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**Datasheet for the decision
of 30 November 2006**

Case Number: T 0993/02 - 3.5.04

Application Number: 93116085.7

Publication Number: 0592922

IPC: G11B 5/706

Language of the proceedings: EN

Title of invention:
Magnetic recording medium

Patentee:
KONICA CORPORATION

Opponents:
TODA KOGYO CORPORATION
EMTEC Magnetics GmbH

Headword:
-

Relevant legal provisions:
EPC Art. 111(1)

Keyword:
"Claims substantially amended with the grounds of appeal -
fresh case - remittal"

Decisions cited:
-

Catchword:
-



Case Number: T 0993/02 - 3.5.04

DECISION
of the Technical Board of Appeal 3.5.04
of 30 November 2006

Appellant: KONICA CORPORATION
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Respondent: TODA KOGYO CORPORATION
(Opponent 01) 7-1, Yokogawa-Shinmachi, Nishi-ku
Hiroshima-shi, Hiroshima-ken (JP)

Representative: Polz, Leo
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Respondent: EMTEC Magnetics GmbH
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Representative: Riedl, Peter
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Decision under appeal: Decision of the Opposition Division of the
European Patent Office posted 18 July 2002
revoking European patent No. 0592922 pursuant
to Article 102(1) EPC.

Composition of the Board:

Chairman: F. Edlinger
Members: M. Paci
T. Karamanli

Summary of Facts and Submissions

- I. The appellant (patent proprietor) lodged an appeal against the decision of the opposition division revoking European patent No. 0 592 922.
- II. Two oppositions had been filed against the patent by opponents O1 and O2, now respondents 1 and 2 respectively. The patent was opposed under Article 100(a) EPC for lack of novelty and inventive step and under Article 100(b) EPC for insufficiency of disclosure.

- III. During the oral proceedings before the opposition division respondent 2 filed the following document:

E2.7: EP-0 566 378 A

which was admitted into the opposition proceedings because of its *prima facie* relevance.

- IV. In the decision under appeal the opposition division revoked the patent for essentially the following reasons:

- the priority claimed in the patent was not valid for the subject-matters of claim 9 of the main request (patent as granted) and claim 1 of the auxiliary request because these claims included ranges of compositions which could not be derived directly and unambiguously from the priority document;
- since priority was not validly claimed, E2.7 was prior art under Article 54(3) and (4) EPC for these claims; and

- the subject-matters of these claims lacked novelty having regard to the disclosure of E2.7.

The opposition division did not comment on the other claims of the main and auxiliary requests but noted that the validity of the priority of E2.7 had not been checked.

Concerning the alleged insufficiency of disclosure, the opposition division held that the patent specification as a whole was sufficiently clear and complete for it to be carried out by a person skilled in the art.

- V. With the grounds of appeal the appellant submitted a new main request, claim 1 being a combination of granted claims 1 and 2 (granted claim 9 had been deleted). As an auxiliary request, oral proceedings were requested.
- VI. Respondent 1 requested that the appeal against the decision be rejected and, alternatively, that oral proceedings be arranged. Respondent 2 did not file any reply.
- VII. In an official communication the board informed the parties of its intention to remit the case to the first instance for further prosecution and invited the appellant and respondent 1 to state whether they maintained their requests for oral proceedings.
- VIII. In reply to the board's communication, the appellant requested that the decision of the opposition division be set aside and that the case be remitted to the opposition division for further prosecution on the

basis of claims 1 to 9 and description pages 2, 3, 12, 16, 17 and 20, filed with the grounds of appeal, as well as description pages 4 to 11, 13 to 15, 18, 19 and 21 of the patent as granted. Furthermore the appellant stated that the novelty of the subject-matter of claims 1 to 9 should be acknowledged. Oral proceedings were requested as an auxiliary request.

- IX. Respondent 1 withdrew his request for oral proceedings in reply to the board's communication.
- X. Respondent 2 has not filed any request on appeal.

Reasons for the Decision

- 1. The appeal is admissible.
- 2. The amendments made to claim 1 (ie the addition of the features of granted claim 2 to granted claim 1), the deletion of granted claim 9 and the abandonment of the previous auxiliary request have the effect that none of the reasons given in the contested decision for revoking the patent still applies to the amended set of claims filed with the statement of grounds of appeal.
 - 2.1 Thus, in the case under consideration, the board is effectively confronted with an entirely fresh case in which:
 - (a) none of the reasons leading to the revocation of the patent is still valid,

- (b) the reasoning concerning the sufficiency of disclosure in the decision under appeal has not been challenged by the respondents, and
- (c) the subject-matters of new claims 1 to 9 (corresponding to granted claims 2 to 8, 10 and 11) had been challenged by the opponents in their notices of opposition, but the raised objections, in particular those concerning inventive step, have not been dealt with in the decision under appeal.

3. Under these circumstances, in order to give the parties the opportunity to defend their claims or submissions before two instances, the board considers it appropriate to exercise the power conferred upon it by Article 111(1) EPC and to remit the case to the department of first instance for further prosecution in accordance with the appellant's main request.

4. For the sake of completeness, the board would also like to draw the attention of the opposition division and of the parties to the fact that document E2.7 might be prior art under Article 54(3) and (4) EPC also for subject-matter which validly claims the priority of the patent. Indeed, three of the four priorities claimed by E2.7 are earlier than the priority date of the patent. Since neither this issue nor, more generally, the novelty of the present claim 1 was a matter decided by the decision under appeal, the board could not acknowledge the novelty of the subject-matter of claims 1 to 9 without further examination, an option which the board has declined to follow after due assessment of the particular circumstances of the present case (see points 2 and 3 above). Any comments

on this issue by the board could prejudice the examination by the opposition division which would run counter to the purpose of remitting the case so that it can be examined by two instances.

5. Since the board has allowed the appellant's main request, oral proceedings according to the appellant's auxiliary request need not be held.

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.

The Registrar:

The Chairman:

D. Sauter

F. Edlinger