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**D E C I S I O N**  
**of 1 March 2006**

**Case Number:** T 1170/02 - 3.3.09

**Application Number:** 95111914.8

**Publication Number:** 0679508

**IPC:** B32B 27/20

**Language of the proceedings:** EN

**Title of invention:**  
Biaxially oriented laminated film

**Patentee:**  
TORAY INDUSTRIES, INC.

**Opponent:**  
Mitsubishi Polyester Film GmbH  
Teijin Chemicals, Ltd.

**Headword:**  
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**Relevant legal provisions:**  
EPC Art. 84, 76(1), 123(2), 114(2), 113(1), 111(2)

**Keyword:**  
"New main request - admissible"  
"Added subject-matter (no)"

**Decisions cited:**  
T 0002/81, G 0004/92, T 0514/88, T 0187/91, T 0527/88,  
G 0001/03

**Catchword:**  
-



Case Number: T 1170/02 - 3.3.09

**D E C I S I O N**  
of the Technical Board of Appeal 3.3.09  
of 1 March 2006

**Appellant:** TORAY INDUSTRIES, INC.  
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**Decision under appeal:** Decision of the Opposition Division of the  
European Patent Office posted 5 November 2002  
revoking European patent No. 0679508 pursuant  
to Article 102(1) EPC.

**Composition of the Board:**

**Chairman:** A.-T. Liu  
**Members:** W. Ehrenreich  
K. Garnett

## Summary of Facts and Submissions

- I. European patent No. 679 508 was granted on a divisional application from the European patent application No. 89 110 301.2. Claim 1 of the divisional application as granted read as follows:

"A biaxially oriented laminated film comprising:

a first layer containing a first thermoplastic resin as a major constituent; and  
a second layer containing a second thermoplastic resin as a major constituent, which is formed on at least one surface of the first layer, the second layer containing inert particles with an average diameter of at least 0.1 times but below 0.5 times the thickness of the second layer, the content of the inert particles in the second layer being 0.5 - 50% by weight, the thickness of the second layer being 0.005 - 3  $\mu\text{m}$  and the second thermoplastic layer resin is a crystalline polyester and the crystallization index of attenuated total reflection Raman of the surface of the second thermoplastic resin is not more than  $20\text{cm}^{-1}$ ."

- II. The parent application had disclosed a range for the inert particles in the second layer (layer A) having an average diameter of from 0.1 to 10 times, preferably 0.1 to 5 times, more preferably 1.1 to 3 times the thickness of layer A, and in Claim 1 a range was claimed for the average diameter of 0.1 to 10 times the thickness of layer A. The range claimed in Claim 1 of the divisional application was also originally 0.1 to

- 10 times the thickness of layer A but following the limitation of Claim 1 of the parent application to a range of 0.5 to 5 times the thickness of layer A, Claim 1 of the divisional application had been limited before the Examining Division to a range of "at least 0.1 but below 0.5 times" the thickness of layer A, in order to avoid double patenting, and this was the form in which the patent was granted.
- III. Two notices of opposition were filed against this patent, based on the grounds of Articles 100(a), (b) and (c) EPC. At the conclusion of the oral proceedings on 24 September 2002, the Opposition Division decided to revoke the patent on the ground that Claim 1 as granted infringed Article 123(2) EPC. It was held that the range of "at least 0.1 but below 0.5 times" was not disclosed in the originally disclosed quantitative range of values, and also that the term "below" 0.5 introduced new subject matter.
- IV. The decision of the Opposition Division was dispatched on 5 November 2002. The proprietor lodged a notice of appeal on 28 November 2002 and a statement of the grounds of appeal on 20 February 2003. By letter of 1 February 2006, the appellant additionally filed questions to be referred to the Enlarged Board of Appeal.
- V. By letter of 22 December 2005, the opponent/respondent 01 (Mitsubishi Polyester GmbH), having been duly summoned, indicated that it would not be represented at the oral proceedings arranged for 1 March 2006.

VI. During the oral proceedings, the appellant submitted a new main request, containing an amended page 3 of the description.

VII. The appellant's arguments were as follows:

- In view of the case law, in particular decision T2/81, the divisional application documents and the patent in suit complied with the requirements of Articles 76(1) and 123(2) EPC.
- Furthermore, the examples also showed that the range of from 0.1 to below 0.5 claimed in the divisional application as granted was consistent with the disclosure of the parent application as originally filed.
- The definition of the range, namely 0.1 to "below 0.5", instead of 0.1 "to 0.5" amounted to a disclaimer.
- The "disclaiming" of the limit value 0.5 from the claimed range should be allowed since it was made with the view to avoid double patenting.
- The new main request was submitted in due time, having been made to meet an objection which had been raised for the first time at the oral proceedings.

