of the main request and auxiliary request 2.

However, the respondents submitted that auxiliary request 1 should not be admitted into the proceedings, since it was very late-filed and represented an unexpected shift in the focus of the alleged invention. This surprising situation could not be properly dealt with without a delay in procedure. In addition, the respondents contested that the amendments introduced could be considered to be clearly allowable.

The respondents raised various objections against the main request and auxiliary request 2 under Article 123(2) EPC. *Inter alia*, the respondents argued that the omission in step (b) of claim 1 of features relating to the mode and duration of mixing contravened Article 123(2) EPC.

XVII. The appellant (patentee) requested that the decision under appeal be set aside and that the case be remitted to the first instance for further prosecution on the basis of the main request, or alternatively on the

basis of the first or second auxiliary requests, all filed with the letter of 14 January 2011.

The respondents (opponents 1 and 3) requested that the appeal be dismissed and that auxiliary request 1, filed with the letter dated 14 January 2011, not be admitted into the proceedings.

XVIII. At the end of the oral proceedings, the decision of the board was announced.

Reasons for the Decision

1. The appeal is admissible.
2. *Admissibility of late-filed requests*
 - 2.1 The admissibility of the main request and auxiliary request 2 filed with the letter of 14 January 2011 was not contested by the respondents. The board sees no reason to differ. Indeed, the amendments undertaken with respect to requests previously on file were of a clear and simple nature (deletion of claims, deletion of optional features). Moreover, said requests were filed as a direct response to the communication sent as an annex to the invitation to oral proceedings (cf. point VII above).
 - 2.2 Auxiliary request 1 filed with the letter of 14 January 2011 was, however, not admitted into the proceedings for the following reasons:

Article 12(2) RPBA (Rules of Procedure of the Boards of Appeal; see Supplement to OJ EPO 1/2011, 38 to 49) requires that the appellant's statement of grounds of appeal contain its complete case. Any amendments to that case can be admitted and considered at the board's discretion. In exercising this discretion, the board must consider a range of factors such as the complexity of the new subject matter submitted, the current state of the proceedings and the need for procedural economy (Article 13(1) RPBA). Other criteria to be taken into account, according to established case law of the boards of appeal, include whether or not the newly filed amendments are clearly allowable, and whether or not there is proper justification for their late filing.

In the present case, the independent process claim as granted comprised a single step of "dispersing dry organic pigment granules in an ink varnish" (cf. point I above). In each of the eight requests considered in the decision under appeal (cf. point III above), this claim was restricted to a process comprising at least two steps, namely, one of "wet granulation using an extruder granulator followed by drying of the granular extrudate" (step (a)), and a dispersion step (b) using specific equipment, namely, "a kneader of the Z-blade type or an extruder" or "an extruder" (see decision under appeal, annexes 1 to 8). Similarly, the respective independent process claims 1 of the forty-two requests filed with the statement of grounds of appeal each comprised steps (a) and (b) (cf. point IV above). Analogous claims were maintained in the thirty-six requests filed with the letter of 29 October 2008 (cf. point VI above). Thus, up to this

point in proceedings, the appellant had conveyed a consistent case of seeking to defend process claims based on a specific granulation step in combination with a specific dispersion step.

About one month prior to the date scheduled for oral proceedings before the board, the appellant filed auxiliary request 1, in which the granulation step (a) had been deleted from claim 1 (cf. point X above). This deletion represents a total departure from the numerous requests previously filed, and results in a substantial redefinition of the characterising features of the invention as lying in the details of the dispersion step alone.

The only reason provided by the appellant for the late filing of auxiliary request 1 was the recent change in representative. However, this is not considered to be a valid ground for justify the late change to the appellant's case, since it must be assumed that all actions taken in the opposition proceedings and opposition appeal proceedings prior to the change in representative had been undertaken with agreement of the appellant and reflected the way in which the appellant wished to conduct its case.

In the absence of convincing justification, it would not be in keeping with the principle of procedural fairness to admit this unexpected and material amendment to the appellant's case at such a late stage in the procedure.

