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**Datasheet for the decision
of 6 June 2012**

Case Number: T 1843/09 - 3.3.09
Application Number: 93306378.6
Publication Number: 583169
IPC: C08J 15/28, B32B 27/20,
C08L 67/02
Language of the proceedings: EN

Title of invention:
Biaxially oriented film

Patent Proprietor:
TORAY INDUSTRIES, INC.

Opponent:
Teijin Limited

Headword:
-

Relevant legal provisions:
EPC Art. 56, 107, 111, 125
EPC R. 80

Keyword:
"Exceptions from the prohibition of reformatio in peius"
"Inventive step (no)"

Decisions cited:
G 0009/92, G 0004/93, G 0001/99, G 0001/03, T 0724/03,
T 0138/04

Headnote:
The prohibition of *reformatio in peius* as far as it entails a procedural limitation of the proprietor's liberty to change by way of amendments the scope of protection sought prevails "in

principle" (G 4/93) until the final settlement of the opposition case and, therefore, also in any proceedings, including further appeal proceedings, subsequent to a remittal under Article 111 EPC (point 2.3.1 of the reasons).

It is clear from G 1/99 that exceptions from the principle of the prohibition of *reformatio in peius* are a matter of equity in order to protect the non-appealing proprietor against procedural discrimination in circumstances where that prohibition would impair the legitimate defence of its patent. Therefore, exceptions from the prohibition of *reformatio in peius* are not limited to the situation specifically dealt with in G 1/99, where an error of judgment by the opposition division occurred concerning an amendment introduced into the version of the patent as maintained by the decision under appeal (point 2.4.4 of the reasons).



Case Number: T 1843/09 - 3.3.09

DECISION
of the Technical Board of Appeal 3.3.09
of 6 June 2012

Appellant: Teijin Limited
(Opponent) 6-7, Minamihonmachi 1-Chome
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Decision under appeal: **Interlocutory decision of the Opposition
Division of the European Patent Office posted
26 June 2009 concerning maintenance of European
patent No. 583169 in amended form.**

Composition of the Board:

Chairman: W. Sieber
Members: W. Ehrenreich
R. Menapace

Summary of Facts and Submissions

I. Mention of the grant of European patent No. 0 583 169 in respect of European patent application No. 93 306 378.6, filed on 12 August 1993 in the name of *Toray Industries Inc.*, was announced on 5 January 2000 (Bulletin 2000/01).

The patent was granted with 18 claims. Claim 1 read as follows:

"1. A biaxially oriented film containing organic particles, which organic particles

- (a) are crosslinked polymer particles having a degree of crosslinking not less than 60%;
- (b) have a strength when deformed by 10% (S_{10}) which is in the range of 29 to 294 MPa (3 to 30 kgf/mm²);
- (c) have a thermal decomposition temperature, for causing 10% loss in weight, not lower than 350°C;
- (d) have a weight average diameter in the range of 0.005 to 5µm; and
- (e) are present in a content of 0.001 to 20% by weight, based on the total weight of the film; and

which biaxially oriented film is other than a film of Comparative Example 4 of EP-A-0546184."

Claim 2 was a second independent claim directed to a biaxially oriented film, and claims 3 to 6 were directly or indirectly dependent on claims 1 and 2. Claims 7 and 8 were each directed to a laminated film. Claims 9 to 18 were directly or indirectly dependent on claims 7 or 8.

II. A notice of opposition was filed by *Teijin Limited* on 5 October 2000 requesting revocation of the patent in its entirety on the grounds of Article 100(a) EPC (lack of novelty and lack of inventive step) and Article 100(c) EPC, relying *inter alia* on the following documents:

- D1 JP-A-62-172031 (English translation)
- D2 Pamphlet on XC99-301 and XC99-501 (Toshiba Silicone Ltd.)
- D8 English translation of D2.
- D15 EP-A-0 546 184

Further documents were filed after the nine months period defined by Article 99(1) EPC including:

- D19A WO-A-93/15145
- D19 EP-A-0 577 846 - English equivalent of D19A, published in accordance with Article 158(3) EPC 1973
- D20 Experimental Report (Example 1 of D19/D19A)
- D21 JP-A-4 309554
- D21A partial English translation thereof
- D22 JP-A-5 84819
- D22A partial English translation thereof.

D15 and D19 constituted prior art according to Article 54(3) EPC for the subject-matter of claim 1. D15 represents the document whose comparative example 4 was excluded from claim 1 by way of a disclaimer.

As D19/D19A to D22/D22A had been submitted only a few days before the oral proceedings with the letter dated

3 March 2003, the proprietor requested their exclusion from the proceedings, arguing that their late filing constituted a flagrant abuse of procedure.

III. With letter dated 10 January 2003 the proprietor had filed a first set of requests including a main request consisting of 16 claims, claim 1 of which contained an additional feature (f), which was based on granted claim 4.

During the oral proceedings held on 11 March 2003 the main request of the above first set of requests was replaced by a new main request in which only claim 2 had been amended.

During the oral proceedings the proprietor filed a further set of requests consisting of a main request and six auxiliary requests (second "replacement" set). This set of requests were to replace the first set of requests on file in the event that the opposition division admitted the late filed documents D19/D19A to D22/D22A.