VIII. The respondents essentially argued as follows:

- The wording "below 0.5" was unclear.

- The range of 0.1 to 0.5 resulted from a combination of the lower limit of a general range with the lower limit of a preferred range. This situation was different from that underlying Decision T 2/81 and the subsequent decisions which followed that decision. The range now claimed did not correspond to a previously claimed range or combination of ranges.
  
- For considerations relating to the requirements of Articles 76(1) and 123(2) EPC, the question to be asked was whether the amendment was consistent with the original disclosure on which it was based.
  
- In the present case, the statement in the description, namely that the scratch resistance, dubbing resistance and the friction property of the laminated film would be degraded if the ratio of the average particle size of the inert particles to the thickness of layer A was larger than the claimed range, was not consistent with the disclosure of the parent application as originally filed.
  
- The exclusion of the specific value 0.5 from the claimed range was not justified as a disclaimer. In all cases where a disclaimer is allowed, the disclaimer is based on the disclosure of a prior art document. This was not the case in the present situation.
  
- The appellant's new main request was late-filed and should be dismissed.

IX. The appellant (patentee) requested that the decision under appeal be set aside and that the case be remitted to the Opposition Division for further prosecution on the basis of claims 1 to 4 as granted and the description as amended in accordance with its new main request. Alternatively, that the questions enclosed with the letter dated 1 February 2006 be referred to the Enlarged Board of Appeal.

The respondents (opponents) requested that the appeal be dismissed.

## **Reasons for the Decision**

### *Clarity: Article 84 EPC*

1. In its letter dated 8 July 2003, the respondent/opponent Mitsubishi Polyester Film GmbH raised the objection that the wording "below 0.5" was unclear (page 3 of the letter). In this respect, the Board observes that a possible lack of clarity is not a ground for opposition. In the present case, the objection is directed against a wording which was already in the claims as granted (Claim 1 of the patent in suit). The board therefore does not need to discuss this objection further.

### *European divisional application: Article 76(1) EPC.*

2. The ground for opposition under Article 100(c) has two aspects: (a) whether the subject matter of the patent extends beyond the content of parent application as filed (in effect, contravening Article 76(1) EPC), or

- (b) whether the subject matter of the patent extends beyond the content of the divisional application as filed (Article 123(2) EPC).
3. As to (a), the opposition ground is not concerned with Claim 1 of the divisional application as originally filed (which, as already indicated, claimed a range for the inert particles of 0.1 to 10 times the thickness of layer A). Indeed, the subject-matter of this claim is a combination of that of Claims 1 and 9 of the parent application as originally filed.
4. The description of the divisional application as originally filed, however, contains a passage stating that "the layer A contains inert particles. The inert particles have an average diameter (particle size) of 0.1 - 10 times, preferably from 0.1 to less than 0.5 times the thickness of layer A" (page 3, second full paragraph). The question is whether the preferred range of "from 0.1 to less than 0.5 times the thickness of layer A" referred to here has a basis in the parent application as filed.
- 4.1 According to the description of the parent application as filed, the inert particles have an average diameter (particle size) of 0.1 - 10 times, preferably 0.5 - 5 times, more preferably 1.1 - 3 times the thickness of layer A (page 5, second full paragraph). Thus, it is undisputed that the parent application documents do not explicitly contain a reference to the now-preferred range. The issues to be addressed are therefore:
- (a) whether the range of 0.1 to 0.5 times can be clearly and unambiguously derived from, and is



consistent with, the disclosure of the parent application, taken as a whole; and further,

(b) whether the stipulation of "below 0.5 times" in lieu of 0.5 times is allowable.

4.2 In the case underlying the decision T2/81 (OJ 1982, 394), the claim was amended inter alia with regard to the concentration of a phospholine oxide catalyst (PO). More precisely, the claimed PO concentration was restricted to a range of "from 0.05 to 10 ppm", based on the description which indicated that the concentration range was "from 1 ppb to 10 ppm, preferably from 0.05 to 5 ppm". The board concerned held that the part range from 5ppm to 10ppm was specifically disclosed, since "The end-points are specifically named, and the two part-ranges of the general lying outside the preferred range would be unequivocally and immediately apparent to the person skilled in the art". Applying this concept to the present case, the end-points (0.1 and 0.5 times) might also be considered as specifically named.

