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**Datasheet for the decision  
of 22 November 2011**

**Case Number:** T 2434/09 - 3.5.04

**Application Number:** 02007071.0

**Publication Number:** 1318510

**IPC:** G11B 7/24

**Language of the proceedings:** EN

**Title of invention:**

Optical disk and recording/reproducing apparatus

**Applicant:**

Kabushiki Kaisha Toshiba

**Headword:**

-

**Relevant legal provisions (EPC 1973):**

EPC Art. 110, 113(1), 54(2)

EPC R. 67, first sentence

**Relevant legal provisions:**

RPBA Art. 12(1)(2)(4), 13(1)

EPC Revision Act of 29 November 2000, Article 7

Decision of the Administrative Council of 28 June 2001 on the  
transitional provisions under Article 7 of the EPC Revision  
Act, Article 1, No. 1

Decision of the Administrative Council of 7 December 2006  
amending the Implementing Regulations to the EPC 2000

Article 2

**Keyword:**

"Examination of the appeal - yes"

"Admission of submissions made for the first time during oral proceedings - (no)"

"Substantial procedural violation - (no)"

"Reimbursement of appeal fee - (no)"

**Decisions cited:**

J 0003/06, J 0010/07, T 0367/91, T 0654/92, T 0951/97,  
T 0376/98, T 1001/98

**Catchword:**

If a European patent application is finally deemed to be withdrawn after an admissible appeal against a decision refusing it has been filed, the appeal can usually be considered disposed of, because there is no possibility of a European patent being granted for the application. (See points 4 and 5).

However, where, as in the present case, the sole aim of the appeal is to obtain a finding by the board of appeal that a substantial procedural violation occurred in the first-instance proceedings, such that the appealed decision is to be set aside and the appeal fee reimbursed, the appeal cannot be dealt with in this way. In these circumstances the appellant has a legitimate interest in receiving a decision on the merits of the appeal. Therefore the appeal must be examined and the appeal proceedings cannot be closed without a substantive decision on the case. (See points 6 to 9).



Case Number: T 2434/09 - 3.5.04

**D E C I S I O N**  
of the Technical Board of Appeal 3.5.04  
of 22 November 2011

**Appellant:** Kabushiki Kaisha Toshiba  
(Applicant) 1-1, Shibaura 1-chome  
Minato-ku  
Tokyo (JP)

**Representative:** Henkel, Breuer & Partner  
Patentanwälte  
Maximiliansplatz 21  
D-80333 München (DE)

**Decision under appeal:** Decision of the Examining Division of the  
European Patent Office posted 19 June 2009  
refusing European patent application  
No. 02007071.0 pursuant to Article 97(2) EPC.

**Composition of the Board:**

**Chairman:** F. Edlinger  
**Members:** T. Karamanli  
C. Kunzelmann

## Summary of Facts and Submissions

I. European patent application No. 02 007 071.0, with the priority date of 6 December 2001, was filed on 27 March 2002 and published as EP 1 318 510 A2.

II. The European search report mentioned *inter alia* the following prior art:

D1: EP 0 994 470 A2

D2: US 2001/012257 A1

D3: MARCHANT ET AL: "Optical Recording" OPTICAL RECORDING. TECHNICAL OVERVIEW, READING, ADDISON WESLEY, US, 1990, pages 125-132, XP002084441

D4: US 6 246 656 B1.

III. In a communication annexed to the summons to oral proceedings dated 21 January 2009, the examining division, in preparation for the oral proceedings, referred to its previous communications of 24 January 2007 and 8 April 2008 and expressed the view that the amended claims filed with letter of 27 July 2007 did not comply with Article 123(2) EPC and that the invention was not sufficiently disclosed under Article 83 EPC. It also referred to the earlier communication dated 24 January 2007, in which objections under Articles 54(1),(2) and 56 EPC had been raised against the set of claims as originally filed. It was also pointed out that, considering the application as a whole, due to the disclosure of documents D1 (column 3, lines 15-21) or D4 (column 8, lines 22-38), the application did not seem to contain any additional subject-matter which could be considered as inventive, having regard to the disclosure of said documents and

to the common general knowledge of a person skilled in the art of optical recording.

IV. In a reply dated 24 April 2009, the applicant filed new claims 1 to 7, which replaced all claims then on file. The applicant did not comment on the examining division's general remark on lack of inventive step in view of D1 or D4 and the common general knowledge of a person skilled in the art of optical recording.