IV. With its interlocutory decision announced orally on 11 March 2003 and issued in writing on 9 May 2003 the opposition division maintained the patent on the basis of claims 1 to 16 of the amended main request according to the first set of requests. Claim 1 of the main request read as follows:

"1. A biaxially oriented film containing organic particles, which organic particles

- (a) are crosslinked polymer particles having a degree of crosslinking not less than 60%;
- (b) have a strength when deformed by 10% (S_{10}) which is in the range of 29 to 294 MPa (3 to 30 kgf/mm²);
- (c) have a thermal decomposition temperature, for causing 10% loss in weight, not lower than 350°C;
- (d) have a weight average diameter in the range of 0.005 to 5µm; and
- (e) are present in a content of 0.001 to 20% by weight, based on the total weight of the film; and

which biaxially oriented film

- (f) contains particles other than the said organic particles each having a primary particle diameter of 5 to 150nm; and
- (g) is other than a film of Comparative Example 4 of EP-A 0546184."

The opposition division admitted the late-filed document D15 into the proceedings, but not D19/19A to D22/D22A. As regards D19/D19A they were considered *prima facie* not sufficiently relevant. The opposition division further held that claim 1 of the main request, now including feature (f), did not enjoy the earliest priority of 12 August 1992 with the consequence that D15 and D19 became prior art according to Article 54(2) EPC. The disclaimer in claim 1, excluding comparative example 4 of EP-A 0 546 184 (D15), was held admissible as being in compliance with Article 123(2) EPC. The essential argument was that the introduction of feature (f) deprived comparative example 4 of D15, where this feature was lacking, of any technical contribution to the subject-matter of claim 1.

Novelty over D15 and inventive step starting from D15 as the closest prior art were acknowledged.

- V. On 4 July 2003 the opponent lodged an appeal (case no. T 724/03) against that decision.

In the grounds of appeal the opponent contested the admissibility of the disclaimer because of non-compliance with Article 123(2) EPC and reiterated the request to admit D19 into the proceedings, arguing that example 20 of D19 was of high relevance for the assessment of novelty of the claimed subject-matter. In order to demonstrate that example 20 was novelty-destroying for the subject-matter of claim 1, an experimental report reworking example 20 of D19 was filed (D23). Furthermore, inventive step was challenged in view of either D19 alone or in combination with other documents, *inter alia* D15.

The proprietor requested that D19 be not admitted into the proceedings and, if it was, that it be allowed to file broader claims than those allowed by the opposition division, in particular it should be permitted to revert to the granted claims in order to regain the earliest priority date lost by the introduction of feature (f) into the claims as allowed by the opposition division, even if such broader claims were contrary to the principle of *reformatio in peius* as laid down in G 9/92.

Furthermore, in the event the board refused to allow broader claims than those allowed by the opposition division, then two questions should be referred to the

Enlarged Board of Appeal concerning the principle of *reformatio in peius* (point V. of T 724/03).

VI. In its decision T 724/03 of 19 October 2006 the board held that the disclaimer in claim 1 as allowed by the opposition division did not contravene Article 123(2) and (3) EPC (points 2.4.4 and 2.5 of the reasons). Furthermore, the board found D19 in combination with D23 to be highly relevant in that its introduction was highly likely to prejudice the maintenance of the patent in the form as maintained by the opposition division (point 3.8.6 of the reasons).

The following order was made by the board:

1. The decision under appeal is set aside.
2. D19 and D23 are admitted into the proceedings.
3. The case is remitted to the opposition division for further prosecution.

The decision is silent on the issue of *reformatio in peius*, in particular whether or not, following the admission of D19 into the proceedings, broader claims should be allowed than those held allowable by the opposition division.

VII. In the continued opposition proceedings the proprietor withdrew the request to maintain the patent in the form as allowed in the first opposition proceedings and filed, with its letter dated 3 January 2008, several sets of claims as basis for a new main and auxiliary requests, from all of which feature (f) had been removed in order to regain the earliest priority date of 12 August 1992. The proprietor maintained that D19

was not prior art under Article 54(2) EPC for the so-amended requests.

In its reply the opponent considered the claims of the new requests not to be allowable because they were broader in scope than the claims allowed by the decision of the opposition division, thereby contravening the principle of *reformatio in peius* laid down in G 9/92.

Further documents and experimental reports were filed in order to attack novelty and inventive step of the subject-matter of the new requests, *inter alia* the experimental report D26, a rework of example 2 of D1.

VIII. With its decision announced orally on 22 April 2009 and issued in writing on 26 June 2009 the opposition division maintained the patent on the basis of the first auxiliary request filed on 9 January 2009. Claim 1 of this request was identical to claim 1 as granted, except that in feature (b) the lower value of the lower limit of the range of S_{10} had been increased from 29 to 48 MPa. Claim 1 read as follows:

"1. A biaxially oriented film containing organic particles, which organic particles

- (a) are crosslinked polymer particles having a degree of crosslinking not less than 60%;
- (b) have a strength when deformed by 10% (S_{10}) which is in the range of 48 to 294 MPa (5 to 30 kgf/mm²);
- (c) have a thermal decomposition temperature, for causing 10% loss in weight, not lower than 350°C;

- (d) have a weight average diameter in the range of 0.005 to 5 μ m; and
- (e) are present in a content of 0.001 to 20% by weight, based on the total weight of the film; and

which biaxially oriented film is other than a film of Comparative Example 4 of EP-A 0546184."

