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**D E C I S I O N**  
of 27 July 1999

**Case Number:** T 0424/97 - 3.3.3

**Application Number:** 91902637.7

**Publication Number:** 0462262

**IPC:** C08G 63/685

**Language of the proceedings:** EN

**Title of invention:**  
Copolymerized Methine colorant-polyester color concentrates

**Applicant:**  
Eastman Chemical Company

**Opponent:**  
-

**Headword:**  
-

**Relevant legal provisions:**  
EPC Art. 54(1), (2), 82, 84, 111(1), 123(2)

**Keyword:**  
"Novelty (yes), after amendment"  
"Remittal at request of Appellant"

**Decisions cited:**  
T 0201/83

**Catchword:**  
-



Case Number: T 0424/97 - 3.3.3

**D E C I S I O N**  
of the Technical Board of Appeal 3.3.3  
of 27 July 1999

**Appellant:** Eastman Chemical Company  
100 North Eastman Road  
Kingsport  
TN 37660 (US)

**Representative:** Behrens, Dieter, Dr.-Ing.  
Wuesthoff & Wuesthoff  
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**Decision under appeal:** Decision of the Examining Division of the  
European Patent Office dated 3 August 1995  
refusing European patent application  
No. 91 902 637.7 pursuant to Article 97(1) EPC.

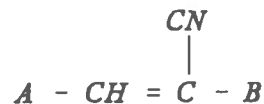
**Composition of the Board:**

**Chairman:** C. Gérardin  
**Members:** R. Young  
J. A. Stephens-Ofner

## Summary of Facts and Submissions

- I. European patent application No. 91 902 637.7, relating to "Copolymerized methine colorant-polyester color concentrates", based on international application No. PCT/US91/00019 and filed on 3 January 1991 was published, with 40 claims, under No. WO-A-91/10693. Claim 1 read as follows:

"A color concentrate comprising a polyester having copolymerized therein at least 1.0 weight percent, based on the weight of the concentrate, of the residue of one or more methine colorant compounds having the formula



wherein

A is an aniline, 1,2,3,4-tetrahydroquinoline, 2,3-dihydro-1,4-benzoxazine or 2,3-dihydroindole residue of a methine colorant compound bearing one polyester-reactive substituent; and

B is an unsubstituted or substituted alkoxy-carbonyl radical or an aromatic, carbocyclic or heterocyclic radical bearing one polyester-reactive substituent."

Claims 2 to 12 were dependent claims directed to embodiments of the color concentrate according to Claim 1.

Claims 13, 20 and 27 were independent claims directed to "An amorphous color concentrate..."; "A partially-crystalline polyester color concentrate..."; and "A colored semicrystalline powder...", respectively, each comprising a particular polyester having copolymerized

therein one or more methine colorant compounds according to Claim 1. The remaining Claims 14 to 19, 21 to 26 and 28 to 40 were dependent claims directed to elaborations of products according to Claims 13, 20 and 27, respectively.

II. The application was refused by a decision of the Examining Division dated 3 August 1995. The decision was issued in response to a request, by the Applicant at oral proceedings held before the Examining Division on 4 July 1995, for a decision on the state of the file. According to the decision, the application in suit did not meet the requirements of the EPC for the reasons given in a communication dated 28 April 1994 and during the oral proceedings itself. The latter proceedings were conducted on the basis of a set of Claims 1 to 13 filed on 2 June 1995 forming a main request, and a set of Claims 1 to 25 filed on 12 August 1994 forming an auxiliary request. Claim 1 according to the main request was directed to a color concentrate generally in accordance with Claim 1 as filed, in which the definitions of the various embodiments of the radicals A and B were, however, further elaborated, and Claims 2 to 13 were dependent claims directed to further features of the polyester/methine colorant combination. The claims of the auxiliary request were directed to a more specific pattern of the embodiments covered by the main request.

According to the minutes of the oral proceedings, reference was made in particular to two documents of the prior art:

D1: WO-A-89/10349; and

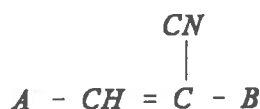
D2: US-A-4 804 719.

These documents were cited in support of objections of lack of novelty against the subject-matter claimed in both requests, although objections under Articles 84 and 123(2) EPC and potentially under Article 82 EPC were also raised.

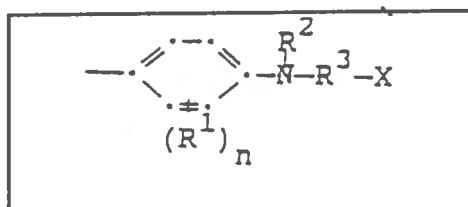
III. On 2 October 1995, a Notice of Appeal against the above decision was filed, together with payment of the prescribed fee.

