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**Datasheet for the decision
of 18 October 2010**

Case Number: T 1858/07 - 3.5.04

Application Number: 02797732.1

Publication Number: 1425741

IPC: G11B 7/24

Language of the proceedings: EN

Title of invention:

Storage medium for data with improved dimensional stability

Applicant:

SABIC Innovative Plastics IP B.V.

Opponent:

-

Headword:

-

Relevant legal provisions:

RPBA Art. 12(4)

Relevant legal provisions (EPC 1973):

EPC Art. 54(1)(2), 111(1)

Keyword:

"Main request: Novelty (no)"

"Auxiliary request: admitted (no)"

Decisions cited:

-

Catchword:

See point 3.4



Case Number: T 1858/07 - 3.5.04

D E C I S I O N
of the Technical Board of Appeal 3.5.04
of 18 October 2010

Appellant: SABIC Innovative Plastics IP B.V.
Plasticslaan 1
NL-4612PX Bergen op Zoom (NL)

Representative: Bublak, Wolfgang
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Decision under appeal: Decision of the Examining Division of the
European Patent Office posted 4 June 2007
refusing European application No. 02797732.1
pursuant to Article 97(1) EPC 1973.

Composition of the Board:

Chairman: F. Edlinger
Members: C. Kunzelmann
C. Vallet

Summary of Facts and Submissions

- I. The appeal is against the decision of the examining division to refuse European patent application No. 02 797 732.1.
- II. The decision to refuse was based on the grounds of lack of novelty (Article 54(1),(2) EPC 1973) and lack of inventive step (Article 56 EPC 1973) of the asymmetric optical storage medium according to claim 1, having regard to the prior-art document
D3: EP 1 031 972 A2.
- III. The applicant appealed and filed claims 1 to 7 according to an auxiliary request with the statement of grounds of appeal.
- IV. The board issued a communication pursuant to Article 15(1) of the Rules of Procedure of the Boards of Appeal (RPBA), annexed to a summons to oral proceedings dated 21 June 2010. In this communication it indicated that it tended to agree with the decision under appeal that D3 disclosed an asymmetric optical storage medium having all the features of claim 1 of the main request. The board also informed the appellant that it should be prepared to discuss whether the claims of the auxiliary request should be admitted under Article 12(4) RPBA and to discuss the issues of novelty (Article 54 EPC 1973) and inventive step (Article 56 EPC 1973) also on the basis of the auxiliary request in case the board decided to exercise its power within the competence of the first instance (Article 111(1) EPC 1973). In particular, the board

referred to two further documents mentioned in the decision under appeal (D2 and D4) which might also need to be discussed in the context of inventive step and to the argumentation concerning lack of inventive step given in the decision under appeal.

- V. With a letter dated 20 September 2010 the appellant submitted arguments in support of novelty and inventive step of the subject-matter according to claim 1 of the main request, having regard to D3. The appellant also submitted arguments as to why the auxiliary request should be admitted into the appeal proceedings and why the subject-matter according to claim 1 of the auxiliary request involved an inventive step having regard to D3.
- VI. With a further letter dated 14 October 2010 the appellant withdrew the request for oral proceedings and requested a decision according to the facts of the file.
- VII. Oral proceedings before the board were held on 18 October 2010 in the appellant's absence in application of Rule 71(2) EPC 1973 and Article 15(3) RPBA. In the oral proceedings the board noted that the appellant had requested in writing that the decision under appeal be set aside and a patent granted on the basis of claims 1 to 8, filed with letter of 24 November 2005, as a main request and, as an auxiliary request, on the basis of claims 1 to 7 filed with the statement of grounds of appeal. At the end of the oral proceedings the chairman announced the board's decision.

VIII. Claim 1 according to the main request reads as follows:

"An asymmetric optical storage medium (10) comprising a plurality of layers, said plurality of layers including a substrate layer (20), a data layer (30) and at least one high modulus layer (40), which improves dimensional stability in said medium, said high modulus layer comprising a cured high modulus organic polymer having a tensile modulus of at least one Gigapascal, and at least one film layer (50) which is in direct contact with said high modulus layer."

IX. Claim 1 according to the auxiliary request is distinguished from claim 1 of the main request in that the last feature reads as follows (added features in italics):

"and at least one *thin* film layer (50) which is in direct contact with said high modulus layer *and is a homopolymer, a copolymer, a thermoplastic, a thermoset or any mixture thereof.*"

X. The decision under appeal may be summarised as follows:

D3 showed an asymmetric optical storage medium (see paragraph [0001] and figure 1) comprising a plurality of layers, said plurality of layers including a substrate layer (reference sign 20, see paragraph [0037] and figure 1), a data layer (reference sign 42, see paragraph [0034] and figure 1) and at least one high modulus layer (reference sign 50, see paragraph [0039] and table 1), which improved dimensional stability in said medium (see paragraph [0046], lines 5-7), said high modulus layer comprising a cured high modulus

organic polymer (table 1, "curable resin") having a tensile modulus of at least one Gigapascal (table 1, last line, fourth column), and at least one film layer which was in direct contact with said high modulus layer (reference sign 44, see paragraph [0034], line 23). Thus the subject-matter of claim 1 was not new (Article 54(1) and (2) EPC 1973) having regard to D3. The different layers (41, 42, 43, 44) could be seen as a single layer (40) only with respect to the physical properties when the neutral plane of deformation was in this layer 40. Since the application did not define any specific property of the film layer in direct contact with the high modulus layer, the layer 44 in D3 had to be identified as this layer of direct contact.