IX. The opposition division argued that the principle of prohibition of *reformatio in peius* was not violated by the proprietor's requests filed in the continued opposition proceedings, because (i) this principle applied only to requests on which a decision was taken in appeal proceedings and (ii) the position of the appellant had in fact been improved by the admission of the highly relevant documents D19 and D23 into the proceedings. The remittal of the case to the opposition division with the order to consider the late filed documents D19 and D23 amounted to a new factual basis due to the high relevance of D19 in combination with D23 for the novelty of the claimed subject-matter. Under Rule 80 EPC the proprietor was entitled to react to a new factual situation by making "appropriate and necessary amendments" occasioned by grounds of opposition. So the fact that the scope of protection sought was broader than under the claims maintained in the first interlocutory decision was immaterial to the present case, even though it did not fall under the exceptions from the prohibition of *reformatio in peius* as defined in G 1/99.

Novelty and inventive step of the subject-matter of auxiliary request 1, in particular over D1, were acknowledged and several documents filed by the

opponent in the continued opposition proceedings, *inter alia* D26, were not admitted into the proceedings. The disclaimer in claim 1 was considered to meet the requirements of Article 123(2) EPC.

- X. On 4 September 2009 the opponent filed a notice of appeal against the decision of the opposition division and on the same day paid the prescribed fee. The grounds of appeal were received on 6 November 2009.

The opponent maintained that the claims allowed by the opposition division in the continued opposition proceedings violated the principle of prohibition of *reformatio in peius* as established in G 9/92, because they were broader in scope than those maintained by the first opposition division. Furthermore, the disclaimer in claim 1 was not allowable under Article 123(2) EPC because it was not in compliance with the principles established in G 1/03.

The subject-matter of claim 1 was also considered to be neither novel nor inventive. As to lack of novelty, several objections were raised, one being based on D1, either alone or in combination with other documents, *inter alia* the experimental report D26 (a rework of example 2 of D1) already filed in the continued opposition proceedings. Admission of D26, not admitted by the opposition division, was again requested. The opponent further denied inventive step starting from D1 as the closest prior art. In support of the inventive step attack an experimental report D32 was submitted.

- XI. With its letter of response dated 14 June 2010 the proprietor requested, as main request, to maintain the

patent on the basis of the claims allowed by the opposition division in their decision of 26 June 2009 (point VIII above), alternatively on the basis of an auxiliary request whose claim 1 was directed to a two-layer laminated film. Both requests were filed with the above letter in re-typed form.

Concerning the issue of *reformatio in peius* the proprietor maintained its position that claim 1 of the main request did not violate this principle.

As to the novelty and inventive step attacks based on D1 in combination with D26 or D32, the proprietor requested that D26 and D32 be not admitted into the proceedings.

XII. On 25 April 2012 the board issued a communication and gave its preliminary opinion on the issue of *reformatio in peius*. The proprietor replied to this opinion with its letter dated 16 May 2012.

XIII. On 6 June 2012 oral proceedings were held before the board. In the proceedings the issues of *reformatio in peius*, added matter in view of the disclaimer, novelty and inventive step were discussed with the parties.

Their arguments, including those put forward in writing, as far as they are relevant for the decision, are summarized in the following.

XIV. Arguments of the opponent

(a) *Reformatio in peius*

The prohibition of *reformatio in peius* is a fundamental legal principle within the meaning of Article 125 EPC, as established in decision G 9/92, in which the Enlarged Board decided that an appellant should not find itself in a worse position by virtue of the filing of an appeal and, therefore, amendments proposed by the patentee could be rejected as inadmissible if they were neither appropriate nor necessary.

The plain fact is that the claims held allowable in the (second interlocutory) decision under appeal are broader than they would have been had the opponent not appealed the first decision of the opposition division. There exist no grounds whatsoever in the present situation for departing from the principle of prohibition of *reformatio in peius*.

The opposition division completely misunderstood what is meant by "position of the opponent" in the relevant decisions of the Enlarged Board of appeal. Of course, in a very narrow sense, there was indeed the potential for the opponent's position to be improved by the admittance of D19 since there was then more prior art on which to argue for lack of novelty or inventive step. However, in the sense of broader claim scope and the commercial impact of those broader claims, the opponent's position was significantly worse. The

reference in G 9/92 to a "worse situation" is a reference to those wider considerations, rather than to the number of prior art documents which the opponent has at its disposal.

Decision G 1/99 provided three precisely defined exceptions from that principle for mitigating the consequences of an error of judgement to the patentee's disadvantage, namely where the patent must be revoked as a direct consequence of an inadmissible amendment allowed by the opposition division in its interlocutory decision. However, decision G 1/99 clearly does not apply in the present case, in which the original amendment (incorporation of the features of granted claim 4 [= feature "(f)"] was not inadmissible. The respondent (proprietor) simply wants a new, additional exception to be made in its favour.

The present situation is different from that underlying decision G 1/99. Even if the opposition division's decision not to admit D19 into the proceedings was an error of judgement, then the patentee contributed to this error. Although the proprietor was better placed than anybody else to judge the relevance of D19, because it was its own document, it maintained broadly formulated claims including feature (f) and waited until document D23, which merely corroborated D19, was presented by the opponent. That document did not provide any new information to the proprietor, and D19 was either relevant or not, independently of D23. So it cannot be said that D19 became relevant only during the appeal proceedings. The proprietor

could have assessed its relevance during the first instance proceedings, but did not do so. It was the strategy of its choice to abandon or withdraw the request for maintenance of the patent as granted and to maintain claims containing the priority-destroying feature (f). The patentee must now be bound by its own decision at that time. It can be accepted that under the general principle of equal treatment the proprietor needs protection where procedural asymmetries operate to its grave disadvantage, but it deserves no protection from itself. Hence, the later admission of D19 by the board of appeal cannot justify a subsequent broadening of the claims to the opponent's detriment.