V. Oral proceedings took place before the examining division on 26 May 2009. A copy of the minutes of these oral proceedings (hereinafter "the minutes") was sent to the applicant in accordance with Rule 124(4) EPC on 27 October 2009 upon the applicant's explicit request of 20 October 2009.

After discussion of the amended claims according to the request filed with letter of 24 April 2009 and the maintenance of the examining division's objection under Article 123(2) EPC, the applicant filed amended claims according to a first auxiliary request (see point 3.1 of the minutes). The examining division raised several objections against these claims under Rule 43(2) and Articles 123(2) and 54(1),(2) EPC. The examining division observed (see point 3.3, last paragraph of the minutes) that the spherical surface aberration correction mechanism did not form part of the system as defined in claim 1 (having the following relevant wording: "... determined based on the allowable value of the aberration in said cover layer (14) which **can be corrected by a** spherical surface aberration correction mechanism" (highlighting by the board)).

After the discussion of the first auxiliary request, the applicant filed amended claims (independent claim 1 and dependent claims 2 and 3) according to a second auxiliary request (see point 4.1 of the minutes). Independent claim 1 was directed to a system based on claim 1 of the first auxiliary request, furthermore defining the values  $t_1$  and  $t_2$  and a spherical surface aberration correction mechanism as a feature of the optical disk apparatus of the system and clarifying that the value of the aberration can be corrected by "the" spherical surface aberration correction mechanism. Inventive step was discussed in view of documents D1 to D4 (see point 4.1 of the minutes).

After deliberation the examining division informed the applicant as follows (see point 4.2, first paragraph, of the minutes):

- the subject-matter of claim 1 of the second auxiliary request could not be regarded as inventive under Article 56 EPC,
- the difference between D2, considered to represent the closest state of the art, and the application was the feature of a spherical surface aberration correction mechanism,
- said feature, however, belonged to the common general knowledge of the skilled person in the field of optical data storage at the date of priority,
- this common general knowledge was already acknowledged in the description of the application (cf. for instance page 5, lines 2 - 7 and page 6, lines 26 - 31), which clearly implied that a spherical surface aberration correction mechanism was known on the priority date and that the object

of the application was to take into account this known mechanism when setting the allowed degree of margin for manufacturers of optical disks.

The applicant did not agree that the use of a spherical surface aberration correction mechanism was publicly known at the priority date and alleged that the description merely reflected in-house knowledge of the applicant which was not public at that time (see point 4.2, second paragraph, of the minutes).

In response to the applicant's argument, the examining division introduced

D5: EP 1 043 615 A1

as an illustration of the skilled person's common general knowledge and practice on the priority date (see point 4.2, third paragraph, of the minutes). The examining division handed out a copy of document D5 to the applicant and referred to paragraphs [0004] to [0007], [0010] and [0015] to [0017] of D5, which suggested the use of a relay lens system (see figure 10, reference no. 21) in a recording and reproducing apparatus for a BluRay disk for correcting spherical surface aberration due to differences in the cover layer thickness. It concluded from this that the description of the present application did not reflect in-house knowledge but mechanisms for correcting spherical surface aberration which belonged to the common general knowledge of the person skilled in the art at the priority date (see point 4.2, fourth paragraph, of the minutes).

After the examining division proposed adjourning the proceedings to give the applicant's professional representative enough time to study document D5, the representative waived this right but requested to continue the procedure in writing because he wanted to present the document to the applicant's technical experts (see point 4.2, fifth paragraph, of the minutes).

The examining division expressed its opinion that the objection of lack of inventive step against claim 1 of the second auxiliary request was still based on the skilled person's common general knowledge as acknowledged in the application, whereas document D5 was merely used to refute the applicant's argument brought forward during the oral proceedings that the background art of the description merely reflected in-house knowledge (see point 4.2, sixth paragraph, of the minutes).

At the end of the oral proceedings the chairman announced the decision of the examining division to refuse the request for continuing the proceedings in writing and to refuse the European patent application under Article 97(2) EPC (see point 5 of the minutes).

- VI. The decision of the examining division was posted on 19 June 2009. The main request and the first auxiliary request were considered as unallowable because the amendments made to the claims infringed Article 123(2) EPC. The subject-matter of claim 1 of the second auxiliary request was considered as lacking inventive step in view of document D2 and common general knowledge (see section 8 of the grounds for the



appealed decision (hereinafter "the reasons")). That the use of an aberration correction mechanism was common general knowledge was even considered to be reflected in several passages of the description of the present application (page 5, lines 2 - 5; page 6, lines 28 - 31; page 7, lines 3 - 5 and page 13, lines 2 - 6) (see point 8.4 of the reasons).

