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**Datasheet for the decision  
of 20 December 2012**

**Case Number:** T 1485/08 - 3.3.01

**Application Number:** 00905576.5

**Publication Number:** 1151043

**IPC:** C09B 67/22, C09B 67/24,  
C07D 251/50, C07C 317/32,  
C07D 251/54, C07D 251/46,  
C07D 239/42

**Language of the proceedings:** EN

**Title of invention:**  
Reactive dye composition

**Patentee:**  
Everlight USA, Inc.

**Opponent:**  
Dr. Stephan Laubereau as insolvency administrator of  
DyStar Textilfarben GmbH & Co Deutschland KG

**Headword:**  
Black azo dyes/DYSTAR

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

**Keyword:**  
"Admissibility of document not admitted during opposition  
proceedings (yes) - highly relevant, discretion not correctly  
exercised"  
"Second auxiliary request maintained by Opposition Division:  
novelty (no)"  
"Third auxiliary request: amendments supported by the  
application as filed (no) - unallowable generalisation"

**Decisions cited:**

T 1002/92, T 0288/92

**Catchword:**

-



Case Number: T 1485/08 - 3.3.01

**D E C I S I O N**  
of the Technical Board of Appeal 3.3.01  
of 20 December 2012

**Appellant:**  
(Opponent)

Dr. Stephan Laubereau  
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as insolvency administrator of

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**Representative:**

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**Respondent:**  
(Patent Proprietor)

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**Representative:**

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Bardehle Pagenberg Partnerschaft  
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**Decision under appeal:**

**Interlocutory decision of the Opposition  
Division of the European Patent Office posted  
21 May 2008 concerning maintenance of the  
European patent No. 1151043 in amended form.**

**Composition of the Board:**

**Chairman:** P. Ranguis  
**Members:** G. Seufert  
L. Bühler

## Summary of Facts and Submissions

- I. The Appellant (Opponent) lodged an appeal against the interlocutory decision of the Opposition Division dispatched on 21 May 2008 on the amended form in which European patent No. 1 151 043 could be maintained.
- II. In this decision the following numbering will be used to refer to the documents:
- (1) Brochure "Current fashion shades 89/90" of Casella AG and Hoechst AG, June 1988
  - (2) Brochure "Current fashion shades 90/91" of Casella AG and Hoechst AG, June 1989
  - (3) Brochure "Current fashion shades 91/92" of Casella AG and Hoechst AG, June 1990
  - (4) Brochure "Current fashion shades 94/95" of Casella AG and Hoechst AG, July 1993
  - (10) JP 1-315469
  - (16) KR 94-2560
  - (16T) English translation of document (16)
  - (16A) Annexes 1 and 2 summarising examples 7 and 8 of document (16T)
  - (57) Comparative data: Appendix 1-4 and 4 colour cards submitted by the Respondent
- III. Opposition was filed requesting revocation of the patent in suit in its entirety on the grounds of lack of novelty and inventive step (Article 100(a) EPC). With letter of 2 September 2005 the Opponent raised an additional objection of prior use.
- IV. The decision under appeal was based on the main request consisting of the claims as granted, auxiliary

request 1 filed with letter of 27 May 2005 and auxiliary request 2 filed on 5 February 2008 during oral proceedings before the Opposition Division.

The Opposition Division held that

- the main request and auxiliary request 1 lacked novelty in view of documents (1) - (4) and (10)
- auxiliary request 2 complied with the requirements of Article 123(2) EPC, was novel over documents (1) - (4) and (10) and involved an inventive step over document (10) taking into account the comparative data provided with respect to this document.

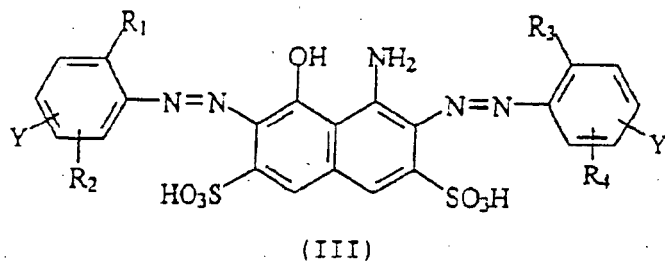
Furthermore, the Opposition Division disregarded document (16), in particular the English translation of this document (16T) provided by the Appellant during oral proceedings, as well as several documents which were considered not to have been available to the public. The alleged prior use was considered to be insufficiently substantiated.