4.3 In the case of T2/81, however, the amendment was a **combination of the lower limit** (0.05 ppm) of the preferred range **with the higher limit** of the general range (10 ppm), **resulting in a range which included the preferred concentration range**. The board went on to note that "the simple sub-combination of these part-ranges would not merit novelty as 'selection', so that the restriction does not represent any new subject-matter within the meaning of Article 123(2)" (para. 3 of the decision - the board was clearly applying the 'novelty' test in relation to Article 123(2) EPC). In

contrast thereto, the range of from 0.1 to less than 0.5 times is, in the present case, based on a **combination of the lower limit of the general range with the lower limit of the preferred range, thus excluding the preferred range.** To the Board, the present situation is consequently different from that in decision T 2/81.

As noted by the opponent/respondent 02 (Teijin Chemicals, Lt) and confirmed at the oral proceedings, in all the decisions cited by the appellant where T2/81 has been followed, the issue was one of a combination of the preferred range and a part range lying on one side of this range (see letter dated 30 June 2003, page 3, item 4.8). The appellant was unable to cite a decision, and the present board is unaware of one, which corresponds to the present situation (see also Case Law of the Boards of Appeal of the EPO, 4th edition 2001, III.A.3.3, page 220, 2nd full paragraph). In consequence, the board holds that the decisions referred to by the appellant cannot be used as precedents for deciding on the conformity of the divisional application documents with the requirements of Article 76(1) EPC.

- 4.4 The Board concurs with the respondent insofar as it is relevant to ask whether or not the amendment is consistent with the original disclosure of the parent application. The fundamental question, however, always remains whether the subject matter of the application extended beyond the parent application as filed, and in answering this question in this case it should be asked whether the range in question is directly and unambiguously derivable from the earlier disclosure,

and is consistent with it (see also Case Law of the boards of appeal of the EPO, 4th Edition 2001, III.A.2, page 213 and III.A.3.3, page 218). In this context, subject matter will be "consistent" with the earlier disclosure if it contains no contradiction to the totality of the earlier disclosure. See Decision T 514/88 (OJ 1992, 570, para. 2.7). In the circumstances of this case, it may also be useful to ask whether the skilled reader of the parent application would seriously contemplate working in the range referred in the divisional application or alternatively whether there was anything in the parent application as filed or his common general knowledge which would cause him to exclude the possibility of working in that range. See Decision T 187/91 (OJ 1994, 572).

4.5 When considering these questions it is necessary to consider in detail what the earlier document discloses to the skilled person when read as a whole (see Decision T 527/88) ie, having regard to the whole disclosure, express or implied, that is directly and unambiguously derivable from this application including information which is implicit and immediately and unambiguously apparent to a person skilled in the art reading the application. This includes the original statements as to the problem to be solved implying certain aims and effects. It follows that every case will depend on its own particular facts and circumstances.

4.5.1 The parent application in the present case indicates that "the invention relates to a biaxially oriented laminated film suitable as, for example, the base film

of the magnetic recording media, which gives high quality image when used as the base film of the magnetic recording media and which has excellent scratch resistance" (page 1, first paragraph). The film parameters considered essential for obtaining the sought-after film properties are inter alia the ratio of the diameter of the inert particles in layer A to the thickness of that layer, the content of the inert particles in layer A and the thickness of layer A (see page 5, lines 3 to 27). This teaching is reflected in Claim 1 of the parent application as filed which stipulates for these parameters a range of 0.1 to 10 times, 0.5 - 50% by weight, and 0.005 - 3  $\mu\text{m}$ , respectively. In addition, examples are shown in Tables 1 to 4 to demonstrate the effect of these parameters on the film properties (pages 37 and 38). Specifically, Example 5 relates to a film having an average particle diameter of 0.5 times the thickness of layer A, a content of 6% by weight of inert particles, and the thickness of layer A being 0.6  $\mu\text{m}$ . The film concerned is described to have excellent scratch resistance and dubbing resistance (Table 1).

- 4.5.2 The parent application thus not only conveys the teaching for working within the ambit of Claim 1 as filed. The skilled person can also directly and unambiguously infer from the examples the information that a film with an average particle size of 0.5 times the thickness of layer A, thus at the lower limit of preferred range for the parameter concerned, has excellent properties. To the Board, the skilled person would, in view of these data, seriously consider working beyond the lower limit of the preferred range as well. Under these circumstances, the range of 0.1 to