Point 8.5 of the reasons reads:

*"The representative at the oral proceedings disagreed with the objection of inventive step (Article 56 EPC) raised by the examining division. He considered that the use of an aberration correction mechanism was not well known and commonly used in the art for solving the problem of how to reduce the spherical surface aberration accompanying the thickness error of the light transmission layer due to the enhancement of NA [(numerical aperture), added by the board] in the next-generation optical systems. He also contested that the description only reflects in-house knowledge which was not public at the priority date of the application.*

*In response to that argument, the examining division, introduced a new document into the proceedings:*

*D5 [.....].*

*This document was published before the priority date of the application and introduced as an example that the problem of the increase of the spherical aberration with the increase of the NA was well-known in the art and the solution of adding a spherical aberration correction mechanism proposed in independent claim 1*

*was known too. As evidence, document D5 discloses the same problem (see paragraphs 4-7) and proposes a relay lens system (see for example figure 10, reference number 21 and paragraphs 53 and 63) in a recording and reproducing apparatus for a BluRay disk for correction spherical aberration due to differences in the cover layer thickness. Hence, the description of the application does not reflect in-house knowledge but mechanisms for correcting spherical aberration which were generally known to the skilled person at the priority date of the application."*

VII. On 10 August 2009 the applicant (appellant) filed a notice of appeal with the EPO and paid the appeal fee.

VIII. By letter received at the EPO on 22 October 2009, the appellant filed its statement setting out the grounds of appeal (hereinafter "the grounds of appeal").

It was requested that the decision of the examining division be set aside and the appeal fee reimbursed.

The grounds of appeal read as follows:

*"During the Oral Proceedings of May 26, 2009 the Examining Division introduced a new document, i.e. document D5 (EP-A1-1043615).*

*This state of the art document is essential for the decision refusing the present application.*

*The representative requested to continue the examining procedure in written so as to give the applicant time to study document D5 and so as to have the opportunity*

*to provide the representative with corresponding instructions how to argue against this state of the art.*

*However, the Examining Division refused this request and instead decided to refuse the present application.*

*It is believed that this represents a procedural violation which justifies the appeal and the refund of the appeal fee.*

*In this connection reference is made inter alia to the decision T 951/97, where it is explicitly stated that the subject of the proceedings is changed within the meaning of Rule 71a(1) and (2) EPC1979 [sic] inter alia where the Examining Division itself introduces a new document (...) for the first time during the Oral Proceedings."*

IX. By communication (EPO Form 2524) dated 25 November 2010, the EPO noted a loss of rights pursuant to Rule 112(1) EPC and informed the appellant that the present European patent application was deemed to be withdrawn under Article 86(1) EPC since the renewal fee for the 9th year and the additional fee had not been paid in due time. No means of redress against this finding have been made use of by the appellant.

X. By letters dated 2 May 2011 and 6 June 2011, the appellant informed the board as follows:

*"Regarding the fact that the present application has lapsed due to the non-payment of the renewal fees, the applicant is strongly interested in receiving a*

*decision setting aside the decision of the Examining Division and refunding the Appeal fee."*

XI. On 21 June 2011 the board issued a summons to oral proceedings to be held on 15 September 2011. In a separate communication under Article 15(1) of the Rules of Procedure of the Boards of Appeal (RPBA, OJ EPO 2007, 536) dated 1 August 2011, the board gave its opinion, which was not binding for the purposes of the final decision.

In the board's view it was doubtful that a breach of Article 113(1) EPC 1973 had taken place in the first-instance proceedings for the following reasons:

- The applicant did not have a right in principle for continuation in writing if the department of first instance introduced a new document for the first time in oral proceedings and thereby changed the subject of the proceedings. It was established jurisprudence that an interruption of the oral proceedings giving the party sufficient time for an adequate analysis was in conformity with the principle of the right to be heard in accordance with Article 113(1) EPC 1973 (see Case Law of the Boards of Appeal, 6th edition, 2010, VI.B.2.2.1). How much time was sufficient depended on the nature of the newly introduced document and the preceding procedure. This was also clear from decision T 951/97 (OJ EPO 1998, 440, in particular Reasons, point 4.1), which had been cited by the appellant.

- In the present case, however, the appellant had not explained in the grounds of appeal why the appellant's representative had waived the offer of the examining division to adjourn the oral proceedings to give the applicant enough time to study D5 (see point 4.2, fifth paragraph of the minutes) and why document D5 was of such a nature that it would have been necessary to continue the proceedings before the examining division in writing. Hence it was not apparent that a substantial procedural violation had occurred in the first-instance proceedings which justified the setting aside of the appealed decision and consequently the reimbursement of the appeal fee.