- V. Auxiliary request 2, which according to the decision under appeal met the requirements of the EPC, consists of 23 claims. Independent claim 1, which is the only claim relevant for the present decision, reads as follows (definition of the components (V) to (XI) being reproduced as far as pertinent):

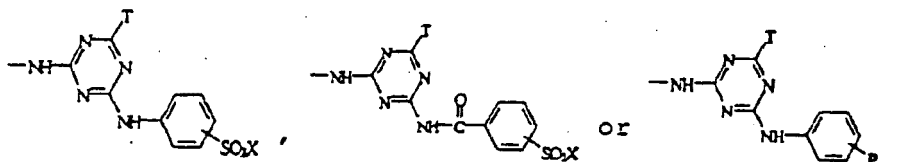
"1. A reactive dye composition which comprises:

- (a) at least a black or navy reactive dye with a good color fastness to laundering-oxidative bleach, said

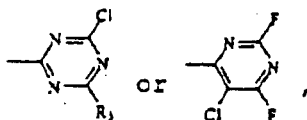
black or navy reactive dye is selected from the group consisting of formula (III)



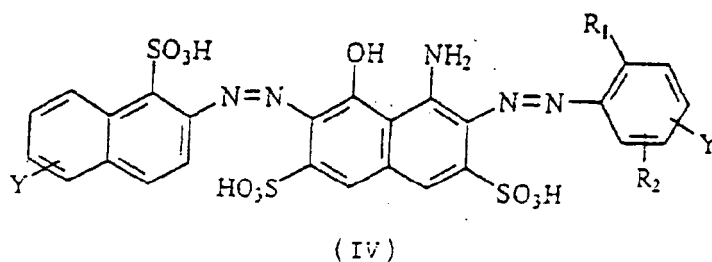
wherein Y and Y' each independent, is  $-\text{SO}_2\text{X}$ ,  $-\text{NH}-\text{W}$ ,



W is



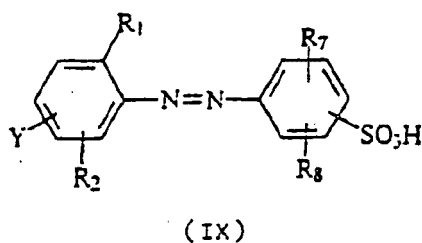
X is  $-\text{OH}$ ,  $-\text{CH}=\text{CH}_2$ ,  $-\text{C}_2\text{H}_4\text{OSO}_3\text{H}$ , or  $-\text{C}_2\text{H}_4\text{Cl}$ , T is  $-\text{NHCN}$ ,  $-\text{F}$  or  $-\text{Cl}$ , P is hydrogen, halogen,  $\text{C}_1-\text{C}_4$  alkyl or  $\text{C}_1-\text{C}_4$  alkoxy,  $\text{R}_5$  is  $\text{C}_1-\text{C}_4$  alkoxy,  $\text{R}_1$ ,  $\text{R}_2$ ,  $\text{R}_3$  and  $\text{R}_4$ , each independent, is hydrogen, halogen, hydroxyl,  $\text{C}_1-\text{C}_4$  alkyl  $\text{C}_1-\text{C}_4$  alkoxy, or sulfonyl groups and at least one of  $\text{R}_1$   $\text{R}_2$ ,  $\text{R}_3$  and  $\text{R}_4$  is other than hydrogen, or formula (IV)



wherein Y and Y', R<sub>1</sub> and R<sub>2</sub> are defined as above and

b) at least a red, orange, yellow or other shade of reactive azo dye, said red, orange, yellow or other shade of reactive azo dye is selected from the group consisting of formula (V), formula (VI), formula (VII), formula (VIII), formula (IX), formula (X) or formula (XI)

.....



wherein Y, R<sub>1</sub> and R<sub>2</sub> are as defined above, R<sub>7</sub> and R<sub>8</sub> each independent is hydrogen, C<sub>1</sub>-C<sub>4</sub> alkyl or amino, .....

VI. With the statement of grounds of appeal the Appellant resubmitted document (16T), which it had filed during oral proceedings before the Opposition Division, together with Annexes 1 and 2 (document (16A)) summarising examples 7 and 8 of document (16T).

VII. With letter of 9 April 2009 the Respondent (Patent Proprietor) filed auxiliary request 3 as well as additional comparative data (document (57)) in support of an inventive step over document (16).

Independent claim 1 of auxiliary request 3 is distinguished from claim 1 of auxiliary request 2 in that formula V has been deleted and that the feature **"and wherein Y is at the para-position"** has been added to formula IX.

