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**Datasheet for the decision
of the Enlarged Board of Appeal
of 24 March 2010**

Case Number: R 0019/09

Appeal Number: T 1874/06 - 3.2.07

Application Number: 97937764.5

Publication Number: 1021584

IPC: C23C 14/06

Language of the proceedings: EN

Title of invention:
Tool with protective layer system

Patentee:
Unaxis Balzers Aktiengesellschaft

Opponent:
Hauzer Techno-Coating B.V.

Headword:
Fundamental violation of Article 113/UNAXIS

Relevant legal provisions:
EPC Art. 56, 112a(2)(c), 113
EPC R. 106, 107(1)(b), (2)

Keyword:
"Petition for review - clearly unallowable"

Decisions cited:
R 0001/08, R 0002/08, R 0009/08

Catchword:
-

Case Number: R 0019/09

D E C I S I O N
of the Enlarged Board of Appeal
of 24 March 2010

Petitioner: Unaxis Balzers Aktiengesellschaft
(Patent Proprietor) LI-9496 Balzers (LI)

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Decision under review: Decision of the Technical Board of Appeal
3.2.07 of the European Patent Office of
14 July 2009.

Composition of the Board:

Chairman: P. Messerli
Members: B. Schachenmann
A. S. Clelland

Summary of Facts and Submissions

- I. The petition for review concerns decision T 1874/06 of Board of Appeal 3.2.07 which dismissed the petitioner's appeal against the decision of the opposition division to revoke European patent No. 1 021 584. The petition of the appellant is based on the ground of Article 112a(2)(c) EPC, i.e. an alleged fundamental violation of Article 113 EPC.
- II. The revoked patent of the appellant/petitioner relates to a tool with a tool body and a wear resistant layer system. The structure of the claimed layer system is defined *inter alia* by a parameter Q_I . Claim 1 of all requests considered by the Board differed from a prior art document E2A by the feature that the value of parameter Q_I was at least 5. According to the patent in suit "the Q_I values as specified lead to an astonishingly high improvement of wear resistance, and thus of lifetime of a tool, if such a tool is of the kind as specified" (page 4, lines 18 and 19 of the patent specification).
- III. The opposition division had revoked the patent for lack of inventive step mainly based on the finding that the proprietor had not been able to show any special technical effect for the selection of a Q_I value over 5. With the statement of the grounds of appeal the appellant/petitioner submitted a "sketch A" with "bottom" and "top" characteristics, respectively representing the cutting performance vs. the Q_I values for layer systems as disclosed in table 1 and table 2 of the patent. In the appellant's submission "sketch A" showed that at Q_I values of at least 5 there was an

unexpected increase of cutting performance. The claimed tool was therefore not obvious in view of E2A.

IV. The written decision of the Board of Appeal deals with the issue of inventive step based on the problem-solution approach. In point 5.5 the Board found that the skilled person, starting from the general teaching of document E2A and the examples disclosed in table 1 of this document and aiming to improve the wear resistance, "would inevitably arrive at the subject-matter of claim 1 of auxiliary request II without any inventive skill". Then, in point 5.5.1 the Board turned to the appellant's submissions and found *inter alia* that, based on "sketch A", no effect could be acknowledged at all, since the appellant had compared cutting performance values belonging to two different layer systems as represented by the two characteristics in "sketch A". "Consequently, it has not been shown that this effect has its origin in the distinguishing feature" as required by the established jurisprudence of the Boards of Appeal. At the end of point 5.5.1 the Board added: "Furthermore, as evident from examples 1-7 a higher Q_I value does not imply an increased cutting distance" and, in support of this statement, made its own comparisons of cutting performance values and Q_I values based on embodiments of table 1 of the patent.

V. In its petition for review the appellant/petitioner submits that the Board 3.2.07 based its written decision on a wrong understanding of the appellant's submissions in support of an unexpected effect, in particular of "sketch A", which had never been discussed. The Board was in error in assuming that the appellant had tried to derive an unexpected effect from

a comparison between the two characteristics in "sketch A", i.e. the "top" characteristic belonging to the layer system of table 2 and the "bottom" characteristic belonging to the different layer system of table 1 of the patent. The appellant had never made such an obviously wrong comparison and the Board had never addressed this issue before. Thus, the Board had refused to acknowledge the unexpected effect to be shown by "sketch A" based on a ground on which the appellant never had an opportunity to present its comments.