The Statement of Grounds of Appeal, which was filed on 22 November 1995, was accompanied by a further, restricted set of Claims 1 to 3 as the sole request, which the Appellant (Applicant) argued were (a) in compliance with Articles 84 and 123(2) EPC, (b) novel and (c) based on an inventive step. Claim 1 read as follows:

"1. A color concentrate comprising a polyester having copolymerized therein at least 1.0 weight percent, based on the weight of the concentrate, of the residue of one or more methine colorant compounds having the formula

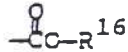


wherein A is



wherein

B is a radical having the formula:



wherein R<sup>16</sup> is an unsubstituted or substituted alkyl, cyclohexyl or aryl radical, containing a total of up to about 20 carbon atoms;

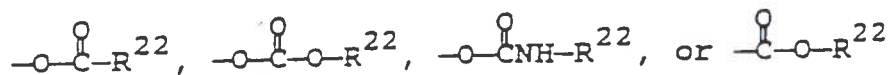
R<sup>1</sup> is lower alkyl, lower alkoxy or halogen;

R<sup>2</sup> is an unsubstituted or substituted alkyl, cyclohexyl or aryl radical, containing a total of up to about 20 carbon atoms;

R<sup>3</sup> is alkylene, alkenylene, alkynylene, cycloalkylene, alkylene-phenylene-alkylene, and alkylene-O-phenylene-O-alkylene;

n is 0, 1, 2 or 3; and

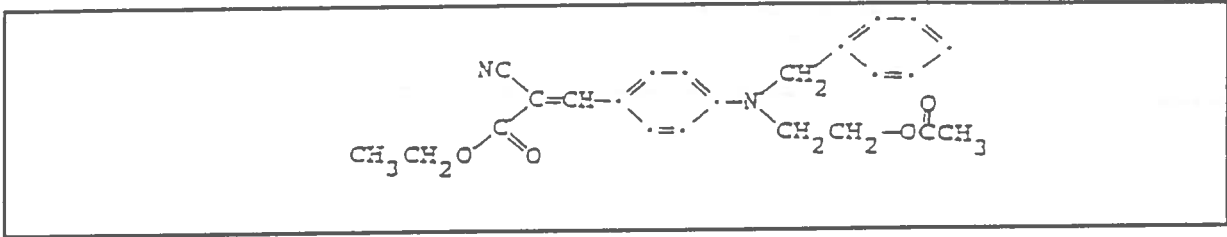
X is hydroxy, carboxy or an ester radical having the formula:



wherein R<sup>22</sup> is an unsubstituted or substituted alkyl, cyclohexyl or aryl radical, containing a total of up to about 20 carbon atoms."

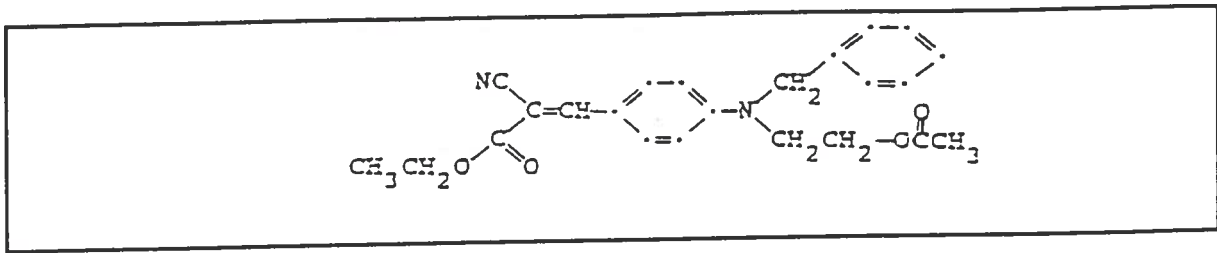
Claim 2 was a dependent claim directed to an elaboration of the concentrate according to Claim 1. Claim 3 read as follows:

"The concentrate of Claim 1 wherein the methine colorant has the structure;



- IV. With a communication issued on 15 April 1999, accompanying a summons to oral proceedings, the Board raised certain objections, again under Articles 123(2) and 84 EPC, against these claims, and also indicated that it considered D2 especially relevant with regard to the issues of novelty and inventive step.
- V. The Appellant replied with a submission, filed on 28 June 1999, which was accompanied by two further sets of Claims 1 to 3, labelled "main" and "alternative" claims, respectively.
- VI. Oral proceedings were held on 27 July 1999. During the oral proceedings, the Appellant abandoned all previous requests and submitted a single claim forming the main and sole request relied upon. The claim reads as follows:

"A color concentrate comprising a polyester having copolymerized therein at least 5 weight percent, based on the weight of the concentrate, of the residue of one or more methine colorant compounds wherein the methine colorant is



or

methyl 3-[4-[[2-(acetyloxy)ethyl]ethylamino]-2-methylphenyl]-2-cyano-2-propenoate."

VII. The Appellant requested that the decision under appeal be set aside and that the case be remitted to the first instance for further prosecution on the basis of the main request submitted during oral proceedings.

### Reasons for the Decision

1. *The decision under appeal*

The decision under appeal, whilst purporting to be a decision "on the state of the file", nevertheless refers, in its reasoning, *inter alia* to a communication dated 28 April 1994, which was established on the basis of a set of claims (the claims as filed), which was not the latest set of claims on file at the date the decision was issued. On the contrary, the claims as filed had been superseded by the two sets of claims referred to in the minutes of the oral proceedings (section II, above). To the extent that the decision relies, for its reasoning, on the communication, therefore, it is not "on the state of the file", nor, consequently, in accordance with Article 113(2) EPC.