The board also drew attention of the appellant to the provisions of Article 13 RPBA.

- XII. By letter dated 23 August 2011 the appellant's representative requested postponement of the oral proceedings since he had already been summoned to oral proceedings in The Hague, and filed evidence to that effect. He also informed the board of further dates on which he was not available for oral proceedings. By communication posted on 12 September 2011, the appellant was informed that the oral proceedings appointed for 15 September 2011 were postponed to 22 November 2011.
- XIII. The appellant did not file any written reply in substance to the board's communication under Article 15(1) RPBA.

XIV. During the oral proceedings before the board, the appellant made submissions which can be summarised as follows.

- (i) The new feature in claim 1 of the second auxiliary request, which formed the basis of the appealed decision, was actually a feature of independent claim 14 of the application as filed. Therefore it was not comprehensible why the examining division had not already introduced document D5 before the oral proceedings. Moreover, after more than seven years of examination, document D5 should not have been introduced at such a late stage.
- (ii) During the first-instance oral proceedings, the examining division had tried to use document D5 as evidence for common general knowledge of a skilled person. However, document D5 was a prior-art document and not a copy of a text book.
- (iii) Document D5 comprised about 70 pages (in the version as filed, and 43 pages in the A1 version to which the decision under appeal refers; comment added by the board) and disclosed all the features of the claims of the second auxiliary request. Hence document D5 was novelty-destroying prior art for the second auxiliary request. This was also supported by the fact that D5 was cited as an X-document in the search report for the

divisional application deriving from the present patent application.

- (iv) Moreover, the examining division had said that document D5 was novelty destroying and showed the disclosure of each feature of claim 1 of the second auxiliary request in document D5. Thus the issue of novelty had been implicitly discussed. This could be seen from the first paragraph on page 5 of the minutes, where it was stated that the examining division referred to several specific paragraphs of D5 because these paragraphs actually disclosed the features of claim 1 of the second auxiliary request.
  
- (v) It was very easy to recognise that document D5 was novelty destroying, but only as far as the features of the claims then on file were concerned. However, at the first-instance oral proceedings, it was not possible for the representative to compare the disclosure of document D5 with that of the description of the present patent application for identifying a difference between both disclosures and drafting new amended claims which could overcome any novelty objection based on document D5. First, for comparing the application with D5 three to five hours would have been necessary and for drafting new amended claims another one to two hours. If more than one difference were identified, the representative would have needed even more

time. It had also been necessary for the representative to contact his client because he had to agree with the applicant on new amended claims in order to react in a reasonable manner and to avoid any liability. Therefore, it had not been possible for the representative to submit in the first-instance oral proceedings claims which contained new subject-matter of the disclosed invention.

- (vi) In view of all these circumstances, the only appropriate thing to do would have been to continue the proceedings in writing.
- (vii) Moreover, it was not the first time that the representative had been surprisingly confronted with a new document in proceedings before an examining division in The Hague. Therefore, the board should clarify in a positive decision on the present appeal that such a course of action was a procedural violation.
- (viii) As far as submissions at a late stage of appeal proceedings were concerned, it was of importance that the minutes of the oral proceedings before the examining division had been sent on 27 October 2009 and could, therefore, not have been taken into account when the grounds of appeal were filed.

XV. At the end of the oral proceedings the chairman announced the board's decision.



## Reasons for the Decision

1. The present decision was taken after the revised European Patent Convention entered into force on 13 December 2007. Since the European patent application in suit was pending at that time, the board applied the transitional provisions in accordance with Article 7(1), second sentence, of the Act revising the EPC of 29 November 2000 (hereinafter "the Revision Act") and the decision of the Administrative Council of 28 June 2001 on the transitional provisions under Article 7 of the Revision Act (Special edition No. 1, OJ EPO 2007, 197) and the decision of the Administrative Council of 7 December 2006 amending the Implementing Regulations to the EPC 2000 (Special edition No. 1, OJ EPO 2007, 89). Articles and Rules of the revised EPC and of the EPC valid until that time are cited in accordance with the "Citation Practice" (see the 14th edition of the European Patent Convention, page 6).