VI. In a communication annexed to the summons to oral proceedings the Enlarged Board of Appeal indicated that the so-called "wrong comparison" argument indeed appeared not to have been raised by the Board of Appeal during the appeal proceedings. It could not be excluded that the petitioner's right to be heard was violated in this respect. It had therefore to be considered whether such a procedural defect amounted to a fundamental violation of Article 113 EPC. According to the jurisprudence of the Enlarged Board of Appeal this would only be the case if a causal link existed between the procedural defect and the final decision. However, there were doubts whether the "wrong comparison" argument indeed was the only reason for which the Board did not acknowledge an unexpected effect. In this connection it was pointed out that the decision under review also contained an analysis of the examples 1 to 7 of table 1 of the patent as represented by the bottom characteristic of "sketch A" and that the Board had concluded from this analysis that a higher Q_I value did not imply an increased cutting distance. Moreover, independently of the alleged unexpected effect, it

appeared that the main ground for the dismissal of the appeal was based on the classical problem-solution approach starting from document E2A as closest prior art.

VII. At the oral proceedings before the Enlarged Board of Appeal, which took place on 24 March 2010, the petitioner disagreed with the communication of the Enlarged Board of Appeal in respect of lack of a causal link. In the petitioner's view there clearly existed a causal link between the denial of the petitioner's right to be heard on the "wrong comparison" argument and the Board's decision to dismiss the appeal.

(a) In this connection the first question to be answered was whether the Board had refused to acknowledge the unexpected effect solely based on the "wrong comparison" argument developed in connection with "sketch A". In the petitioner's submission this was indeed the case. The fact that the Board, in a passage following the "wrong comparison" argument, further analysed the cutting distances and the Q_1 values of embodiments of the patent, had nothing to do with the previous interpretation of "sketch A". Had this interpretation been done correctly, as proposed by the petitioner, it would have led to the acknowledgement of an unexpected effect. On the other hand, the purpose of the additional analysis by the Board of the examples 1 to 7 was simply not clear. Even if the bottom characteristic of "sketch A" had partly been derived from table 1 of the patent, it could not simply be equated with the examples 1 to 7 of this table. In any case the

Board did not, in this connection, refer to "sketch A". It therefore could not be concluded that the analysis by the Board of examples 1 to 7 was an additional reason for not acknowledging an unexpected effect.

- (b) The second question to be considered was whether the submitted unexpected effect, had it been acknowledged by the Board, would have influenced the problem-solution approach on which the dismissal of the appeal was based. This question only needed to be answered if the Enlarged Board of Appeal agreed with the petitioner's arguments referred to in paragraph (a) above. In this case it had to be considered that the motivation of the skilled person to depart from the closest prior art, i.e. document E2A, was an important aspect of the could-would consideration within the framework of the problem-solution approach. In this connection "sketch A" was decisive because it showed that there was no motivation for the skilled person, starting from Q_I values in the range of 1.5 to 3 known from document E2A, to further raise the Q_I value as the unexpected increase of the cutting performance would not have occurred until a Q_I value of 5 was reached. Therefore, a correct interpretation of "sketch A" would have influenced the problem-solution approach and led to a different decision.

VIII. The petitioner requested that the decision of the Board of Appeal be set aside and proceedings before the Board of Appeal be re-opened.

Reasons for the Decision

Admissibility of the petition for review

1. The petitioner is adversely affected by the decision T 1874/06 to dismiss its appeal. The petition for review was filed on the grounds referred to in Article 112a(2)(c) EPC. It contains an indication of the decision to be reviewed and reasons for setting aside this decision. The petition therefore complies with the provisions of Article 112a(1) and (2) EPC and of Rule 107(1)(b) and (2) EPC.
2. The written decision T 1874/06 was notified to the parties by registered letter posted on 23 September 2009. The two month period for filing a petition for review expired on 3 December 2009. The present petition for review was filed and the fee was paid on 23 November 2009. The petition therefore also complies with Article 112a(4) EPC.
3. Pursuant to Rule 106 EPC a petition under Article 112a(2)(a) to (d) EPC is only admissible where an objection in respect of the procedural defect was raised during the appeal proceedings and dismissed by the Board of Appeal, except where such objection could not be raised during the appeal proceedings. In the circumstances of the present case the petition is based on the submission that the written decision of the Board of Appeal contains grounds on which the petitioner had no opportunity to presents its comments. Therefore, the exception of Rule 106 EPC applies here.

4. Accordingly, the Enlarged Board of Appeal is satisfied that the petition is not clearly inadmissible.

Allowability of the petition for review

5. The discussion during the appeal proceedings mainly concerned inventive step pursuant to Article 56 EPC in view of document E2A and, in particular, the following question: Was it obvious for the skilled person aiming at further improving the performance of tools to increase the Q_I value of the layer system known from E2A to a value of at least 5? It is in this context that the petitioner referred to measuring results disclosed in tables 1 and 2 of his patent. Together with the grounds of appeal he filed "sketch A" representing the values of these tables in the form of two characteristics showing the cutting performance versus the Q_I values. It was submitted that both characteristics showed an unexpected increase of the cutting performance of the tool at Q_I values of at least 5. This was one of the proprietor's arguments in support of inventive step.
6. Neither in the Board's communication annexed to the summons to oral proceedings nor anywhere else in the file is there any indication that the issue of an allegedly "wrong comparison" between the Q_I values of the top characteristic and those of the bottom characteristic in "sketch A" was raised. It therefore appears that this reason of the Board of Appeal for not acknowledging an unexpected effect, as set out in point 5.5.1 of the decision under review, was indeed never discussed in the appeal proceedings. Thus, it

cannot be ruled out that the petitioner's right to be heard was disregarded in this respect.