1.1 Although the Board considers that it would have been entitled, after having heard the Appellant, and on the basis of this procedural point alone, to refer the case back to the Examining Division with an order to re-draft the decision in accordance with Article 113(2) EPC, the following considerations have caused it to refrain from doing so.

- (i) The matter was not complained of by the Appellant;
- (ii) Additional reasoning, related to the relevant latest sets of claims submitted by the Appellant (section II, above) is present in the minutes of the oral proceedings, from which a relevant ground of refusal of the application is furthermore discernible; and
- (iii) The early date of the decision under appeal (1995) means that such an action by the Board would have resulted in a considerable further delay, which would have been to the disadvantage of the Appellant, without materially affecting the outcome.

1.2 Consequently, the examination of the appeal has been carried out on the basis of the reasoning relating to the claims referred to in the minutes of the oral proceedings held before the Examining Division on 4 July 1995, and not those set out in the communication dated 28 April 1994 (section II, above). In particular, the grounds of refusal of the application in suit are deemed to be only those referred to in the minutes.

2. *Admissibility of the appeal*

The deficiencies referred to above do not affect the appealability of the decision in the sense of Articles 106 to 108 EPC. Consequently, the appeal is admissible.

3. *Admissibility of amendments (Article 123(2) EPC)*

The claim forming the sole request to be considered in the appeal is based on Claim 1 of the application as filed and published, read in conjunction with the description on page 4, lines 21 to 23 ("polyesters containing... especially at least 5.0, ... weight percent of colorant residue") and with Examples 1 and 8, the latter disclosing the particular methine colorant compounds now referred to in the claim. In the latter connection, the exemplified methine colorant compounds are stated in the general description to be "useful in the preparation of the color concentrate compositions of this invention" (page 22, last paragraph). Consequently, the skilled person would understand that the features of the colorants were not so closely associated with the other features of the examples as to determine the effect of that embodiment of the invention as a whole in a unique manner and to a significant degree. Hence, there is no obstacle to the combination of the particular methine colorant compounds defined in the claim with the polyesters as originally broadly defined (T 201/83, OJ EPO 1984, 481). Hence, the requirements of Article 123(2) are met in the amended claim.

4. *Clarity (Article 84 EPC)*

The objections of lack of clarity previously raised by the Board no longer arise, since each colorant compound is now uniquely defined. The claim thus meets the clarity requirements of Article 84 EPC.

5. *Novelty (Article 54(1) and (2) EPC)*

The subject-matter of the claim is not disclosed in either D1 or D2, since the two particular methine colorant compounds defined in the claim are neither mentioned *per se* in the cited documents, nor as a variant which would yield an identical residue on copolymerisation. In particular, the most relevant species in D2, i.e. Table 1, compound 7, referred to in the minutes of the oral proceedings before the Examining Division (point 5.2) does not contain the appropriate relevant reactive linking group  $R_1$  to yield an identical residue on copolymerisation. Consequently, the claimed subject-matter is novel.

6. *Unity of invention (Article 82 EPC)*

Whilst an objection of lack of unity of invention was only raised in provisional form, according to the minutes of the oral proceedings held before the Examining Division, it follows from the above finding in relation to novelty, that there is sufficient structural commonality between the two methine colorant compounds defined in the claim, for no difficulty to arise in relation to Article 82 EPC.

7. *Remaining issues; Inventive step*

7.1 Whilst the unorthodox presentation of the decision under appeal offers little help to shed light upon the precise ground(s) on which the refusal of the application was based (section II, above), it is nevertheless clear from the various issues which are mentioned (lack of novelty, lack of clarity, potential lack of unity of invention), that lack of inventive step is not one of them. Consequently, it is evident that, on the date of issue of the decision under appeal, the examination of the application was, in this respect at least, incomplete.

7.2 It is furthermore a consequence of the radically restricted scope of the present claim, in relation to the choice of methine colorant compounds, that the Board is effectively confronted with a new case in appeal.

7.3 Whilst the Board has considered it appropriate to address the issues arising under Articles 123(2), 84, 54(1) and (2) and 82 EPC in relation to this new claim (sections 3 to 6, above), a final determination of the issue of inventive step would in its view be premature, since it would deprive the Appellant of one instance of jurisdiction in this respect.

7.4 In any case, the Appellant requested, at the oral proceedings before the Board, that the case be remitted to the Examining Division for further prosecution.

7.5 Consequently, the Board, in the exercise of its powers under Article 111(1) EPC and in the light of the request of the Appellant, has decided to remit the case

for completion of the examination of the application.  
This will involve a determination of the issue of  
inventive step at least.

## Order

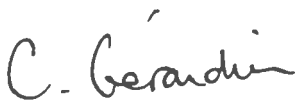
**For these reasons it is decided that:**

1. The decision under appeal is set aside.
2. The case is remitted to the first instance for further prosecution on the basis of the main request submitted during oral proceedings.

The Registrar:

  
E. Görgmaier

The Chairman:

  
C. Gérardin