### *Admissibility of the appeal*

2. The provisions to be applied in the present case with regard to the admissibility of the appeal are those in accordance with the above-mentioned transitional provisions, since the time limits for complying with the conditions for filing an appeal expired after the revised EPC entered into force (see also J 10/07, OJ EPO, 2008, 567, Reasons, section 1). Accordingly, the provisions of Articles 106 and 108 EPC are to be applied (Article 1, No. 1, of the decision of the Administrative Council of 28 June 2001 on the transitional provisions under Article 7 of the Revision Act (loc. cit.)) as well as Rules 99 and 101 EPC (see

Article 2, first sentence, of the decision of the Administrative Council of 7 December 2006 amending the Implementing Regulations to the European Patent Convention 2000 (loc. cit.) and J 10/07, loc. cit., Reasons, point 1.3). The present appeal meets the requirements of said EPC provisions and is thus admissible.

*Examination of the present appeal*

3. Article 110 EPC (which is to be applied in the present case in accordance with Article 1, No. 1, of the decision of the Administrative Council of 28 June 2001 on the transitional provisions under Article 7 of the Revision Act (loc. cit.)) provides that, if the appeal is admissible, the board has to examine whether the appeal is allowable.
4. In the present case, however, the European patent application in respect of which the first-instance examination under Article 94 EPC was carried out and which is the subject of the appealed decision was finally deemed to be withdrawn after the appeal had been filed due to the non-payment of the renewal fee and the additional fee and no means of redress against this finding had been made use of (see point IX above).
5. In such a case, the *ex-parte* appeal proceedings are usually closed without a substantive decision and the appellant is informed accordingly. Subsequently, the grant procedure in respect of the European patent application concerned is closed by the first-instance department.

The reason for taking this course of action is that if a European patent application is finally deemed to be withdrawn after an admissible appeal against a decision refusing it has been filed, the appeal can usually be considered disposed of, because there is no possibility of a European patent being granted for the application.

6. However, in certain situations it may not be possible to take the above course of action. The board is faced with such a situation in the present case.
7. The sole aim of the present appeal was clearly to obtain a finding by the board that a (substantial) procedural violation occurred in the first-instance proceedings which justifies the setting aside of the appealed decision and consequently the reimbursement of the appeal fee (see point VIII above). This means that the main issues to be decided by the board in the present appeal proceedings are whether a substantial procedural violation occurred during the first-instance examination proceedings which justifies in itself the setting aside of the appealed decision and whether the appeal fee has to be reimbursed to the appellant.
8. It is also obvious from the appellant's letters dated 2 May 2011 and 6 June 2011 (see point X above) that the appellant wished to pursue its appeal irrespective of the fact that a European patent could no longer be granted on the basis of the present application.

This is plausible in the board's view because, according to the present appeal, which was filed before the non-payment of the renewal fee, the only reason why the appellant initiated the appeal proceedings was that,

in its view, a procedural violation had occurred in the first-instance proceedings which in itself justified the setting aside of the appealed decision and the reimbursement of the appeal fee. Consequently, if the board had concurred with the appellant's view as set out in the grounds of appeal and had allowed the appellant's requests (see point VIII above), the appellant would have received the board's declaratory judgement that the examining division had committed a substantial procedural violation which justified the setting aside of the appealed decision and would have obtained a refund of the appeal fee. Subsequent to such a decision the grant procedure in respect of the European patent application concerned would be closed.

9. It follows from the above that the appellant had a legitimate interest in receiving a decision on the merits of this case and that therefore the present appeal was not disposed of by the application being finally deemed to be withdrawn. Accordingly, an examination of the present appeal is necessary and the present appeal proceedings could not be closed without a substantive decision.

*Submissions made for the first time during oral proceedings before the board*

10. According to Article 12(1)(a) and (c) RPBA, *ex-parte* appeal proceedings are based on the notice of appeal and grounds of appeal filed pursuant to Article 108 EPC and, in addition to that, any communication sent by the board and any answer thereto filed pursuant to directions of the board. Under Article 12(2) RPBA the statement of grounds of appeal must contain a party's

complete case and set out clearly and concisely the reasons why it is requested that the decision under appeal be reversed or amended, and should specify expressly all the facts, arguments and evidence relied on. Article 12(4) RPBA requires the board to take into account everything presented by the parties under Article 12(1) RPBA if and to the extent it relates to the case under appeal and meets the requirements in Article 12(2) RPBA. However, according to Article 12(4) RPBA, the board has the discretionary power to hold inadmissible facts, evidence and requests which could have been presented or were not admitted in the first-instance proceedings.

It follows quite clearly from the above that the board is not required to take into account matter which does not meet the requirements of Article 12(2) RPBA. This means that, if the appellant has not specified all the facts, arguments and evidence on which he relies in the statement of grounds of appeal, but supplements his case later in the course of the appeal proceedings, for example in a reply to a communication from the board, the board is not required to consider every supplementary submission.

