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D E C I S I O N
of 13 September 2002

Case Number: T 0865/00 - 3.3.3

Application Number: 93306654.0

Publication Number: 0586161

IPC: C08J 5/18

Language of the proceedings: EN

Title of invention:

Biaxially oriented polyester film for lamination onto metal sheet

Applicant:

TEIJIN LIMITED

Opponent:

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Headword:

-

Relevant legal provisions:

EPC Art. 123(2)

Keyword:

"Amendments - added subject-matter (yes)"

Decisions cited:

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Catchword:

-



Case Number: T 0865/00 - 3.3.3

D E C I S I O N
of the Technical Board of Appeal 3.3.3
of 13 September 2002

Appellant: TEIJIN LIMITED
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Decision under appeal: Decision of the Examining Division of the
European Patent Office posted 29 March 2000
refusing European patent application
No. 93 306 654.0 pursuant to Article 97(1) EPC.

Composition of the Board:

Chairman: R. Young
Members: W. Sieber
J. van Moer

Summary of Facts and Submissions

- I. European patent application No. 93 306 654.0, filed on 23 August 1993, claiming a JP priority of 25 August 1992 (JP 225759/92) and published under No. 0 586 161, was refused by a decision of the Examining Division issued in writing on 29 March 2000.
- II. The decision was based on a set of Claims 1 to 13 forming a main request, a set of Claims 1 to 11 forming a first auxiliary request, and a set of Claims 1 to 11 forming a second auxiliary request, all filed during the oral proceedings held on 2 September 1999. Claim 1 of the main request read as follows:
- "1. A biaxially oriented polyester film made of a polyester composition which polyester composition consists essentially of:
- (a) an aromatic copolyester having a melting point of 210-245°C,
 - (b) first inert fine solid particles having an average particle diameter of 0.05 to 0.6 µm, and
 - (c) second inert fine solid particles having an average particle diameter of 0.3 to 2.5 µm,
- wherein said first inert fine solid particles and said second inert fine solid particles each have a sharp particle diameter distribution and a relative standard deviation of particle diameter of 0.5 or less, and the ratio of the average particle diameter of the second inert fine solid particles to the average particle diameter of the first inert fine solid particles being at least 2.5, and the amounts of the components (b) and (c) being 0.01 to 3% by weight and 0.001 to 0.2% by weight, respectively, based on the total weight of the components (a), (b) and (c);

wherein the polyester film has a plane orientation coefficient of 0.08 to 0.16."

Claim 1 of the first auxiliary request read as follows:

"1. Use for lamination on to a metal sheet of a biaxially oriented polyester film made of a polyester composition which polyester composition comprises (a) an aromatic copolyester having a melting point of 210-245°C and filler particles, characterized in that said filler particles consist of (b) first inert fine solid particles having an average particle diameter of 0.05 to 0.6 µm, and (c) second inert fine solid particles having an average particle diameter of 0.3 to 2.5 µm, and the ratio of the average particle diameter of the second inert fine solid particles to the average particle diameter of the first inert fine solid particles being at least 2.5, and the amounts of the components (b) and (c) being 0.01 to 3% by weight and 0.001 to 0.2% by weight, respectively, based on the total weight of the components (a), (b) and (c); and wherein the polyester film has a plane orientation coefficient of 0.08 to 0.16."

Claim 1 of the second auxiliary request differed from Claim 1 of the first auxiliary request in that it contained the further requirement that the first inert fine solid particles were titanium dioxide and the second inert fine solid particles were silica.

III. At the oral proceedings held on 2 September 1999, the examining division decided that the main request and the first auxiliary request did not meet the requirements of Articles 84 and 54 EPC. Having regard

to the second auxiliary request, the applicant was given a period of four months to provide appropriate evidence establishing an inventive step of the subject-matter of Claim 1 of this request. The applicant did not, however, not file any observations within the time limit given but requested a decision according to the state of the file (letter of 23 February 2000). Consequently, the application was refused on the grounds that the subject-matter of the main request and the first auxiliary request contravened Articles 84 and 54 EPC, and the subject-matter of the second auxiliary request did not meet the requirements of Article 56 EPC. Both the novelty and the inventive step objection were raised in the light of document D1:

D1: EP-A-0 415 383.

