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**Datasheet for the decision
of 8 July 2015**

Case Number: T 0262/12 - 3.3.01

Application Number: 03728080.7

Publication Number: 1505128

IPC: C09D17/00, C09D11/00, B41M5/00,
B41J2/01

Language of the proceedings: EN

Title of invention:
PIGMENT DISPERSION AND INK COMPOSITION FOR INK-JET

Patent Proprietor:
Seiko Epson Corporation
MIKUNI SHIKISO KABUSHIKI KAISHA

Opponent:
Currado, Luisa

Headword:
Pigment dispersion/SEIKO EPSON

Relevant legal provisions:
EPC Art. 123(2), 123(3), 84, 100(b), 111(1)

Keyword:

Main request: amendments - added subject-matter (no) -
broadening of claims (no)

Main request: lack of clarity caused by amendments of the
claims after grant (no)

Obiter dictum concerning Article 100(b) EPC in the decision
under appeal

Appeal decision -
remittal to the department of first instance (yes)

Decisions cited:

G 0009/91

Catchword:



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Case Number: T 0262/12 - 3.3.01

D E C I S I O N
of Technical Board of Appeal 3.3.01
of 8 July 2015

Appellant: Seiko Epson Corporation
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Appellant: MIKUNI SHIKISO KABUSHIKI KAISHA
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Respondent: Currado, Luisa
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Decision under appeal: **Decision of the Opposition Division of the
European Patent Office posted on 5 December 2011
revoking European patent No. 1505128 pursuant to
Article 101(3) (b) EPC.**

Composition of the Board:

Chairman A. Lindner
Members: C. M. Radke
L. Bühler

Summary of Facts and Submissions

- I. European patent No. 1 505 128 relates to a pigment dispersion for ink-jet printing.
- II. The opponent sought revocation of this patent in its entirety under Article 100(a) (alleged lack of novelty and inventive step) (b) and (c) EPC.
- III. The opposition division revoked the patent. In particular, it decided that the claims then on file did not comply with Article 123(2) EPC because
 - in claim 1 of the main request, the essential feature of original claim 2 "to cause crosslinking" had been deleted;
 - in auxiliary request 1, claim 2 had been deleted;and did not comply with Article 123(2) and (3) EPC because
 - in auxiliary request 2, the words "thereto to cause crosslinking" had been deleted.
- IV. The patent proprietors appealed this decision.
- V. In the communication annexed to the summons to oral proceedings, the board
 - stated why the amendments to the claims then on file rendered these unclear and
 - asked the appellants for a clarification of their request for remittal.
- VI. In their reply dated 2 April 2015, the appellants submitted the following claims:
 - claims 1 to 5 of a main request,
 - claims 1 to 5 of a first auxiliary request and
 - claims 1 to 5 of a second auxiliary request.

Furthermore, they stated clearly the conditions under which they requested remittal.

- VII. In their letter dated 18 May 2015, the appellants
- made the first auxiliary request filed under cover of the letter dated 2 April 2015 their main request and
 - withdrew their request for oral proceedings.

As the respondent had not requested oral proceedings, the board informed the parties that they were cancelled.

VIII. The claims of the main request read as follows:

- "1. A pigment dispersion for ink jet having a pigment dispersed, which comprises
- (i) a water-soluble resin and
 - (ii) a resin having a urethane bond and/or an amide bond;
- wherein the pigment dispersion is obtainable by
- (a) blending the water-soluble resin with the pigment,
 - (b) finely pulverizing the pigment in a kneading step and a dispersing step, and further
 - (c) adding the resin having a urethane bond and/or an amide bond thereto to cause crosslinking,
- whereby crosslinking with a crosslinking agent is carried out after adding the resin having a urethane and/or amide bond."
2. An ink composition for ink jet comprising a pigment dispersion according to claim 1.
3. The ink composition for ink jet according to

claim 2, which is obtainable by adding an organic solvent to the pigment dispersion as defined in Claim 1.

4. An ink jet recording method, which comprises printing by discharging the ink composition for ink jet as defined in any one of Claims 2 or 3 from a nozzle of an ink jet printer.
5. An ink set having the ink composition for ink jet as defined in any one of Claims 2 or 3 charged into a cartridge."

IX. The arguments of the appellants, as far as relevant for this decision, may be summarised as follows:

The claims of the main request met the requirements of Article 123(2) EPC; claim 1 was based on original claims 1 and 2 and on page 20, lines 6 to 16, of the application as originally filed.

The claims of the main request were clear, now that the alternative of crosslinking before adding the resin having a urethane and/or an amide bond had been deleted.