7. In point 3.3 of the petition and at the oral proceedings before the Enlarged Board of Appeal (see point VII, supra) the petitioner submitted that the violation of his right to be heard was fundamental as there was a **causal link** between this violation and the final decision (thereby implicitly applying the jurisprudence of the Enlarged Board of Appeal in case R 1/08). As conceded by the petitioner such a link can only be assumed to exist if the Board had refused to acknowledge an unexpected effect **solely** based on the "wrong comparison" argument (on which the petitioner was not heard). If, on the other hand, the Board had refused to acknowledge the unexpected effect also for other reasons on which the petitioner was heard it could not be argued that the procedural deficiency causally determined the final decision.

8. The "wrong comparison" argument referred to above is discussed in point 5.5.1 of the decision under review. Point 5.5.1 is clearly devoted to a discussion of the arguments forwarded by the petitioner. These considerations are preceded, in point 5.5, by a comprehensive reasoning of the Board concerning inventive step having regard to document E2A. Based on the teaching of document E2A alone, in particular of its examples 1 and 7, the Board comes to the conclusion that "the application of a bias voltage of -50V in combination with the discharge current and the nitrogen pressure being held constant at those of examples 1 and 7 (...) **would inevitably produce a Q_I value above 5.** Therefore the person skilled in the art would

inevitably arrive at the subject-matter of claim 1 of auxiliary request II **without any inventive skill**" (emphasis added). Whether this argumentation is correct in substance cannot be the subject of review proceedings (see R 2/08, point 5 of the reasons; R 9/08, point 6.3 of the reasons). In any case the line of reasoning in point 5.5 is independent of a possible unexpected effect of the claimed subject-matter and therefore independent of "sketch A".

9. For this reason it is highly questionable whether the procedural deficiency referred to in point 6., supra, could have been causal for the final decision. However, this question can be left open since, as will be shown in the following, the "wrong comparison" argument was not the only reason of the Board for not acknowledging an unexpected effect.

9.1 Point 5.5.1 of the reasons deals, in a first paragraph, with the appellant's counter-arguments in respect of the teaching of document E2A. In a second paragraph the Board then analyses appellant's "sketch A" in view of the alleged unexpected effect. Based on the "wrong comparison" argument the Board concludes that "it has not been shown that this effect has its origin in the distinguishing feature". Then the Board goes on to state: "Furthermore, as evident from examples 1-7 a higher Q_I value does not imply an increased cutting distance", followed by an analysis of the Q_I values and the corresponding cutting distances of various examples of table 1 of the patent. Independently of whether or not this analysis is correct in substance, it shows that the Board considered the alleged effect of an increased cutting distance at higher Q_I values not only

under the aspect of a supposedly "wrong comparison" between two different layer systems, but also based on an analysis of the Q_I values and the cutting distances belonging to one specific layer system. Even if it is true that the Board of Appeal did not explicitly refer to "sketch A" in this connection, its analysis refers to measuring values substantially as contained in the bottom characteristic of "sketch A" from which the petitioner derived the existence of an unexpected effect. The conclusion drawn by the Board from these measuring values that "a higher Q_I value does not imply an increased cutting distance" is to be considered as a direct answer to the appellant's argumentation of an unexpected effect. The Board thus denied the existence of an unexpected effect for a second reason on the same factual basis as "sketch A" submitted and discussed by the appellant/petitioner during the appeal proceedings. The question whether or not this finding of the Board of Appeal was correct in substance cannot be the subject of the review proceedings (see point 8, supra).

- 9.2 The Enlarged Board of Appeal therefore concludes that the "wrong comparison" argument was only one of two grounds for which the Board did not acknowledge the existence of an unexpected effect and that the second ground given in the decision under review was a reaction to the submissions of the appellant on this issue. Consequently, for this reason alone there is no causal link between the procedural deficiency as specified in point 6, supra, and the decision under review. Due to such a lack of causal link the violation of Article 113 EPC is clearly not fundamental within the meaning of Article 112a(2)(c) EPC.

Order

For these reasons it is unanimously decided that:

The petition for review is rejected as clearly unallowable.

The Registrar:

The Chairman:

W. Roepstorff

P. Messerli