Furthermore, it was a matter of dispute between the appellant and respondents as to whether the amendments

introduced into claim 1 of auxiliary request 1 were clearly allowable under Article 123(2) EPC. In this context, the appellant referred to the claims of the patent in suit as providing the basis for amended claim 1. It is noted that it is the claims as originally filed that are of relevance in this context. Examination thereof reveals that the individual features that have now been incorporated into claim 1 of auxiliary request 1 are to be found in a number of separate claims, namely, independent claim 1 and dependent claims 3, 4, 7 and 9, which are each dependent on all preceding claims. In addition, the features concerned are partly presented as members of lists (cf. claim 7, "carrier vehicle"; claim 9, "dispersing equipment"). Therefore, it cannot be said to be immediately apparent that the combination of features now claimed is directly and unambiguously disclosed as a preferred embodiment in the application as originally filed. Hence, the amendments introduced do not fulfil the criterion of clear allowability with respect to Article 123(2) EPC.

In view of the considerations outlined above, the board comes to the conclusion that the admittance of auxiliary request 1 at this late stage in the proceedings would have been contrary to procedural fairness and would not have been conducive to procedural economy. The board therefore exercises its discretion not to consider this request.

3. *Added matter (Article 123(2) EPC)*

3.1 *Main request*

Claim 1 of the main request relates to a process for the manufacture of a dispersed pigment concentrate comprising steps (a), (b) and (c). In step (b), a pulp of 40-80% pigment concentration is produced by "dispersing the dry organic pigment granules from step (a) in a printing ink varnish using a kneader of the Z-blade type or an extruder". In step (c), the fully dispersed pulp from step (b) is diluted.

The appellant identified the last paragraph on page 6 of the application as originally filed as providing the basis for said step (b). Indeed, this is the only passage of the application as originally filed referring to the production of "a pulp of 40-80% pigment concentration". This paragraph reads as follows (emphasis added by the board):

"The dispersed pigment concentrates so produced by this process have a pigment concentration ranging from 20-75% but preferably from 30-60%. The process of manufacture for example using conventional kneaders e.g. of the Z-blade type is most conveniently but not exclusively carried out by adding the appropriate amount of carrier, for example a printing ink varnish, **mixing said varnish in the mixer rather than metering in the appropriate quantity of granules over a period of 1-20 mins** but more normally 2-5 minutes to produce a pulp of 40-80% pigment concentration but more ideally 50-65%. **The granules rapidly wet out and are dispersed after 5-45 minutes** but more often over 5-30 minutes.

The resulting fully dispersed viscous pulp is then diluted by careful addition of carrier vehicle e.g. ink varnish and if required any other desired additives to the required pigmentation level of the final concentrate. The concentrate is then discharged for use in the appropriate application at the required pigmentation level."

In the above excerpt, the emphasis in bold type has been added by the board in order to highlight features of the dispersion step that have been omitted from step (b) according to claim 1 of the main request. It is clear from the underlined expressions "to produce" and "the resulting" that the preceding features in bold relating to the mode and duration of mixing, and the duration of dispersion are to be viewed as being essential limiting features in the production of the "fully dispersed viscous pulp".

The argument of the appellant that the skilled person would understand said features to be optional is relevant to the question of what might be rendered obvious by the content of the application as originally filed taking into account the general knowledge of the skilled person. This must be clearly distinguished from the question of what has been directly and unambiguously disclosed in the application as filed.

Thus, several features that were presented as being essential in the application as originally filed have now been omitted from step (b) of claim 1. This constitutes an unallowable generalisation of a preferred embodiment, which is not unambiguously disclosed in the application as filed.

Hence, at least on the basis of this objection, claim 1 of the main request contravenes the requirements of Article 123(2) EPC. It is therefore not necessary to decide on the further objections raised by the respondents under Article 123(2) EPC with respect to this claim.

3.2 *Auxiliary request 2*

The appellant did not advance any additional arguments in favour of auxiliary request 2 with respect to the issue of added subject-matter.

Since claim 1 of this request also omits the features highlighted above in bold type, the conclusions under point 3.1 apply equally thereto.

Therefore, claim 1 of auxiliary request 2 does not meet the requirements of Article 123(2) EPC.

Order

For these reasons it is decided that:

The appeal is dismissed.

The Registrar:

The Chairman:

M. Schalow

P. Ranguis