- 0.5 times can be directly and unambiguously derived from, and is consistent with, the parent application as originally filed.
- 4.6 Concerning the range "0.1 to less than 0.5", the Board does not consider that this should be regarded as involving a disclaimer in respect of the value of 0.5. In this context, a disclaimer means an amendment to a claim resulting in the incorporation therein of a "negative" technical feature, typically excluding from a general feature specific embodiments or areas (see Decision G 1/03, (OJ 2004, 413), para. 2). Thus, the question to be asked here is not whether a disclaimer is allowable in the present case. Rather, the question is the same as for the range "0.1 to 0.5", namely, whether it is directly and unambiguously derivable from the disclosure of the parent application, taken as a whole, and is consistent with it. Since the reasoning is the same as for the range "0.1 to 0.5", the conclusion applies *mutatis mutandis* to the range "0.1 to less than 0.5".
- 4.7 As a corollary to the above, the Board holds that the description is also in conformity with the requirements of Article 76(1) EPC.

*Amendment: Article 123(2) EPC*

5. Claim 1 as granted is based on Claim 1 as filed, the only difference being that the second layer is now stipulated to contain "inert particles with an average diameter of at least 0.1 times but below 0.5 times the thickness of the second layer". In comparison, Claim 1 as originally filed stipulated that the average

diameter of these inert particles was "0.1 to 10 times the thickness of the second layer".

Since the amendment to Claim 1 is based on the description of the divisional application as filed, the requirements of Article 123(2) are met. This is not in dispute.

6. Before the Examining Division, the description of the patent in suit was amended with respect to the description as filed in that the inert particles in layer A were now stated to "have an average diameter (particle size) from 0.1 to less than 0.5 times the thickness of layer A" (patent in suit column 3, lines 17 to 20). It is not disputed that the ratio concerned is based on the preferred range as disclosed in the description as originally filed (see also point 4 above).

The description of the patent in suit was further amended during the oral proceedings before the Board by the deletion of the further passage stating that "If the ratio (of the average particle size of the inert particles to the thickness of layer A, remark added by the board) is larger than the above-described range, the scratch resistance, dubbing resistance and the friction property are degraded" (column 3, lines 23 to 26 of the patent in suit, passage in brackets added by the Board). Since it is not true that the properties of the film would degrade if the ratio was higher than the upper limit of 0.5, the amendment is clearly designed to rid the description of self-contradictions and to harmonise it with Claim 1 as granted.

In consequence, both amendments are in compliance with the requirements of Article 123(2) EPC.

*Late filing: Article 114(2) EPC*

7. The Board does not concur with the respondent that the appellant's new main request should be dismissed as late-filed.

First, the objection concerning the contradiction between the now deleted passage of the description and the remainder of the disclosure was raised for the first time during the oral proceedings. Since the appellant did not have any notice of that objection, it did not have any reason for submitting a request earlier to overcome such an objection. The Board therefore considers that the request was submitted in due time. Further, the new request only involved a harmonisation of the description with the existing Claim 1. Thus, the Board found that the amendment was straightforward, such that neither the respondent nor the Board was faced with a complex situation which called for a postponement of the proceedings so as to deal with such a request.

For these reasons, the Board decided to admit the new main request into the proceedings.

*Right to be heard: Article 113(1) EPC*

8. At this point, the Board also wishes to observe that the decision to admit the new main request presented at the oral proceedings and to reach a conclusion based on that new main request was made in the absence of

respondent 01 (see point V above). However, as observed in the case law, an absent party must expect the opposing party to react within the legal and factual framework of the case established prior to the oral proceedings, and the board to take these reactions into consideration. Otherwise, no decision could ever be issued at the end of a hearing where, as is often the case, auxiliary requests are filed and, as is also frequently the case, the opposing party does not attend the hearing (see Case Law of the Boards of Appeal of the EPO, 4th edition 2001, VI.B.3, page 268, last paragraph to page 269, first full paragraph).

In the present situation, the issue at stake has always been the question of conformity of the patent in suit with the original disclosure. Therefore, the respondent 01 would not have been taken by surprise by the appellant's request, which was made in an effort to meet the requirements concerned, much less when the request only involved a harmonisation of the description with the existing main claim. The submission of the new main request is thus clearly not a "fact" within the meaning of the decision of G 4/92 (OJ 1994, 149).

*Referral to the Enlarged Board of Appeal, Article 112(1) EPC*

9. The appellant's request for referral to the Enlarged Board of Appeal was conditional on a refusal of its new main request. Since this main request is allowed, there is no need to discuss the merit of the auxiliary request.



**Order**

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

1. The decision under appeal is set aside
2. The case is remitted to the opposition division for further prosecution on the basis of the claims 1 to 4 as granted and the description as amended in accordance with the new main request.

The Registrar:

The Chairman:

G. Röhn

A. T. Liu