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File Number: T 281/90 - 3.3.1
Application No.: 83 109 653.2
Publication No.: 107 088
Title of invention: Novel pigment grinding vehicle

Classification: C07C 93/04

D E C I S I O N
of 10 June 1991

Proprietor of the patent: PPG INDUSTRIES, INC.

Opponent: HOECHST AG

Headword: Pigment grinding vehicle/PPG

EPC Article 102(3); Rule 67

Keyword: "Maintenance of the European patent in amended form" - "Incomplete adaptation to amended Claim 1" - "Substantial procedural violation (no)"

Headnote



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Boards of Appeal

Chambres de recours

Case Number : T 281/90 - 3.3.1

D E C I S I O N
of the Technical Board of Appeal 3.3.1
of 10 June 1991

Appellant :
(Opponent)

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Representative :

Respondent :
(Proprietor of the patent)

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US

Representative :

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Decision under appeal :

Interlocutory decision of the Opposition Division
of the European Patent Office of 2 November 1989,
posted on 31 January 1990 concerning maintenance
of European patent No. 107 088 in amended form.

Composition of the Board :

Chairman : K. Jahn
Members : P. Krasa
J. Stephens-Ofner

Summary of Facts and Submissions

I. This appeal lies from the interlocutory decision of the Opposition Division of 2 November 1989 with written reasons posted on 31 January 1990 maintaining the European patent 107 088, as amended in the course of oral proceedings which took place on 2 November 1989.

II. The only passage of the amended Claim 1 which is relevant to the sole issue before the Board is the definition of its feature (2). This passage reads as follows:

"(2) the amine is an amine containing ... at least one organic group which is an acyclic moiety of ..."

In this amended definition the present wording "which is an acyclic moiety" replaces the former wording of the claim as granted "which contains an acyclic moiety".

In the above-mentioned oral proceedings the Respondents submitted consequential amendments on page 2 of the description, where the term "contains" was replaced by "is" at lines 41 and 57. This was the only amendment submitted by them.

III. The appeal was received on 3 April 1990, together with the appeal fee, and the statement of grounds of appeal.

The Appellants request the description of the disputed patent to be adapted completely to the amended claims. Their basic argument in support of this request can be understood to be that while the scope of protection conferred by a European patent is determined by the terms of the claims, according to Article 69(1) EPC the description

and the drawings are also to be used in the interpretation of such claims. A description which is not brought completely in line with the amended claims would give rise to legal uncertainty and therefore result in claims which contravened Article 84 EPC, (relevant under Article 102(3) EPC).

The Appellants submit that the same amendments as already made on page 2 are necessary additionally on page 2, line 59, on page 3, line 9 and in dependent Claim 3, page 7, line 16.

The Appellants further request the reimbursement of the appeal fee under Rule 67 EPC, on the ground of a substantial procedural violation, namely the omission by the Opposition Division to effect all necessary consequential amendments in addition to the one specifically requested by the patentee.

- IV. The Respondents agreed to the suggested amendments with their submission received on 7 September 1990 and submitted simultaneously an amended specification and amended claims; they request maintenance of the patent in suit on the basis of these documents.

Reasons for the Decision

1. For an appeal to be admissible it is necessary (Article 107 EPC) for the Appellants to be adversely affected by the impugned decision. This requirement is met - see paragraph III above - because the possible remaining presence of legal uncertainty in the construction of the claims (Article 84 EPC) could be damaging to the Appellants' commercial interests. In this connection it is not necessary for the Board to give a definite judgment on the presence/absence of such legal uncertainty.

2. The suggested amendments are clearly allowable under Article 123 EPC. This not being contested, no further comments are necessary.
3. According to Rule 67 EPC the reimbursement of the appeal fee can only be ordered if the appeal is allowable and if such reimbursement seems to be equitable because of a substantial procedural violation.

Having regard to all the circumstances of this case, the Board cannot accept that the course of action adopted by the Opposition Division in amending the description only to the extent requested by the Respondents and not specifically objected to by the Appellants amounts to a substantial procedural violation under Rule 67 EPC.

4. Other reasons against the maintenance of the patent as amended were neither submitted nor were such reasons identified by the Board.

Order

For these reasons, it is decided that:

1. The decision under appeal is set aside.
2. The case is remitted to the Opposition Division with the order to maintain a patent on the basis of the documents submitted on 7 September 1990.
3. The request for reimbursement of the appeal fee is dismissed.

The Registrar:

The Chairman:

E. Görgmaier

K. Jahn