

Publication in the Official Journal Yes / No

File Number: T 280/90  
Application No.: 83 109 654.0  
Publication No.: 107 089  
Title of invention: Novel pigment grinding vehicle

Classification: C08G 59/14

**D E C I S I O N**  
of 26 November 1991

Proprietor of the patent: PPG Industries

Opponent: Hoechst AG

Headword:

EPC Articles 107, 133, Rule 67

Keyword: Reimbursement of appeal fee (yes)

Headnote



Case Number : T 280/90

**D E C I S I O N**  
of the Technical Board of Appeal 3.3.3  
of 26 November 1991

**Appellant :**  
(Opponent)

HOECHST AG  
Werk Kalle-Albert  
Postfach 3540  
6200 Wiesbaden 1

**Respondent :**  
(Proprietor of the patent)

PPG Industries  
1 PPG Place  
Pittsburgh  
Pennsylvania 15272  
United States of America

**Representative :**

Patentanwälte Dr. Michael Hann  
Dr. H.G. Sternagel  
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5060 Bergisch Gladbach 2

**Decision under appeal :**

Interlocutory Decision of Opposition Division of  
the European Patent Office of 2 November 1989,  
issued 31 January 1990 concerning maintenance of  
European patent No. 107 089 in amended form

**Composition of the Board :**

**Chairman :** F. Antony  
**Members :** R. Schulte  
C. Gérardin

## Facts and Submissions

- I. The Respondent is owner of European patent No. 107 089.
- II. The Appellant (Opponent) filed an oppositions against the European patent.
- III. The Respondent (Proprietor) requested that the patent be maintained with the following amendments:  
  
page 2, line 45: "contains" to be replaced by "is"  
  
page 3, line 24: "contains" to be replaced by "is"  
  
page 3, line 30: "Also, the" to be replaced by "The"  
  
page 3, line 40: "contains, each independently" to be replaced by "is an acyclic moiety of"  
  
Claims 1, 2 and 6: replace "contains" by "is".
- IV. The Appellant (Opponent) requested that the patent be revoked even if the amendments made by the Proprietor should be taken into account.
- V. The Opposition Division decided to maintain the patent in amended form on the basis of the documents filed by the proprietor during oral proceedings. These documents contained all amendments according to the request of the proprietor made during oral proceedings before the Opposition Division with the exception of the amendment in Claim 6.
- VI. An appeal against this decision was lodged by the Opponent requesting that the decision under appeal be set aside and the patent be only maintained with further

amendments, namely on page 3, lines 25 and 42 the words "containing" and "contains" should be replaced by the word "is" and in Claim 6 on page 10, line 10 the word "contains" should be replaced by the word "is". They further requested reimbursement of the appeal fee.

VII. In reply, the Respondent (Patentee) agreed with the request of the Appellant and filed an accordingly amended specification with all corrections requested by the Appellant.

VIII. After a communication of the Board the Respondent agreed to delete the words "an organic group containing" on page 3, line 25 instead of replacing "containing" by "is" and requested that Claim 6 should remain as it presently stands. The Appellant did not comment on these amendments.

#### Reasons for the Decision

1. The appeal is admissible. The Appellant (Opponent) is in accordance with Article 107 EPC adversely affected. By the decision under appeal the European patent was maintained in amended form although the Appellant requested that the patent be revoked. With his appeal the Appellant pursues his request in the first instance in a restricted form. The amendments cannot be regarded as mere linguistic corrections, because the corrected words in the description can no longer give rise to a possible misinterpretation of the scope of the patent.
2. There are no objections to the requested amendments because they limit the protection conferred by the patent and both parties agreed or did not object to them.

3. According to Rule 67 EPC the reimbursement of an appeal fee shall be ordered where the Board of Appeal deems an appeal to be allowable if such reimbursement is equitable by reason of a substantial procedural violation. The decision under appeal maintained the patent on the basis of a text not being submitted or agreed by the Proprietor of the patent. This amounts to a contravention against Article 113(2) EPC which has to be regarded as a substantial procedural violation. It is the duty of the deciding division to check the documents which shall form the basis for decision maintaining the patent. The failure in controlling the documents forced the other party, the Opponent, to file an appeal and to pay an appeal fee. Under these circumstances the Board is of the opinion that it is equitable to reimburse the appeal fee.

#### Order

For these reasons, it is decided that:

1. The decision under appeal is set aside.
2. The European patent 107 089 is maintained in amended form on the basis of the following documents:

pages 2 to 9 filed 7 September 1990 with the further amendment that on page 3, line 25 the words "an organic group containing" are deleted instead of replacing the word "containing" by "is";

Claims 6 to 12 as granted.

3. Reimbursement of appeal fee is ordered.

The Registrar:

The Chairman:

E. Görgmaier

F. Antony