VIII. Under the cover of a letter dated 28 July 2010, Dystar Colours Deutschland GmbH requested acknowledgement of a transfer of party status to it from the Appellant/Opponent Dystar Textilfarben GmbH & Co. Deutschland KG.

IX. With the interlocutory decision dated 23 September 2011, the Board refused the request for transfer of appellant status to Dystar Colours Deutschland GmbH. The Board informed the parties that proceedings would be continued with Dr. Stephan Laubereau as insolvency administrator of Dystar Textilfarben GmbH & Co. Deutschland KG as Appellant.

X. In a communication accompanying the summons to oral proceedings, the Board informed the parties of the issues that it would be necessary to discuss during oral proceedings. The Board indicated its intention to admit document (16T), as it was of the preliminary opinion that this document was relevant at least to the question of novelty and that the Opposition Division, in not admitting it without having examined its relevance, had not correctly exercised its discretion.



The Board also invited the Respondent to provide a clear and unambiguous basis in the application for the amendment made to formula (IX) in claims 1 and 10 of auxiliary request 3, namely that the substituent Y is at the para-position. Concerning the assessment of inventive step, the Board indicated that one of the issue to be discussed would be whether or not the comparative data provided by the Respondent with respect to documents (10) and (16) could support the alleged effects.

XI. By letter of 20 November 2012 the Respondent notified the Board that it would not be attending oral proceedings and requested "to decide the case according to the facts of the file". No further submissions concerning substantive issues in reply to the Board's communication were made.

XII. The arguments provided by the Appellant in writing and during the oral proceedings before the Board, to the extent that they are relevant for the present decision, can be summarised as follows:

Document (16T) should have been considered by the Opposition Division, because it confirmed in a straightforward manner that document (16), which had been filed with the notice of opposition against novelty of the patent in suit, contained novelty-destroying subject-matter. The relevance of document (16) was already recognisable even without the translation and all that was necessary for the Opposition Division was to establish the meaning of the substituents, which could be easily done with the help of document (16T). However, notwithstanding the

Opposition Division's decision to disregard this document, due to its high relevance it should be admitted by the Board into the appeal proceedings.

The subject-matter of claim 1 of auxiliary request 2 was not novel in view of examples 7 and 8 of document (16T), which disclosed a black dye mixture comprising compounds according to the claimed formulae (III) and (IX). The respective formulae of the reactant and the product mixture were summarised in document (16A).

Auxiliary request 3 did not comply with the requirement of Article 123(2) EPC, because there was no basis in the application as filed for the feature that Y was in para-position. Nor could the four examples on pages 22 and 23 with their specific substituent combination support this amendment.

XIII. The arguments provided by the Respondent in writing, to the extent that they are relevant for the present decision, can be summarised as follows:

Document (16T) should not be admitted into the proceedings, because it had been filed too late without any reason. The Appellant had submitted this document more than 30 months after the Respondent had indicated in its reply to the notice of opposition that the alleged novelty-destroying disclosure of document (16) could not be verified because it was in Korean.

The introduction of the feature that the substituent Y was attached in para-position restricted the claims and was therefore admissible under Article 123(2) EPC.

- XIV. The Appellant requested that the decision be set aside and that the patent in suit be revoked in its entirety. Furthermore, it requested that document (16T) be admitted into the proceedings.
- XV. The Respondent requested in writing that the appeal be dismissed, i.e. that the patent be maintained on the basis of auxiliary request 2 underlying the contested decision or, alternatively, that the patent be maintained on the basis of auxiliary request 3 filed with the reply to the statement of grounds of appeal of 9 April 2009. It also requested that document (16T) not be admitted into the procedure.
- XVI. Oral proceedings took place as scheduled on 20 December 2012 in the absence of the Respondent (Rule 115(2) EPC, Article 15(3) RPBA). 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 document (16T)
  - 2.1 Document (16T), which is an English translation of Korean patent No. 94-2560 (document (16)) filed with the notice of opposition, was submitted by the Appellant during oral proceedings before the Opposition Division and was resubmitted with the statement of grounds of appeal. According to the decision under appeal (page 8, first and second paragraphs) the

Opposition Division adopted the Respondent's position that the translation had been filed too late in the proceedings and should therefore be disregarded.

This decision was challenged by the Appellant on the grounds that the Opposition Division in disregarding document (16T), which was highly relevant to the issue of novelty, had not properly exercised its discretion.