The proprietor's position is also incompatible with the strict order which has to be observed pursuant to G 1/99 when making use of one of these exceptions. So even if the exception of G 1/99 applied in the present case, the proprietor could not just make any amendment he desired. The first course of action must have been for the proprietor to seek additional amendments to overcome D19, and retain the amendments already made to overcome the other documents. Furthermore, it must be remembered that the proprietor maintained the request before the opposition division despite having full knowledge of D19, which is the patentee's own document and which was cited before the first opposition division hearing. The fact that the proprietor now wished to follow a different strategy for maintaining the patent in suit was not a reason to derogate from the basic

principle that the position of the opponent as the sole appellant could not be made worse by its appeal. The patentee must bear the consequences of its own choices and mistakes.

(b) Added matter - Article 123(2) EPC

The disclaimer in claim 1 simply indicating that comparative example 4 of EP-A 0 566 184 (D15) is excluded was not a technical feature and therefore contravened Article 123(2) EPC. The issue of whether or not a feature in a disclaimer is technical was addressed in T 11/89 in which it was concluded that the published number of a patent specification was not a technical feature. The disclaimer in claim 1 was therefore not in compliance with G 1/03 (point 2 of the reasons), where it was stated that the term "disclaimer" is used as meaning an amendment to a claim resulting in the incorporation of a negative technical feature.

(c) Novelty over D1

D1 disclosed a biaxially oriented film with organic particles having the properties (a), (c), (d) and (e) indicated in claim 1 of the main request. The only feature which was not explicitly disclosed in D1 was feature (b), ie the range for the strength when deformed by 10% (S_{10}). There was no evidence provided by the respondent that the particles in the film of D1 unambiguously exhibit an S_{10} value outside the claimed range of 5 to 30 kgf/mm². The mere specification of a particular

range in claim 1 for a parameter not specified in the prior art D1 could not, however, establish novelty over this document.

(d) Inventive step

In the event novelty over D1 was acknowledged, this document represented the closest prior art. D1 was concerned with biaxially oriented films for magnetic recording media having improved scratch and high speed abrasion resistance and therefore related to the same technical field as the patent. The proprietor did not show that the distinguishing feature over D1, namely the S_{10} value defined in feature (b) of claim 1, was per se responsible for an improved high speed abrasion resistance of the claimed film. The distinguishing S_{10} value was therefore a new parameter with no technical effect. Hence, the problem to be solved had to be seen in the provision of an alternative film to the film of D1. Thus, claim 1 of the main request covered an arbitrary modification of the prior art. Its subject-matter was therefore not based on an inventive step.

The same considerations applied to the subject-matter of claim 1 of the auxiliary request.

XV. Arguments of the proprietor

(a) *Reformatio in peius*

There is clearly a deliberate position taken in G 9/92 (see in particular the order, the headnote

and "primarily" in point 16 of the reasons of the decision) such that exceptions to the principle of prohibition of *reformatio in peius* may occur. Indeed, it is this flexible approach which permits the later decision G 1/99 (see headnote: "*In principle, an amended claim ... must be rejected.*") to describe just such an exception. The second sentence of point 16 in G 9/92 clearly empowers the Boards of Appeal to decide for themselves whether or not an amendment should be allowed, with reference to its appropriateness in the specific factual, procedural and legal context. The Enlarged Board of Appeal provided not just the exception for the "added matter" situation but also general guidance as to the application of the principle of the prohibition of *reformatio in peius* which is also a matter of the fundamental principle of equity (see below).

It is also inherent in the reasoning of G 9/92 that the non-appealing party has accepted the decision of the first instance and, on that basis, should not benefit, through inaction, by the appeal of the other side, here of the opponent. But this presupposes that the factual situation at the time of the first instance decision is the same as on appeal. In the present case, this is not true.

Actually, it was the extremely late filing of D19 [to D22A] by the opponent during the first opposition proceedings which forced the proprietor to submit two alternative sets of claim requests, the first including feature (f) in the event that

D19 was not allowed into the proceedings, the second if it was. The need for two different approaches to the defence of the patent arose because the admission of D19 into the proceedings would have completely changed (and subsequently did completely change) the basis and the substance of the opposition. Both alternative sets of claim requests were maintained throughout the proceedings (including those before the Board).

The substance of the opponent's (first) appeal was that D19 should be entered into the proceedings and that the opposition division erred in not allowing it. The Board's reversal of that decision was based on the content of D23 which was filed on appeal and, therefore, was not available to the opposition division or the proprietor at first instance. In practice, this means that D19 was introduced only on appeal. So, effectively, in the continued opposition proceedings following remittal the proprietor had, for the first time, an opportunity to defend the patent against an attack based on D19.

When the decision under appeal was taken, the proceedings did not include D19 and it was on that basis that the proprietor chose not to appeal. He could not be expected to foretell the filing of D23 and the subsequent shift in the substance of the opposition. As in the referring case of G 1/99, the proprietor in good faith defended its patent at first instance and did not appeal in view of the factual and legal situation at the time of the

decision of the opposition division. There was no abuse of the proceedings on his side.