X. In their letter dated 18 May 2015, the appellants made the first auxiliary request their main request. This implies that the former main request was withdrawn. Hence, the appellants' requests may be formulated as follows:

that the decision under appeal be set aside and that the case be remitted to the department of first instance for assessment of novelty and inventive step if

- the claims of the main request, filed as first auxiliary request under cover of the letter dated 2 April 2015,
- or, alternatively,
- the claims of the auxiliary request, filed as second auxiliary request under cover of the letter dated 2 April 2015,
- are found to meet the remaining requirements of the EPC (see paragraph 2 of page 5 of their letter dated 2 April 2015).

The respondent neither filed any requests nor presented any arguments or observations during the appeal proceedings.

- XI. The appellants having withdrawn their request for oral proceedings and the respondent not having asked for them, the present decision could be taken in written proceedings.

Reasons for the Decision

1. The appeal is admissible.

Main Request

2. Article 123 EPC

- 2.1 Article 123(2) EPC

- 2.1.1 The subject-matter of claim 1 is disclosed in the application as originally filed as follows:

- the features "A pigment dispersion ... and (ii) a resin having a urethane bond and/or an amide bond;" in original claim 1;
- the features "wherein the pigment dispersion is obtainable by and further (c) adding the resin having a urethane bond and/or an amide bond thereto to cause crosslinking" in original claim 2;
- the features "whereby crosslinking with a crosslinking agent is carried out after adding the resin having a urethane and/or amide bond" on page 20, lines 15-17, and page 28, line 25, to page 29, line 5, of the description as filed.

2.1.2 Claims 2 to 5 correspond to original claims 6, 8, 9 and 10.

2.2 Article 123(3) EPC

2.2.1 Claim 1 differs from claim 1 as granted in that the former

contains the following additional requirements:

- that the addition of the resin (ii) in step (c) is "to cause crosslinking";
- that the crosslinking is carried out "with a crosslinking agent"

and in that

- the option to carry out crosslinking before resin (ii) has been deleted, and
- the alternative "(A) the resin has a crosslinking rate of from 20 to 100 %; or" has been deleted.

None of these amendments extends the protection conferred by claim 1 as granted.

2.2.2 Claims 2 to 5 correspond to original claims 3, 4, 5 and 6 as granted.

2.3 For these reasons, the claims of the main request meet the requirements of Article 123(2) and (3) EPC.

3. Article 84 EPC

In its preliminary opinion, the board considered the claims then on file unclear, as crosslinking **before** the addition of the resin (ii) is incompatible with the requirement that this resin was to **cause** crosslinking (see point 3.2.3 of the communication of the board dated 8 January 2015).

Now that the appellants have deleted from the claims the option that crosslinking may occur before the addition of resin (ii), this objection no longer applies.

Furthermore, the board is not aware of any other amendment after grant which could justify an objection under Article 84 EPC.

For these reasons, objections under Article 84 EPC do not prejudice the maintenance of the patent on the basis of the main request.

4. Article 100(b) EPC

In section 5 of the reasons of the decision under appeal, the opposition division took the view in an *obiter dictum* that the determination of the crosslinking rate was not disclosed in a manner sufficiently clear and complete to enable the person

skilled in the art to carry out the subject-matter claimed.

Although the board generally only deals with the reasons on which the decision under appeal is based - and not with *obiter dicta* - it would point out that due to the deletion of the alternative "(A) the resin has a crosslinking rate of from 20 to 100 %; or" the present claims no longer refer to a crosslinking rate (see point 2.2.1 above), so the objection raised in the *obiter dictum* is no longer applicable.

5. Remittal

According to Article 111(1) EPC, the board "may either exercise any power within the competence of the department which was responsible for the decision appealed or remit the case to that department for further prosecution."

According to decision G 09/91, "The purpose of the appeal procedure inter partes is mainly to give the losing party a possibility to challenge the decision of the Opposition Division on its merits" (see OJ EPO 1993, 408, point 18 of the reasons).

The decision under appeal was based solely on the finding that the claims then on file did not meet the requirements of Article 123 EPC (see point III above).

It is evident from point 2 above that the claims of the main request meet these requirements.

The opposition division has not yet decided whether grounds under Article 100(a) EPC prejudice the

maintenance of the patent, nor has it expressed its preliminary opinion as to novelty and inventive step of the subject-matter claimed (see section 2.4 of its communication dated 31 March 2011).

For these reasons, the board grants the appellants' request and remits the case to the opposition division for further processing on the basis of the main request.

Auxiliary Requests

6. Consequently, there is no need to decide on the auxiliary requests.

Order

For these reasons it is decided that:

1. The decision under appeal is set aside.
2. The case is remitted to the department of first instance for further prosecution on the basis of claims 1 to 5 of the main request, filed as first auxiliary request under cover of the letter dated 2 April 2015.

The Registrar:

The Chairman:



C. Vodz

A. Lindner

Decision electronically authenticated