- 2.2 An Opposition Division has a discretionary power under Article 114(2) EPC to disregard evidence which has not been submitted in time. A Board of Appeal should only overrule the way in which a first-instance department has exercised its discretion in a decision in a particular case if the Board comes to the conclusion that the first-instance department in its decision has exercised its discretion according to the wrong principles, or without taking into account the right principles, or in an unreasonable way (G 7/93, OJ EPO 1994, 775, point 2.6 of the reasons).

The question to be examined therefore is whether or not the Opposition Division has exercised its discretion correctly.

- 2.3 According to established jurisprudence of the Boards of Appeal, a decisive criterion for admitting late-filed documents is their *prima facie* relevance (T 1002/92 OJ EPO, 1995, 605, point 3.3).

In this context the Board notes that document (16) was filed with the notice of opposition against novelty of the patent in suit. Although not in one of the official languages of the EPO, from the use of various English

terms in the description of document (16) it is already discernible that its subject-matter is related to the claimed subject-matter (see page 4 of document (16), which refers to "exhausting dying", "printing", and "cold pad batch dying"). Moreover, the structural formulae according to claim 1 and on pages 1-2 closely correspond to the formulae of compounds III, VIII and IX of the patent in suit. The definition of the substituents in the formulae of document (16) cannot be clearly determined from the Korean patent, but this information is available in a straightforward manner, without requiring particular effort, from the English translation of document (16), in particular the examples. Taking into account the diazo starting material, it can immediately be seen that some of these examples disclose mixtures falling within the scope of the patent in suit. Document (16T) was, therefore, *prima facie* relevant to the issue of novelty.

The contested decision and the minutes of the oral proceedings, however, do not contain anything that allows the conclusion that the Opposition Division considered the relevance of document (16T).

- 2.4 Other criteria for deciding on the admissibility of late-filed documents, such as whether their submission disadvantaged the other party in presenting its case or even constituted a procedural abuse or led to excessive delay in the proceedings, have also been held to be relevant for the exercise of discretion. However, neither the decision under appeal nor the minutes of the oral proceedings contain anything that allows the conclusion that the Opposition Division took into

- consideration any criteria other than the late-filing of the translation.
- 2.5 In view of the above, it is the Board's opinion that the Opposition Division in not admitting document (16T) for the sole reason that it was late-filed, without having examined its relevance or considered any other criteria, did not properly exercise its discretion.
- 2.6 In its reply to the statement of grounds of appeal the Respondent argued that the late-filing of document (16T) was at odds with fair proceedings. The document had been filed more than 30 months after the Respondent's reply to the notice of opposition, where it had been pointed out that document (16) was in Korean and could not be understood. Moreover, the Appellant had made further submissions on 2 September 2005 before the oral proceedings before the Opposition Division without addressing document (16).
- 2.7 The Board is not convinced by the Respondent's argument.
- 2.7.1 Although the Appellant should have provided a translation of document (16) much earlier, preferably with the notice of opposition or at least sufficiently in advance of the oral proceedings, nevertheless, in the present case considering the *prima facie* relevance of document (16T) the decision of the Opposition Division to disregard this document solely because it was filed at a late stage in the proceedings was not justified. The Board also notes that the Respondent did not provide any arguments to the effect that it would not have been in a position to adequately deal with the content of document (16T) and to properly address the

objection of lack of novelty during the oral proceedings before the Opposition Division. The argument that it would have been unfair to admit document (16) can therefore not succeed.

2.7.2 Furthermore, document (16T), which was resubmitted with the Appellant's statement of grounds of appeal, is sufficiently highly relevant to justify its admission into the appeal proceedings, as the Board had clear reasons to believe that it would prejudice the maintenance of the patent (see point XI above). The Board is also satisfied that the Respondent had ample time to consider the content of document (16T) and a fair chance to prepare a proper defence.