The present situation was comparable to that underlying G 1/99 in that, owing to the D19/D23 interaction in conjunction with the complex priority situation, feature (f) was no longer tenable in the claim because a further narrowing from feature (f) was not possible. It would be inequitable for the proprietor not to be given a fair opportunity to mitigate the consequences of the admittance of D19/D23 by an appropriate action, ie in the sense of the third (final) exception as defined in G 1/99, this being supported by the cited considerations in point 12 of the reasons of G 1/99

Furthermore, in points 13.1 and 13.2 of the reasons of G 1/99 the Enlarged Board of Appeal highlighted the fundamentally different consequences in the symmetric application of the prohibition of *reformatio in peius* as between a sole appellant/opponent and a sole appellant/proprietor, the latter not having recourse to national courts once the patent has been revoked. This should be taken into account when deciding whether it is equitable to apply the prohibition of *reformatio in peius* rigidly in the present case.

(b) Added matter - Article 123(2) EPC

In the present case the disclaimer was allowable because it excluded prior art according to

Article 54(3) EPC. It excluded a technical feature because it did not simply refer to a publication number of a document; rather it specified with precision a technical content of a document, namely a comparative example of D15. The facts of the present case were different to those of T 11/89 cited by the appellant, the decision in which could not be applied as a general rule.

(c) Novelty over D1

The S_{10} value in feature (b) of claim 1 represented a convenient and useful way of quantifying a particular physical property of the organic particles in the claimed film, namely their deformation under a particular load. It was found (page 3, lines 38-40 of the patent specification) that selection of particles having S_{10} values in the range specified in claim 1 give rise to good high speed abrasion and scratch resistance. Definition of this parameter in the claim was therefore appropriate. The S_{10} parameter was nowhere explicitly or implicitly disclosed in D1.

(d) Inventive step

D1 represented the closest prior art, from which the claimed subject-matter differed in that a specific strength was defined for the organic particles when deformed by 10% (S_{10}), i.e. feature (b). There was no disclosure in D1 that the S_{10} value was an important parameter which had considerable influence on the abrasion resistance of the film. It should further be noted that the

particles in the film of D1 were required to be silicone particles whereas the excellent abrasion resistance of the films according to the present invention was shown in the patent for a number of different particles, e.g.

ethylvinylbenzene/divinylbenzene (EVB/DVB), styrene/divinylbenzene (ST/DVB), styrene/ethylene glycol dimethacrylate (ST/EDMA) or silicone particles. Moreover, D1 was not concerned with the aims of the patent and related rather to the provision of a film surface free from voids around the fine particles.

Although there was no side-by-side comparison in the examples and comparative examples of the patent which demonstrated the decisiveness of the S_{10} value (i.e. the distinguishing feature) vis-à-vis D1, there was no incentive for a skilled person to select the claimed S_{10} range in order to arrive at a higher performance of the claimed film. The claimed film was therefore a non-obvious alternative.

- XVI. The opponent (appellant) requested that the decision under appeal be set aside and that the patent be revoked.
- XVII. The proprietor (respondent) requested that the appeal be dismissed (main request) or alternatively, that the patent be maintained on the basis of the claims according to the auxiliary request filed with the letter dated 14 June 2010.

Reasons for the Decision

1. The appeal is admissible.
2. Admissibility of the amendments in view of decisions G 9/92, G 4/93 and G 1/99 - principle of and exceptions from the prohibition of *reformatio in peius*
 - 2.1 It is evident and undisputed that the deletion of feature (f) in the claims according to the main request as held allowable by the second decision of the opposition division - the one now under review - resulted in a broadening of the protection sought by the proprietor as compared to its main request held allowable by the first decision of the opposition division against which only the opponent had lodged an appeal (T 724/03).
 - 2.2 The opposition division (point IX, above) and the parties (see points XIV(a) and XV(a), above) have expressed themselves extensively and in disagreement on the question of whether or not the proprietor's requests directed to the broader claims are admissible in view of the principle of the prohibition of *reformatio in peius* (henceforth also "PRP") as established in the (identical) decisions G 9/92 and G 4/93 (for simplicity only the second one will be quoted hereafter), namely that "*If the opponent is the sole appellant against an interlocutory decision maintaining a patent in amended form, the patent proprietor is primarily restricted during the appeal proceedings to defending the patent in the form it was maintained by the Opposition Division in its interlocutory decision.*" (Headnote 2). This dispute was

clearly due to the fact that the circumstances in the case at hand differ in several respects from those specifically dealt with in G 4/93 and, as to exceptions from the principle, in G 1/99.

2.3 In the present case the Board of Appeal in its decision T 724/03 limited itself to admitting documents D19 and D23 into the proceedings and to remitting the case to the opposition division for further prosecution (point 2 of the order). As the Board did not itself review the decision under appeal in the light of these newly admitted documents the *PRP* was not an issue during these first appeal proceedings.

2.3.1 As pointed out in G 1/99 (point 9.2 of the reasons) the *PRP* was established in G 4/93 not as a principle of procedural law generally recognised in the Contracting States (Article 125 EPC), but as a consequence of the principle of *ne ultra petita*, more specifically "*it is the appellant who in the notice of appeal determines the extent to which amendment or cancellation of the decision is requested*" in the subsequent appeal proceedings (G 1/99, point 6.4 of the reasons). The fact that the proprietor could not (for lack of adverse effect) or did not appeal against a decision of the opposition division cannot be altered later (just like the scope of protection conferred by the patent as granted). The ensuing procedural limitation on the proprietor's liberty to change by way of amendments the scope of protection sought prevails until the final settlement of the opposition case (just like the limitation pursuant to Article 123(3) EPC) and, therefore, also in any proceedings, including further appeal proceedings, subsequent to a remittal under

Article 111 EPC. Otherwise the *PRP* would not serve its purpose, namely to avoid a situation whereby the opponent and sole appellant would be put "*in a worse situation than if he had not appealed*" (G 1/99, Headnote), or, in procedural terms, whereby the opponent would eventually be adversely affected by its own appeal (G 4/93, point 9 of the reasons: "*The aim of an appeal is to eliminate an 'adverse effect' (Article 107, first sentence, EPC).*").

