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D E C I S I O N
of 30 April 1999

Case Number: T 0683/96 - 3.3.3

Application Number: 92107118.9

Publication Number: 0497388

IPC: C08K 5/00

Language of the proceedings: EN

Title of invention:

Thermoplastic resin composition containing an organometallic colorant

Applicant:

Sumitomo Dow Limited

Opponent:

-

Headword:

-

Relevant legal provisions:

EPC Art. 84

Keyword:

"Claims - clarity - yes after amendment"

Decisions cited:

-

Catchword:

-



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Boards of Appeal

Chambres de recours

Case Number: T 0683/96 - 3.3.3

D E C I S I O N
of the Technical Board of Appeal 3.3.3
of 30 April 1999

Appellant:

Sumitomo Dow Limited
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Representative:

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Decision under appeal:

Decision of the Examining Division of the
European Patent Office posted 20 February 1996
refusing European patent application
No. 92 107 118.9 pursuant to Article 97(1) EPC.

Composition of the Board:

Chairman: C. Gérardin
Members: P. Kitzmantel
A. Lindqvist

Summary of Facts and Submissions

I. This appeal, which was filed on 19 April 1996, lies against the decision of the Examining Division dated 20 February 1996, refusing European patent application No. 92 107 118.9, published under No. 0 497 388, in the name of Sumitomo Naugatuck Co., Ltd., now Sumitomo Dow Co., Ltd., filed on 25 April 1992 as a divisional application of the application No. 87 114 928.2 (filing date: 13 October 1987; JP-priorities from 13 October 1986, 27 October 1986 and 17 March 1987; publication number: EP-A-0 264 01).

The appeal fee was paid simultaneously with the Notice of Appeal and the Statement of Grounds of Appeal was filed on 15 June 1996.

II. The decision under appeal was based on a set of four claims filed on 21 October 1995, independent Claims 1 and 4 reading as follows:

"1. A thermoplastic resin composition which comprises a thermoplastic resin which contains at least 5% by weight of an α -alkyl-substituted aromatic copolymer comprising α -alkyl-substituted aromatic vinyl compound and at least one other comonomer copolymerizable therewith, wherein the composition contains an organometallic colorant containing free metal content of not more than 2,000 ppm."

"4. Use of an organometallic colorant for a thermoplastic resin which contains at least 5% by weight of an α -alkyl-substituted aromatic copolymer comprising α -alkyl-substituted aromatic vinyl compound and at least one other comonomer copolymerizable therewith, which colorant contains free metal in an amount of not more than 2,000 ppm."

Claims 2 and 3 were dependent upon Claim 1.

- III. The decision under appeal held that the subject-matter of the application as claimed complied with the requirements of Articles 76(1), 123 (2), 54 and 56 EPC, but failed to meet those of Article 84 EPC, because Claim 1 tried to define a thermoplastic composition in terms of an impurity present in one of its components, i.e. by the amount of free metal in the colorant. Since, however, Claim 1 contained the open-ended statement "which comprises", further components could be present, which might as well be sources of free metal, thus rendering it impossible to ascertain, in the final composition, the amount of metal originating from the colorant.
- IV. With his Statement of Grounds of Appeal the Appellant filed an amended set of four claims allegedly no longer suffering from the clarity defects objected to in the decision under appeal.
- V. In communications of 19 August 1998 and 26 January 1999 the Board informed the Appellant that the amended claims would still be unclear with respect to the amount of free metal in the final thermoplastic composition originating from the colorant.
- VI. In submissions dated 15 December 1998 and 29 March 1999 the Appellant acceded to the respective suggestions of the Board and, with the last-mentioned submission, filed a new set of three claims directed to the use of the colorant in a thermoplastic resin composition. At the occasion of a personal consultation on 21 April 1999 the Representative of the Appellant submitted a further amended version of this set of claims.

Claim 1 of this final version reads as follows:

"1. Use of an organometallic colorant containing free metal content of not more than 2,000 ppm, in a thermoplastic resin composition which comprises a thermoplastic resin which contains at least 5% by weight of an α -alkyl-substituted aromatic copolymer comprising repeating units of α -alkyl-substituted aromatic vinyl compound and of at least one other comonomer copolymerizable therewith for the purpose of providing colored moldings having few or no silver streaks on its surface."

Dependent Claims 2 and 3 relate to specific embodiments of Claim 1.

VII. The Appellant requested that the decision under appeal be set aside and that a patent be granted on the following basis:

Claims: No. 1 to 3 filed on 21 April 1999;

Description: pages 1, 1a, 2 to 4, 4a, 5 to 7, 11 to 16, 18, 23, 24, 24a, 25 to 32 (pages 8 to 10, 17, 19 to 22 have been deleted) filed with the submission dated 15 April 1999.

Reasons for the Decision

1. The appeal is admissible.
2. *Article 123(2) EPC and Article 76(1) EPC*

Concerning its compositional features Claim 1 is based on its version as originally filed as well as on Claim 1 of the parent application No. 87 114 928.2; the

feature concerning the "use for the purpose of providing colored moldings having few or no silver streaks on its surface" is based on the disclosure on page 1, first paragraph and page 3, first paragraph of the application as filed (which is identical to the parent application No. 87 114 928.2).

Claims 2 and 3 correspond to Claims 4 and 5 of the application as filed, respectively to Claims 5 and 6 of the parent application No. 87 114 928.2, but drafted as use claims.

The requirements of Articles 123(2) and 76(1) EPC are therefore complied with by all claims.

3. *Article 84 EPC*

By the change of the category of Claim 1 to the use of the colorant the Article 84 EPC objection raised in the appealed decision does no longer apply. By that change the free metal content has become a feature directly contributing to the scope of the claim, whose presence can be positively ascertained.

4. *Novelty and inventive step (Articles 54 and 56 EPC)*

4.1 The decision under appeal acknowledged that the subject-matter of the application in suit was novel and involved an inventive step over the cited prior art (cf. points 3 and 4 of the Reasons).

4.2 These conclusions are not affected by the change of the category of the claims from product claims to use claims, because the compositionary features of the respectively claimed subject-matter as well as the technical problem and its solution remain the same.

4.3 The Board is not aware of anything able to invalidate the Examining Division's conclusions concerning the issues of novelty and inventive step.

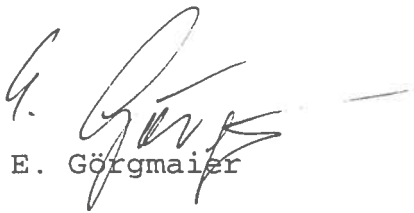
4.4 Therefore, the Board recognizes that the claimed subject-matter is novel and involves an inventive step over the cited prior art.

Order

For these reasons it is decided that:


1. The decision under appeal is set aside.
2. The case is remitted to the Examining Division with the order to grant a patent on the basis of the documents set out in point VII supra.

The Registrar:



E. Görgmaier

The Chairman:



C. Gérardin