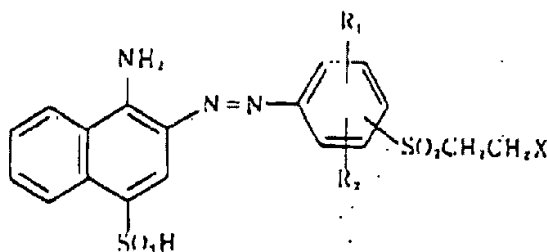
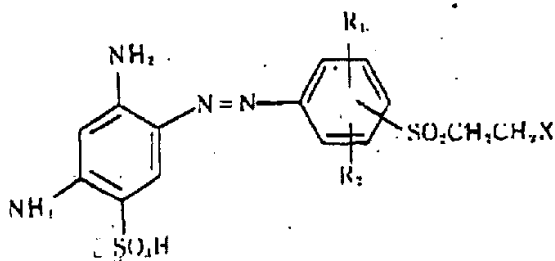
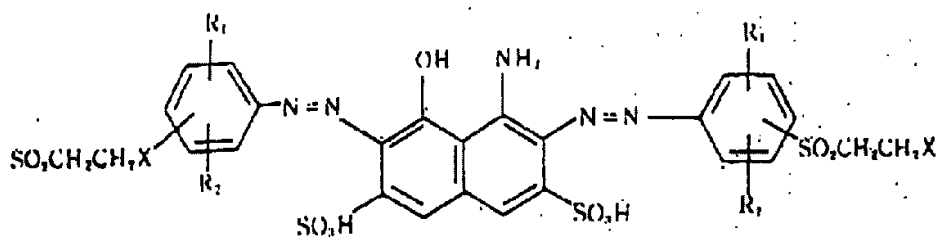
2.8 For the above reasons, the Board decided, in the exercise of its discretion pursuant to Article 12(4) RPBA, not to hold document (16T) inadmissible.

*Auxiliary request 2*

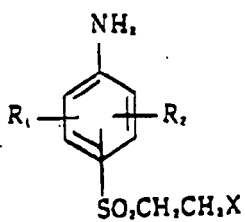
3. Novelty

3.1 According to the Appellant, claim 1 of auxiliary request 2 lacked novelty in view of examples 7 and 8 of document (16T).

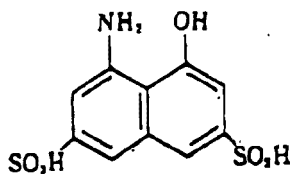
3.2 Document (16T) discloses deeply black reactive dye compositions (I) obtained via the reaction of the diazotised compound of formula (II) with compounds of formula (III-1), (III-2) and (III-3).



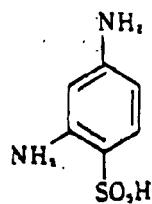
(1)



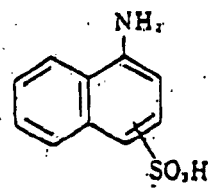
(II)



(III-1)



(III-2)



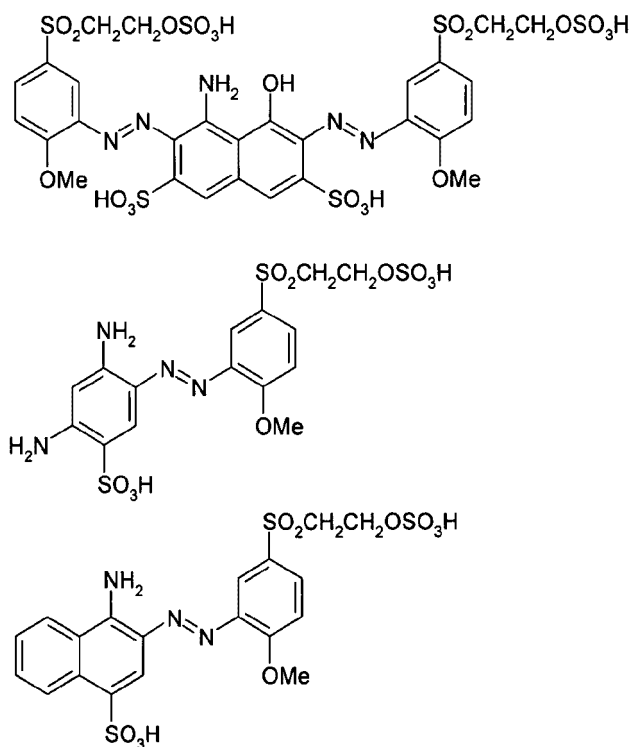
(III-3)

(see formulae on page 2 and page 2, lines 2-7 of document (16T)). The Board notes that the first formula of product (I) contains an obvious error in that the group  $\text{SO}_2\text{CH}_2\text{CH}_2\text{X}$  on the left phenyl ring should be



attached via the sulfone group. This error is obvious with regard to formula (II).