For this reason the opposition division was wrong to hold that the *PRP* applied only to requests on whose allowability a decision had been taken by the Board of Appeal (point IX, above).

2.3.2 The reasoning of G 4/93 also does not imply that, as the opponent argued (point XIV (a) above), the *PRP* prevails only on condition that the factual situation at the time of the first instance decision is the same as on appeal by the opponent. The legal basis for the *PRP* (*ne ultra petita* - see above) is not related in any way to the facts underlying the decision which the proprietor did not appeal against, or to the reasons for not doing so (see decision T 138/04 as to the deletion of a term introduced at the suggestion of the opposition division). Again, otherwise the *PRP* would not serve its purpose as explained above (which purpose does, however, not exclude the possibility that a change of the relevant facts may justify an exception from the principle - see below).

2.3.3 It follows for the case at hand that the principle of the prohibition of *reformatio in peius* had to be taken into account in the continued opposition proceedings

and, as both parties now seem to agree, it applies also in the present (second) appeal proceedings, the claims setting the framework for *reformatio in peius* being those according to the main request as held allowable by the opposition division in its (first) interlocutory decision announced on 11 March 2003.

2.4 A further feature of the case at hand concerns the circumstances which may justify exceptions from the principle of the *PRP* in accordance with decision G 1/99.

2.4.1 In the situation specifically dealt with in G 1/99 the decision under appeal had to be set aside and the patent had to be revoked by the board of appeal as "*a direct consequence of an inadmissible amendment held allowable by the Opposition Division in its interlocutory decision*", the critical amendment consisting in the addition of a particular limiting feature during the opposition procedure, which did not, however, comply with (e.g. Article 123(2) of) the EPC (see Headnote, points 13 and 14 of the reasons). The Enlarged Board held that "*it would be inequitable for the patent proprietor not to be given a fair opportunity to mitigate the consequences of errors of judgment made by the Opposition Division. Therefore, the patent proprietor may be allowed to file requests in order to overcome this deficiency*" (point 14 of the reasons), if necessary even by deletion of the inadmissible amendment/the critical feature (point 15 of the reasons, last alternative).

2.4.2 In contrast thereto, no error of judgement by the opposition division was established by the board of appeal in T 724/03, which set aside the decision under

appeal because the factual basis of the opposition had changed by the admission of D19 into the proceedings, a document which the board found to represent highly relevant state of the art in view of D23, a corroborating document first filed by the opponent during the (first) appeal proceedings.

2.4.3 As to the possibility of exceptions from the *PRP* as such, the Enlarged Board of Appeal considered in G 1/99 that the undifferentiated application of the *PRP* "*could lead, in certain specific circumstances, to inequitable consequences. ... Indeed, objections raised in first instance may be supported by new facts and new objections may be raised in appeal proceedings with the consequence that the basis on which limitations have been made may still change and it would not be equitable to allow the opponent/appellant or the Board to present new attacks and to deprive the proprietor/respondent of a means of defence.*" (points 11 and 12 of the reasons).

2.4.4 By this the Enlarged Board made it clear that exceptions from the *PRP* are to be allowed as a matter of equity in order to protect the non-appealing proprietor against procedural discrimination in circumstances where the *PRP* would impair the legitimate defence of its patent. That means that exceptions from the *PRP* are not limited to the situation specifically dealt with in G 1/99, ie an error of judgment by the opposition division concerning an amendment introduced into the version of the patent as maintained by the decision under appeal. Rather, the equity approach as taken by the Enlarged Board of Appeal covers, beyond an error of judgment by the opposition division, any

change of the factual and/or legal basis on which limitations have been made by the proprietor prior to the appeal by the opponent as the sole appellant, provided the proprietor would be prevented by the *PRP* from adequately defending its patent against new facts and objections introduced into the proceedings at the appeal stage.

- 2.4.5 Under the circumstances prevailing in the opposition proceedings before the opposition division took its first interlocutory decision on 11 March 2003, it was a perfectly appropriate and legitimate line of defence for the proprietor to file a main request with claims containing the priority-destroying feature (f) in order to cope - successfully, as the opposition division held - with D15, a document which was in the proceedings already, and to ignore D19. As long as this late filed document, even if it represented state of the art within the meaning of Article 54(2) EPC for claims which did not enjoy the (earliest) priority, was not admitted into the proceedings, it could not have any bearing on the decision on the opposition against the patent in dispute. By the same token, in the event that D19 were to be admitted into the proceeding, the proprietor would be entitled to file an auxiliary request from whose claims feature (f) had been deleted so that D19 - a highly relevant document, as it turned out later, when taking into account the corroborating document D23 filed by the opponent in the (first) appeal proceedings - could not be cited against such a version of the patent in dispute. The filing of an auxiliary request with claims necessarily broader in scope than those according to the main request did not, in the given circumstances, constitute an abuse of the

proceedings by the proprietor, in particular not a circumvention of the *PRP*. It is immaterial in this context that D19 was filed only shortly before the (first) oral proceedings before the opposition division, a fact relied on by the proprietor - point XV(a), above - and as to whether the latter was better placed to judge the relevance of D19, since it was the proprietor's own document, as maintained by the opponent - point XIV(a), above.