- (i) According to the decision under appeal, it was not possible to distinguish between first and second inert fine solid particles, at least in some situations covered by the claims. Consequently, all claims of the main request and first auxiliary request requiring certain weight ratios or particle diameter ratios of components (b) and (c) lacked clarity.

- (ii) Furthermore, it was held that the filler used in Examples 3 and 4 of D1 inevitably contained particles considerably smaller and larger than the average particle size diameter of 0.3 μm so that the prior art disclosed inherently a combination of two particle components as required in the application in suit. Because D1 disclosed also all the other parameters required in Claim 1 of the main request and the first

auxiliary request these claims were considered to be anticipated by Examples 3 and 4 of D1.

- (iii) Because the applicant did not provide any evidence for a technical effect due to the use of two specified particles, the subject-matter of Claim 1 of the second auxiliary request was considered to be an obvious alternative to the polyester film used in D1.

IV. On 5 May 2000, a Notice of Appeal against the above decision was filed, the prescribed fee being paid on the same day.

In the Statement of Grounds of Appeal filed on 7 August 2000, the appellant made no criticism of the reasoning in the decision under appeal but submitted a new main request with Claims 1 to 12 which replaced all the requests before the examining division and was believed to overcome the objections raised in the decision under appeal. Claim 1 read as follows:

"1. A process for making a metal sheet laminated with a biaxially oriented polyester film comprising the steps of:

- (i) adding (a) first inert fine solid particles having an average particle diameter of 0.05 to 0.6 μm , and
- (b) second inert fine solid particles having an average particle diameter of 0.3 to 2.5 μm , to (c) an aromatic copolyester having a melting point of 210 to 245°C or to the reaction system in production of such an aromatic copolyester to make a biaxially oriented polyester film, wherein the polyester film has a plane orientation coefficient of 0.08 to 0.16, and

wherein the ratio of the average particle diameter of the second inert fine solid particles to the average particle diameter of the first inert fine solid particles is at least 2.5, and the amounts of the components (a) and (b) are 0.01 to 3% by weight and 0.001 to 0.2% by weight, respectively, based on the total weight of the components (a), (b) and (c); and (ii) laminating a metal sheet with the biaxially oriented polyester produced in step (i)."

According to the appellant, the two groups of particles were distinguishable from each other before they were added to the polyester composition, and D1 did neither disclose nor suggest a process where two separate groups of inert fine solid particles were added to an aromatic polyester.

- V. In a communication accompanying a summons to oral proceedings the salient issues were identified by the Board as being firstly, the amendment of Claim 1 (Article 123(2) EPC), secondly, the clarity of Claim 1 with regard to the determination of the plane orientation coefficient and the definition of the two groups of particles, thirdly, the novelty of the claimed subject-matter over D1 and fourthly, whether the subject-matter of Claim 1 involved an inventive step over D1. Having regard to the latter, the appellant was asked plausibly to demonstrate that a technical effect or an advantage of the claimed process occurred over the whole scope of Claim 1.
- VI. With letter of 5 August 2002, the appellant withdrew the request for oral proceedings made in the Statement of Grounds of Appeal.

VII. On 13 September 2002, oral proceedings were held before the board at which the appellant was not represented. In accordance with Rule 71(2) EPC, the oral proceedings were continued in the absence of the appellant based on the request on file to set aside the decision under appeal and a patent be granted on the basis of the set of Claims 1 to 12 filed on 7 August 2000.

Reasons for the Decision

1. The appeal is admissible.
2. *Amendments*

According to step (i) of amended Claim 1, first and second inert fine particles are added to an aromatic copolyester or to the reaction system in production of such an aromatic copolyester. Whilst the wording for the latter possibility is explicitly disclosed on page 9, lines 29 to 32 as originally filed, the addition to the copolyester is disclosed only in the context of melt mixing (page 10 as originally filed, lines 1 to 8). There is no basis in the application as originally filed which would justify the generalization of a specific embodiment, ie addition including melt mixing, to a broader application, ie addition having no further requirement. Thus, amended Claim 1 does not meet the requirements of Article 123(2) EPC.

3. As Claim 1 of the only request on file does not meet the requirements of Article 123(2) EPC any further consideration of the merits is not appropriate.

Order

For these reasons it is decided that:

The appeal is dismissed.

The Registrar:

The Chairman:

E. Görgmaier

R. Young