This conclusion is supported by Article 13(1) RPBA, which stipulates that any amendment to a party's case after it has filed its grounds of appeal may be admitted and considered at the board's discretion. It further provides that the discretion must be exercised in view *inter alia* of the complexity of the new subject-matter submitted, the current state of the proceedings and the need for procedural economy.

11. In the present case, in the grounds of appeal (see point VIII above), the appellant submitted that, during the first-instance oral proceedings, the examining division introduced document D5 as a new prior-art document which was essential for the appealed decision refusing the present application. It further submitted that, although the applicant's representative requested continuation of the examination proceedings in writing so that the applicant would have time to study document D5 and the opportunity to provide the representative with instructions as to how to argue against document D5, the examining division refused this request and decided to refuse the present application. In the appellant's view, the examining division committed a substantial procedural violation by not continuing the examination proceedings in writing.
  
12. According to the minutes and the reasons (see points V and VI above), inventive step was the only issue which was discussed with regard to the claims of the second auxiliary request filed during oral proceedings (see point 4.1 of the minutes and points 7 and 8 of the reasons). The examining division concluded that the subject-matter of claim 1 of the second auxiliary request lacked inventive step within the meaning of Article 56 EPC 1973 in view of D2 and common general knowledge acknowledged in the description of the present application (see point 4.2, first paragraph of the minutes and points 8.1 - 8.4 of the reasons). The examining division introduced document D5 only after the applicant's representative had raised the objection for the first time in oral proceedings that the description of the present application merely reflected in-house knowledge which was not public at the relevant

priority date (see point 4.2, second to fourth paragraphs of the minutes and point 8.5 of the reasons). The board does not concur with the appellant's view that it is obvious from page 5, first paragraph (i.e. point 4.2, fourth paragraph) of the minutes that novelty over D5 was (implicitly) discussed. This passage essentially deals with the question of whether the description of the present application refers to a mechanism for correcting spherical surface aberration which belonged to the common general knowledge of the person skilled in the art at the priority date. According to the minutes, this question was only of importance for the assessment of inventive step, as can be seen from the whole context of section 4.2 of the minutes. Additionally, the reasons do not indicate that novelty was a further issue with respect to the claims of the second auxiliary request.

13. In view of the foregoing it came as a surprise for the board to hear from the appellant's representative for the first time in the oral proceedings before the board that, in the first-instance oral proceedings, the examining division had also considered document D5 as novelty-destroying prior art because it disclosed each feature of claim 1 of the second auxiliary request (see in detail point XIV, (iii) - (iv), above). The appellant's representative further submitted that this was easily recognised, but the oral proceedings were not sufficient for comparing the disclosure of document D5 with that of the description of the present application and for drafting new claims and that, therefore, the examining division should have continued the proceedings in writing, in particular to give the representative the opportunity to contact the appellant

for further information and/or instruction (see in detail point XIV (v) above).

14. Since there was no indication of these alleged facts and the arguments based thereon in the grounds of appeal, they are considered as amendments to the party's case within the meaning of Article 13 RPBA. They may thus be admitted into the proceedings and considered at the board's discretion.
  
15. The board is of the view that all the alleged facts and arguments with regard to the discussion of lack of novelty, which the appellant's representative submitted for the first time during the oral proceedings before the board (see in detail point XIV (iii) - (v) above), could and should have been submitted with the grounds of appeal in accordance with Article 12(2) RPBA. The appellant's argument that this could not have been done because the minutes were sent only after the grounds of appeal were filed does not convince the board. The appellant's representative who signed the statement of grounds of appeal was also present at the oral proceedings before the examining division. Hence, even without the minutes at hand he could have described the course taken by the oral proceedings from memory. Moreover, the appellant did not even reply to the board's communication under Article 15(1) RPBA but waited until the oral proceedings to supplement its case. The board thus considers the oral proceedings a very late stage for presenting new facts and arguments with regard to an alleged course of the oral proceedings before the examining division which is not even reflected in the minutes or the appealed decision, as explained below.



16. The amendments to the appellant's case also raise new issues which would have made necessary further investigation and examination. First, in the board's view, neither the minutes nor the reasons indicate at all that novelty of the subject-matter of the claims of the second auxiliary request was at issue before the first-instance department (see also point 12 above). Therefore, and because the appellant has not challenged the correctness of the minutes by filing for example a request for correction of the minutes with the examining division, the board has doubts as to whether the alleged course of the oral proceedings and the appellant's conclusions therefrom are in fact correct. Second, the board would have had to study in detail document D5 to determine whether its disclosure was indeed of such a nature that it could not have been dealt with during the first-instance oral proceedings.
17. In view of the above, the board decided, exercising its discretion under Article 13(1) RPBA, not to admit the facts and arguments with regard to the discussion of lack of novelty which were submitted for the first time during the oral proceedings before the board (see point XIV (iii) - (v) above).