- 2.4.6 Where the filing of broader claims as an auxiliary request would have been a legitimate means of defence in proceedings before the opposition division as department of first instance, it would be inequitable to deprive the proprietor of that means of defence by applying the *PRP* if in later appeal proceedings the conditions for filing the broader auxiliary/alternative request are eventually met - in the present case following the admission of the highly relevant D19 into the proceedings. Otherwise, the proprietor would be discriminated against and the opponent would benefit from the *PRP* beyond its purpose in the - certainly rare, but, as the present case demonstrates, not impossible - situation where a limitation of the claims is not the appropriate response to new facts and new objections (as in the present case "*owing to the D19/D23 interaction in conjunction with the complex priority situation*", as the proprietor put it - point XV (a), above). It is also to be borne in mind that the principle of *ne ultra petita* as developed in G 4/93 and relied on in G 1/99 is exclusively a matter of the scope of protection sought or (implicitly) no longer sought by the proprietor. This cannot reasonably be the sole relevant criteria for assuming an implied waiver

also of the priority right by the non-appealing proprietor where the filing of broader claims was both intended and appropriate to keep the (earliest) priority right in the case of the later admission of a specific intermediate document into the proceedings.

2.4.7 It is true that in the case at hand the opponent's situation was worsened by the deletion of the fatal feature (f), and that it was the proprietor's choice to maintain claims containing the priority-destroying feature (f) as its main request. But arguing, as the opponent did (point XIV, above), that the proprietor is bound by its own decision at that time because it does not deserve protection from itself, is begging the question. The decisive question is whether or not the proprietor deserves protection, as a matter of equity, in view of a later change of the factual basis of the decision on the opposition (a change which in the present case was brought by the opponent by filing the corroborating document D23 in support of its appeal against the first interlocutory decision of the opposition division).

2.4.8 On the other hand, it is not sufficient for granting an exception from the *PRP* that, as the proprietor argued (point XV, above), it defended its patent in good faith at first instance and did not appeal in view of the factual and legal situation at the time of the decision of the opposition division, and it could not be expected to foretell the filing of D23 and the subsequent shift in the substance of the opposition. All this was not different from the standard situation where the sole or main request was found to be allowable and the patent can later be defended in

appeal proceedings by the standard means of defence, that is by narrowing the protection sought in response to new facts or objections.

2.4.9 The present case is not of that standard type, rather the relevant circumstances were such that the deletion of the critical priority-destroying feature (f) was exceptionally justifiable while also respecting the rule that such an exception should only be construed narrowly (G 1/99, point 15 of the reasons). There is nothing in that point or elsewhere in G 1/99 from which it can be derived that the three types of amendments and their order set out therein (point 15 and Headnote, second paragraph) have to be considered as the sole equitable and, therefore, admissible amendments, also where no error of judgement by the opposition division was present. Whether at all, to what extent and in what form any such exception may be granted has to be decided along these lines in each individual case with an aim to re-conciliate the adequate protection of the rights and interests of the sole appellant/opponent with the legitimate defence of the patent by the (non-appealing) proprietor. The proprietor thus correctly argued that the decision G 1/99 provides guidance for the exercise of the relevant discretionary power beyond the facts underlying the referring decision (see point XV, above).

3. Added matter by disclaimer - main request

Claim 1 of the main request (point VIII, above) excludes a film of comparative example 4 of EP-A 0 546 184 (D15) via a disclaimer in order to restore novelty over the disclosure in this document.

3.1 The board notes that these claims are entitled to the earliest priority date of 12 August 1992. D15 claims three priorities from 1991 and was published on 15 October 1992, ie after the above earliest priority date. It therefore constitutes prior art according to Article 54(3) EPC. This was not contested by the parties.

The requirement set out in point 2.1 of the order of G 1/03 that a disclaimer may be allowable in order to restore novelty by delimiting a claim against state of the art under Article 54(3) EPC is therefore fulfilled.

3.2 The opponent argues that the disclaimer contravened Article 123(2) EPC because the wording of the disclaimer that the claimed film *"is other than a film of Comparative Example 4 of EP-A 0546184"* did not represent a technical feature.

The board does not accept this argument. Although it is true that technical information cannot directly be extracted from the wording of the disclaimer in claim 1 as such, it should be noted that the disclaimer does not merely cite a published patent document, but clearly refers to a specific disclosure in D15, namely a single film described in comparative example 4. Table 4 of D15, characterises this film unambiguously by a number of technical features. The skilled person is therefore able to determine simply by reading the comparative example in D15 which technical embodiment should be excluded from the scope of the claim. The disclaimer in claim 1 therefore represents a negative technical feature in the sense of G 1/03 (point 2 of

the reasons) and therefore complies with Article 123(2) EPC.