According to example 7, 4 mol of 1-amino-2-methoxybenzene-5- $\beta$ -sulfatoethyl sulfone, a compound of formula (II), was diazotised and reacted with 1 mol of each of the compounds 1-amino-8-hydroxynaphthalene 3,6-disulfonic acid (compound III-1), 1,3-diaminobenzene-4-sulfonic acid (compound (III-2) and 1-naphthylamine-4-sulfonic acid (a compound of formula (III-3) (see table on page 7 of document (16T)). The Board agrees with the Appellant (see Annex 1 of document (16A)) that the resulting black reactive dye composition thus comprises the following compounds:



In example 8 of document (16T) the reaction takes place with 1-amino-2-**methy**l benzene-5- $\beta$ -sulfatoethyl sulfone, resulting in a composition as described above with a

methyl instead of a methoxy group in the structure of each of the compounds (see table on page 7 of document (16T) and Annex 2 of document (16A)).

The first of the compounds in the aforementioned compositions corresponds to a compound of formula (III) of auxiliary request 2, with  $R_1/R_3$  equal to methoxy ( $C_1$  alkoxy) or methyl ( $C_1$  alkyl),  $R_2/R_4$  equal to hydrogen and  $Y/Y'$  equal to  $SO_2X$  with  $X$  equal to  $CH_2CH_2OSO_3H$ . The second compound of the aforementioned compositions corresponds to a compound of formula (IX) of auxiliary request 2, with  $R_7/R_8$  equal to amino,  $R_1$  equal to methoxy ( $C_1$  alkoxy) or methyl ( $C_1$  alkyl),  $R_2$  equal to hydrogen and  $Y$  equal to  $SO_2X$  with  $X$  equal to  $CH_2CH_2OSO_3H$ .

Due to the word "comprises" in claim 1 of auxiliary request 2, compounds other than those of formula (III) and (IX) can be present, for example the third compound of the composition according to examples 7 and 8 of document (16T). Accordingly, compositions obtained in examples 7 and 8 of document (16T) fall within the scope of claim 1 of auxiliary request 2.

- 3.3 The Respondent did not provide any arguments concerning this issue.
- 3.4 For the aforementioned reasons, the Board concludes that the subject-matter of claim 1 of auxiliary request 2 is not novel within the meaning of Article 54 EPC.

*Auxiliary request 3*

4. Amendments

4.1 Claim 1 of auxiliary request 3 was amended *inter alia* by introducing the feature that the substituent Y in the general formula (IX) is at the para-position.

4.2 The Respondent did not provide a basis for this amendment in the application as filed, but rather argued that the amendment restricted the claim and was therefore admissible under Article 123(2) EPC.

4.3 The Board cannot accept this argument. Article 123(2) EPC prohibits amendments which generate "subject-matter that extends beyond the content of the application as originally filed". Thus, the introduction of **any technical information** which a skilled person would not have **objectively and unambiguously** derived from the application as filed, even if it results in a restriction, is prohibited (see decision T 288/92, not published in OJ EPO, point 3.1 of the reasons)

4.4 According to the general formula IX of the application as filed, the position of the substituent Y at the phenyl ring to which it is attached is not defined (see page 14 of the description and claim 1) and no explicit disclosure can be found elsewhere in the description referring to a particular position of Y. The Board notes that in addition to the general formula (IX) the application as filed also refers to four individual compounds (IX-1) to (IX-4) (see pages 22 and 23). In these compounds Y is attached in para-position to the azo group. However, at the same time Y is always a

particular residue, namely  $-\text{SO}_2\text{CH}_2\text{CH}_2\text{OSO}_3\text{H}$ , and, except for the azo group, no further substituent is present on the phenyl ring to which Y is attached, i.e.  $\text{R}_1$  and  $\text{R}_2$  according to the general formula (IX) are hydrogen. Moreover, in all four individual compounds, the second phenyl ring also has a specific substitution pattern, i.e. an amino group in para- and the required  $-\text{SO}_3\text{H}$  residue in meta-position. Therefore, the original disclosure of these individual compounds cannot support the generalisation in amended claim 1, which results in claiming compounds of formula (IX) where Y, independently of its definition and independently of the definition of the other substituents, is in para-position.

Thus, the amendment that Y in the general formula (IX) is in para-position represents technical information which is not objectively and unambiguously derivable from the application as filed.

- 4.5 For the aforementioned reasons, the Board concludes that claim 1 of auxiliary request 3 extends the subject-matter claimed beyond the application as originally filed and thus contravenes Article 123(2) EPC.

**Order**

**For these reasons it is decided that:**

1. The decision under appeal is set aside.
2. The patent is revoked.

The Registrar:

The Chairman:

M. Schalow

P. Ranguis