*Procedural violation*

18. The principle of the right to be heard is laid down in Article 113(1) EPC 1973, which is the provision to be applied in the present case according to Article 7(1), second sentence, of the Revision Act (loc. cit.), since Article 113 EPC is not indicated in Article 1 of the decision of the Administrative Council of 28 June 2001

on the transitional provisions under Article 7 of the Revision Act (loc. cit.).

19. Taking into account the appellant's statement of grounds of appeal, which comprises essentially the party's case as well as the essential facts and arguments as to why it is requested that the decision under appeal be reversed, the board is of the view that no breach of Article 113(1) EPC 1973 took place in the first-instance proceedings, for the following reasons.
  
20. The applicant does not have a right in principle to continuation in writing if the department of first instance introduces a new document for the first time in oral proceedings and thereby changes the subject of the proceedings. Where a new document is first introduced by the examining division in oral proceedings, the party's right to be heard under Article 113(1) EPC 1973 is observed if the applicant is given an adequate amount of time to study the document and present comments (see e.g. decision T 376/98, Reasons, point 4.3, which also refers to T 951/97 (OJ EPO 1998, 440)). It is established jurisprudence that an adjournment of the oral proceedings giving the party sufficient time for an adequate analysis ensures its right to be heard in accordance with Article 113(1) EPC 1973 (see Case Law of the Boards of Appeal, 6th edition, 2010, VI.B.2.2.1). How much time is sufficient depends on the nature of the newly introduced document and the preceding procedure. This is also in line with decision T 951/97 (loc. cit., in particular Reasons, point 4.1), which was cited by the appellant.

21. In the present case, in its communication annexed to the summons to oral proceedings dated 21 January 2009, the examining division already raised an objection (albeit a very general one) of lack of inventive step of all subject-matter contained in the present application in view of D4 and the common general knowledge of a person skilled in the art of optical recording (see point III above). The applicant did not comment on this general remark in its reply (see point IV above). In particular nothing was said about aberration correction mechanisms not being within the common general knowledge of a person skilled in the art of optical recording at the relevant date, even though an aberration correction mechanism was referred to as a means which determined the allowable value of the aberration in the cover layer in claim 1 then on file (i.e. the main request underlying the decision under appeal).
22. At the oral proceedings before the examining division the common general knowledge of a person skilled in the art at the relevant date was not an issue until amended claims according to a second auxiliary request were filed (see point V above). With regard to these claims the examining division took the view that the feature of a spherical surface aberration correction mechanism belonged to the common general knowledge of the skilled person in the field of optical data storage at the date of priority, and that this common general knowledge was already acknowledged in the description of the application, which clearly implied that a spherical surface aberration correction mechanism was known on the priority date and that the object of the application was to take into account this known

mechanism when setting the allowed degree of margin for manufacturers of optical disks (see also point V above).

It was only then that the applicant's representative denied that the use of a spherical surface aberration correction mechanism was publicly known at the priority date. He declared that the description disclosed in-house knowledge of the applicant which was not public at that time (see also point V above). According to the jurisprudence of the boards of appeal, in-house knowledge, or matter which cannot be identified as forming part of the state of the art within the meaning of Article 54(2) EPC 1973, has no relevance for assessing inventive step (see decisions T 1001/98 and T 654/92). Hence, in reaction to the representative's declaration made for the first time at the oral proceedings, the examining division had to introduce a corresponding published document, confirming the common general knowledge of the skilled person in the art which was at issue in the discussion on inventive step of the amended claims of the second auxiliary request, if it wished to use such prior art for assessing inventive step. The examining division did so by introducing document D5. That this did not happen at an earlier stage of the examination proceedings but only at the oral proceedings is comprehensible in view of the fact that, before the oral proceedings, the applicant had not commented on or contested the common general knowledge of a person skilled in the art of optical recording at the relevant date. The board also takes the view that, in principle, it does not matter that document D5 was not a copy of a text book since, in accordance with Article 117(1) EPC, means for giving evidence on common general knowledge of a person

skilled in the art are not restricted to specific documents. The evidential weight as to what constituted common general knowledge might be different, depending on the circumstances of the case. But it does not matter for the present appeal proceedings whether the examining division's assessment that the indicated specific text passages of document D5 reflected common general knowledge was correct. Even if this assessment were incorrect, that would not amount to a procedural violation (see also T 367/91).