4. Novelty over D1 - main request

D1 describes a biaxially oriented polyester film containing organic silicone particles which are characterised by the following parameters:

- The silicone resin particles contain organopolysiloxane moieties $\text{CH}_3\text{-Si}[\text{O}]_{3/2}$ in an amount of 80 wt% or more of the structural units of the silicone (page 4, line 4; paragraph bridging pages 6 and 7 and page 19, lines 3 to 5). These units are trifunctional and therefore provide crosslinking of the silicone particles. The degree of crosslinking of the particles is therefore 80% or more in accordance with feature (a) of claim 1.
- The silicone resin particles are particles of the type XC99-301 or -501 (page 15, second paragraph). Physical properties of XC99-301, 501 particles are given in D8. *Inter alia* the weight loss at a thermal decomposition temperature of 350°C is 2 to 3% for both types of particles (D8, last table at page 2/2). Feature (c) of claim 1 is therefore fulfilled.
- The average particle size is 0.01 to 4 µm (page 6, last paragraph). Feature (d) of claim 1 is therefore fulfilled also.
- The particles are present in the polyester in an amount of 0.005 to 1.0 wt% (paragraph bridging pages 3 and 4), in accordance with feature (e) of claim 1.

D1, however, does not explicitly and unambiguously disclose the strength of the particles when deformed by 10% (S_{10}) as required by feature (b) of claim 1. The claimed film is therefore novel over D1.

5. Inventive step - main request

5.1 The patent is concerned with a biaxially oriented film with good abrasion resistance and scratch resistance when running at a high speed, in particular when used as a magnetic recording medium (paragraph [0001]). It is stated in paragraph [0008] of the patent specification that the abrasion resistance and scratch resistance of a magnetic surface at a high running speed of the film are improved by using crosslinked organic particles having a specified hardness and a high degree of crosslinking. According to paragraphs [0024/25] an appropriate hardness, which is represented by the S_{10} value of the particles, is obtained by providing crosslinked organic particles with S_{10} values in the range of 3 to 30 kgf/mm², preferably 5 to 20 kgf/mm².

5.2 As agreed by the parties, D1 represents the closest prior art. D1 is concerned with biaxially oriented polyester films for which, when used in magnetic recording media, the need exists to improve *inter alia* the scratch resistance and abrasion resistance (D1, the paragraph bridging pages 2 and 3). In order to achieve these desired properties, the film contains organic crosslinked silicone particles which meet, as set out in point 4 above, the following requirements:

- the degree of crosslinking is 80% or more;
- the loss in weight when heated at 350°C is 2 to 3%;
- the average diameter is in the range of 0.01 to 4 µm;
- the content in the film is 0.05 to 1 wt%.

The organic particles of the film according to D1 therefore meet the requirements (a), (c), (d) and (e) of claim 1 of the main and auxiliary request.

Feature (b) of claim 1, relating to the deformation of the particles by 10% (S_{10}) is not disclosed in D1.

5.3 In the light of the closest prior art the respondent saw the problem to be solved underlying the subject-matter of claim 1 of the main request in the provision of films for magnetic recording media having an improved abrasion resistance and scratch resistance, in particular at a high running speed.

Although the experimental evidence in the patent specification shows that the claimed films possess good abrasion resistance and scratch resistance at a high running speed it is not demonstrated that the claimed range for the S_{10} values, i.e. the sole distinguishing feature over D1, provides a particular advantage over films with S_{10} values outside the claimed range.

Therefore, the objective technical problem can only be seen in the provision of an alternative biaxially oriented film. There can be no doubt that this less ambitious problem is solved by a film according to claim 1 of the main request.

5.4 It remains to be decided whether the solution to the problem, namely satisfaction of the S_{10} value as claimed in feature (b) of claim 1 is obvious from the prior art.

As can be derived from paragraph [0005] of the patent in suit dealing with films for magnetic recording media of the prior art, appropriate hardness of the organic particles is *inter alia* responsible for achieving sufficient abrasion resistance at a high running speed. Adjustment of appropriate hardness of organic particles in films for magnetic recording media is therefore a need in the prior art. A skilled person starting from D1 and intending to optimize abrasion resistance of the films disclosed in this document is therefore incited to adjust the hardness of the particles. As is apparent from paragraph [0025] of the patent in suit the deformation by 10% (S_{10}) is an index representing the hardness of the particles. In essence, therefore, the alleged distinguishing feature is nothing but a new parameter defining a known property relevant to organic particles in films suitable for magnetic recording media.

Since furthermore the proprietor has not provided experimental evidence showing that the 10% deformation strength of the particles expressed by the range for the S_{10} values has a specific, let alone surprising, technical effect on the abrasion resistance of the claimed film, the definition of the particle deformation via the S_{10} deformation strength as claimed in feature (b) of claim 1 is arbitrary and cannot involve an inventive step.

The film according to claim 1 of the main request is therefore not inventive over D1.

6. Auxiliary request

6.1 Claim 1 of the auxiliary request is directed to "A two-layer laminated film in a magnetic recording medium, namely layer (A) of a biaxially orientated film containing organic particles and a layer (B) other than the layer (A) containing organic particles", wherein the biaxially orientated film containing organic particles of layer (A) is defined as the biaxially orientated film containing organic particles of claim 1 of the main request.

6.2 In view of the disclosure in the last full paragraph at page 10 of D1 that the biaxially oriented film can be used as a base film of a magnetic recording medium, ie is part of a multi-layer film, the reasons for denying an inventive step for the subject-matter of claim 1 of the main request equally apply to the subject-matter of claim 1 of the auxiliary request (points 5.1 to 5.4 above).

7. In summary, both the main and auxiliary request are not allowable because the subject-matter of the respective claim 1 does not involve an inventive step.

Order

For these reasons it is decided that:

1. The decision under appeal is set aside.
2. The patent is revoked.

The Registrar

The Chairman

M. Cañueto Carbajo

W. Sieber