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**Datasheet for the decision
of 14 July 2022**

Case Number: T 0283/20 - 3.3.06

Application Number: 12754405.4

Publication Number: 2683776

IPC: C09C1/36

Language of the proceedings: EN

Title of invention:

TITANIUM DIOXIDE PIGMENTS AND MANUFACTURING METHOD

Patent Proprietor:

Tronox LLC

Opponent:

KRONOS INTERNATIONAL, INC.

Headword:

Tronox/Pigments

Relevant legal provisions:

EPC Art. 113(2), 113(1)

EPC R. 103(1) (a)

Keyword:

Basis of decision - text or agreement to text withdrawn by
patent proprietor

Right to be heard - substantial procedural violation (yes)

Reimbursement of appeal fee - violation of the right to be
heard (yes)

Decisions cited:

Catchword:



Beschwerdekammern

Boards of Appeal

Chambres de recours

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Case Number: T 0283/20 - 3.3.06

D E C I S I O N
of Technical Board of Appeal 3.3.06
of 14 July 2022

Appellant: KRONOS INTERNATIONAL, INC.
(Opponent) Peschstrasse 5
51373 Leverkusen (DE)

Representative: Hoffmann Eitle
Patent- und Rechtsanwälte PartmbB
Arabellastraße 30
81925 München (DE)

Respondent: Tronox LLC
(Patent Proprietor) 3301 NW 150th
Oklahoma City, OK 73134 (US)

Representative: J A Kemp LLP
80 Turnmill Street
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Decision under appeal: **Decision of the Opposition Division of the
European Patent Office posted on 16 December
2019 rejecting the opposition filed against
European patent No. 2683776 pursuant to Article
101(2) EPC.**

Composition of the Board:

Chairman J.-M. Schwaller
Members: R. Elsässer
R. Cramer

Summary of Facts and Submissions

- I. The appeal of the opponent lies from the decision of the opposition division to reject the opposition against European patent No. EP 2 683 776.
- II. With its grounds of appeal the appellant requested the revocation of the contested patent and the reimbursement of the appeal fee.
- III. With its reply, the patentee and respondent filed 4 auxiliary requests.
- IV. With its later submission of 28 June 2022, the respondent indicated that it did not approve the text in which the patent was granted, withdrew all auxiliary requests and stated that the patent was to be revoked.

Reasons for the Decision

1. Under Article 113(2) EPC, the European Patent Office shall consider and decide upon a European patent only in the text submitted to it or agreed by the proprietor of the patent.

In the present case there is no text on the basis of which the patent could be maintained because the proprietor itself disapproved the text of the patent as granted and withdrew all auxiliary requests. Thus, as also explicitly concluded by the proprietor, the patent has to be revoked, according to Article 101 EPC (Case Law of the Boards of Appeal of the EPO, 9th edition 2019, IV.D.2).

2. Reimbursement of the appeal fee

The board has come to the conclusion that the appellant's right to be heard has been violated because key arguments brought forward during the discussion of sufficiency of disclosure have not been considered by the opposition division (Article 113(1) EPC). The reasons are as follows:

- 2.1 During the examination proceedings, the term "essentially" had been deleted in claims 1 and 30 as filed so that granted claims 1 and 5, which were based on claims 1 and 30 as filed, define pigments which comprise a porous coating "consisting of" silica and a dense coating "consisting of" alumina.
- 2.2 As acknowledged in the decision (points 3.3.1 and 3.3.2) the opponent argued in detail why D8 and D14 proved that the in-situ coating-methods of the invention inevitably produced mixed metal oxides and were therefore unable to produce coatings "consisting of" alumina or silica so that the claimed invention could not be carried out.
- 2.3 However, from the reasoning given by the opposition division (point 3.3.3), it is not apparent why these arguments have not been found convincing because neither the argument nor the evidence presented in its support have been discussed in the decision. Instead, the division merely referred to example 2 as allegedly showing how the claimed invention could be carried out. However, this is not an appropriate rebuttal because it was exactly the opponent's argument that D8 and D14 proved that the method of example 2 was unable to produce coatings "consisting of" alumina or silica.

- 2.4 According to established jurisprudence, the right to be heard entails not only that a party is given an opportunity to present its arguments but also that these arguments are considered in the decision (Case Law of the Boards of Appeal, III. B. 2.4.2). While there is no need to address each and every argument, the issue at hand constituted a key aspect of the opponent's objection of lack of sufficiency (grounds for opposition, point 4.1) and was also backed up by evidence.
- 2.5 Thus, the board concludes that the appellant's right to be heard has been violated, which constitutes a procedural violation. According to established jurisprudence, the appeal fee is reimbursed only if said procedural violation is substantial in the sense that it was decisive for the outcome of the decision under appeal (Case Law of the Boards of Appeal, V.A. 9.5.2).
- 2.6 In the present case, the board holds that the violation was relevant for the outcome of the decision to reject the opposition because a proper consideration of the opponent's argument might at least potentially have lead to a more favourable decision for the opponent, making the need to file an appeal redundant.
- 2.7 The board therefore concludes that a reimbursement of the appeal fee is appropriate.

Order

For these reasons it is decided that:

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

The Registrar:

The Chairman:



A. Pinna

J.-M. Schwaller

Decision electronically authenticated