In view of the above the board concludes that the fact that, as the appellant submitted, D5 could have been cited earlier with regard to independent claim 14 is not decisive for the question at issue.

23. The board turns now to the question whether the applicant's representative was given an adequate amount of time to study document D5 and present comments in oral proceedings before the examining division. According to the minutes (see point V above), the examining division proposed to adjourn the oral proceedings to give the applicant enough time to study document D5. However, the applicant's representative waived this offer of the examining division. The appellant did not explain in the grounds of appeal why the appellant's representative waived the offer of the examining division to interrupt the oral proceedings to give the applicant enough time to study document D5 and implicitly to give him the opportunity to prepare comments on the issue of common general knowledge for assessing inventive step. The grounds of appeal are also silent on why document D5 is of such a nature that it would have been necessary to continue the

proceedings before the examining division in writing. Nor, in the oral proceedings before the board, did the appellant give any explanation on this issue apart from new facts and arguments with regard to the assessment of novelty and the drafting of new claims, thereby delimiting the claimed subject-matter from the novelty-destroying disclosure of document D5. However, as set out above (points 10 to 17), these facts and arguments were not admitted into the appeal proceedings. It is also not evident to the board why an adjournment of the oral proceedings before the examining division would not have provided the applicant's representative with sufficient time to study the specific passages of document D5 which were indicated by the examining division as being sufficient evidence of the common general knowledge at issue.

24. Finally the board turns to the argument of the appellant's representative that it was not the first time that he had been surprisingly confronted with a new document in proceedings before an examining division in The Hague. First, the board may only give a judgement on the basis of the facts of the present case and not on the course of proceedings of other examination proceedings which are not the subject of the present appeal proceedings. Second, it is the board's view that it should not have come as a surprise to the representative in the present case that the examining division introduced a new document at oral proceedings since this was a reaction to the filing of amended claims according to a new second auxiliary request and the contesting of the common general knowledge of the skilled person in the art at issue for the first time at the oral proceedings.

25. In view of the above it is not apparent to the board that a substantial procedural violation occurred in first-instance proceedings which would justify the setting aside of the appealed decision. Accordingly, the appeal is unallowable.

*Reimbursement of the appeal fee*

26. First the board has to determine whether the provisions of Rule 67, first sentence, EPC 1973 or Rule 103(1)(a) EPC apply to the present case as far as the requirements for reimbursement of the appeal fee are concerned.
27. An application that was filed before 13 December 2007 is, in the sense of Article 2 of the decision of the Administrative Council of 7 December 2006 amending the Implementing Regulations to the European Patent Convention 2000 (*loc. cit.*), subject to the provisions of the revised EPC if the article of the European Patent Convention to which the implementing regulation relates is applicable from the time the revised EPC entered into force (see in detail case J 3/06, Reasons, point 3).
28. Rule 103(1)(a) EPC is linked to Articles 109 and 111 EPC (see also decision J 10/07, Reasons, point 7). According to Article 1 of the decision of the Administrative Council of 28 June 2001 on the transitional provisions under Article 7 of the Revision Act (*loc. cit.*), the provisions of Articles 109 and 111 EPC do not however apply to the present European patent application, which was pending at the time of their

entry into force (see point 1 above). Therefore, in accordance with Article 7(1), second sentence, of the Revision Act revising (loc. cit.), Articles 109 and 111 EPC 1973 continue to apply. Hence, for determining whether the requirements for reimbursement of the appeal fee are met in the present case, Rule 67, first sentence, EPC 1973 is to be considered the relevant legal basis.

29. A request for reimbursement of the appeal fee can be allowed under Rule 67, first sentence, EPC 1973 only in the event of interlocutory revision (Article 109 EPC 1973) or where the board deems an appeal to be allowable and such reimbursement is equitable by reason of a substantial procedural violation. In the present case, however, the appeal cannot be held to be allowable (see points 18 - 25). Hence, the conditions of Rule 67, first sentence, EPC 1973 for reimbursement of the appeal fee are not met. The request for reimbursement of the appeal fee must thus be refused.
  
30. The board finally notes that subsequent to this decision, the grant procedure in respect of the present European patent application can be closed by the first-instance department.



**Order**

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

1. The appeal is dismissed.
  
2. The request for reimbursement of the appeal fee is refused.

The Registrar:

The Chairman:

K. Boelicke

F. Edlinger