Moreover, it was common general knowledge to apply additional film layers onto a disc, such as a colour layer, a protection layer, or even a film resulting from manual pencil labelling. All of these film layers had to be identified as at least one film layer in direct contact with said high modulus layer because of a lack of detailed layer specification in claim 1. Therefore, the subject-matter of claim 1 was not considered to involve an inventive step (Article 56 EPC 1973).

XI. The appellant's arguments can be summarised as follows:

The examining division's approach of equating the substrate layer, the data layer, the high modulus layer and the thin film layer specified in claim 1 with the substrate layer (20), the recording film (42), the protecting film (50) and the reflecting film (44) in D3

was incorrect because the reflecting film (44) in D3 was not an individualised layer. The splitting of layer 40 into four layers 41, 42, 43 and 44 was incorrect. Paragraph [0047] of D3 stated that each layer forming the thin film layer 40 of the optical information recording medium was so thin that the thin film layer 40 could be deemed as a single layer, more particularly a data layer. Since the film 44 was not an individualised layer, the whole reasoning in the decision under appeal was not conclusive. Hence the subject-matter of the present application was new and involved an inventive step having regard to D3.

The additional features in claim 1 of the auxiliary request were present in the international application as filed and had been searched in the international preliminary report on patentability. The additional features in claim 1 of the auxiliary request specified the material of the thin film layer (50) in such a way that the thin film layer could not be equated to the reflecting film 44 in D3. Thus the auxiliary request should be admitted into the appeal proceedings.

Reasons for the Decision

1. The appeal is admissible.
2. *Main request: novelty (Article 54(1) and (2) EPC 1973)*
 - 2.1 As far as the issue of novelty of the subject-matter of claim 1 according to the main request over D3 is concerned, it is clear from points VIII to XI above that the appellant only disputes that layer 44 in D3

constitutes a thin film layer as specified in claim 1. In this context the appellant refers to D3, paragraph [0047].

2.2 Paragraph [0047] in D3 has to be read in the light of the overall disclosure of D3. In particular paragraph [0048] explains that, for the purpose of the examples explaining the principles of the invention disclosed in D3, the thin film layer 40 may be made of an aluminum nitride layer alone. This is because, in most cases, deformation of the thin film layer 40 is caused by the dielectric layers 41 and 43 made of aluminum nitride. The recording film 42 and the reflecting film 44 do not essentially cause deformation of the thin film layer 40 and thus may be omitted in the examples. Hence the decision under appeal is correct that the different layers (41 to 44) have to be seen as a single layer (thin film layer 40) only as far as the problem of preventing deformation is concerned. For the functioning as an optical storage medium, however, the recording film 42 and the reflecting film 44 are essential and are also individually specified in D3. In particular, the reflecting film 44 is an individualised layer (which corresponds to the "reflective metal layer" specified on page 5, lines 9 to 12 of the present application) and may thus be considered as a film layer which is in direct contact with protective film 50 (see figure 1 in D3), i.e. the layer which corresponds to the high modulus layer in the present claim 1.

2.3 The appellant does not dispute that the decision under appeal is correct in its assessment of novelty as far as the other features in claim 1 are concerned. Also

the board has come to the conclusion that the decision under appeal has correctly identified the features of claim 1 in document D3 and that the subject-matter specified in claim 1 is directly and unambiguously derivable from D3.

2.4 Hence the board finds that the subject-matter of claim 1 is not new (Article 54(1) and (2) EPC 1973).

3. *Auxiliary request: admission into the appeal proceedings (Article 12(4) RPBA)*

3.1 In claim 1 according to the auxiliary request, the thin film layer material has been specified by features set out in original claim 17. However, original claim 17 was present only in the international phase. It was not present in the first-instance proceedings, i.e. the European phase. More specifically, original claim 17 was not present in any of the claim sets submitted to the first instance and the features of original claim 17 have not been discussed in first-instance proceedings.

3.2 The thin film layer materials specified in claim 1 of the auxiliary request are not disclosed in the description, with the exception of the specific example of a "co-polycarbonate-ester thin film of about 75 micron thickness" given on page 8, line 15. The function or technical meaning of this thin film layer, however, is not disclosed in the application. In particular, the application does not disclose which function this thin film layer has in the context of improving dimensional stability. Nor has the appellant submitted any arguments concerning the relevance and

function of the thin film layer specified in claim 1 of the auxiliary request in the context of inventive step, particularly in view of the reasoning as to lack of inventive step given in the decision under appeal. Hence admission of the auxiliary request would result in the need for further investigations at least as to inventive step.

3.3 In the board's view, the applicant could have presented this or a similar request in response to one of the objections of lack of novelty based on D3 in the first-instance proceedings, so that the examining division could have carried out a complete examination in the present case after duly exercising its power of discretion under Rule 137(3) EPC. The board could then have carried out its primary task of examining the correctness of the decision under appeal.

3.4 In addition, the appellant's case in respect of the auxiliary request is incomplete. If the board had decided to exercise its power within the competence of the examining division in accordance with Article 111(1) EPC 1973, it could not have ordered the grant of a patent without further investigations. The decision under appeal gave reasons why it may have been obvious to a person skilled in the art to provide certain additional layers to an (optical) disc. However, the appellant's arguments concerning this reasoning's relevance in view of the auxiliary request are not on file. Nor has the appellant discussed the further documents (D2 and D4) mentioned in the board's communication dated 21 June 2010 or their relevance in view of the auxiliary request. The appellant has merely argued that these additional features established

novelty, and decided not to attend the oral proceedings scheduled by the board.

3.5 In view of the above, the board does not admit the auxiliary request into the appeal proceedings (Article 12(4) RPBA).

Order

For these reasons it is decided that:

The appeal is dismissed.

The Registrar:

The Chairman:

L. Fernández Gómez

F. Edlinger